BL O/0900/25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NUMBER 3789940

BY PETER SMALLWOOD

TO REGISTER THE FOLLOWING TRADE MARK:

larry the lamb

IN CLASSES 38 AND 41

AND

IN THE MATTER OF OPPOSITIONS THERETO

UNDER NUMBERS 436206 & 436228

BY RENOWN PRODUCTIONS LIMITED AND

TALKING PICTURES TV LIMITED

Background And Pleadings

1. On 19 May 2022 (“the relevant date”), Peter Smallwood (“the applicant”) applied to register the trade mark “larry the lamb” under number 3789940 (“the application”). The application was published in the Trade Marks Journal for opposition purposes on 10 June 2022 in respect of the following services:

> Class 38: Broadcasting; Broadcasting services; Broadcast services; Satellite broadcasting; Broadcasting (Television -); Video broadcasting; Television broadcasting; Cable television broadcasting; Broadcasting (Cable television -); Satellite television broadcasting; Satellite broadcasting services; Internet broadcasting services; Data broadcasting services; Television broadcast transmissions; Television broadcasting services; Subscription television broadcasting; Television programme broadcasting; Subscription television broadcasting services; Broadcasting of teleshopping programmes; Broadcasting of television programs; Broadcast transmission by satellite; Cable television broadcast services; Radio and television broadcasting; Broadcasting of television programmes; Television and radio broadcasting; Broadcast of television programmes; Cable television broadcasting information; Broadcast of cable television programmes; Television and/or radio broadcasting; Broadcasting of programmes by television; Television programme broadcasting via cable; Interactive television and radio broadcasting; Radio and television program broadcasting; Radio and television programme broadcasting; Radio and television broadcasting services; Broadcasting of cable television programs; Cable and satellite broadcasting services; Broadcasting of programmes by satellite; Broadcasting of motion pictures by satellite; Broadcasting of motion pictures by television; Rental of satellite broadcast receiving antenna; Broadcasting of radio and television programmes; Broadcasting and transmission of television programs; Broadcasting of radio and television programs; Television and radio transmission and broadcasting; Satellite broadcasting services relating to entertainment; Broadcasting of programmes via the internet; Broadcasting and transmission of radio programs; Television broadcasting services for mobile phones; Wireless transmission and broadcasting of television programmes; Broadcasting programs via a global computer network; Broadcasting and transmission of cable television programs; Broadcasting of television programs via the Internet; Broadcasting of motion picture films via the Internet; Audio and video broadcasting services provided via the Internet; Radio and television broadcasting, also via cable networks; Broadcasting and transmission of pay-per-view television programs; Broadcasting of video and audio programming over the Internet; Broadcasting of audiovisual and multimedia content via the Internet; Broadcasting of television and radio programs via cable or wireless networks; Broadcasting of radio and television programs via cable or wireless networks; Simulcasting broadcast television over global communication networks, the Internet and

wireless networks; Audio, video and multimedia broadcasting via the Internet and other communications networks; Transmission of digital audio and video broadcasts over a global computer network.

Class 41

Television entertainment; Television production; Television program production; Television show production; Television programme production; Satellite television shows; Satellite television series; Radio and television entertainment; Production of television films; Presentation of television programmes; Production of television programmes; Production of television features; Preparation of television programmes; Production of television programs; Television and radio entertainment; Television and radio entertainment services; Production of cable television programs; Entertainment provided by cable television; Entertainment by means of television; Production of television entertainment programmes.

2. On 12 September 2022, Renown Productions Limited and Talking Pictures TV Limited, ("the opponent") filed notices of opposition, opposing the application in full under sections 3(1)(b), (c), 3(6) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). As the opponents are connected, the oppositions were consolidated, and I shall therefore refer to them in the singular.

3. The basis for each ground of opposition is set out below:

s.3(1)(c): it is claimed that the application is descriptive of the fictional character Larry the Lamb, depicted in the works carried out by the opponent. In other words, it is claimed that the application will merely be viewed "as describing the title or subject matter of the works, productions or broadcasts…and / or a character by the name of Larry the Lamb featured in such works, productions or broadcasts."[1]

s.3(1)(b): the opponent claims that the application is devoid of distinctive character. The notice of opposition outlines these grounds under the same heading and there is no notable difference to the reasons set out in respect of the s.3(1)(c) claim.

s.3(6): at the time of filing the application, "the applicant was aware that the Opponent and / or companies within the Opponent's group were broadcasting the Series under the sign [2]*Lamb the Lamb / Stories from Toytown featuring Larry the Lamb*, and / or the Opponent and / or its group of companies had an

[1] Para 21 of the TM7

[2] I take this and the subsequent reference to Lamb the Lamb as being a typographical error and it should read Larry the Lamb.

interest in broadcasting and / or producing works under the sign *Lamb the Lamb / Stories from Toytown featuring Larry the Lamb*."[3]

The opponent also claims that the applicant did not have a *bona fide* intention to use the mark in the course of trade. Instead, the intention was to frustrate the business of the opponent and its legitimate interests.

s.5(4)(a): the opponent claims that since at least February/March 2022 it has been operating a business throughout the UK under the signs LARRY THE LAMB and STORIES FROM TOYTOWN FEATURING LARRY THE LAMB. It is claimed that the services offered under the signs are as follows:

> Broadcasting, transmission and / or production services; provision of entertainment; satellite television entertainment services; television entertainment services; preparation and / or production or television programmes, series, films, audio and / or audio-visual works; television productions and / or programmes; provision or advice and information in relation to television programmes, films, audio and / or audio-visual works; provision of advice and information in relation to all the aforementioned services.

4. It is claimed that use of the application "would misrepresent a connection with the Opponent, and / or the Opponent's business and / or the Opponent's trade in the Opposed Services."[4] As a result of the alleged misrepresentation it is claimed that this would cause damage to the opponent's business which would amount to passing off.

5. The applicant filed a defence and counterstatement denying all the opponent's claims but admitted that the marks are identical. The applicant was informed that the "evidence" attached to the Form TM8 counterstatement was not in evidential format and therefore would not be considered, but I do note that it appears to have later been filed at the appropriate time and in the correct format. Therefore, it is admitted, acceptable and shall be taken into account.

6. The applicant is unrepresented. The opponent is represented by Greaves Brewster.

7. Neither party asked for an oral hearing, but both parties filed written submissions in lieu. I will not summarise the submissions here, but I will refer to them as and where appropriate during this decision. This decision is taken following careful consideration of the papers.

Evidence

8. Both sides filed evidence. This comprises of the following:

[3] Para 9 of the TM7
[4] Para 18 of the TM7

Opponent's evidence

- Witness statement from Corinna Hiscox plus exhibits CH1&2
- Two witness statements from Sarah Cronin-Stanley plus exhibits SC1-SCS47
- Witness statement from David Woodward plus exhibits DW1 and DW2

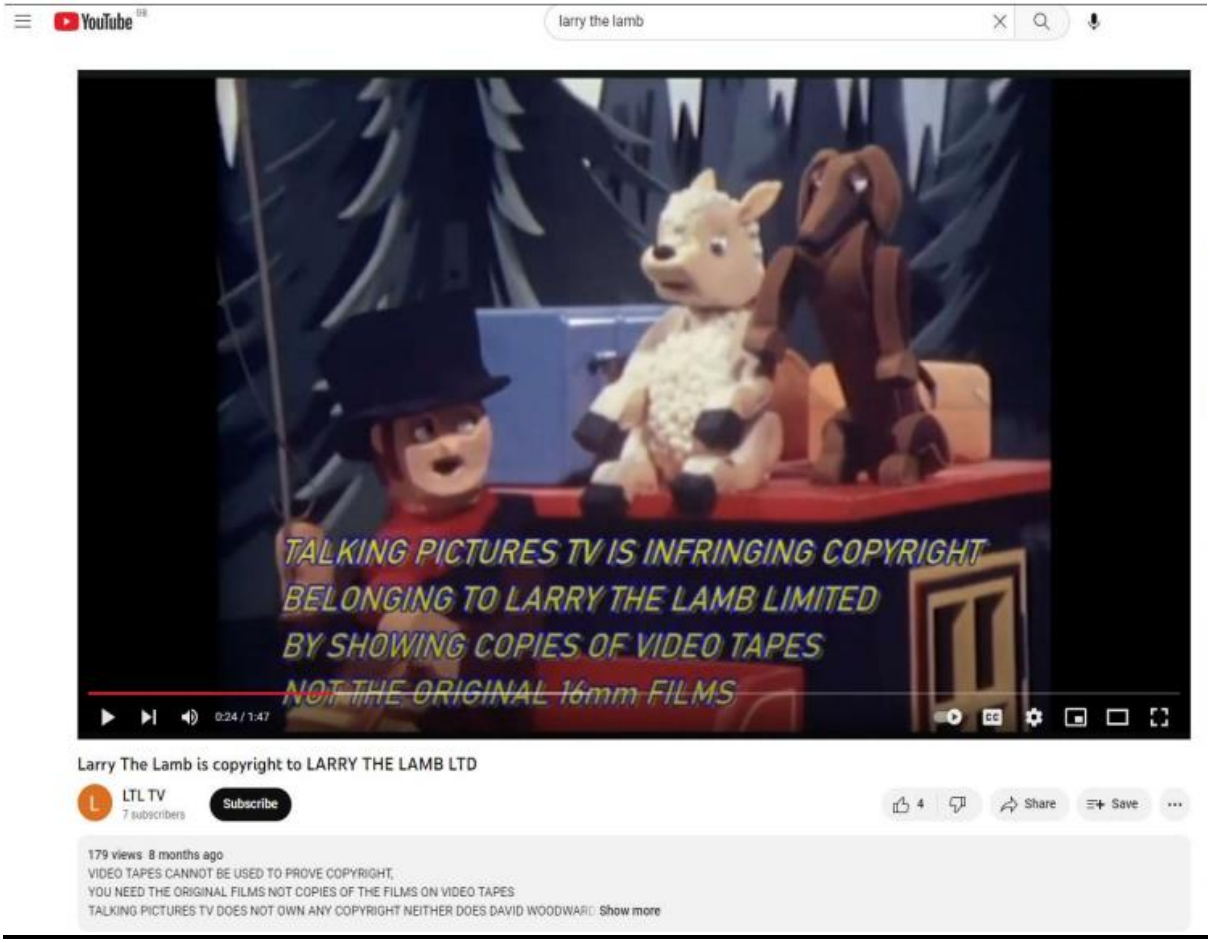
Applicant's evidence

- Witness statement of Peter Smallwood plus exhibits PS1 to PS6

Opponent's evidence

Corinna Hiscox

9. Corinna Hiscox is the opponent's professional representative and a trade mark attorney since March 2019. It is stated that between 8 and 10 March 2023 Corinna Hiscox conducted searches on YouTube for the combination "larry the lamb". The search identified a video entitled, "Larry the Lamb is copyright to LARRY THE LAMB LTD". There are various screenshots to this effect:



10. Exhibit CH2 to the witness statement consists of a print out from companies house records dated 28 March 2023 which shows that the company Larry the Lamb Limited was incorporated in 2013. The applicant (Peter Smallwood) is listed as the sole director.

David Woodward

11. Mr Woodward is a retired director. He says that the character Larry the lamb was originally featured in a short series created by Sydney George Hulme Beaman in the 1920s. He states that his uncle, Mr Hendrik Baker, "that is to say he was married to my father's younger sister, Dorothy Baker, nee Woodward",[5] was a good friend and neighbour of Hulme Beaman (who I take to be Sydney George Hulme Beaman).

12. He goes on to state that Mr Baker produced at least two series of Stories from Toytown featuring Larry the lamb. They totalled 26 episodes and were broadcast in the UK between 1972 and 1974. Mr Baker and Mr Beaman went on to co-author a series of books under the general title of "Stories from Toytown with Larry the Lamb".

13. Following the death of Mr Baker, Mr Woodward assisted Dorothy Baker (Hendrik's widow) to produce VHS video tapes of Stories from Toytown featuring Larry the Lamb. Exhibit DS2 to the witness statement consists of a VHS Video cover (this is shown as Annex A). These were produced in the 1990s.

14. Following Dorothy Baker's passing, and acting on behalf of himself and Mrs Baker's two children, Mr Woodward granted Renown Productions Limited ("Renown") the rights to broadcast the 26 episodes, sharing the profits equally which he claims was a reflection of the agreement he had with Dorothy Baker.

15. Mr Woodward concludes that he "was very shocked"[6] to learn that the applicant has applied to register "larry the lamb" as a trade mark. He claims that the applicant does not have a basis to monopolise Larry the Lamb, which was created by Hulme Beaman and Mr Woodward's uncle, Hendrik Baker.

Sarah Cronin-Stanley

16. Sarah Cronin-Stanley is a director of the opponent companies. It is stated that the opponent (more specifically, mainly Renown) is essentially a DVD label and archive owner, specialising in vintage and discontinued footage of British films.

[5] Para 12
[6] Para 19 of the witness statement

Renown Productions Limited ("Renown") is the sister company of Talking Pictures Limited ("Talking Pictures") and Renown Pictures Limited.

17. Renown also organises film festivals and film based events for the public. This is alongside retailing of various "TV merchandise including gifts music CDs, audio books, books and other memorabilia in the UK"[7].

18. Talking Pictures is an independent film and television channel that has been broadcasting British film and television, principally from the 1930s to 1970s. It has been doing this in the UK since 2015 and has an average of over 5 million viewers per week. It is stated that "From the very beginning since the channel started broadcasting, Talking Pictures has acquired considerable goodwill amongst UK viewers"[8].

19. Ms Cronin-Stanley refers to Children's hour which was a BBC Radio broadcast where Toytown, and then Toytown featuring Larry the Lamb, was first broadcast on 19 July 1929.

20. Ms Cronin-Stanley also refers to extracts from the BBC website which relate to "broadcasts of The Showing Up of Larry the Lamb and A Portrait of the Mayor, which it states to be an episode in which "Larry the Lamb gets into trouble"."[9] It is claimed that the extracts show these episodes were broadcast on BBC Radio 7 on 12 and 19 July 2009, which coincide with the 80 year anniversary of when they were first broadcast on the radio.

21. The witness statement goes on to set out various historical references to Larry the lamb. For example, a Wikipedia entry[10] which sets out the radio plays between 1929 and ITV broadcasts between 1972 and 1974. Of the 31 "Radio plays", Larry the Lamb is listed in the radio title once and also once in the "Television" listings. Both are listed as "The Showing Up of Larry the lamb".

22. There are further extracts from various websites which include ToyTown and reference Larry the lamb. These include:

    a. Suttonelms.org.uk[11] which refers to ToyTown and Larry the lamb. The extract was captured by using the Wayback machine and is dated 21 May 2021. It is not explained what the purpose of the website is or how many views it has had.

[7] Para 9 of the witness statement
[8] Para 14 of the witness statement
[9] Para 27 of the witness statement
[10] Exhibit SCS22
[11] Exhibit SCS23

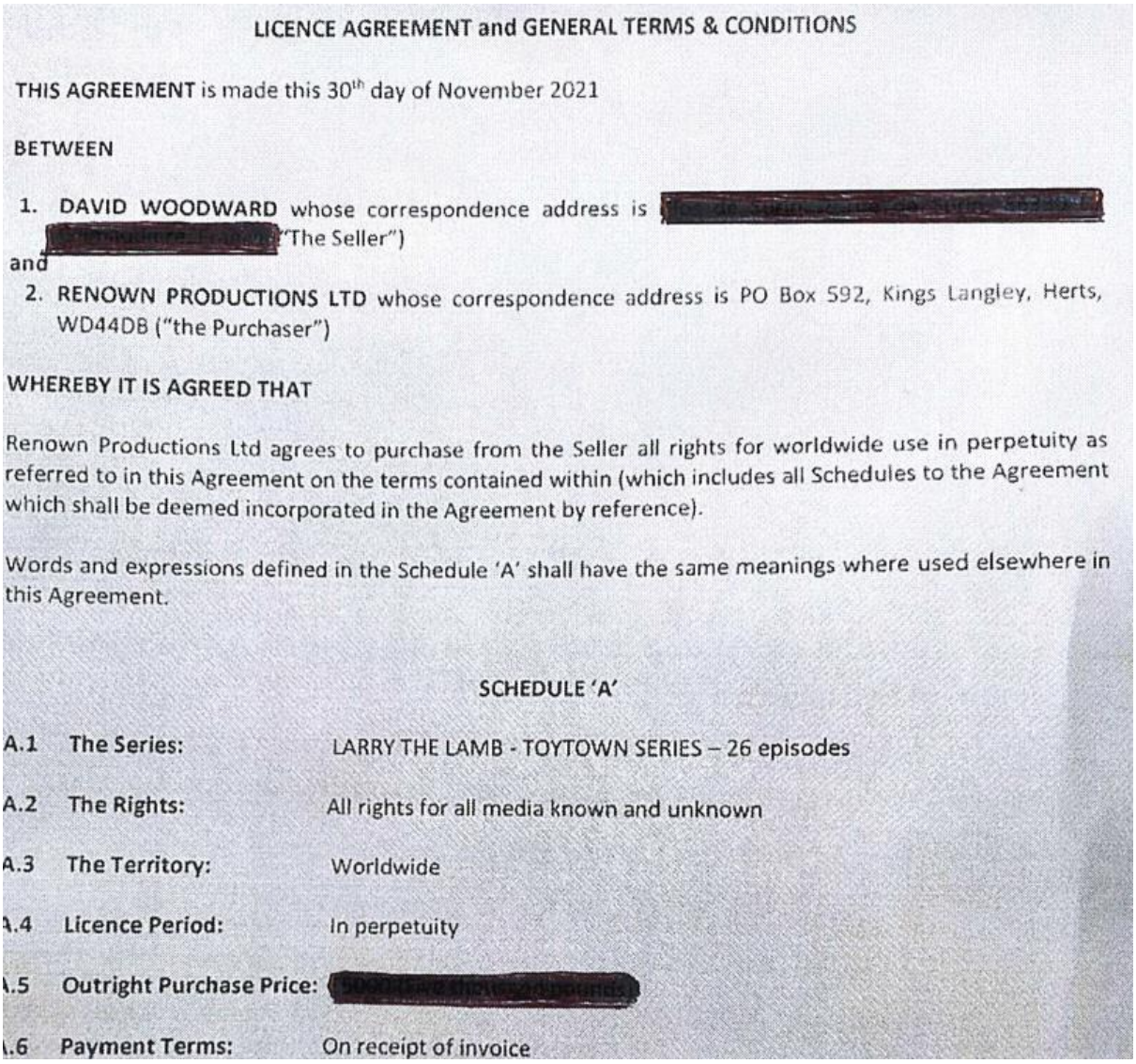
b. Thechestnut.com:[12] this is described as “a website dedicated to “little gems” of children’s television programmes”[13]. The extracts are dated 8 January 2022 and 21 March 2022 and reference Larry the lamb.

c. Toonhound.com[14] which is “a website dedicated to “cartoons, animation, comic strips and puppets in the UK””[15]. It is dated 8 January 2022 and references “Larry the lamb and Stories from Toytown” along with around 100 further TV programmes.

23. There are further references to Larry the lamb in various books and articles, but I shall not summarise these here but may refer to them where necessary in this decision.

24. The second witness statement of Sarah Cronin-Stanley, which was filed in evidence in reply, includes a “Licence Agreement and General Terms and Conditions”[16]. It is dated 30 November 2021 between David Woodward and Renown Productions Ltd and is for the latter to broadcast 26 episodes of Toytown/Stories in Toytown featuring Larry the Lamb in all forms of media. I reproduce it below (apart from the signatures of Mr Woodward and Renown Productions Ltd):

[12] Exhibit SCS24
[13] Para 38 of the witness statement
[14] Exhibit SCS25
[15] Para 39 of the witness statement
[16] Exhibit SCS47



LICENCE AGREEMENT and GENERAL TERMS & CONDITIONS

THIS AGREEMENT is made this 30th day of November 2021

BETWEEN

1. **DAVID WOODWARD** whose correspondence address is [redacted] ("The Seller")

and

2. **RENOWN PRODUCTIONS LTD** whose correspondence address is PO Box 592, Kings Langley, Herts, WD44DB ("the Purchaser")

WHEREBY IT IS AGREED THAT

Renown Productions Ltd agrees to purchase from the Seller all rights for worldwide use in perpetuity as referred to in this Agreement on the terms contained within (which includes all Schedules to the Agreement which shall be deemed incorporated in the Agreement by reference).

Words and expressions defined in the Schedule 'A' shall have the same meanings where used elsewhere in this Agreement.

SCHEDULE 'A'

A.1	**The Series:**	LARRY THE LAMB - TOYTOWN SERIES – 26 episodes
A.2	**The Rights:**	All rights for all media known and unknown
A.3	**The Territory:**	Worldwide
A.4	**Licence Period:**	In perpetuity
A.5	**Outright Purchase Price:**	[redacted]
A.6	**Payment Terms:**	On receipt of invoice

25. The witness statement goes on to state that around May 2022 the opponent uploaded a trailer promoting an upcoming broadcast of Toytown/Stories in Toytown featuring Larry the Lamb on to YouTube. They subsequently received a notification from YouTube that a "copyright takedown notice"[17] had been logged with them by Larry the Lamb Ltd.

26. The evidence also includes a list of episodes of Toytown featuring Larry the Lamb which were aired by the opponent. Exhibit SCS 34 sets out the viewing figures as follows:

[17] Exhibit SCS 44

Channel	Date	Day	Start Time	End Time	Average UK Audience in Thousands
Talking Pictures TV	12/03/2022	Saturday	9.54	10.07	29.0
Talking Pictures TV	19/03/2022	Saturday	9.55	10.07	38.5
Talking Pictures TV	26/03/2022	Saturday	9.56	10.08	32.3
Talking Pictures TV	02/04/2022	Saturday	9.56	10.06	18.7
Talking Pictures TV	09/04/2022	Saturday	9.56	10.07	24.4
Talking Pictures TV	16/04/2022	Saturday	9.55	10.06	26.2
Talking Pictures TV	23/04/2022	Saturday	9.56	10.07	9.8
Talking Pictures TV	30/04/2022	Saturday	9.55	10.06	25.6
Talking Pictures TV	07/05/2022	Saturday	9.56	10.07	16.1
Talking Pictures TV	14/05/2022	Saturday	9.55	10.06	7.3

27. The episodes are listed as follows:

Episode 1
1971. The Arkville Dragon. Stars: Patsy Blower, Wilfred Babbage. Larry learns that it's wrong to play jokes on the police as he helps to save toytown and capture the dragon. [S]

Episode 2
1971. The Tale of Captain Brass the Pirate. An unwelcome visitor returns to the town, looking for treasure. [S]

Episode 3
1972. The Tale Of The Magician. When the town complains about a magician, the lordship offers to help him, but at a cost... [S]

Episode 4
1973. Mr Growser Moves. Larry and the gang help Mr Growser move to his new house, but as usual nothing goes smoothly. [S]

Episode 5
1973. The Showing Up of Larry the Lamb. Larry and Dennis end up a bit too involved when the mayor gets a new car and goes for a long drive. [S]

Episode 6
1973. Larry the Plumber. Larry and Dennis take up plumbing to help at the mayors house, but all doesn't go well, but Larry knows he must keep the mayor at home today. [S]

Episode 7
1973. The Tale of the Inventor. After a stagecoach hold up, the inventor is tasked with making a safe carriage, with the help of Larry and Dennis. [S]

Episode 8
1973. Dreadful Doings in Ark Street. Dreadful doings in ark street, Larry and Dennis take up the offer of a free pet, but their good idea soon goes wrong. [S]

Episode 9
1971. The Great Toytown War. Stars Patsy Blower, Wilfred Babbage & Peter Hawkins. A war between Arkville and Toytown is declared after Larry and Dennis splash water on the Mayor of Arkville. [S]

Episode 10
1971. The Toytown Mystery. Somehow the mayor's statue turns green overnight... Larry and Dennis offer to help solve the case. [S]

28. That concludes my summary of Ms Cronin-Stanley's evidence.

Applicant's evidence

Peter Smallwood

29. Mr Smallwood is the Director of Larry the Lamb Limited, a position he has held since 2013. He states that he "acquired the Larry the Lamb and Toytown Archive on 21 March 2011 from Auction-Plus at a cost of £1,694".[18]

30. Mr Smallwood's witness statement includes 61 exhibits, many of which I do not need to summarise. What is clear from the evidence is that Mr Smallwood has gone to great lengths to establish who owns the copyright in the original Toytown featuring Larry the lamb footage. This includes a letter from the Treasury Solicitor to Mr Smallwood dated 12 September 2012.[19] The letter refers to the Larry the lamb archive material which was put up for auction in 2011. It is reasonable to infer that this is the lot that Mr Smallwood purchased from Auction-Plus. There are a further 3 letters from the Treasury Solicitor, the latest dated 14 November 2012 which concludes that[20]:

"

Thank you for your letter dated 14th September 2012 and your e-mail of 11th November 2012. Please accept my apologies for the delay in responding to you.

I have reviewed this file and discussed it with my Line Manager. I am afraid that in the absence of evidence that the copyright was assigned by the creator of the work to the (now dissolved) company, the Treasury Solicitor is unable to sell the copyright to you. Consequently, this is not a matter in which there is any bona vacantia interest. Bona vacantia only arises in cases where property or rights are owned by a registered company which has been dissolved. The evidence which has been provided to establish ownership in this case, I am afraid, does not prove that any assignment took place. Therefore, the Treasury Solicitor is not in a position to sell the copyright.

I understand that this may be a disappointment to you. However, it would be improper for the Treasury Solicitor to sell an asset to you which he was not satisfied was beneficially owned by the company at the time of dissolution. In the circumstances, I will be closing my file.

If you have any queries in relation to this letter, please do not hesitate to contact me.

31. The exhibits also include copies of various wills of people who are not party to these proceedings but are individuals who may have bequeathed or inherited copyright to the footage. Mr Smallwood appears to conclude that since the person

[18] Para 2 of the witness statement
[19] Exhibit PS-25
[20] Exhibit PS-28

who wrote all the Larry the lamb and Toytown stories (Haume Beaman) died on 4 February 1932, and the copyright would rest with him for his lifetime plus seventy years, it would have been in the public domain since 2002.

32. With regard to the copyright, Mr Smallwood summarises the position as follows[21]:

> "As the name Larry the lamb and Toytown have been public domain since 2002 I was within the law to apply to register the trademark Larry the lamb because it is not owned by anyone, not even Renown Productions or Talking Pictures TV Limited. But I applied to register the trademark TO USE IT and nothing else, there were no plans to deceive anyone because why would I buy the Larry the lamb archive to start with way back in 2011, no I applied to register the trademark with genuine reasons."

33. Finally, I also note that Mr Smallwood states that "I made a DVD and advertised it on Facebook Vimeo and YouTube and elsewhere, I felt sure if anyone owned copyright they would soon challenge me, but nobody ever did and so was streaming these films of Larry the lamb on the internet and so really I was transmitting these stories by streaming them live from 2013 till 2022"[22]. It is not stated if any DVDs were sold, how many streams done or if any revenue created.

34. That concludes my review of the evidence filed by Mr Smallwood, but I shall refer to parts of it where necessary in the decision.

DECISION

35. It is convenient for me to start with the claim under s.3(1), which reads:

> "3.— Absolute grounds for refusal of registration
>
> (1) The following shall not be registered—
>
> (a) […]
>
> (b) trade marks which are devoid of any distinctive character.
>
> (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
>
> (d) …:

[21] Para 54 of the witness statement
[22] Para 29 of the witness statement

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.".

36. It must be borne in mind that the claims under s.3(1)(b) and (c) are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of s.3(1)(c), but still be objectionable under s.3(1)(b). Therefore, I must address each separately.[23]

37. It should also be borne in mind that a trade mark application may be *prima facie* objectionable under s.3(1)(b) and/or (c), but may be acceptable because it has "acquired a distinctive character as a result of the use made of it". The applicant has not claimed to have acquired distinctive character and therefore I do not need to consider this point further.

Average consumer

38. The CJEU has examined the question of the relevant public for the purposes of trade mark law. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. The court found that:

> "In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for."

39. The court had earlier addressed the significance of the trade's perception of trade marks in more detail in *Björnekulla Fruktindustrier AB v Procordia Food AB*, Case C-371/02, where it found that:

> "24. In general, the perception of consumers or end users will play a decisive role. The whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it.
>
> 25. Accordingly, the relevant circles comprise principally consumers and end users. However, depending on the features of the product market concerned,

[23] *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P

the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration."

40. In this instance, the average consumer of the services will be members of the general public, plus professionals such as broadcasters, including TV entertainment producers. It is therefore important that I assess the s.3(1)(b) and (c) claims in the context of these average consumers.

41. The opponent's s.3(1)(b) and (c) claims are set out as follows:

> **E. Sections 3(1)(b) and 3(1)(c)**
>
> *20.* In addition, or in the alternative, it is submitted that the Opposed Sign is descriptive of the fictional character of Larry the Lamb, depicted in the works discussed in paragraphs 5-6 above, and / or the title or subject matter of fictional works, productions or broadcasts, as will be demonstrated in evidence.
>
> *21.* As a result, it is submitted in addition, or in the alternative, that the Opposed Sign is not capable of distinguishing the Applicant's Opposed Services, as consumers will merely understand the Applicant's use of the Opposed Sign as describing the title or subject matter of the works, productions or broadcasts, the subject of the Opposed Services, and / or a character by the name of Larry the Lamb featured in such works, productions or broadcasts.

Section 3(1)(c)

42. I will begin with the examination of the trade mark under s.3(1)(c) of the Act. The case law under s.3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

> "91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:
>
> > "33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728

[2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. … due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of

any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, Koninklijke KPN Nederland , paragraph 86, and Campina Melkunie, paragraph 19).

There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, Koninklijke KPN Nederland, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a ‘characteristic’ of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms ‘the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’, the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104,

Windsurfing Chiemsee, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

43. The UKIPO trade marks work manual practice on "Names of well-known fictional stories or characters" states:

"The names of fictional characters/stories will be accepted prima facie unless they are well known to the extent that they have passed into common language and culture. The level of recognition, fame and historical use associated with some fictional names means that they are unlikely to be perceived as indicators of trade origin. For example, 'SHERLOCK HOLMES' is a name that has been used by many traders over the years in order to describe both a series of stories and a character that appears therein. Because of the extent of its use, today's relevant public would not expect products bearing the name 'SHERLOCK HOLMES' to originate from the estate of Arthur Conan Doyle. In this type of scenario, the name of the character is devoid of any distinctive character, and is descriptive of any books, films etc. which feature that character. Objections would therefore be taken under sections 3(1)(b) and (c). However 'SHERLOCK HOLMES' applied for bananas or wedding dresses for example, which have no association with the character, would not face an objection.

The Court of Appeal confirmed this approach in *TARZAN* ([1970] RPC 450). Although the applicant, Edgar Rice Burroughs Inc. of Tarzana, California, had been granted certain exclusive rights by the estate of Edgar Rice Burroughs (author of the Tarzan stories) to produce films, records and merchandise for distribution within the United Kingdom, registration was refused on the basis that the name of the lead character had passed into language and had become a household word. The word 'TARZAN' now appears in most dictionaries as referring to a strong, agile and virile man. It would not therefore be seen as a trade mark.

On the other hand, where a fictional character name has been used by a single undertaking, and/or where the Registrar believes that the relevant public perceives said character name to be under the control of a single undertaking, then there is greater likelihood that it will possess distinctiveness, and will have the inherent ability to denote commercial origin. By way of example, 'SPIDER MAN' is the name given to a fictional superhero who frequently appears in both comic books and films published by, produced by, or associated with Marvel

> Comics. The relevant public will be aware of the character's long-standing association with the Marvel brand, and will assume that use of the name is either under the control of, or sanctioned by, Marvel comics, and so would recognise its capacity to function as a trade mark.
>
> In cases where a fictional name has passed into language, the question of who coined it is not decisive in terms of assessing its inherent distinctiveness. Similarly, the question of whether the applicant has copyright or some other exclusive right to publish the printed material commonly associated with the title/character concerned is not of itself decisive. The question is whether the sign is likely to be taken as a badge of origin.
>
> Depending upon the nature of the mark in question, and although not an exhaustive list, an objection may be taken in respect of goods such as printed matter, posters, photographs, figurines, films, videos, TV programs, organisation of plays and shows, toys, badges and fancy dress costumes.
>
> In deciding whether a fictional character is 'well known and long established' to the extent that it has entered the language, care should be taken to avoid taking into account the applicant's own efforts to promote the name after the date of application. If the name in question has already entered the language prior to the date of application, subsequent concerted promotional activity by the applicant would not overcome any objection.

44. Names which denote only the subject matter of goods may be caught by 3(1)(b)[24]. It is accepted that marks that are found to designate a characteristic of goods or services under section 3(1)(c) are also caught by the section 3(1)(b) provision. I also keep in mind the comments of Mr Iain Purvis QC sitting as a Deputy Judge of the High Court in *Canary Wharf Group plc v The Comptroller General of Patents, Designs and Trade Marks* [2015] EWHC 1588 (Ch), where he set out the correct approach to assessing whether a trade mark is descriptive of the subject matter of the goods/services. He stated that:

> "39. The general approach to be taken by a tribunal dealing with a 'subject matter' or 'theme' objection under s3(1)(c) or s3(1)(b) was recently considered by Geoffrey Hobbs QC sitting as the Appointed Person in *NMSI Trading Ltd's Trade Mark Application (Flying Scotsman)* [2012] RPC 7 by reference to a number of authorities including the General Court in Danjaq v OHIM (Dr No) [2009] ECR II-2097, Mr Richard Arnold QC (as he then was) sitting as the Appointed Person in *Linkin Park* [2006] ETMR 74, the First Board of Appeal of

[24] See, for example, Executrices of the Estate of Diana, Princess of Wales' Application [2001] E.T.M.R. 25 (TMR) – Princess Diana memorabilia, and Flying Scotsman Trade Mark – BL-O/313/11 (AP) – printed matter about the steam engine of this name

OHIM in *Ferrero OHG v FIFA* [2008] ETMR 76 and Mr Allan James in *Diana Princess of Wales Trade Mark* [2001] ETMR 25 .

40 Following, in general terms, the approach of Mr Hobbs as set out in particular in paragraph 18 of Flying Scotsman, I believe that at least three matters need to be considered where a 'subject matter' or 'theme' objection arises under s 3(1)(c) or (b):

> (a) The nature of the goods or services for which the application is made. Are they in principle apt to provide or convey information about (or imagery relating to) the subject matter of the sign?
>
> (b) The nature of the sign. Is it something which it is reasonable to believe would be recognised by the relevant class of persons (that is to say average consumers of the goods or services in question) as indicating a particular subject matter or theme?
>
> (c) Is the subject matter or theme of a kind which (in the context of the goods or services in question) the average consumer would consider was controlled by a single economic undertaking, as opposed to something which was free to be used and exploited by anyone. See for example *Psytech International v OHIM* [2011] ETMR 46 at [34]-[43] and the concept of 'official merchandise' recognised in Arsenal Football Club v Reed [2003] RPC 9 (CJEU) and [2003] RPC 39 at [50]-[69] (Court of Appeal)."

45. In essence, the opponent argues that the sign "exclusively consists of indications of the subject matter of the Opposed Services, the subject matter of the works being broadcast or which provide the basis of the entertainment services"[25].

46. Applying the guidance set out above, I find that the application "larry the lamb" is *prima facie* acceptable. The question is whether, from the evidence filed, that the fictional character is sufficiently well known for it to have passed into common language and culture.

47. The fictional character, Larry the lamb, was first created for radio around the 1920/30s. It appears to have risen to relative fame as a children's radio broadcast in the 1960s, though the exact extent of such fame is not clear. Further episodes were broadcast on TV in the 1970s and a radio broadcast on BBC Radio in 2009 to mark its 80-year anniversary. Since then, it appears that it is available on YouTube, there are VHS copies in circulation and the opponent has used the footage which attracted from 7,000 to 39,000 weekly viewers on its Talking Pictures TV between 12 March

[25] Para. 20 of the applicant's submissions dated 6 November 2023

2022 and 14 May 2022. It is notable that the last episode is 5 days prior to the relevant date.

48. The nature of the services are apt at conveying information about the subject matter of the services, i.e. broadcasting, entertainment, etc. about a character called Larry the lamb. This may not be true for all of the applied for services, e.g. rental of satellite broadcast receiving antenna, but I shall return to considering all of the services later if necessary.

49. I take account that of the guidance that the names of fictional characters/stories will be accepted *prima facie* unless they are well known to the extent that they have passed into common language and culture. I do not doubt that at its peak the character Larry the lamb was popular, but this was around 60 years ago. The average consumer of the applied for services may recall Larry the lamb, but at the relevant date I do not consider it to be famous or well known. I note that episodes were aired just 5 days prior to the relevant date, but this was on a niche channel and the viewing figures were low (see paragraph 26 above which shows the figures to range from 7,000 to 10,000). Therefore, in respect of the question, "is it something which it is reasonable to believe would be recognised by the relevant class of persons…as indicating a particular subject matter or theme?", the evidence simply does not support this claim.

50. I note that the trade mark application covers various services in class 38 (e.g. rental of satellite broadcast services) as well as the television entertainment, production, etc services under class 41. It is more questionable whether these services are apt at conveying information, but nevertheless I do not consider the opponent to be in any better position against these services as the thrust of the argument is that Larry the lamb is the subject matter, and no further argument in respect of other services would have put it in any better position.

51. As I have found that the trade mark application is acceptable it follows that I do not need to consider whether the mark has acquired distinctive character by virtue of the use made of it. However, it seems to me that if it has become sufficiently recognisable by the relevant class of persons as indicating the subject matter, it would not have met the criteria to have acquired distinctive character.

52. The section 3(1)(c) claim fails.

Section 3(1)(b)

53. I do not consider the opponent's claim to be materially different under this ground compared to 3(1)(c), i.e. that Larry the lamb is a description of the subject matter of the applied for services. The opponent essentially argues that because it is descriptive, the mark is therefore also devoid of distinctive character. I have already concluded that the opponent has failed to demonstrate that the mark is descriptive, and there is

no further point pleaded or argued. On this basis, the opponent cannot succeed under section 3(1)(b).

Section 3(6)

54. 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."

55. 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).
>
> (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)."

56. Further relevant points arising from the case law are the following:

a) An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies. However, Arnold J (as he then was) said that "cogent evidence is required due to the seriousness of the allegation". 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 & Anor* [2012] EWHC 1929 (Ch), paragraph 133;

b) It is necessary to ascertain what the applicant knew at the relevant date: see *Red Bull*, paragraph 137; and c) Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2008] EWHC 3032 (Ch), paragraph 167.

57. The opponent's bad faith claim is twofold, with some overlap:

1) that "the applicant was aware that the Opponent and / or companies within the Opponent's group were broadcasting the Series under the sign [26]*Lamb the*

[26] I take this and the subsequent reference to Lamb the Lamb as being a typographical error and it should read Larry the Lamb.

Lamb / Stories from Toytown featuring Larry the Lamb, and / or the Opponent and / or its group of companies had an interest in broadcasting and / or producing works under the sign *Lamb the Lamb / Stories from Toytown featuring Larry the Lamb*."[27] And "had the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, including, but not necessarily limited to, the Opponent."

2) the applicant did not have a bona fide intention to use the mark in the course of trade.

58. The first strand of attack is that filing the trade mark application "was motivated, whether wholly or partly, by an intent to control or prevent the Opponent's from broadcasting programmes featuring Larry the Lamb, allowing him to derive the benefit of, control or monopolise, copyright works, which he did not create and does not own."[28]

59. It is common ground between the parties that the applicant acquired memorabilia and documentation relating to Toytown and Larry the lamb from an auction which took place in March 2011. The lot was described as "a large quantity of original materials relating to the most iconic children's series "Larry The Lamb"."[29] which came from a house clearance following the death of Dorothy Baker. Ms Cronin-Stanley's view is that the purchase was for the goods only and not any IP rights that may be attached to them.

60. To support this, the evidence includes a copy[30] of the auction listing referred to above. It is described as including over 100 items such as "original studio copies of film & original artwork used in film making". There is a further detailed description of the items for auction, most notably it states:

> It is unknown if anyone or who still owns any copyright to this series, but there are original letters of correspondence made in 1992 between Hendrick Bakers widow & others which suggest they had some difficulty in establishing proof of copyright as the this was originally owned by the Ltd company which was dissolved upon Hendrick Bakers death in 1991.
>
> However in any event it would be up to any successful auction purchaser to establish full copyright ownership before using any of the material for commercial purposes. As such the auctioneers will be offering this lot as unique collector's items only.

61. This clearly demonstrates that the purchase of the goods did not include the copyright or any IP. Mr Smallwood has gone to great lengths to try to acquire the copyright in the footage that he purchased at auction. This included writing numerous times to the treasury solicitor. However, the evidence shows that Mr Smallwood purchased goods and not copyright to the footage that the goods contain. Further,

[27] Para 9 of the TM7
[28] Para 62 of Ms Cronin-Stanley's witness statement
[29] Para 60
[30] Exhibit SCS41 to the witness statement of Ms Cronin-Stanley

treasury solicitors were not able to establish who the copyright owner is. Therefore, despite Mr Smallwood's best efforts, he has not established that he is the copyright owner. Indeed, I would go as far to say that it appears that he is not and nor are the opponents.

62. It is not known who the copyright owner is. However, who owns the copyright is not the issue before me. The question is, was the trade mark application was filed in bad faith?

63. Mr Smallwood's position is that:

> "…my actions were nothing to do with upsetting anyone or for financial gain from Renown Productions Limited as my plans were all genuine and to make the Toytown Stories of Larry the lamb available on TV and satellite and streaming on YouTube, Vimeo and other platforms"[31].

64. He goes on to state that all of the stories are now in the public domain and so he cannot be stopped from making them available again in a brand-new series. It is in evidence, however, that Mr Smallwood has sent a number of emails, all prior to the relevant date, insisting that the opponents cease broadcasting the shows. Shortly after these emails he filed the application for services in classes 38 and 41. At some point Mr Smallwood was informed that "it seems my trademark class 9 was not very clear about television broadcasting and streaming".[32]

65. In the opponent's submissions it refers to Mr Smallwood's earlier trade mark registration no. 3020158 also for the mark "larry the lamb" covering various class 9 goods. They note the existence of the registration, but do not accept its validity. The fact is that it is a valid trade mark registration unless and until it is the subject of a successful cancellation action, which means that it has no bearing on these proceedings.

66. The opponent also claims that around the time Talking Pictures began to publicise and broadcast Toytown featuring Larry the lamb, they were contacted by Mr Smallwood who asked them to stop transmitting the show. The first email[33] to the opponent is dated 21 March 2022 asking how many episodes it intends on airing. The subsequent emails dated 21 April, 28 May and 30 May 2022, allege copyright ownership and that the opponent's use infringes it and therefore they should cease broadcasting. None of the emails include reference to trade marks, a trade mark application being filed or due to be.

[31] Para. 57
[32] Para. 52 of his witness statement
[33] Exhibit SCS40

67. It is clear from the above that at the time of filing the trade mark application, Mr Smallwood knew about the opponent showing episodes of Toytown featuring Larry the lamb, the last airing on 14 May 2022 (5 days prior to the relevant date). Mr Smallwood is aggrieved with the opponent that it is airing Toytown featuring Larry the lamb because he owns the original footage, but not the copyright. It appears as though Mr Smallwood purchased the footage, made legitimate attempts to find the copyright, but when this did not materialise, he effectively took it to be an orphan work and unilaterally decided it was his.

68. The question, is, however, was the trade mark application filed in bad faith. 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. balance of probability). 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).

69. In other words, has the applicant acted with a dishonest state of mind or intention. In the context of trade mark law, this means that the trade mark was not filed with the aim of engaging fairly in competition. I do not consider this to be the case. I am of the view that it was done in order for Mr Smallwood to preserve his position, in the knowledge that the existing trade mark registration under class 9 did not provide him with sufficient coverage and to further explore airing Larry the lamb. Therefore, this strand of bad faith attack is dismissed.

70. With regard to Mr Smallwood's lack of intention to use, this point has not been particularly pursued beyond the pleadings. The various emails, the first being around March 2022, do demonstrate that Mr Smallwood contested use of the mark by the opponent but I have already found that this is not bad faith. The evidence also demonstrates that Mr Smallwood has uploaded his original Larry the lamb footage on to YouTube (see paragraph 9 above). Mr Smallwood repeatedly refers to a DVD that he produced in 2013 which he says was advertised on eBay and Facebook Vimeo. He does not state how many DVDs were sold, but this points away from there being a lack of intention to use.

71. Having considered all of the evidence, it appears to me that Mr Smallwood has been spending a lot of time trying to establish who the copyright owner is and to secure a trade mark registration prior to commencing any such use. I do not see how these can be perceived as bad faith, and no further arguments have been put forward to persuade me otherwise. Therefore, there is no prima facie argument for Mr Smallwood to counter.

72. The s.3(6) bad faith claim fails.

Section 5(4)(a)

73. S.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."

74. Subsection (4)(A) is as follows:

> "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 the registration of the trade mark or date of the priority claimed for that application."

75. The opponent's claim under s.5(4)(a) is that since February/March 2022 it has been operating a business throughout the UK under the signs LARRY THE LAMB and STORIES FROM TOYTOWN FEATURING LARRY THE LAMB for the following services:

Broadcasting, transmission and / or production services; provision of entertainment; satellite television entertainment services; television entertainment services; preparation and / or production or television programmes, series, films, audio and / or audio-visual works; television productions and / or programmes; provision or advice and information in relation to television programmes, films, audio and / or audio-visual works; provision of advice and information in relation to all the aforementioned services.

76. The first hurdle for the opponent to overcome is that they need to demonstrate that they had the requisite goodwill in the sign at the relevant date. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

> "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 customers. It is the one thing which distinguishes an old-established business from a new business at its first

start."

77. In *South Cone Incorporated v JackBessant, 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; 54 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."

78. 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."

79. The applicant claims to own the copyright in the video footage but does not claim to have had prior use. Therefore, the date I must make the assessment under this ground is 19 May 2022[34].

[34] *Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 220, Kitchin LJ

80. The opponent has not submitted any sales or advertising figures. The use which the opponent appears to be relying upon are the 10 weeks of Toytown featuring Larry the lamb episodes aired between 12 March and 14 May 2022. The average audience of these approximately 10-minute broadcasts ranged from 7,300 to 38,500. The episodes were aired under the channel Talking Pictures TV and therefore any broadcast goodwill generated from these episodes would reside with Talking Pictures TV rather than Larry the lamb. It is for this reason that the opponent has failed to demonstrate that it has the requisite goodwill.

81. Even if I am incorrect about any potential goodwill residing in Larry the lamb rather than Talking Pictures TV, the opponent has not submitted any sales or advertising figures. Further, the audience figures are so low that I consider them to be trivial at best.

82. In view of the above, I find that the opponent has not demonstrated that it had the requisite goodwill at the relevant date. The s.5(4)(a) claim fails.

OVERALL CONCLUSION

83. The opposition has failed in its entirety and the application may to proceed to registration.

Costs

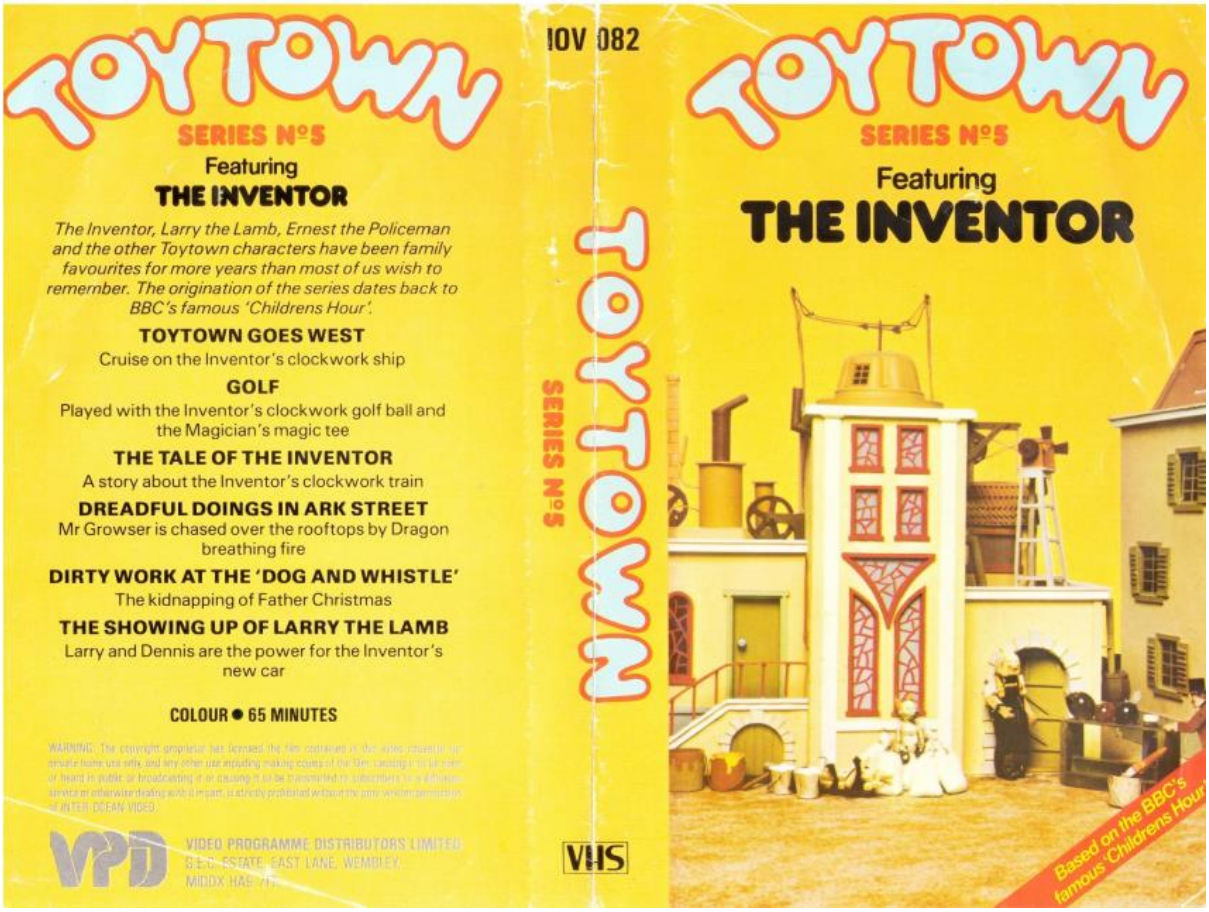
84. The applicant has been successful and would therefore typically be awarded a contribution towards its costs. This is in accordance with Tribunal Practice Notice ("TPN") 1/2023. However, on 9 October 2023, the Tribunal wrote to the applicant stating that if they intended to request costs they should complete and submit the costs proforma. In this letter it states that "If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded."

85. The costs proforma was not submitted and therefore I decline to make an award of costs in respect of the proceedings themselves.

Dated this 29th day of September 2025

Mark King
For the Registrar

ANNEX A


TOYTOWN
SERIES Nº5
Featuring
THE INVENTOR
The Inventor, Larry the Lamb, Ernest the Policeman and the other Toytown characters have been family favourites for more years than most of us wish to remember. The origination of the series dates back to BBC's famous 'Childrens Hour'.
TOYTOWN GOES WEST
Cruise on the Inventor's clockwork ship
GOLF
Played with the Inventor's clockwork golf ball and the Magician's magic tee
THE TALE OF THE INVENTOR
A story about the Inventor's clockwork train
DREADFUL DOINGS IN ARK STREET
Mr Growser is chased over the rooftops by Dragon breathing fire
DIRTY WORK AT THE 'DOG AND WHISTLE'
The kidnapping of Father Christmas
THE SHOWING UP OF LARRY THE LAMB
Larry and Dennis are the power for the Inventor's new car
COLOUR ● 65 MINUTES
VPD
VIDEO PROGRAMME DISTRIBUTORS LIMITED
IOV 082
TOYTOWN
SERIES Nº5
VHS
TOYTOWN
SERIES Nº5
Featuring
THE INVENTOR
Based on the BBC's famous 'Childrens Hour'