O/0934/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NO. 3845829

IN THE NAME OF RUSSELL CHARLES GILL

FOR THE FOLLOWING TRADE MARK:



AND AN APPLICATION FOR A DECLARATION OF INVALIDITY

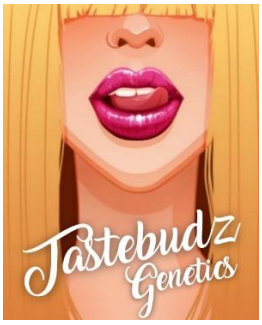
THERETO UNDER NO. 506491

BY FAYE DEBORAH DOUGLAS

AND

IN THE MATTER OF APPLICATION NO. 3846443 BY

FAYE DEBORAH DOUGLAS FOR THE TRADE MARK:



AND OPPOSITION THERETO UNDER NO. 600002824

BY

RUSSELL CHARLES GILL

Background and Pleadings

Opposition proceedings

1. On 6 November 2022, Faye Deborah Douglas applied for UK trade mark application no. 3846443 ("the 443 mark"), as shown on the cover page of this decision. The application was published for opposition purposes on 10 February 2023 in relation to the goods and services outlined below namely:

> Class 16: Packaging materials.
>
> Class 25: Clothing.
>
> Class 31: Seeds.
>
> Class 35: Advertising.

2. On 28 March 2023, Russell Charles Gill filed a partial opposition under the Fast Track procedure under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is only brought against the applied for goods in class 31 namely '*seeds*'. For the purposes of his opposition, Mr Gill relies upon trade mark registration number 3845829 ("the 829 mark") as shown on the cover page of this decision, which was filed on 3 November 2022 and achieved registration on 3 March 2023 for goods in class 31 namely '*seeds*'.

3. Under section 5(2)(b) of the Act, Mr Gill claims that as a result of the high degree of similarity between the respective marks and the identity of the respective goods this will lead to a likelihood of confusion in the minds of the public to include a likelihood of association. Consequently, Mr Gill contends that the 443 mark should be refused registration.

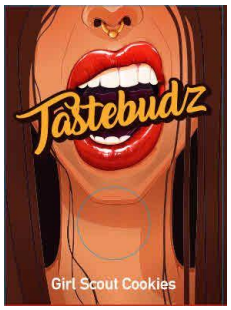
4. Ms Douglas filed a defence and counterstatement to the opposition denying the claims and putting Mr Gill to strict proof of the same.

Invalidation Proceedings

5. Mr Gill is the proprietor of the aforementioned 829 mark, as shown on the cover page of this decision, which is relied upon by him in the opposition against the 443 mark. On 5 September 2023, Ms Douglas applied to have the 829 mark declared

invalid pursuant to section 47 and sections 5(2)(b), 5(3), 3(1)(b) and 3(6) of the Trade Marks Act 1994 ("the Act").[1]

6. Under sections 5(2)(b) and 5(3) of the Act, Ms Douglas relies on the following trade mark registration:

> UKTM no. 3399120[2]
>
> 
>
>
> Filed on 14 May 2019 and registered on 4 October 2019 for *seeds* in class 31. ("the 120 mark")

7. Under section 5(2)(b) of the Act, Ms Douglas contends that as a result of the high degree of similarity between the respective marks and the identity between the respective goods this will result in a likelihood of confusion on the part of the relevant public to include a likelihood of association.

8. Under section 5(3) of the Act, Ms Douglas claims that the 120 mark has a reputation for *seeds* in class 31. It is contended that use by Mr Gill of a mark that is similar to it, by using "the same font, brand name that is aurally identical, colours and slightly altered image" would lead "the relevant public to believe that there is an economic link as they are under the impression that they are purchasing the original product when they are not". Ms Douglas did not specify within her pleadings which statutory heads of damage would arise as a result.

9. Under section 3(6), Ms Douglas claims that the application to register the 829 mark in relation to seeds in class 31 was filed in bad faith. She claims that:

> "The proprietor is fully aware of the [registered 120 mark] and is misappropriating the acquired good will of the mark. Consumers would be

[1] Whilst initially relying on a claim under section 5(4)(a) Ms Douglas confirmed in her letter dated 12 December 2023 that she was no longer relying on an unregistered right.
[2] This trade mark registration is jointly owned by Ms Douglas and Mr Gill.

confused and would not be able to identify the origin of the business's goods and services.

The proprietor has always been aware they are using an [sic] similar mark for identical or goods and services which could be confused with the mark for which a reputation, customer base good will has been built.

Bad faith is shown here as it can be seen that the proprietor is seeking to exploit the reputation of the mark and take advantage of it by gaining access to the market and taking economic advantage of it.

Another indication of bad faith.…can also be seen as there was a direct business relationship between both parties prior to the application for the trade mark.

The proprietor had full intention of obtaining the exclusive rights for the goods/services covered by the 2019 trade mark through bad faith without prior notice to the applicant. As this is a jointly owned mark and a decision to cut all ties with the proprietor was made in 2022."

10. Under section 3(1)(b) of the Act, Ms Douglas claims that the 829 mark is devoid of any distinctive character as follows:

"The proprietor's mark includes the word 'TASTE-BUDZ', an image of an open mouth with red lips and white teeth & is visually and conceptually identical. It is dominated by the word 'TASTE-BUDZ' in the same yellow, represented in the same customised font 'Amarillo' down to the slanted angle of the text and includes an image of an open mouth with red lips and white teeth biting down on the text. In common practice, the addition of a black background, inverted mouth and a dash is not sufficient to give the mark distinctive character also, in common practice, the addition of symbols commonly used does not add distinctive character to a mark."

11. Mr Gill filed a defence and counterstatement denying each claim and putting Ms Douglas to strict proof in relation to the same. In particular:

- In response to the section 5(2)(b) claim, Mr Gill admits that the respective marks are similar and that the goods are identical, however, he relies upon section

5(5) of the Act as a defence arguing that he is the co-proprietor of the 120 mark as relied upon and as such has consented in this capacity to the registration of the 829 mark.

- In relation to the section 5(3) claim, Mr Gill denies that the 120 mark holds a reputation and again contends that as the co-proprietor of the 120 mark he has consented in this capacity to the registration.
- In so far as the claim under section 3(1)(b) is concerned, it is said that the 829 mark is a complex graphic device incorporating the word 'Taste-budz' in a highly stylised font. The mark is neither descriptive nor non-distinctive and is clearly capable of acting as a badge of commercial origin.
- Under section 3(6) Mr Gill denies the application was made in bad faith. It is said that he filed the 829 registration to protect his legitimate interest in the 'Tastebudz' business and brand that he personally devised, launched and paid for. The filing was as a result of Ms Douglas' claims that she was the true owner of the brand and after he discovered that the 120 mark application had been applied for in joint names without authorisation, contrary to his instructions and belief that it was to be held in his sole name.

Consolidation

12. The respective proceedings were consolidated on 21 May 2024, and the parties were notified accordingly. As a consequence, the Fast Track opposition proceedings were converted to a standard opposition.

Proof of use

13. Due to their earlier filing dates, the marks upon which both parties rely in the respective proceedings qualify as earlier marks within the meaning of section 6 of the Act. The registration processes of the 120 and 829 marks were completed less than five years before the filing/registration dates of the respective marks being opposed/invalidated and therefore they are not subject to the proof of use provisions as set out in section 6A. Consequently, subject to the outcome of the invalidation proceedings, Mr Gill may rely upon his 829 mark and Ms Douglas may rely upon her 120 mark as earlier rights, without having to show what use has been made of them.

Representation

14. Mr Gill is represented by Gateley PLC, whereas Ms Douglas is self represented. Both parties filed evidence during the evidence rounds. Whilst initially a hearing was listed to take place before me on 15 January 2026, the parties notified the Tribunal that they no longer sought to be heard on the matter and were content for the proceedings to be determined from the papers. The hearing listed for 15 January 2026 was therefore subsequently vacated. Consequently, the parties were given the opportunity to file submissions in lieu of a hearing. Ms Douglas filed submissions dated 22 January 2026, but Mr Gill did not. This decision is taken following a careful perusal of all papers filed.

Relevance of EU Law

15. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

16. Ms Douglas' evidence in support of her invalidation action is provided by her first witness statement dated 19 July 2024 accompanied by twenty four exhibits marked FD1-FD24. Her evidence serves to support her bad faith claim and to seek to show that the business was a joint venture as opposed to being under Mr Gill's sole control as claimed, in order to undermine Mr Gill's evidence. Further Ms Douglas provides evidence in support of the reputation she claims that the 120 mark holds.

17. Mr Gill's evidence is provided by his witness statement dated 22 July 2024 accompanied by five exhibits marked RCG1-RCG5.

18. Ms Douglas filed a second witness statement dated 23 September 2024 as her evidence in reply together with a further 2 exhibits marked FD1 and FD2. For the most part her evidence merely serves to rebut and challenge the various claims made by Mr Gill.

19. Whilst I have taken into account all the material filed in these proceedings, I do not propose to summarise it in full, but rather I shall refer to the relevant parts to the extent I consider necessary in support of the respective claims brought.

My Approach

20. Given that Mr Gill relies upon the 829 mark as an earlier right in the opposition, which is the subject to invalidation brought by Ms Douglas I shall deal with the invalidation action first. I shall only return to the opposition once I have determined whether or to what extent the 829 mark is validly registered.

Decision

21. Sections 5(2)(b), 5(3), 3(1)(b) and 3(6) of the Act have application in invalidation proceedings pursuant to section 47 of the Act. The relevant parts of section 47 state 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).
>
> Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> > (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
> >
> > (b) […]
>
> unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> […]
>
> (2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[…]

(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.

[…]

(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(2)(b)

22. Sections 5(2)(b) and 5(5) of the Act read as follows:

"5(2) A trade mark shall not be registered if because –

(a)…

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

[…]

5(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

23. Section 5A of the Act reads as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Consent

24. Before undertaking the global assessment, I note that Mr Gill has defended the invalidity action by reliance on section 5(5) of the Act. His position appears to be that he was the sole owner of the Tastebudz business and brand, and as the proprietor of the 120 mark he consented to the registration of the 829 mark.

25. Taking general principles first, the premise of consent in legal terms presupposes consent being sought from, or given by, another person. It is inherent in the nature of consent that there must be two distinct entities; the person giving consent and the person acting upon it. It would, therefore, appear incongruous to suggest that a person carrying out the relevant action would give consent to himself. I am not entirely satisfied, therefore, that Mr Gill's reliance on consent gives rise to an appropriate defence as claimed.

26. Even if my position under general principles is wrong, Mr Gill's position is not improved in terms of trade mark law. I do not accept that Mr Gill's purported consent, as one of the joint proprietors of the earlier 120 mark, is sufficient to engage section 5(5).

27. Firstly, taking the position that he is the 'proprietor' of the earlier right, Mr Gill is not the sole proprietor of the 120 mark, which is the mark being relied upon as an earlier right by Ms Douglas. The 120 mark is registered in joint names, with Ms Douglas being the other co-owner. Any consent in this scenario would have to be by the 'proprietors' i.e. both proprietors. There is no suggestion that Ms Douglas gave actual consent to Mr Gill to apply for the contested 829 mark, and further Ms Douglas' consent cannot be assumed or inferred especially where she says the opposite and alleges that Mr Gill applied for the mark in bad faith.

28. Secondly, taking into account the alternative position i.e. that Mr Gill applied for the mark with his own consent as the co-proprietor of a similar mark (i.e. the 120 mark)

this argument is even less convincing given that he is not the exclusive owner of the 120 mark. I consider that the reference to "proprietor" in section 5 falls to be understood, in the case of a jointly owned registration, as referring to the registered co-proprietors collectively. It follows that the consent of the co-proprietor who himself applied for the contested mark, does not amount to the consent of the 'proprietor of the earlier trade mark' for the purposes of section 5(5).

29. The same conclusion follows in the context of these invalidity proceedings, in relation to section 47(2) which provides that a registration may be declared invalid on relative grounds unless the proprietor of the earlier trade mark or other earlier right has consented to the registration. The earlier registration is jointly owned by Ms Douglas, the applicant for invalidity, and Mr Gill, the proprietor of the contested registration. Mr Gill's application for, and subsequent ownership of, the contested registration demonstrates his own consent to the 829 registration (although this is arguable given that consent implies consent given by a person other than the applicant). However, in the absence of consent from Ms Douglas, I do not consider that Mr Gill's consent, without more, amounts to the consent of the 'proprietor' of the earlier trade mark for the purposes of section 47(2) either.

30. Accordingly, my reading and interpretation of the provisions of the Act mean that Mr Gill cannot rely upon his own consent in his capacity as a co-proprietor of the earlier registration and neither is he the sole proprietor of the earlier right to establish a defence under section 5(5) or section 47(2), and I shall say no more about it. In any event, even if I am wrong, as will become clear later in my decision this will not make any difference to the overall outcome of the decision, given Ms Douglas' reliance on other grounds other than those brought on relative grounds, which do not restrict the applicant for invalidity as being the proprietor of an earlier right.

The principles

31. The standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25 and are as follows:

> (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may

retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the goods

32. The 829 mark is registered for *seeds* in class 31, which are self evidently identical to the 120 mark's *seeds* in the same class and which Mr Gill accepts are identical.

Average consumer and the purchasing process

33. When considering the opposing marks, the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods in question.[3]

34. In *Iconix,*[4] the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average

[3] *Lloyd Schuhfabrik Meyer*, case c-342/97.
[4] Ibid

consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

35. The average consumer of the parties' goods is a member of the general public. The costs are likely to vary, but the goods are not particularly costly or bought frequently but likewise they are not likely to be purchased daily. Various factors will be taken into account in the purchasing process namely their cost, quality, yield and suitability. Consequently, I consider that the level of attention paid would be between low to average for such goods. Whilst I consider that the average consumer for the goods is in general likely to be the end user, I do not discount that they may include business users namely those that run or own nurseries for example. Even if this is the case the same considerations would apply other than cost where a business may wish to buy in bulk and more frequently. Consumer popularity and trends will also be a factor. In the case of a business user I consider that the level of attention would be slightly higher, but no more than medium.

36. The goods are likely to be self-selected from brochures, retail outlets or their online equivalents where visual considerations will dominate. I do not discount aural considerations however where advice/requests may be made to sales assistants for example.

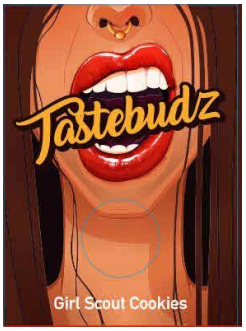
Comparison of the marks

37. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

38. It would be wrong to artificially dissect the trade marks, although it is necessary to consider the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

39. The respective trade marks are shown below:

The 829 mark	The 120 mark
	

Overall Impression

40. The 829 mark is a figurative mark which includes at its centre a device depicting an image of an open mouth slightly turned to the side with red lips and teeth. The

device is overlaid by the hyphenated word ‘Taste-budz’ in a highly stylised yellow font, presented as if the teeth are biting down on the word. The word and the device are presented on a black rectangle. I consider that the overall impression resides in the hyphenated word and the device roughly equally but weighted slightly in favour of the word since this is the element that can be read. The colour combination, stylisation and font of the word contribute to the mark as a whole but to a lesser degree. The black rectangle has little trade mark significance as it merely acts as a background upon which the other elements are presented. The direction and angle of the mouth will also have little trade mark significance.

41. The 120 mark is also a figurative mark which includes an image of the lower part of a person’s face shown square on. The attention of the consumer is drawn to the open mouth with red lips and teeth which is at the centre of the image. The word ‘Tastebudz’ (in a highly stylised yellow font) is presented within the mouth device which appears to bite down on the word. The words Girl Scout Cookies are presented at the bottom of the image in considerably smaller sized font. The overall impression of the 120 mark is dominated by the word ‘Tastebudz’ and the figurative element (particularly the mouth) but again weighted in favour of the word, as this is the element that can be read. The words Girl Scout Cookies whilst contributing, play a much lesser role due to their size and position within the mark as a whole. The same can be said of the stylisation, colour and font used which whilst contributing play much lesser roles overall.

Visual comparison

42. The marks overlap in relation to the mouth device and the words Taste-budz/ Tastebudz. The stylisation of these words, font and colour are identical, albeit the word is hyphenated in the 829 mark as opposed to being presented as one word in the 120 mark. The differences reside in the 829 depicting an image of only the mouth presented at a slight angle, the black rectangle and the 120 mark depicting an image of the lower part of a person’s face but still dominated by a similar red lipped mouth presented square on. The 120 mark also includes the words Girl Scout Cookies there being no counterpart in the 829 mark. Weighing up the differences as against the similarities, in light of my findings regarding the overall impression of the respective

marks and the elements that dominate in each, I consider that visually the marks are similar to between a medium and high degree.

Aural comparison

43. The device and stylisation of the respective words in each mark will not be articulated. Consequently, the dominant verbal element of each mark will be pronounced identically as TASTE-BUDS irrespective of the inclusion or omission of the hyphen.

44. In relation to the other verbal elements present in the 120 mark namely 'Girl Scout Cookies' these are a point of aural difference. However, I bear in mind the comments of Mr Phillip Johnson, sitting as the Appointed Person, on appeal, in *TM ENRICH LEARNING*[5] where he said:

> "15. The General Court continues to take the view that secondary or descriptive elements of marks are not necessarily spoken: see T-68/2021 *Hauz 1929 v EUIPO*, EU:T:2021:127, [40]; T-560/20 *Yadex International v EUIPO*, EU:T:2021:714, [75]; T-357/21 *Jose Alfonso Arpon v EUIPO*, EU:T:2022:405, [52]; T-1144/23 *Enedo Oyj v EUIPO*, EU:T:2025:207, [88]. These cases follow the general pattern of the jurisprudence before the UK left the EU and so they remain strongly persuasive, and I therefore consider them as reflecting English law: see *Lipton v BA Cityflyer Ltd* [2024] UKSC 24, [158].
>
> 16. In my view, the principle that descriptive or secondary elements in a mark may not be pronounced when the mark is spoken is distinct from the rule that negligible elements of marks can be disregarded in the comparison of marks (see C-3/03/P *Matratzen Concord* [2004] ECR I-3657). The former is a reflection of the fact that in everyday life people often say things in a simplified or shortened form (even though they may be aware of the entire mark). The latter principle, on the other hand, reflects the fact that negligible or insignificant elements of the mark will be forgotten (or not memorised in the first place)."

45. Given my findings regarding the role played by the words 'Girl Scout Cookies' in the overall impression of the 120 mark and taking note of Mr Johnson's comments, I consider that due to their size and position, consumers will only pronounce the central

[5] BL O/1141/25

and dominant element ‘Tastebudz’ when referring to the 120 mark verbally. Consequently, the respective marks are aurally identical.

46. If I am wrong and all the verbal elements are articulated in the 120 mark, then the aural similarity between the marks will be reduced to between a medium and high degree as the word ‘Tastebudz’ will still be the first word that is spoken and as such will have a greater impact than the words that follow.

Conceptual comparison

47. Both marks include the words Tastebudz/Taste-budz which will be regarded as a misspelling of the word ‘taste buds’ meaning the sensory cells on the tongue which allow different tastes to be recognised. The images in each mark merely reinforce the tasting process. Although Ms Douglas’ evidence contains references suggesting that Girl Scout Cookies is a variety or strain of cannabis seed, this has not been directly advanced by either party and neither do I consider that there is sufficient basis to conclude that this meaning would be immediately graspable by a significant proportion of consumers (albeit it may be to a small discreet proportion). These words will therefore be given their obvious and ordinary meaning. Taking these matters into account, as a result of the common element TASTE-BUDS which dominates the marks, they are overall conceptually highly similar.

Distinctive character

48. Registered trade marks possess varying degrees of inherent distinctive character. Those marks that are regarded as descriptive of the goods will possess a low degree of distinctiveness. Conversely invented words with no association to the goods are highly distinctive. The more distinctive the earlier marks (either per se or by the use that has been made of them) the greater the likelihood of confusion.[6]

49. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,* Case C-342/97, the CJEU stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an

[6] *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch)

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).

50. The 120 mark is dominated by the misspelt word Tastebudz and the highly stylised pictorial element such that both these elements increase the level of the distinctive character from the word in isolation. Notwithstanding that the evidence points to the goods being cannabis related products and therefore the word and image may allude to the goods providing an enhanced sensory experience, the assessment of the distinctive character of a mark must be made on a notional basis of the specification as registered. Consequently, given that the mark is not directly descriptive of the goods being *seeds* more generally, I consider that, as a whole it possesses between a medium to high degree of inherent distinctive character. The word Tastebudz solus is inherently distinctive to a slightly higher than medium degree as a result of it being a misspelling of a dictionary word and the stylisation and font used.

Enhanced Distinctive Character

51. Ms Douglas did not claim an enhanced degree of distinctive character in relation to the 120 mark although she did file evidence to support the claim that it held a reputation.

52. Ms Douglas' evidence for the most part deals with issues more relevant to her bad faith claim. However, in relation to her claim to holding a reputation, which would equally apply to a claim to an enhanced degree of distinctiveness, I note the high point of Ms Douglas' evidence consists of a small selection of invoices (five in total) to one wholesaler[7] and a self generated document headed Sales Report.[8] In so far as the sales document is concerned, which is said to cover the period from February 2020 to September 2022, the document appears to indicate total profits generated of over £200,000. Whilst I note that the five invoices tally with five entries in the sales report,

[7] Exhibit TB7
[8] Exhibit TB6

there is no reference to the mark within the document itself or that the remaining entries are attributable to the sale of goods under the Tastebudz mark as opposed to other branded goods being used by the parties at the time. I also note that the figures produced by Ms Douglas appear to be contradicted by those provided by Mr Gill's accountant in his letter dated 1 August 2023[9] where he attributes profits arising from the supply of Tastebudz products per annum as £657, £445 and £925, over the same period. Notwithstanding that Ms Douglas disputes the accuracy of the figures provided by Mr Gill's accountant, I cannot be certain that the figures produced by Ms Douglas reflect the level of sales as claimed either, given the sparsity of the other evidence filed, which does not support sales to the degree claimed.

53. Ms Douglas also provides details of promotional activities undertaken over the same period, which include a small selection of social media advertising by sponsored individuals, attendance at conventions and trade shows, and the display of the mark on packaging, merchandise and promotional banners.[10] I note that the social media posts are dated in September 2021 but there is very little engagement from consumers to the posts and even then it is not clear whether these were viewed by UK followers.

54. Further a number of the promotional material produced, by way of flyers/posters advertising sponsorship or attendance at events appear to have taken place in the USA and Canada as opposed to the UK. I note that the images in relation to stands and events are undated and it is not clear whether they relate to activity within the UK or overseas, how many people attended or the sales generated as a result. No indication is given as to how geographically widespread the use was, the amount expended on marketing or the market share held.

55. Given the very limited level of engagement shown from consumers, and taking the evidence as a whole, I am not satisfied that it is sufficient to demonstrate that the 120 mark has enhanced its distinctive character to a degree beyond that which it holds inherently.

[9] Exhibit TB8
[10] Exhibit TB10 – TB11

Likelihood of confusion

56. In determining whether there is a likelihood of confusion between the marks I must consider whether there is direct or indirect confusion. Direct confusion is where one mark is mistaken for the other or imperfectly recalled, whereas indirect confusion is where the average consumer recognises that the marks are not the same but nevertheless the similarities that exist between the marks lead to the belief that the respective goods originate from the same or related source.

57. The difference between the two types of confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:[11]

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> > (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

[11]BL O/375/10.

distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI", etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

58. I bear in mind that the examples as set out by Mr Purvis in *L.A.Sugar* (above) are not exhaustive and that they are only intended to be illustrative of the general approach.[12] Furthermore, in *Liverpool Gin,* Arnold L.J. pointed out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. A finding of indirect confusion should not be made merely because two marks share a common element; it is important to note the aspects of the other elements within the respective marks and the part they play.

59. There are a number of factors in the global assessment to bear in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the 120 mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

60. I remind myself that earlier in my decision I made the following findings:

- The 829 mark was visually similar to the 120 mark to between a medium and high degree.
- Taking my primary position that only the word Tastebudz/Taste-budz would be articulated then the respective marks were aurally identical, otherwise if the

[12] *Liverpool Gin Distillery Limited v Sazerac brands LLC* [2021] EWCA Civ 1207

words Girl Scout Cookies were also articulated the aural similarity would be reduced to between a medium and high degree.

- The marks were conceptually highly similar.
- The respective goods were identical.
- The average consumer was a member of the general public undertaking between a low and average degree of attention in the selection process, purchasing the goods predominantly by visual means but not discounting aural considerations. I accepted that some average consumers would be business users and that the level of attention for those would be slightly higher but to no more than a medium degree.
- The 120 mark as a whole was inherently distinctive to between a medium and high degree, but the stylised word Tastebudz solus was inherently distinctive to slightly higher than a medium degree.

61. Dealing with direct confusion first. I consider that given the identity between the respective goods and the use of the highly similar dominant elements in the marks, the differences that I identified earlier will not be sufficient for the marks to be distinguished from each other by consumers, even for those paying a medium degree of attention in the selection process. As a result of the interdependency principle in my view any differences between the marks in their visual presentation will be offset by the identity between the goods. I take particular note of the fact that the same colour and font is used in the lettering of the word Tastebudz/Taste-budz and that the words are presented within a highly similar device of an open red lipped mouth which are very similarly stylised sharing the same overall aesthetic, look and feel. When consumers seek to recall the marks, they will focus their attention on the dominant elements of the respective marks namely the open mouth and the words, paying particular attention to the misspelling of the word Tastebudz/ Taste-budz in each mark. They will not in my view remember whether this word is hyphenated or presented as one word or remember the presence/omission of other less dominant elements. Given that marks are not compared side by side, I consider that consumers will misremember or imperfectly recall the marks one for the other. This results in a likelihood of direct confusion.

62. If I am wrong and the differences between the particular presentational elements are noticed, namely the different images used in each mark and the additional words, I still believe that confusion will arise. This is because each mark is dominated by highly similar elements namely the word Tastebudz/Taste-budz together with an open red lipped mouth device. In my view the differences I identified earlier will be regarded as one mark being a more stylised version of the other and the differences put down to an alternative mark being used by the same or related undertaking. Consumers will regard the differences in the 829 mark as an alternative or simplified version of the 120 mark, used on social media and invoices for example, where the more stylised version is used on the packaging of the product itself or any promotional material. The style of the pictorial elements and the font and stylisation of the word Taste-budz used in the 829 mark follows that used in the 120 mark such that consumers already familiar with the 120 mark will believe that the 829 mark is another variant used by the same or related entity.

63. I note that Ms Douglas has provided some evidence of a small number of instances of confusion, however, this evidence is neither persuasive nor determinative, as the assessment of a likelihood of confusion must be based on an objective test of all the relevant factors.

64. For the reasons outlined above, and taking all global factors into account, I consider that there would be a likelihood of confusion and the invalidation action under section 5(2)(b) succeeds in its entirety.

Other grounds

65. Strictly speaking, having succeeded under section 5(2)(b), the determination of the remaining grounds is unnecessary. However, for completeness I shall deal with these grounds albeit briefly.

Section 3(6)

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

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

67. 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)."

68. According to *Alexander Trade Mark*,[13] the key questions for determination in a claim of bad faith are:

(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

[13] BL O/036/18

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

69. The date for assessing whether an application to register a trade mark was made in bad faith is the filing date the application. In this case, the relevant date is 3 November 2022. It is necessary therefore to ascertain what Mr Gill knew at the relevant date, albeit the evidence of subsequent events may be relevant if it casts light backwards on the position as at the relevant date.[14]

70. 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 (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as they are with bad faith.[15] Also, it is for the party alleging bad faith to prove it. The initial evidential burden therefore falls upon Ms Douglas: she must provide evidence from which a rebuttable presumption of bad faith can be drawn. Provided she does that, then the burden shifts to Mr Gill to rebut the allegation.

71. I shall start by considering the evidence filed by both parties.

Ms Douglas' evidence

72. Ms Douglas states that she was a co-founder of the Tastebudz business and a joint proprietor of the 120 mark with Mr Gill. She relies on emails and trade mark records in support of this claim which, she says, identify her as a co-founder, owner and business partner.[16] Further she provides an undated excerpt of an article taken from Vice magazine in which she is identified as the owner of Tastebudz while attending a convention.[17]

73. She contests Mr Gill's assertion that he founded and ran the Tastebudz business solely or that she filed the application in relation to the 120 mark in joint names without his knowledge and consent. Ms Douglas provides documentation to show that the

[14] *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).
[15] *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)
[16] Exhibit TB1, TB2 and TB5
[17] Exhibit TB5

application was submitted by Mr Gill rather than herself, supporting her claim that they were co-owners and that he was fully aware that the application would be held jointly.[18]

74. Ms Douglas outlines her role in the Tastebudz business between May 2019 and September 2022 and sets out her contribution to the partnership.[19] She states that she was responsible for branding, logo and packaging development, sourcing product content and images, researching product names and descriptions, social media management, marketing materials, invoicing, website development and the sourcing of products, sponsors and promotional opportunities.

75. Ms Douglas provides details of sales and turnover, including a sales report covering the period 4 February 2022 to 14 September 2022[20] and five sample invoices (dated from December 2020 to February 2022) showing sales made under the mark to one wholesaler.[21] I note that all the invoices are issued by 'Discreet Gifts T/A Tastebudz' some of which show account details directing payment to an account held in Mr Russell Gill's sole name. Ms Douglas refers to correspondence from an accountant regarding profits covering the period 2020 to 2022 but disputes that the figures are accurate.[22]

76. Ms Douglas provides evidence regarding the use of the Tastebudz trade mark in relation to seeds from at least February 2020. In support she produces a promotional email from a wholesaler introducing the brand.[23]

77. It is said that the business was promoted as a female-owned or female-led enterprise, including social media content, online references and communications said to have been made by Mr Gill. She produces various correspondence regarding her role in the business.[24]

78. Ms Douglas states that she was responsible for the creation and development of the Tastebudz logo, working directly with the design agency and designer for all

[18] Exhibits TB1 to TB4
[19] Paragraph 4
[20] Exhibit TB6
[21] Exhibit TB7
[22] Exhibit TB8
[23] Exhibit TB9.
[24] Exhibit TB12-TB14

aspects of the design. She relies on emails with the designer and invoices relating to earlier logo concepts.[25]

79. Following the registration of the 829 mark, Ms Douglas gives examples of a number of the business' previous customers querying the commercial origin of goods supplied by Mr Gill. She states that she received complaints from customers who mistakenly purchased products associated with Mr Gill believing they were those provided by the previous business in which she was associated. She produces screenshots taken from various messaging apps which although undated appear to have been sent after the relevant date. Ms Douglas also provides an example of Mr Gill contacting a previous customer attempting to change the contact details they held in an attempt to divert trade from the previous business to one he was trying to establish in his sole name.[26]

80. Ms Douglas provides evidence concerning the use of social media accounts, websites and email addresses, established in 2019. She states that she has continued to use the original Tastebudz online platforms since, whereas Mr Gill established new accounts after the end of their partnership.[27]

Mr Gill's evidence

81. Mr Gill's evidence is as follows:

- he is a sole trader specialising in the sale of seed products and has operated a business under the name "Discreet Gifts" since 2015. He states that he conceived the name "Tastebudz" in 2019 and adopted it as a sub-brand for seed products sold through his business.
- during the time he filed the original registration (the 120 mark) in May 2019, Ms Douglas was employed by another seed business, Hocus Pocus, rather than by Mr Gill. Mr Gill states that he worked alongside Ms Douglas and asked her to assist him with matters relating to his business. He exhibits a letter from his accountant said to confirm Ms Douglas' employment with Hocus Pocus between December 2013 and June 2019.

[25] Exhibit TB15-TB16
[26] Exhibit TB19
[27] Exhibit TB20-TB21

- he instructed Ms Douglas to liaise with a Dutch design company, Vandenburg Products, regarding the creation of the Tastebudz logo. He states that he directed the communications, paid approximately €300 for the logo design and exhibits the resulting logo.
- he decided to protect the logo by way of a trade mark registration and instructed Ms Douglas to file the 120 trade mark application on his behalf in May 2019. He states that the application fee was paid by him and that his email address was provided to the UKIPO as the contact address.
- a copy of UKIPO correspondence dated 20 June 2019, is produced which he says was addressed to him and identified him as the owner of the application.
- he sold and advertised seeds under the Tastebudz brand and provides details of a purchase order dated 29 January 2020 from Basil Bush Limited addressed to "Discreet Gifts T/A Tastebudz". Further he states that he instructed a YouTuber DS to promote the products, for which he was paid £1500 for doing so. The invoice dated 23 August 2022 is produced to show that it was addressed to Discreet Seeds. I note that no reference is made to the Tastebudz mark.
- the business Hocus Pocus ceased trading in September 2019, and it is said that, after this, Ms Douglas began providing administrative assistance to Mr Gill's business. Mr Gill states that her duties included customer communications, social media activity and handling payments. He states that she was paid a fixed amount, that no partnership existed between them, and that he continued to operate as a sole trader.
- It is accepted that sometimes Mr Gill referred to Ms Douglas as a partner when dealing with customers and that some advertising described the business as female-owned. However, he states that these descriptions were adopted to "help her communicate with those customers and to make us look like a bigger, more established business" and "because I had seen other businesses in the seeds industry make this claim [to be female owned] and noticed that it worked well to differentiate them in a mainly male industry". Mr Gill refutes that they actually operated as a partnership. Mr Gill states that he filed all relevant tax returns for the business as a sole trader and did not register any partnership with Ms Douglas with HMRC at any point. He states that he paid Ms Douglas a

fixed amount to carry out work for the business. I note no documentation is provided to support his contact with HMRC.

- The working relationship between himself and Ms Douglas ended in or around September 2022 after the parties fell out. Mr Gill states that Ms Douglas stopped working for him but alleges that thereafter she claimed ownership of the Tastebudz business and brand, contacted wholesalers and stockists asserting that she was the true owner, and published social media posts alleging that Tastebudz products sold by him were “fakes”.
- After becoming aware of those activities, Mr Gill reviewed the original trade mark application [the 120 mark] and discovered that it had been filed in the joint names of himself and Ms Douglas (which I take to mean that he only became aware after September 2022). He states that he had intended and instructed Ms Douglas to file the application in his sole name and that he had not been informed that she had added herself, as a joint applicant.
- He filed the 829 trade mark after discovering that Ms Douglas was making inaccurate and damaging claims that she was the true owner of the Tastebudz brand and had been entered as a joint applicant for the earlier 120 mark. He considered himself to be the legitimate owner of the Tastebudz business and brand. He further states that he believed he was entitled to take steps to protect his interests in the brand and filed the 829 mark accordingly.

Ms Douglas’ evidence in reply

82. Ms Douglas’ evidence in reply for the most part is merely rebuttal evidence serving to dispute Mr Gill’s assertions/claims. I do not propose therefore to outline this statement to any extent. Suffice to say Ms Douglas disputes Mr Gill’s account of their working relationship or the assertions made within his witness statement. In particular Ms Douglas states that it was her who conceived the Tastebudz name and logo concept in 2019 and produces correspondence with the design company said to show the early discussions regarding the logo design.

83. Ms Douglas produces various correspondence relating to the circumstances leading to the filing of the 120 mark which she states demonstrates that both parties are identified and that Mr Gill would have been aware of the details of the application, given that it was he that filed the application.

Assessment and findings of fact

84. Ms Douglas' pleaded case is that both parties had entered into a joint venture and that following their relationship ending, Mr Gill filed the application in his sole name in order to undermine or otherwise interfere with the existing business that was being run by the parties jointly and to attempt to benefit in his name alone. Whilst both parties confirm that the 'relationship' ended at some point in September 2022 neither provides information as to the reasons why. The fact that Mr Gill acknowledges that the parties had a relationship undermines to a degree his contention that he was solely responsible for the business, albeit I accept that he views the relationship as one of employer-employee. Although Mr Gill states that he was unaware of the joint ownership of the 120 mark I note that he has not made any attempt to change the status of the proprietorship or challenge this position since discovering this fact. It appears clear, however, that the ending of the relationship precipitated Mr Gill filing an application in his sole name.

85. Whilst the evidence from both parties is sparse, I am satisfied that Ms Douglas has sufficiently demonstrated that the parties were in a joint venture together. I do not accept Mr Gill's assertions that he was solely responsible for setting up the business under the Tastebudz brand as a sole trader. I find that the evidence supports Ms Douglas' contention that they were partners, which is demonstrated by correspondence at the time from Mr Gill in which he refers to her as his co-founder and business partner. I do not accept Mr Gill's explanation that the only reason he referred to her in these terms was to inflate the business' profile with third parties and customers. His explanation does not ring true, particularly when taken together with the evidence which shows that the application for the 120 mark was filed by Mr Gill and granted in joint names. The letter from the Registry sent to him at his address and the subsequent email he sent to Ms Douglas confirming the application as having been accepted, undermines his evidence that he was not aware of and did not consent to the application being made in joint names.

86. It appears that this business was running alongside Mr Gill's other business and that payments and invoices were paid through accounts belonging to Mr Gill. The invoices submitted from both parties are addressed to Mr Gill and to Discreet Gifts trading as Tastebudz. I am not entirely clear and have not been told as to the exact

structure of the business, how payments were to be made or profits split. However, I find that it was more likely than not to have been a shared enterprise. Although the evidence is not extensive, on balance it supports Ms Douglas' case that the parties entered into the venture jointly and that, contrary to Mr Gill's account, they were in an informal partnership and co-founded the business together.

87. Against this background, therefore, the explanation provided by Mr Gill that the filing of the 829 mark was done so as to protect his interest as a sole trader does not ring true. Whilst I acknowledge that as a co-owner he would have had some rights in the business, this does not justify him misappropriating those rights for himself when the partnership ended, rights that were previously held jointly. I find that in filing the 829 mark in his sole name, Mr Gill was attempting to secure for himself exclusive rights in a mark which corresponded closely to a jointly owned mark held with a partner with whom he had, if not a contractual relationship, at least a quasi contractual one. Perhaps in his mind, because the relationship had come to an end, he believed that he was justified in making the application in his sole name. However, in my view he did so in an attempt to lay claim to a right for himself to the exclusion of his partner. I find that Mr Gill filed the application of the contested mark to try and take advantage of any business contacts that had been built up and attempting to put himself in a position to undermine that business by taking it for himself. It is clear that he made attempts to contact existing customers instructing them that the contact details had changed in direct competition with the joint venture with which Ms Douglas was involved. I consider that his actions in this regard amount to bad faith.

88. Mr Gill's explanation has been undermined by the documentary evidence, which calls material aspects of his evidence into question. Whilst not the strongest Ms Douglas has sufficiently raised a prima facie case that Mr Gill has failed to rebut. I find that the application in Mr Gill's sole name was done in order to undermine Ms Douglas' legitimate interests as a joint owner and was an attempt to exclude her from continuing that business. In my view the 829 mark was applied for in bad faith and Mr Gill's actions in so doing fall below the acceptable standards of honest practices.

89. The invalidity based on section 3(6) succeeds.

Section 5(3)

90. Section 5(3) of the Act states:

> "A trade mark which-
>
> (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
>
> (3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

91. I bear in mind the relevant case law set out in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The conditions of section 5(3) are cumulative. Firstly, Ms Douglas must show that the 120 mark is similar to the 829 mark. Secondly, Ms Douglas must show that the 120 mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first three conditions are met, section 5(3) requires that one or more of the types of damage will occur. For the purposes of section 5(3) the relevant date for the assessment is 3 November 2022.

Similarity between the marks

92. In light of my earlier findings where I found the marks to be visually, aurally and conceptually similar in varying degrees, this first condition is met on the same basis and for the same reasons.

Reputation

93. In *General Motors*, Case C-375/97, the CJEU held that:

> “25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State‘. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout‘ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

94. In assessing whether the 120 mark has a reputation to a significant part of the relevant public, I must assess the evidence in terms of the extent it demonstrates “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”[28]

95. I note that the assessment of whether Ms Douglas holds a reputation for the goods claimed is a different test to the one undertaken for an enhanced level of distinctive character, but in reality, they rarely produce different outcomes. I have already summarised and assessed Ms Douglas’ evidence earlier in my decision when considering whether the 120 mark had enjoyed an enhanced level of distinctive character through use.

96. In light of my earlier findings regarding Ms Douglas’ failure to demonstrate that the 120 mark enjoyed an enhanced degree of distinctive character, I consider that those findings apply equally to the assessment of whether it holds a reputation. For the same reasons, I find the inadequacies highlighted in terms of the small scale of sales, promotional activity and engagement with consumers, means that I am unable to

[28] *General Motors* para 27

conclude that the mark benefits from a reputation. I am unable to assess the economic strength, market penetration or the degree of consumer recognition in the mark. In my view whilst the sales and invoices establish that the business was trading, they are insufficient to conclude that the mark enjoyed any degree of reputation as claimed.

97. For these reasons the evidence falls short of establishing that the 120 mark holds a reputation as claimed and without being able to show a protectable reputation no damage can follow. Ms Douglas' claim under section 5(3) falls at the first hurdle.

Section 3(1)(b)

98. I can deal with this ground swiftly. This ground is misconceived and the pleaded case does not address the applicable principles that have to be applied in order to succeed under this ground. The 829 mark includes the misspelling of a dictionary word in a highly stylised font. Further the word is used in conjunction with a stylised device. Whilst the mark as a whole may, by some consumers, allude to the perception of a heightened sensory experience, neither the word nor the figurative elements are descriptive or devoid of distinctive character in relation to the goods at issue. I find that the 829 mark as a whole is distinctive. Further Ms Douglas has not expanded on her pleaded claim other than setting out the statutory wording of the section. I find no merit in the claim brought under this provision and find that the mark as a whole is sufficiently distinctive for it to be able to function as a trade mark to denote trade origin.

99. Consequently, the claim brought under section 3(1)(b) fails.

Overall conclusion

100. Ms Douglas' invalidation action succeeds under sections 5(2)(b) and 3(6) but the grounds under sections 5(3) and 3(1)(b) fail.

The Opposition

101. In light of these findings, given that Mr Gill is not able to rely on the 829 mark as an earlier right, the opposition under section 5(2)(b) against UKTM no. 3846443 inevitably fails.

Conclusion

102. The application for invalidation against UKTM no. 3845829 succeeds and pursuant to section 47(6) of the Act, the registration is deemed never to have been made.

103. The opposition against UKTM no. 3846443 fails and the application shall proceed to registration in respect of all the goods and services as outlined below:

UKTM no. 3846443

Class 16: packaging materials.

Class 25: clothing.

Class 31: Seeds.

Class 35: Advertising.

Costs

104. Ms Douglas has succeeded overall, in both the invalidation and the opposition and therefore, she is entitled to a contribution towards her costs. I note that as a litigant in person her costs are governed by the Civil Procedure Rules, Part 46 which awards costs at a rate of £19 per hour. Ms Douglas completed a pro forma document outlining 31 hours of work undertaken in prosecuting and defending this case, amounting to £589. I do not consider that this figure is unreasonable bearing in mind that there were two sets of proceedings and that it would have taken Ms Douglas more time to prepare her case and consider the documents than would be the case were she a legal professional. Consequently, I make the award as claimed in addition to the official fee for bringing the action. Whilst I note that she was unsuccessful on two of the grounds brought, this does not materially affect the reasonableness of the claim and the award that I make.

105. I award costs as follows:

31 hours at £19ph	£589
Official fee	£200
Total	**£789**

106. I order Mr Russell Gill to pay Ms Faye Douglas the sum of £789 as a contribution towards her costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 16th day of October 2026

Leisa Davies

For the Registrar