O/0947/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004128484
BY COSAMI LLC
TO REGISTER:

Wanonoo

AS A TRADE MARK IN CLASS 28

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 451629
BY CHUNFEN HU

BACKGROUND AND PLEADINGS

1. On 23 November 2024, COSAMI LLC ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 06 December 2024 in respect of the following goods:

> **Class 28:** *Baby playthings; Toys for infants; Toys for animals; Motor driven toy animals; Toy animals; Toy trains; Toy vehicles; Toy vehicle playsets; Toy construction blocks.*

2. On 27 December 2024, the application was opposed in its entirety by CHUNFEN HU ("the opponent") based upon Section 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under this ground, the opponent relies upon the sign 'Wanonoo' which it claims to have used throughout the UK since 2 February 2024 in relation to *Baby playthings; Toys for infants; Toys for animals; Motor driven toy animals; Toy animals; Toy trains; Toy vehicles; Toy vehicle playsets; Toy construction blocks*. The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

3. The applicant filed a defence and counterstatement denying the claims made.

4. The applicant is represented by LINPULSE LIMITED, whereas the opponent is represented by AXIS PROFESSIONALS LTD.

5. Both parties filed evidence in these proceedings. Neither party requested a hearing, nor did they file written submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

6. 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

7. The opponent's evidence came in the form of a witness statement from Hu Chunfen, the opponent himself, dated 17 May 2025. Mr Chunfen's witness statement is accompanied by three exhibits, being those numbered 1-3.

8. The applicant's evidence came in the form of a witness statement from Lifeng Chen dated 2 September 2025. Mr Chen is the director of ETHOSCAPE LIMITED, the applicant's predecessor in title. Mr Chen states that ETHOSCAPE LIMITED *"was the original proprietor of the trade mark "Wanonoo", which was actively used in the United Kingdom prior to July 2025 in relation to the goods specified in the application"*. His witness statement is accompanied by four exhibits being those labelled A-D.

9. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

10. Section 5(4)(a) states:

> "(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."

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

The relevant date

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

> "43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:
>
> > 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

15. The applicant filed evidence during the evidence rounds. I will consider such evidence briefly at this point, insofar as it is necessary to assess whether it establishes that there has been use of the contested mark prior to the filing date of 23 November 2024.

16. Mr Chen says that on 1 July 2025, the applicant acquired the trade mark "Wanonoo" from ETHOSCAPE LIMITED. Most of Mr Chen's evidence consists of comments about the opponent's evidence. Insofar as Mr Chen refers to use of the contested mark, he simply says that the mark 'Wanonoo' was actively used by ETHOSCAPE LIMITED in the UK prior to July 2025, however, he does not specify if the first use was earlier than the application date of 23 November 2024. Mr Chen produces additional evidence including: (a) a statement dated 1 July 2025 setting out the reasons for acquiring the contested application;[1] (b) a copy of a sale agreement

[1] Exhibit A

and an exclusive sale agreement between the applicant and CASSIOUEMI LIMITED, a UK-based company, for the purchase and distribution of some goods, however, these documents are dated 11 and 7 August 2025 respectively (i.e. after the relevant date), and contain no reference to the mark 'Wanonoo';[2] (c) screenshots from the website https://wanonoo.co.uk/, showing the trade mark 'wanonoo' used in relation to toy products; however the pages are undated. Accordingly, since this evidence does not establish that the applicant has used the mark before the date of the application, I will assess the passing off claim at the *prima facie* relevant date of 23 November 2024.

Goodwill

17. The meaning of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) as follows:

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

18. As regards the proof of goodwill, in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing of 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

[2] Exhibit B and C

(OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

19. 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."

20. Goodwill must be more than trivial in extent. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

"62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you

could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

21. The opponent's evidence is very brief. Mr Chunfen's stated as follows:

"My trade mark Wanonoo has been used worldwide for a long time, and has achieved good reputation, but there has been no registration certificate in the UK before.

2. Attached as Exhibit 1 are Product Image of the Opponent's in the United Kingdom.

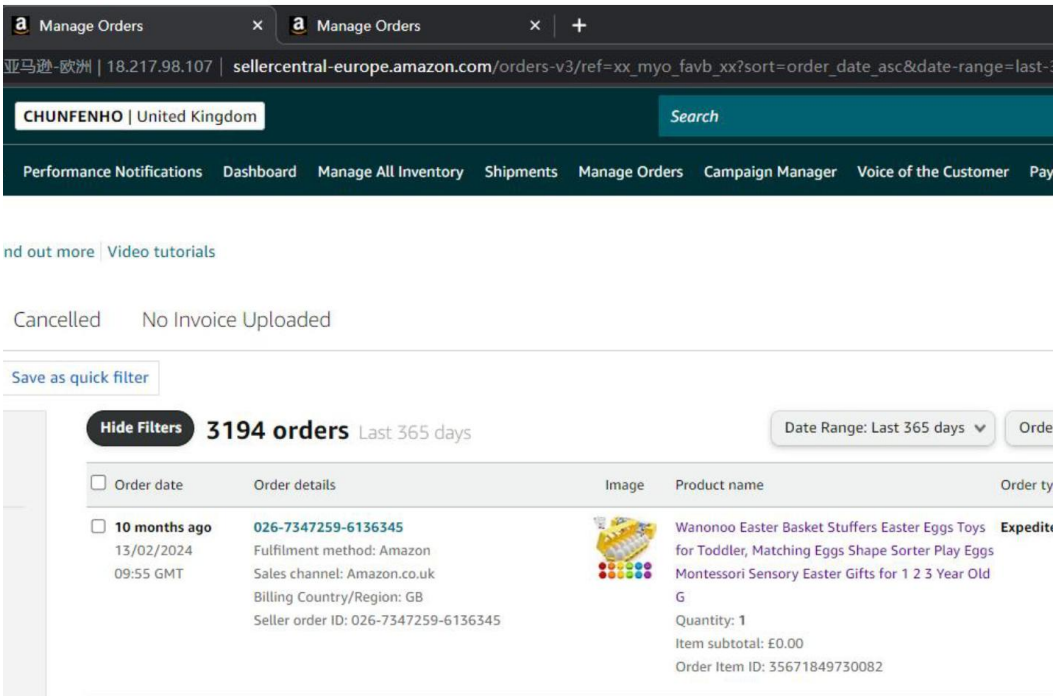
3. Attached as Exhibit 2 are sales records of the Opponent's in the United Kingdom.

4. Attached as Exhibit 3 are examples of the Opponent's Wanonoo products that are available for purchase through the Opponent's website: https://www.amazon.co.uk/dp/B0CQJW9J18?th=1"

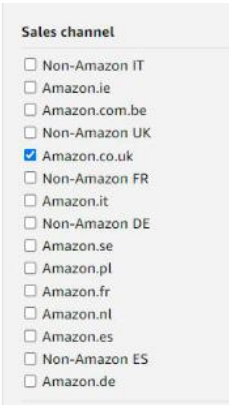
22. The first thing to note is that Mr Chunfen's statement that its "*trade mark Wanonoo has been used worldwide for a long time*" lacks any context. It is a very general statement that is wholly unsupported by any further narrative or exhibited evidence and does not establish that Mr Chunfen used the sign 'Wanonoo' in the UK in relation to the goods claimed prior to the relevant date of 23 November 2024.

23. Exhibits 2 is, admittedly, the most relevant evidence. The exhibit is described as showing sales records and consists of screenshots from Amazon showing a number

of orders made through Amazon UK. There are eight orders all dated February 2024, i.e. before the relevant date. Each order relates to a single unit, amounting to a total of eight units sold. The goods in question are baby toys:



24. As it can be see, the screenshot exhibited indicates that 3,194 orders were placed. Although the page identifies the source of this information as sellercentral-europe.amazon.com (rather than a specific record relating to Amazon UK), in his witness statement, Mr Chunfen confirmed that the sales shown in exhibit 2 relate to the UK, and this evidence has not been challenged. Furthermore, the screenshots indicate that only UK sales have been selected:



25. Having said that, no information is provided as to whether any of the goods purchased through the 3,194 orders bore the sign relied upon. Nor is there any indication of the specific products to which these sales relate, and the witness statement provides no further information on this point. Lastly, while it is clear that eight purchases were made in February 2024, the evidence indicates that the 3,194 orders were received within the "last 365 days", and the screenshots are dated "2024/12/5" which I consider to be 5 December 2024. I therefore consider that the 3,194 orders received may include (a) sales that were made after the relevant date of 23 November 2024; (b) sales of goods other than those relied upon; and (c) sales of goods made under signs other than the sign relied upon.

26. I have considered the evidence as a whole for the purpose of determining whether the opponent had established a protectable goodwill under the sign at the relevant date. Whilst the evidence demonstrates that a small number of items bearing the sign 'Wanonoo' were sold by the opponent through Amazon UK prior to the relevant date, I do not consider those sales to be sufficient to establish more than a trivial level of goodwill. As noted above, the evidence identifies only eight orders, each relating to the sale of a single toy. Although the documented trading activity appears more extensive in terms of volume and scale, referring to 3,194 orders in total, there is insufficient information to establish what goods (and signs) those orders relate to, or whether the sales took place before the relevant date. Thus, the only unambiguous evidence of relevant trading activity is that relating to eight orders.

27. Accordingly, the evidence does not provide any indication of the overall value of the opponent's trading activity in the UK, or the economic significance of the sales made under the earlier sign. Furthermore, the evidence does not sufficiently establish the extent of the opponent's customer base, the geographical reach of its trading activity, the duration and continuity of its use (the sales documented being all concentrated in February 2024) or the extent of its marketing activity.

28. Taking all the above into account, I am satisfied that the opponent's evidence fails to establish the existence of a more than trivial goodwill at the relevant date. It follows that the opponent's passing off claim fails at the first hurdle.

OUTCOME

29. The opposition has failed and the application will proceed to registration.

COSTS

30. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £1,100 calculated as follows:

Preparing the counterstatement And considering the Form TM7:	£350
Filing evidence and considering the other party's evidence:	£700
Total:	£1,100

31. I therefore order CHUNFEN HU to pay COSAMI LLC the sum of £1,100. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 22nd day of October 2026

TERESA PINTO
For the Registrar