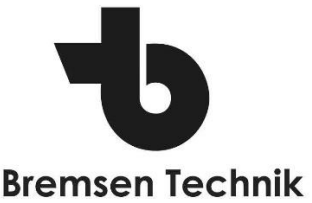
O/0975/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3772660
IN THE NAME OF BREMSEN TECHNIK HOLDINGS LIMITED
IN RESPECT OF THE TRADE MARK



IN CLASSES 1, 4, 7, 12 & 35

AND

THE OPPOSITION THERETO UNDER NO. 600002468
BY ANTHONY STOCK

Background and pleadings

1. Bremsen Technik Holdings Limited ("the applicant") applied to register the trade mark no. 3772660 as shown on the cover page of this decision in the UK on 1 April 2022. It was accepted and published in the Trade Marks Journal on 13 May 2022 in respect of the following goods and services:

> Class 1: *Brake fluids, Hydraulic fluid for brake and clutch systems.*
>
> Class 4: *Greases, lubricating graphite, oils for industrial purposes, lubricating oils, industrial oils, brake cleaner, permanent lubricant for brake systems.*
>
> Class 7: *Valve diaphragms; valves; servo valves; servo control valves; pneumatically operable valves, pneumatically operable actuators; hydraulic valves; valves for air brakes; compressors; air compressors.*
>
> Class 12: *Brake linings, Brake shoes, Brake disks, Brake drums, Wear indicators, rivet sets and Accessories, Hydraulic units for brake systems for land vehicles, in particular main brake cylinders, Wheel cylinders, Brake calipers, Braking installations, Brake hoses; Brake boosters; All the aforesaid goods for land vehicles.*
>
> Class 35: *Retail services, wholesale services, mail order services and electronic retail services all in connection with the sale of alternators, shock absorbers, batteries, belts for motor vehicles, air cushions, starter motors, brake discs, exhausts, clutches, vehicle tyre inflation systems, Brake linings, Brake shoes, Brake disks, Brake drums, Wear indicators, rivet sets and Accessories, Hydraulic units for brake systems for land vehicles, in particular main brake cylinders, Wheel cylinders, Brake calipers, Braking installations, Brake hoses, Brake boosters, Brake fluids, Hydraulic fluid for brake and clutch systems, Greases, lubricating graphite, oils for industrial purposes, lubricating oils, industrial oils, brake cleaner, permanent lubricant for brake systems, Brake fluids, Power steering fluids, Hydraulic fluid for brake and clutch systems, Greases, lubricating graphite, oils for industrial purposes, lubricating oils, industrial oils, brake cleaner, permanent lubricant for brake systems, Steering*

racks for vehicles, Steering linkages for vehicles, Valve diaphragms, valves, servo valves, servo control valves, pneumatically operable valves, pneumatically operable actuators, hydraulic valves, valves for air brakes, compressors, air compressors.

2. On 12 July 2022, Anthony Stock ("the opponent") opposed the trade mark. Following a number of amendments to the original form, including a request to add additional grounds, the opposition was ultimately filed on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. The opposition based on section 5(2)(b) and 5(3) of the Act relies upon UK trade mark registration no. 2617800 for the mark BREMSEN. By virtue of its earlier filing date of 16 April 2012, this registration constitutes an earlier mark in accordance with section 6 of the Act. The opponent relies upon all of the registered goods under both of these grounds, those being *components for motor vehicles* in class 12.

4. In respect of section 5(2)(b) of the Act, the opponent argues that the marks are highly similar and that the goods are either identical or highly similar, and that as such there exists a likelihood of confusion, including a likelihood of association between the marks.

5. In respect of the opposition based on section 5(3) of the Act, the opponent submits that he holds a reputation for the goods under the earlier mark, and that use of the contested mark would result in a link being made between the marks, including a misplaced belief that the marks derive from the same undertaking, or that there is an economic connection between the entities responsible for the same. The opponent argues that this will result in the contested mark taking unfair advantage of the earlier mark's reputation, as well as a likelihood of detriment to the distinctive character and reputation of the earlier mark.

6. In respect of section 5(4)(a) of the Act, the opponent claims he has used the sign BREMSEN in the UK since at least 2012, and that he owns goodwill in his business in respect of components for motor vehicles including brake pads and brake discs, as distinguished by that sign. The opponent submits that the applicant's use of the contested mark would result in a misrepresentation that the applicant's goods are

those of the opponent, and that this in turn would result in damage to the opponent's goodwill.

7. The applicant filed a counterstatement denying that the marks are similar, or that there will be a likelihood of confusion between the same. As the earlier mark had been registered for a period of over five years at the date on which the contested mark was filed, it is subject to the use provisions set out under section 6A of the Act, and the applicant requested the opponent file proof of its use within these proceedings. The applicant concedes that all of the goods in classes 7 and 12 are identical or similar to those covered by the earlier mark, but contends that the remaining goods and services are dissimilar. In respect of section 5(3) of the Act, the applicant denies that the marks are similar, and claims that it has a "justifiable reason" to continue the use and registration of its mark in the UK. In respect of the opposition based on section 5(4)(a), the applicant put the opponent to proof of his claimed goodwill, and asserts to be the senior user, claiming it has used its own mark in the UK since 2001. The applicant claims the opponent could not have held goodwill in the earlier mark at that date.

8. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Neither party filed written submissions and no hearing was requested. This decision is taken following a careful perusal of the papers.

9. The opponent represents himself in these proceedings. The applicant is represented by The Endeavour Partnership LLP.

10. 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

11. The opponent filed his evidence in the form of a witness statement in his own name. The statement is dated 15 June 2023. It introduces 11 exhibits labelled Exhibit 1 – Exhibit 11. These go to the use of the earlier mark.

12. The applicant filed its evidence in the form of a witness statement in the name of Brian Hall, managing director of the applicant. The statement is dated 20 September 2023 and introduces 30 exhibits, namely Exhibit BH1 to Exhibit BH30. These go to the applicant's use of its mark.

Proof of Use

13. The relevant statutory provisions are as follows:

Section 6A:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

14. Section 100 of the Act states that:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

15. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-

9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

16. In this instance it is for the opponent to prove his earlier mark has been used in the relevant territory, that being the UK, in respect of the goods relied upon, within the

relevant period beginning on 2 April 2017 and ending on the date of filing of the contested application, namely 1 April 2022.

17. I begin by noting that whilst there is no *de minimis* rule, the evidence filed by the opponent in this opposition is very thin. The witness statement filed by Mr Stock does not contain much information itself, rather it simply describes the exhibits filed. As previously set out, there are 11 exhibits filed in total. Exhibits 1, 5 and 7 are all images of boxes displaying the mark below:

18. The boxes are all labelled as either containing brake pads or brake discs. The images are undated, and no dates are provided in the witness statement. Exhibit 2 is described by Mr Stock as being "…fitting instructions for the installation and removal of disk brake pads from motor vehicles up to 3.5T." This shows an undated instructions manual headed with the mark below:

BREMSEN

19. Exhibit 3 is described by Mr Stock as "…the Bremsen labelled design as part of an overall artwork setting". However, looking at the exhibit it does not appear to display the mark or the goods, and it is not dated. Exhibit 4 is a simple undated image of the

logo displayed above in the colour blue, in which the letter 'B' has been omitted. Mr Stock does not appear to acknowledge the missing letter within his witness statement when referring to the exhibit. Exhibit 6 shows what appears to be promotional material for the business 'Marathon Warehouse Distribution', as well as a copy of what appears to be a page from this businesses' UK website.[1] This material shows the Bremsen logo above as well as the word BREMSEN used in relation to brake discs and pads, and hub and wheel 'brg' kits. No prices for the products are given on the promotional material, and no information regarding the promotional materials use or distribution is provided. Again, there is no date provided on the pages shown, or in the witness statement referring to this exhibit, although I note a reference to a nomination in the 2018 IAAF Car distributor of the year awards on the copied webpage, and so it seems likely this material dates from either 2017 or 2018. Exhibit 10 is an undated page onto which various logos have been placed. The Bremsen logo mark is shown as an image alongside what Mr Stock explains in his statement are his other marks. Exhibit 11 is what is described by Mr Stock in his witness statement as a wallcard, which again appears to be undated promotional material from Marathon Warehouse Distribution showing the Bremsen logo above. Again, no information regarding the possible distribution of this material is provided.

20. Exhibit 8 provides a stock receipt 'from' Marathon Warehouse Distribution NDC 'to' a company based in Italy. The stock receipt is dated 21 March 2019 and appears to detail the receipt of Bremsen goods. The goods all appear to be different types of brake pads and a total of 2996 items are listed on the single invoice, to the value of £22,558.31[2]. It appears to me as though this evidences the receipt of stock by Marathon Warehouse Distribution from LPR S.R.L. However, I note this could perhaps be the other way round, as it could have been sent with the shipment of goods rather than issued on the receipt of the same.

21. An invoice to a UK customer is provided at Exhibit 9. However, this invoice is dated outside of the relevant period on 28 July 2022. It details the sale of a single unit of brake pads to the value of £6.44 + VAT.

[1] Mr Stock describes Marathon Warehouse Distribution at his company within his witness statement.
[2] I have presumed this invoice is issued in GBP but it is not specified on the document itself.

22. I note that when assessing evidence of use, I must consider the picture that the sum of the evidence creates, rather than what each individual piece of evidence does or does not show. However, it is clear here that there are significant pieces missing in picture created by the evidence. The most fundamental flaw with the evidence provided is that it does not give a clear indication as to the extent of the use of the earlier mark within the relevant territory and timeframe. In the Registry's letter of 6 January 2023, the opponent was informed of the five-year period in which evidence of use was required. The opponent has not provided any figures relating to the sale or turnover of goods under the mark. Whilst I note the stock receipt provided, there is no evidence relating to whether (or indeed when) this stock was then sold on under the mark to customers in the UK. If this stock receipt is to be read the other way round, it simply indicates a single transfer of goods from the opponent's company to an entity in Italy. Whilst it appears from the evidence the mark BREMSEN has likely to some extent been used by a company related to the opponent, at least in relation to brake pads and discs, without any indication as to the extent of this use within the UK and within the relevant timeframe, it is impossible to determine whether there has been genuine use, for the purpose of creating and maintaining a market for the opponent's goods in the UK, during the relevant period.

23. In *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having

regard to the interests of the proprietor, the opponent and, it should be said, the public."

24. In my view, it should not have been difficult for the opponent to provide evidence of the extent to which the mark has been used within the UK and within the relevant time period. I do not consider the evidence provided sufficiently solid to show that the opponent has made genuine use of its mark.

25. For completeness, I note here that I have reviewed and considered Mr Stock's statements at paragraphs 1 and 2 of his witness statement, those being:

> "1. I attach 11 exhibits showing use of the trade mark BREMSEN in various formats and I confirm that this usage has been continuous since at least April 2012.
>
> 2. It will be seen that the use encompasses components for motor vehicles including brake pads and brake disks and I will go through each exhibit in sequence in that context."

26. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL O/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

> "21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:
>
> > [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or

her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

27. It is clear from the above that the broad assertions made by Mr Stock at the outset of his witness statement will not be sufficient to prove use of his mark, nor can they be used to fill in the significant gaps in the rest of the evidence provided.

28. As the opponent has failed to evidence genuine use of his earlier mark relied upon, the opposition based on section 5(2)(b) and 5(3) of the Act must fail.

Section 5(4)(a)

29. 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."

30. 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."

31. 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)."

32. 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."

33. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC, 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.'"

34. In this instance, the application was filed on 1 April 2022. However, the applicant claims to have been using its own mark since as early as 2001.

35. I would, at this point, normally review the evidence filed by the applicant, with a view to establishing the actual date of its first use. However, due to the sparsity of the evidence filed by the opponent in this instance, I will begin by considering the opponent's position in relation to goodwill at the filing date of 1 April 2022. If the opponent cannot support his claim to own goodwill in his business under the sign at the filing date, he will not be in a position to maintain the opposition under this ground. If this proves to be the case, it will not be necessary to consider the applicant's claim to be the senior user of the mark.

36. Goodwill is described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 233 as below:

> “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.”

37. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others,* [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 47 of the judgment) that*:*

> “I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.”

> And later said, at paragraph 52:

> “As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited in paras 21-26 and 32-36 above establish. The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a

case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant."

38. 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."

39. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> "... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

40. Considering the sum of the evidence filed by the opponent in this instance, which I have outlined in my assessment of proof of use at paragraphs 17 to 22, it is my view that it has not been established that prior to the relevant date, the opponent had customers within the UK. As set out in *Starbucks (HK) Limited* above, establishing goodwill within this jurisdiction requires the presence of clients or customers in the jurisdiction. Whilst I note the presence of the stock receipt, indicating (I believe) that the opponent's company received a shipment of stock from a company in Italy during the relevant period, this has not been furnished with evidence that this stock was then sold on to consumers in the UK prior to the relevant date, or indeed that is has been sold on at all. Further, even if is to be considered evidence of a stock transfer from the opponent's company to a company in Italy, for obvious reasons, namely that this is not evidence of customers in the UK, this does not further the opponent's case.

41. As I have not found the evidence sufficient to show the opponent held goodwill in his business at the filing date of the application, the opposition based on section 5(4)(a) of the Act must fail.

Final Remarks

42. The opposition has failed on all three grounds. The application will therefore proceed to registration in its entirety.

COSTS

43. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances, and in accordance with Tribunal Practice Notice 2/2016 I award the applicant the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Reviewing the TM7 and preparing and filing the TM8:	£400
Reviewing the evidence filed and preparing evidence:	£800
Total:	**£1200**

44. I therefore order Anthony Stock to pay Bremsen Technik Holdings Limited the sum of £1200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 14th day of October 2024

Rosie Le Breton

For the Registrar