O/0752/26

<u>CONSOLIDATED PROCEEDINGS</u>

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. UK00003891414 IN THE NAME OF SULAIMAN SALOOJEE FOR THE TRADE MARK:

IN CLASSES 35 & 41

AND

AN APPLICATION FOR INVALIDITY UNDER NO. 507327 BY CXOSYNC LLC

AND

IN THE MATTER OF APPLICATION NO. UK00004058211 BY SULAIMAN SALOOJEE TO REGISTER:

CXOSYNC

IN CLASSES 35 & 41

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 449678 BY CXOSYNC LLC

BACKGROUND AND PLEADINGS

1. This decision involves consolidated proceedings wherein CXOsync LLC ("CXO") has brought both an application for invalidity and an opposition against trade marks owned by Sulaiman Saloojee ("SS"). I will summarise those proceedings below, beginning with the invalidation proceedings on the basis that they were brought first.

The invalidation for invalidity

2. SS is the proprietor of the first mark shown on the cover of this decision, being that under registration number 3891414 ("the figurative mark"). It was filed on 21 March 2023 and granted registration on 9 June 2023. It stands registered for the following services:

Class 35:	Lead generation services.
Class 41:	Publication of educational texts; Writing and publishing of texts, other than publicity texts; Arranging and conducting of seminars and workshops; Education information; Educational research; Education and instruction services; Online education services; Organisation of conferences, exhibitions and competitions.

3. On 7 May 2024, CXO filed an application for a declaration of invalidity against the above mark. The application is brought under section 47 of the Trade Marks Act 1994 ("the Act") and is reliant upon sections 5(4)(a) and 3(6) of the Act.

4. Under the section 5(4)(a) ground, the opponent relies on the following unregistered signs:

CXOSYNC
("CXO's first sign"); and

CXOSYNC

("CXO's second sign")

5. CXO claims to have used both signs throughout the UK with its first sign being used since 2014 and its second since 2018. It claims to have used them in respect of a range of services including, but not limited to, the following:

> "Arranging and conducting special events for business purposes; Organizing business networking events in the field of Information Technology, Finance, Cybersecurity, Marketing, Human Resources and Healthcare; Organizing, promoting and conducting exhibitions, tradeshows and events for business purposes, these services also extend to virtual experiences, workshops and events."

6. While I appreciate the fact that the services are not 'limited to' the above in CXO's statement of grounds, it is not possible for me to determine what is meant by this. Given that there needs to be specificity in respect of what services are relied upon, I will proceed on the basis that the present ground is limited precisely to the above services only.

7. Under this ground, CXO claims that its longstanding use is such that its business benefits from a significant goodwill in the UK. As such, it is claimed that SS's use of an identical or similar mark on identical or related services amounts to a misrepresentation which, in turn, will cause damage to CXO's goodwill.

8. Under the 3(6) ground, CXO claims that SS had knowledge of CXO's business and use of the 'CXOSYNC' branding. It is also claimed that SS contacted customers of CXO to sell counterfeit services, fraudulently took control of CXO's 'LinkedIn' account and registered a website with an identical name and with identical content to CXO's own website. CXO argues that these actions point to an intent by SS to misrepresent himself as CXO, inevitably causing damage to the brand. It is claimed

that this conduct falls far short of the standards of acceptable commercial behaviour, meaning that the filing was made in bad faith.

9. SS filed a counterstatement wherein he denied the claims against him.

<u>The opposition</u>

10. On 31 May 2024, SS applied for the registration in the UK of the second trade mark shown on the cover page of this decision, being that under number 4058211 (“the word mark”). The word mark was published for opposition purposes on 14 June 2024 and registration is sought for services identical to those listed at paragraph 2 above.

11. On 16 September 2024, the application was opposed by CXO. The opposition is based on sections 5(4)(a) and 3(6) of the Act. The arguments in support of each ground are identical to those relied upon under the invalidation proceedings, being those set out at paragraphs 4 to 8 above.

12. SS filed a counterstatement wherein he denied the claims against him.

13. Upon the filing of SS’s counterstatements, the Tribunal consolidated these proceedings in accordance with the power granted to the Registrar under Rule 62(1)(g) of the Trade Marks Rules 2008. This was communicated to the parties via written correspondence on 19 February 2025.

14. CXO is represented by Sanderana Limited and SS is represented by Trama Legal S.R.O. Both parties filed evidence in chief during these proceedings, with SS filing submissions alongside its evidence. CXO filed evidence in reply. No hearing was requested and only CXO filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

15. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in

accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

16. CXO's evidence in chief came in the form of the witness statement of Rupen Patel dated 23 September 2024. Mr Patel is the CEO of CXO and his evidence is accompanied by 19 annexes, being Annex A to S. His evidence was adduced in order to substantiate the grounds relied upon in both sets of proceedings.

17. SS's evidence came in the form of the witness statement of Mr Igor Demcak dated 3 February 2025. Mr Demcak is the Executive Director of SS's representative and is, therefore, authorised to file evidence on his behalf. Mr Demcak's witness statement is accompanied by nine exhibits, being ID1 to ID9, and was adduced in order to refute the claims against SS.

18. In reply, CXO filed the second witness statement of Mr Patel dated 3 April 2025. This statement was accompanied by four exhibits, being RP1 to RP4, and was adduced in direct response to Mr Demcak's evidence and SS's submissions.

19. I will refer to points from the evidence or submissions where necessary.

DECISION

<u>My approach</u>

20. I have confirmed above that the claims in support of each of the grounds relied upon in the invalidation are identical to those relied upon in the opposition. As such, I will take the approach of considering the grounds across both sets of proceedings together, whilst having regard to the different relevant dates, which I will detail below. Before proceeding, I note that sections 5(4)(a) and 3(6) of the Act have

application in invalidation proceedings by virtue of section 47 of the Act, which states as follows:

"47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

[…]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) […]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[…]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

> (6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

Section 5(4)(a)

21. Section 5(4)(a) of the Act reads as follows:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) …..
> >
> > (b) …..
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

22. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

23. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon case (Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

24. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

<u>Relevant Dates</u>

25. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

26. The figurative mark was filed on 21 March 2023 and the word mark was filed on 31 May 2024. Neither mark has a priority date and SS has filed no evidence of any earlier use that could be said to be the behaviour complained about. As such, the relevant date for the invalidation proceedings is 21 March 2023 and the relevant date for the opposition is 31 May 2024.

Goodwill

27. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

28. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

29. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

30. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by *s.2(2) of the Trade Marks Act 1994*. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark [1969] R.P.C. 472*. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

31. Goodwill results from trading activities in the UK. The evidence confirms that CXO has used its mark globally in respect of services such as ‘lead generation events’ and ‘arranging and conducting special events for business persons’. It began offering its services under the first sign in the UK in 2014 and the second sign in 2018. Screenshots from CXO’s website from 2020 (showing the word only use of the first sign in the domain name and the second sign on the site itself) are provided in evidence.[1] In order to demonstrate the level of sales, CXO has provided a number of invoices.[2] It is noted that the narrative evidence sets out that the invoices are only a representative example of use and that the evidence includes a breakdown of annual revenue. However, no such breakdown has been provided and despite the claims that the invoices are only representative examples, I have no overarching level of use to assist with this point.

32. Having considered the invoices, there are 17 provided and they are dated between 16 December 2015 and 6 April 2022. They appear to show the offering of services

[1] See page 1 of Annex P
[2] Annex S.

in line with the organisation of events in London. For example, each invoice refers to the name or location of an event, with one referring to an event dinner being hosted. It is noted that none of the invoices demonstrate repeat custom. The narrative evidence explains that these are invoices sent to UK customers for UK events. However, only six of the invoices show UK customers and I do not consider the reference to the event taking place in London automatically means that the customers are UK-based. Therefore, despite what the narrative evidence states, the fact that 11 of the 17 invoices are not expressly to UK customers leads me to cast doubt on the claim in the narrative evidence. On this point, I remind myself that in order to sustain a claim for passing off, customers in the UK are required.[3] Therefore, those invoices to customers that I cannot determine as being UK customers are of no assistance here.

33. In addition, CXO sought to file evidence in reply introducing further examples of trading activities.[4] This includes a range of quotes, proposals and agreements as well as duplicates of invoices already filed as evidence in chief. Having considered the additional documents, the same issue arises in that while the events may have been in London, there is no evidence as to the customer's location. Further, where proposals are provided, there is nothing to demonstrate that the client actually proceeded with the service offered. For example, there is a proposal from 2019 for 'SurveyMonkey'[5] but there are no corresponding agreements or invoices to confirm that the client accepted the proposal. Lastly, I note that some of these documents do not reference the relevant branding. For example, one proposal for 'LivePerson Inc.' fails to reference 'CXOsync' but simply refers to 'CMOdinner – London'.[6] Again, I struggle to see how any goodwill stemming from such a service would be associated with the signs relied upon.

34. I appreciate that there is a degree of generality in CXO's evidence in that the invoices are referred to as being a representative example to be considered in light of a breakdown of annual revenue. However, no such breakdown is included in

[3] *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others,* [2015] UKSC 31
[4] RP1
[5] See page 4 of RP1
[6] See page 3 of RP1

CXO's evidence, which causes significant problems for CXO. This is because the evidence I has discussed above is representative of a low level of use. Whilst a low level of use may give rise to a finding of goodwill,[7] I am of the view in the present case, it does not. This is because the only cogent evidence I have of UK use comes from just six UK invoices over a period of seven years with no evidence of repeat custom. Further, the additional documents relied upon do not assist in demonstrating that CXO had a sufficient number of UK customers and neither do they show the actual extent of CXO's trading activities in the UK prior to the relevant dates. In short, I appreciate that CXO was conducting some form of business in the UK but I do not consider that it was at a level that adequately demonstrates that its business enjoyed goodwill in the UK as at the relevant dates. As such, I find that the present ground fails in its entirety under both the opposition and the invalidation application.

35. I will now proceed to consider the section 3(6) ground.

Section 3(6)

36. Section 3(6) of the Act states:

> "(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

37. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

> "(i) […]
>
> (ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

[7] See *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, for example.

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*"), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro*

Inc v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

38. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. the balance of probabilities). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

39. It is necessary to ascertain what SS knew at the relevant date: *Red Bull* (cited above). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

40. The relevant dates for the present assessment are the same as those under the section 5(4)(a) ground above, being 21 March 2023 for the invalidation and 31 May 2024 for the opposition.

41. In considering claims under the present ground, I remind myself of the case of *Alexander Trade Mark*, BL O/036/18, wherein the key questions for determination in a claim of bad faith were set out as being:

    (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

    (b) Was that an objective for the purposes of which the contested application could not be properly filed? and

    (c) Was it established that the contested application was filed in pursuit of that objective?

42. Dealing with the above questions in turn, I note that, under the present ground, CXO claims that SS had knowledge of CXO's business and use of the 'CXOSYNC' branding. It is claimed that, with this knowledge, SS went on to contact customers of CXO to sell counterfeit services, fraudulently take control of CXO's 'LinkedIn' account and register a website with an identical name and identical content to CXO's own website. CXO's position is that these actions were undertaken so that SS could misrepresent himself as CXO, culminating in the application for the marks at issue. CXO argues that these actions reflect conduct that falls far short of the standards of acceptable commercial behaviour.

43. In considering the second question set out in *Alexander*, I am satisfied that the claimed objectives of SS are such that, if proven, would mean that neither of his marks could have been properly filed. As a result, I must now move to consider the third question set out in *Alexander*, namely whether it has been established in evidence that the marks were filed in pursuit of that objective.

44. The evidence of CXO was provided by Mr Rupen Patel (who, for reasons that will become obvious below, I will refer to as Mr R. Patel). His evidence sets out that CXO was founded in 2008 and, since then, it has used the 'CXOSYNC' branding globally. Evidence of the claimed first use of 'CXOSYNC' is provided by way of an invoice to an American company on 2 December 2008.[8] Whilst of no assistance to demonstrating use in the relevant territory, it clearly indicates that, as of 2008, CXO was using the 'CXOSYNC' branding. Further, the 'CXOSYNC' logo (being that identical to the figurative mark) is confirmed to have been adopted by CXO in 2018. There is nothing before me to confirm this but I note the presence of a printout of CXO's '.com' website from 2020 that shows the use of the figurative mark.[9] Therefore, I am satisfied that CXO adopted the figurative mark by 2020 at the latest.

45. In terms of CXO's relationship with SS, the evidence sets out that SS was initially employed by CXOsync Limited (being the company through which CXO conducted its business in the UK)[10] between June 2018 and February 2023. It is explained that he was hired by CXO's former owner and director, being Mr Nipul Patel (who I will refer to as Mr N. Patel), and that, during his employment, he operated at CXO's UK satellite office. In respect of Mr N. Patel, the evidence confirms that he passed away due to COVID-19 in 2021, at which point Mr R. Patel (his brother and the witness to these proceedings) took over ownership of CXO.

46. Evidence is provided that shows SS initially contacted Mr N. Patel via email on 11 June 2018.[11] The email chain includes reference to SS offering to work for CXO.

[8] Page 1 of Annex B
[9] Annex P
[10] See paragraph 1 of Mr R. Patel's first witness statement.
[11] Page 1 of Annex A

An employment agreement between CXO and SS is provided which was signed by SS (and SS only) on 14 June 2020.[12] In addition, a number of payslips from CXOSYNC LTD are provided that show payments made to SS between 30 April 2019 and 31 July 2019.[13] These payslips pre-date the signing of the agreement.

47. On the point of whether SS was employed by CXO or not, it is noted that he claims to have been an independent contractor. In support of this, a contract dated 20 June 2018 is provided that demonstrates that SS and CXO, at that time, entered into an independent contractor relationship. In respect of the employment contract adduced by CXO, SS alleges, via submissions, that it is fraudulent and not valid. The reasons for this are extensive but essentially boil down to the fact that it is signed digitally and that there is nothing to prove it was authorised by SS. In addition, the submissions refer to a discrepancy with the dates in that CXO claimed employment began in 2018 but the document is signed in 2020. In response to this point, an email dated 14 June 2020 is provided (that includes the figurative mark at issue in these proceedings) from SS regarding the signing of the employment contract filed by CXO.[14] The cover email sets out that the document is signed but that SS tweaked a number of clauses to reflect various points he wished to make. It is noted that this email came from 'PandaDoc' (seemingly an online document signing service) but makes direct reference to SS's CXO email address. In light of this and absent any actual evidence rebutting the point from SS himself, I am content to conclude that it was SS who (digitally) signed the document.

48. In further support of CXO's position regarding the nature of the parties' relationship, a text conversation between SS and Mr R. Patel is provided in evidence wherein SS states, on 1 February 2023, that "its stressful for us as employees".[15] Clearly, this is an acknowledgment of his position as an employee. The evidence in chief from Mr R. Patel goes on to explain that it became clear to CXO that SS was attempting to take CXO's goodwill and intellectual property to divert business away from CXO. It is explained that, at that point, CXO decided to terminate SS's

[12] Pages 2 to 33 of Annex A
[13] Pages 34 to 37
[14] See the first page of RP3
[15] Annex R

employment via email on 25 February 2023. A copy of this email is provided and it is noted that it expressly states that SS would receive his final pay check *as an employee, not as a contractor*.[16]

49. Taking all of the evidence into account regarding SS and CXO's relationship, I am of the view that it shows that SS was an independent contractor of CXO from June 2018 to June 2020. However, from June 2020 until February 2023, I am content to conclude that SS was an employee of CXO. In any event, regardless of the actual nature of the relationship, the evidence demonstrates that the parties had some form of a professional relationship between June 2018 and February 2023.

50. On 21 March 2023, just one month after the relationship ended, SS applied to register the figurative trade mark that CXO now seeks to invalidate. It was not until over a year later on 31 May 2024 that SS applied for the word only trade mark of 'CXOSYNC'. The applications were filed for a range of services, including lead generation services, publishing services, educational services and organisation of event services. Insofar as the services relate to lead generation and organisation of events, they operate in the same sectors as those for which CXO's evidence confirms that its business relates to.[17] Further, whilst I did not find the evidence sufficient to demonstrate goodwill, it does show that CXO did offer some of its event services in the UK prior to the relevant date.

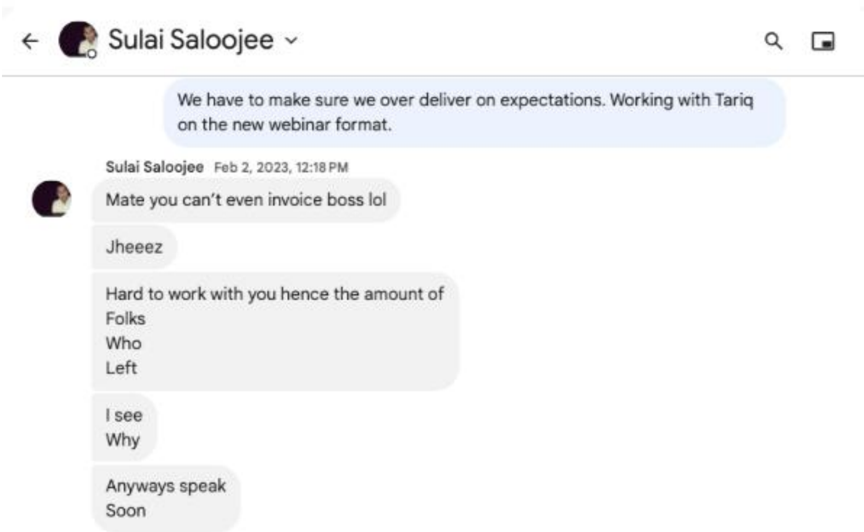
51. I now turn to consider the evidence as to the alleged actions of SS in the lead up to filing for the disputed marks.

52. The first instance complained of occurred on 15 September 2022 when CXO received an email from a customer inquiring about messages they had received from an email address with the domain name 'cxosync.uk'.[18] The customer forwarded the email to CXO and it includes the offering of event organising services from 'erik@cxosync.uk'. In response, CXO confirmed that it was not an email from

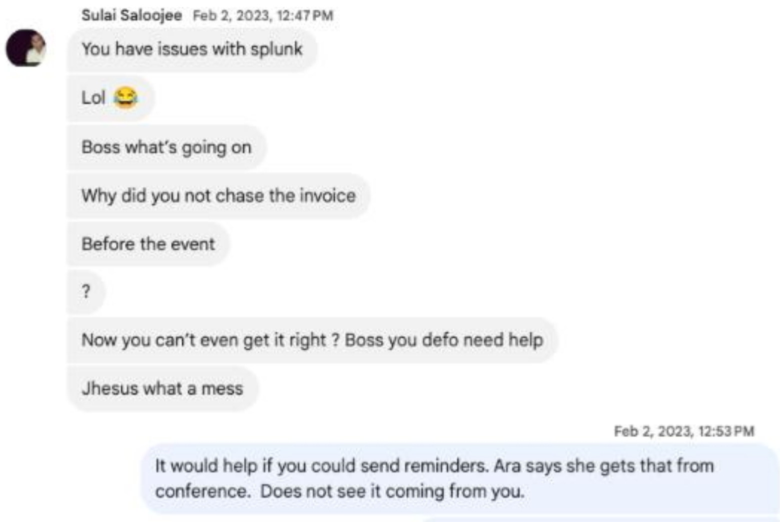
[16] Annex G
[17] See paragraph 3 of the first witness statement of Mr R. Patel
[18] Exhibit D

an employee of theirs and that they would look into the matter. It is explained at this time that CXO was unaware who the owner of this website was. From my own assessment of this evidence, I can see that the address associated with the contact who emailed CXO's client was shown as 'International House, 142 Cromwell Road, London, SW7 4EF'. On this point, I note that Mr Damcek's evidence introduces a printout of the LinkedIn page for SS's company which (1) lists this same address as being its primary location and (2) confirms SS as being an employee of the same.

53. In February 2023, CXO received a payment notification from an existing customer called 'Splunk Services UK Limited'. CXO was not aware of the order the payment referred to and, upon further investigation, noted that the contact for the order was SS. A printout of a 'vendor onboarding questionnaire' is provided to demonstrate this.[19] It is this transaction that is cited in CXO's email to SS (discussed above) as the reason for CXO terminating the contract of SS. CXO's evidence includes a text exchange between Mr R. Patel and SS on 2 February 2023 wherein 'Splunk' is mentioned during what appears to be an argument between the two.[20] For illustrative purposes, the text exchange is as follows:



[19] Annex E
[20] Annex P



54. CXO's evidence goes on to claim that SS fraudulently contacted its customers to sell what CXO refers to as "counterfeit services". This is supported by an email chain from April 2024 between CXO and a customer wherein the customer was making an SAR request following an email from an address associated with 'CXOsync.uk'. [21] The original email from 'CXOsync.uk' was forwarded as part of the SAR request and it includes an invite for the customer to be a private guest at a dinner with CXOsync.uk and others in Helsinki in May 2024. In response, CXO sought to clear up the issue as the email complained about was not from CXO. This evidence post-dates the relevant date for the invalidation proceedings but, as set out above, evidence from after the relevant date may be of assistance if it casts light backwards on the position as at that time. Lastly in respect of this evidence, it is noted that the address shown in the email from what CXO refers to as the "fraudulent company" is the same as that discussed at paragraph 52 above.

55. In addition, CXO claims that SS took control of CXO's LinkedIn account and created fake profiles and posted announcements to CXO's community. Screenshots of various posts are shown[22] and I note that some of them are from SS and refer to CXOSync UK. However, these are not dated so I am unable to determine when they were made but again, I remind myself that even if they were

[21] Annex I
[22] Annex J

after the relevant dates for both proceedings, they may still be of assistance as casting light on SS's intentions prior to the filing of the marks at issue.

56. Throughout the evidence, reference is made to attempts by SS to secure similar website domains to that of CXO[23] and images of SS's website are provided which are claimed to be exact copies of CXO's website.[24] On the latter point, a side by side comparison of the websites 'cxosync.uk' and 'cxosync.com' (from 2020) is provided in evidence and whilst these are not identical, both use the figurative mark.[25]

57. In response to the claims against him, SS filed evidence in the name of his attorney. Such evidence introduces a witness statement from SS himself, dated 30 September 2024.[26] This appears to be evidence introduced into a domain name dispute between the parties as opposed to evidence prepared for the purpose of these proceedings. On this point, I refer to paragraph 20.1 of Practice Direction 32 of the Civil Procedure Rules, which states that:

> "20.1 A witness statement is the equivalent of the oral evidence which that witness would, if called, give in evidence"

58. As the statement provided was given in proceedings before a separate tribunal, it is not capable of satisfying the above requirement. In short, SS is not a witness in the present proceedings. In considering the nature of this evidence, I remind myself of section 1(2) of the Civil Evidence Act 1995 ("the CE Act") which states that:

> (2) In this Act—
>
> (a) "hearsay" means a statement made otherwise than by a person while giving oral evidence in the proceedings which is tendered as evidence of the matters stated; and

[23] Annex L and Annex M
[24] Annex N
[25] Annex P
[26] ID4

(b) references to hearsay include hearsay of whatever degree.

59. As above, SS is not a witness in these proceedings meaning that his statement is, clearly, hearsay. In estimating the weight to be given to such evidence, I draw attention to section 4 of the CE Act which sets out that:

(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following—

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.

60. In considering the above factors in turn, I am of the view that, firstly, it is entirely practical to suggest that SS, as a party to these proceedings (and one who is facing

direct allegations over his own personal actions), should have filed his own evidence before the Tribunal. Secondly, the statement is dated 30 September 2024 and as I will discuss below, the events discussed stem from prior to August 2021 so the evidence is contemporaneous to the extent that it was made during the same period as the events stated. Thirdly, the nature of the evidence is hearsay but it also contains statements of ‘multiple hearsay’ in that it attempts to speak to comments or actions of a deceased third party who is unable corroborate or deny the statement. For example, it states that Mr N. Patel “put his trust” in SS. As for the fourth and fifth factors, I have nothing before me to suggest that either of these factors apply and, in short, they are serious allegations that would require cogent proof. Lastly, the nature of the filing means that CXO did not have the ability to scrutinise the veracity of the evidence by way of applying for cross-examination. Therefore, the evidence *could* be said to be filed in this way to attempt to prevent a proper evaluation of its weight.

61. In short, I consider that attempting to rely on a statement that was made during separate non-UK IPO proceedings is not reasonable or appropriate, especially when said statement was introduced merely as an exhibit to another person’s witness evidence. In light of what I have said above, I am of the view that the statement of SS should be given little weight in these proceedings.

62. Having considered SS’s hearsay statement, any evidence of note comes via reference to ‘informal discussions’ with Mr N. Patel *before* his passing. In short, SS claims that it was Mr N. Patel’s wish that SS continued the work they built together without any interference. It is also claimed that there was a verbal agreement that SS was given permission to register the trade marks. In response to these points, CXO’s evidence in reply (which comes from Mr N. Patel’s brother, Mr R. Patel), refutes that Mr N. Patel would ever allow someone else to use his intellectual property rights or to verbally assign them. I appreciate that this is merely Mr R. Patel’s opinion but I note that, in support of this point, he refers to clause 17 of the employment contract with SS which he claims to show a restrictive approach to

intellectual property rights.[27] It is claimed that this reflects Mr R. Patel's view that it was always Mr N. Patel's wish to control the intellectual property associated with CXO. Having considered the clause referred to, I note that it relates to designs, copyrights and patents. In short, it sets out that any invention or works made or created by SS that could relate directly or indirectly to CXO shall be held on trust for CXO and be assigned to CXO. As far as I understand it, this is a fairly ordinary approach to the ownership of Intellectual property created in the course of employment and I have nothing before me to suggest otherwise.

63. In considering the claims regarding these alleged agreements between Mr N Patel and SS, I make the following observations:

    a. There is nothing accompanying SS's statement to support the claims made and, further, there is no real specificity surrounding the events described. For example, it is noted that the discussion took place *before* Mr N. Patel passed away but there is no reference as to when or where said discussions took place or what prompted them.

    b. The convenience of the discussions referred to by SS taking place with Mr N. Patel, who has since passed away, is not lost on me. The fact that Mr N. Patel has now passed away means that he is unable to refute or corroborate these allegations. On this point, I appreciate that someone suffering from a long term ailment that causes their passing may turn their mind to what will happen with their company after their death and make the necessary arrangements. However, this is nothing before me to suggest whether or not N. Patel was suffering from such an ailment to suggest that he was likely to seek such arrangements with SS.

    c. While he does not speak with first-hand knowledge of the situation, Mr R. Patel did seek to make some points in reply regarding his own understanding of his brother's view on intellectual property. While merely opinion, I do acknowledge

[27] See pages 16 and 17 of the agreement at Annex A of Mr R. Patel's first statement.

Mr R. Patel's reference to the use of clauses regarding intellectual property in the employment contracts associated with his business. While not indicative of an unusually restrictive approach to employment contracts, it does indicate an awareness of intellectual property rights and, on balance, I consider that it would be unusual for such a person to assign any rights in his company on an unwritten basis.

d. Given the existence of two separate contracts between CXO and SS, it is surprising that no such agreement was ever formulated in writing to confirm the position as to the alleged agreement. Even if no agreement was drawn up, I consider it reasonable to expect to see some form of follow up correspondence from after these alleged meetings confirming the nature of any agreement made.

64. As it was SS who alleged the existence of an agreement with Mr N. Patel, the burden to prove this point fell directly to him. Taking all of the above into account, I do not consider that SS's hearsay evidence sufficiently proves that he obtained the relevant permissions/agreements with N. Patel to take over CXO's trade mark rights. As such, I see no merit in the primary line of SS's defence, namely that the rights to the brand name were passed to him.

65. In addition to the above, SS's evidence makes reference to the fact that 'CXOSYNC LTD', being the UK-subsidiary of CXO, was dissolved on 11 June 2019.[28] However, this dissolved company shows a different registered company number (10737248) than that of 'CXOsync Limited' (being 12097642) as referred to in the employment agreement discussed at paragraph 47 above (which postdates the June 2019 dissolution, thereby implying that a new or different company existed after that time). Further, it is shown that CXO itself entered into involuntary dissolution in the USA on 10 May 2024.[29]

[28] ID5
[29] ID6

66. In response to the above points, Mr R. Patel explains that the UK company was dissolved in 2019 because there was nobody to sign the paperwork and that its purpose was to handle UK taxes. While he makes no comment as to the company covered by the different UK registration number referred to in the employment agreement, Mr R. Patel does confirm that the employment activities and sales in the UK were always controlled by CXO. As for the USA registered company (being CXO itself), Mr R. Patel confirms that a petition to revive the company was filed. A printout from The Office of the Illinois Secretary of State is provided that shows, as of 14 October 2024, CXO was an active company.[30] As a result, I do not see that the status of CXO has any bearing on the present proceedings as it remains an active company.

67. SS also seeks to rely on positive reviews of his company. This comes via both Reddit and Google reviews.[31] Reference is made to the reviews being posted between '7 days ago' and '3 months ago'. However, the printout introducing the posts is undated, meaning that I have nothing to suggest when these posts were made. Lastly, a LinkedIn printout is shown for 'CXOsync UK', which I note is undated.[32] While this evidence is noted, the activities of SS's company are not relevant to these proceedings as the purpose of the present assessment is to determine whether the marks were applied for in bad faith. If they were, then the operations of SS's company (regardless of its success or size) thereafter are of no consequence.

<u>Conclusion of section 3(6) ground</u>

68. As an employee or independent contractor of CXO, it is highly likely that SS would have had knowledge of CXO's operations in the UK. Further, it is clear that he was well aware of CXO's branding under both the word and figurative marks. On the latter point, I remind myself that the email surrounding the signing of the employment agreement in June 2020 was emblazoned with the figurative mark so

[30] RP4
[31] ID8
[32] ID9

I have no doubt that SS was fully aware of its use by CXO from that point at the earliest. While a relevant factor, this alone does not mean that filing for the marks at issue was in bad faith as there must be something more to indicate a dishonest filing.[33]

69. As the evidence of the text message exchange reproduced above and the nature of CXO's termination email to SS suggest, there was some animosity between SS and Mr R. Patel in the lead up to SS's first filing. Further, it is noted that SS has not directly sought to refute that it was he who was behind the actions described in the evidence discussed at paragraphs 52 to 55 above. On this point, I have explained above that the address of 'CXOsync.uk' is one that was directly associated with SS via his own LinkedIn evidence. Therefore, I am content to conclude that the actions of this company can be linked to SS and, again, there has been no denial of any association between SS and that company during this time.[34]

70. In my view, the above actions demonstrate an attempt to redirect custom from CXO to SS's new company and to mislead CXO's customers into thinking the services were provided by CXO when they were not.[35] This is especially the case given the use of 'cxosync.uk' as a website and email address domain. Clearly, such a website and domain were used to encourage the contact to believe that the communication was from CXO. When it came to the surface that SS was behind this, CXO terminated his employment/contract. Just one month later, SS filed his first trade mark application. The coincidence of the timing of this application is not lost on me. Further, the application for a mark identical to the distinctive branding used by CXO cannot, in any way, be said to be coincidental.

71. I remind myself that, under bad faith claims, consideration may be given to the extent of the reputation enjoyed by the sign at the time it is filed.[36] I appreciate that CXO's use is limited so failed to establish a protectable goodwill in the UK.

[33] *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH,* Case C-529/07
[34] While some of this evidence is from after the relevant date for the invalidation proceedings, I am content to conclude that such activity casts light backwards on the position as at the relevant date.
[35] I repeat that while the evidence of CXO was not sufficient to find goodwill, the evidence does show an active attempt to take custom from CXO.
[36] See paragraph 46 and 47 of *Lindt*

However, there were some attempts to offer event services in London and to UK customers prior to the relevant dates. In any event, the lack of an established and protectable goodwill under the provisions of section 5(4)(a) of the Act does not mean that SS's actions were automatically in good faith, especially when SS was directly involved with CXO's activities within the UK prior to February 2023.

72. In the present circumstances, I am of the view that the evidence of CXO gives rise to a *prima facie* case of bad faith in that SS conducted himself in a way that falls far short of the standards of acceptable commercial behaviour by appropriating CXO's name without any legitimate basis for doing so. At that point, the burden shifted to SS to respond and there was clearly a case for him to answer. However, while evidence was filed on his behalf, it was in the name of his legal representative who is not best placed to speak directly to SS's intentions. It is noted that he also filed submissions but these also cannot suitably speak to SS's intentions because they do not form evidence of fact. On this point, I note that at paragraph 38 of his submissions, for example, SS set out that the incorrect invoices (seemingly being the 'Splunk' invoices referred to at Annex E of CXO's evidence in chief) appear to result from administrative errors as opposed to deceit. While noted, this comment was introduced as a submission from SS's representative and is, in my view, a mere supposition. Further, it is not something that is duly supported by a statement of truth so cannot, therefore, form evidence from SS himself as to his true understanding of the invoices complained of.

73. The only comment from SS himself came via unsupported and unreliable hearsay evidence. Having considered SS's submissions in full, this statement and the alleged agreement with Mr N. Patel form the crux of his defence but, for the reasons set out above, I do not consider that forms a satisfactory defence. In addition, and as explained above, there was no attempt to actively refute, in evidence, that it was SS behind the entity that sought to contact CXO's clients and that which took payment for services provided to Splunk under the CXOSYNC branding.[37] Lastly, it is noted that SS's evidence mostly sought to deflect the claim by alleging that

[37] Again, the submissions of SS seem to make some allegation that these were erroneous invoices but this is not supported via any actual evidence of fact.

CXO was no longer an active company and by filing a range of his own company's reviews and social media profiles to demonstrate his own alleged success. Such evidence does not refute the case put forward by CXO that his actions were in bad faith.

74. In light of SS's hearsay evidence being of no assistance, I find that he has failed to rebut the *prima facie* case against him. He has provided no reasonable explanation for why, in September 2022, he began contacting CXO's customers using the 'cxosync.uk' branding. In the circumstances, I have no alternative but to accept that he sought to misrepresent himself as CXO with an aim to redirecting CXO's business to himself via his own company. On this point, I acknowledge the limited nature of CXO's business but the evidence sufficiently demonstrates that CXO was at least seeking to establish a business in the UK,[38] even if it had not gotten as far as establishing a protectable goodwill as at the relevant dates.

75. SS's actions continued over the course of several months, leading to his ultimate dismissal from the company in February 2023 and I fail to see how, just over one month later, applying to register a mark identical to that which he knew was being used by CXO in the UK (or at least one that CXO was attempting to use) was in line with the standards of acceptable commercial behaviour. While the application for the word only mark was over a year later (in May 2024), the evidence sets out that SS was still seeking to misrepresent himself as CXO in April 2024. Therefore, I consider that the same finding applies equally to the word-only mark.

76. In conclusion, I find that both of SS's applications in issue were filed in bad faith as they fell far short of the standards of acceptable commercial behaviour. For the avoidance of doubt, I consider that the actions of SS are such that this applies to all of the services applied for, be that those that are relatively close to CXO's attempted business operations or not. As a result, the present ground succeeds in full in respect of both sets of proceedings.

[38] And that SS would have been aware of this, especially being a UK-based employee of the company. For the avoidance of doubt, even if he was not an employee, he would have been aware of CXO's activities due to his relationship with said company.

CONCLUSION

77. The invalidation application succeeds in full and, subject to any successful appeal against my decision, the trade mark under registration number 3891414 is hereby declared invalid in its entirety and the application is deemed never to have been made. Additionally, the opposition has succeeded in full and, again, subject to any successful appeal against my decision, the applied for trade mark under number 4058211 is refused registration for all services applied for.

COSTS

78. CXO has succeeded and is, therefore, entitled to a contribution towards its costs. In the circumstances, I award CXO the sum of £2,400 as a contribution towards its costs. The sum is calculated as follows:

Preparing an application for invalidity and considering a counterstatement	£300
Preparing a notice of opposition and considering a counterstatement	£300
Preparing evidence, considering the evidence of the opponent and filing evidence in reply:	£1,000
Written submissions in lieu of a hearing:	£400
Official fees:	£400
Total:	**£2,400**

79. I hereby order Sulaiman Saloojee to pay CXOsync LLC the sum of £2,400. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 19th day of August 2026

A COOPER
For the Registrar