O/0990/26

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. 3871064 & 3871065

BY MARK JACOBS

AND

IN THE MATTER OF THE OPPOSITIONS THERETO

UNDER NOS. 441860 & 441861 BY

DEE HARPER & WILLIAM HARPER

AND

IN THE MATTER OF UK REGISTRATION NOS. 3836020 & 3833355

IN THE NAMES OF DEE HARPER & WILLIAM HARPER

AND

IN THE APPLICATIONS FOR DECLARATIONS OF THE INVALIDITY THEREOF UNDER NOS. 506596 & 506597

BY AMERICAN RV CLUB

BACKGROUND AND PLEADINGS

1. These proceedings concern two oppositions and two applications for declarations of invalidity arising from competing claims to trade marks including the phrases "American Recreational Vehicle Club" or "American RV Club" or variations thereof. The oppositions have been brought by Dee Harper and William Harper against two trade mark applications made by Mark Jacobs. As I set out more fully below, they rely on two trade marks, of which they are the proprietor and which are the subject of the invalidity applications made by American RV Club.

2. The abbreviation "RV" stands for "Recreational Vehicle", which is defined in the evidence as *"a motorhome or caravan which is self-contained with all home conveniences, including cooking, sleeping and permanent sanitary facilities. An RV can either be self-propelled or hitched to a towing vehicle."*[1]

The Oppositions

3. On 24 January 2023, Mark Jacobs applied to register **THE ORIGINAL AMERICAN R V CLUB LTD** ("the 064 mark") and **AMERICAN RV CLUB (1993) LTD** ("the 065 mark") as trade marks in the United Kingdom. Both applications have identical specifications, namely:

> *Class 41*
> *Club services [entertainment].*

4. Both were accepted and published for opposition purposes on 7 April 2023.

5. On 7 July 2023, the applications were opposed by Dee Harper and William Harper. The oppositions are based on sections 5(2)(b), 5(4)(a) and 3(6) of the Trade Marks Act 1994 ("the Act") and the claims are identical.

6. Under section 5(2)(b), Mr and Mrs Harper rely on two earlier marks.[2] The first of these is UKTM No. 3833355 ("the 355 mark") for the series of two marks **AMERICAN RECREATIONAL VEHICLE CLUB** and **AMERICAN RECREATION VEHICLE CLUB**.

[1] Exhibit MJ2, page 23.
[2] A further mark, UKTM No. 3838755 was also originally relied on, but reliance on this mark was withdrawn following its surrender on 17 December 2024.

The 355 mark has an application date of 26 September 2022 and a registration date of 23 December 2022. It stands registered for the following goods and services:

Class 12

Vehicles; Towed vehicles; Automotive vehicles; Camping vehicles; Vans [vehicles]; Motor vehicles; Land vehicles; Sports utility vehicles; Land automotive vehicles; Land motor vehicles; Campers [recreational vehicles]; Recreational vehicles (RV); Truck campers [recreational vehicles]; Combination camping recreational vehicle and horse trailer.

Class 41

Recreation services; Information (Recreation -); Recreational camps; Recreational services; Recreational facilities; Recreation information; Recreation information services; Recreational park services; Providing recreational facilities; Recreational camp services; Recreation facilities (Providing -); Providing recreation facilities; Provision of recreational events; Provision of recreation facilities; Sporting and recreational activities; Recreation and training services; Recreation (Information relating to -); Organisation of recreational competitions; Providing facilities for recreation; Recreational facilities (Provision of -); Arranging group recreational activities; Provision of recreation information; Organisation of recreational activities; Provision of recreational areas; Organising of recreational events; Workshops for recreational purposes; Organisation of recreational tournaments; Provision of recreational facilities; Recreation facilities (Provision of -); Provision of recreational activities; Organisation of group recreational activities; Information services relating to recreation; Provision of facilities for recreation; Club recreation facilities (Provision of -); Providing facilities for recreational activities; Services for providing recreational facilities; Providing leisure and recreation facilities; Providing facilities for recreation activities; Recreational services for the elderly; Festivals (Organisation of -) for recreational purposes; Providing information relating to recreational activities; Arranging the provision of recreation facilities; Arrangement of conferences for recreational purposes; Arrangement of seminars for recreational purposes; Arrangement of conventions for recreational purposes; Fetes (Organisation of -) for recreational purposes; Services for the provision of recreational facilities; Provision of facilities

for outdoor recreational activities; Ticket reservation and booking services for recreational and leisure events.

7. The second mark relied on is UKTM No. 3836020 ("the 020 mark"), **ARV CLUB**, which has an application date of 5 October 2022 and a registration date of 30 December 2022. It stands registered for the following goods and services:

Class 12

Campers [recreational vehicles]; Recreational vehicles (RV); Truck campers [recreational vehicles]; Combination camping recreational vehicle and horse trailer.

Class 41

Recreational camps; Recreation services; Information (Recreation -); Recreational services; Recreational facilities; Recreation information; Recreation information services; Recreational park services; Providing recreational facilities; Recreational camp services; Recreation facilities (Providing -); Providing recreation facilities; Providing facilities for recreation; Recreational facilities (Provision of -); Arranging group recreational activities; Provision of recreation information; Organisation of recreational activities; Tuition in recreational pursuits; Provision of recreational areas; Organising of recreational events; Rental of recreation facilities; Provision of recreation facilities; Sporting and recreational activities; Recreation and training services; Recreation (Information relating to -); Organisation of recreational tournaments; Provision of recreational facilities; Recreation facilities (Provision of -); Provision of recreational activities; Information services relating to recreation; Provision of facilities for recreation; Club recreation facilities (Provision of -); Organisation of group recreational activities; Providing leisure and recreational facilities; Providing facilities for recreational activities; Services for providing recreational facilities; Providing facilities for recreational activities; Conducting of exhibitions for recreation purposes; Festivals (Organisation of -) for recreational purposes; Providing information relating to recreational activities; Arranging the provision of recreation facilities; Arrangement of conferences for recreational purposes; Arrangement of seminars for recreational purposes; Arrangement of conventions for recreational purposes; Fetes (Organisation of -) for recreational purposes; Services for the

provision of recreational facilities; Provision of facilities for outdoor recreational activities; Ticket reservation and booking services for recreational and leisure events.

8. These marks qualify as earlier marks under section 6(1) of the Act by virtue of their earlier filing dates. As neither mark completed its registration procedure within the five-year period preceding the filing date of Mr Jacobs' applications, Mr and Mrs Harper are not required to prove for the purposes of the section 5(2)(b) claims that the earlier marks have been used.

9. Mr and Mrs Harper claim that the parties' marks are highly similar and that the services covered by Mr Jacobs' applications are identical or equivalent to their own *Club recreation facilities (Provision of -)*, as well as other terms covered by their marks such as *Recreational services* and *Arranging group recreational activities*. Should they not be considered identical, Mr and Mrs Harper submit, the services are highly similar. Consequently, they claim that there is a likelihood of confusion under section 5(2)(b).

10. Under section 5(4)(a), Mr and Mrs Harper claim to have used the signs **AMERICAN R V CLUB**, **ARV CLUB, AMERICAN RECREATIONAL VEHICLE CLUB** and **AMERICAN RECREATION VEHICLE CLUB** throughout the UK since 1993 for the following goods and services:

Campers [recreational vehicles]; Recreational vehicles (RV); Truck campers [recreational vehicles]; Combination camping recreational vehicle and horse trailer.

Recreational camps; recreation services; Information (Recreation -); Recreational services; Recreational facilities; Recreation information; Recreation information services; Recreational park services; Providing recreational facilities; Recreational camp services; Recreation facilities (Providing -); Providing recreation facilities; Providing facilities for recreation; Recreational facilities (Provision of -); Arranging group recreational activities; Provision of recreation information; Organisation of recreational activities; Provision of recreational areas; Organising of recreational events; Provision of recreational events; Provision of recreation facilities; Sporting and recreational activities; Recreation and training services; Recreation (Information relating to -); Workshops for

recreational purposes; Provision of recreational facilities; Recreation facilities (Provision of -); Provision of recreational activities; Information services relating to recreation; Provision of facilities for recreation; Club recreation facilities (Provision of -); Organisation of group recreational activities; Providing leisure and recreation facilities; Providing facilities for recreational activities; Services for providing recreational facilities; Providing facilities for recreation activities; Conducting of exhibitions for recreation purposes; Festivals (Organisation of -) for recreational purposes; Providing information relating to recreational activities; Arranging the provision of recreational facilities; Arrangement of conferences for recreational purposes; Arrangement of seminars for recreational purposes; Arrangement of conventions for recreational purposes; Services for the provision of recreational facilities; Provision of facilities for outdoor recreational activities; Ticket reservation and booking services for recreational and leisure events; club services; vehicle clubs services.

11. Mr and Mrs Harper say that in the past they had a business connection with Mr Jacobs and that he is fully aware of their business. They claim that use of the 064 and 065 marks will constitute a misrepresentation that will deceive customers into thinking that the services provided under those marks are theirs or are endorsed by or related to them. They claim that this would damage their goodwill and so use of the 064 and 065 marks would be contrary to the law of passing off.

12. Under section 3(6), Mr and Mrs Harper claim that Mr Jacobs has sought to register marks to which he is not entitled and that he has filed the applications in a deliberate attempt to block Mr and Mrs Harper from securing rights to which they are entitled, to disrupt their business or gain leverage over it, and to mislead consumers. Consequently, they claim, the applications were made in bad faith and should be refused under section 3(6) of the Act.

13. Mr Jacobs filed a defence and counterstatement in each of the oppositions. He denied the claims made and stated that he was Vice Chairman of American RV Club, an organisation of which Mr and Mrs Harper were former members. He claimed to be acting with the full authority of his club in making the applications.

The Invalidation Applications

14. On 8 October 2023, American RV Club filed applications to have Mr and Mrs Harper's marks declared invalid under the provisions of sections 5(4)(a) and 3(6) of the Act, which are relevant in invalidation proceedings under section 47 of the Act. Those applications concern all the goods and services in respect of which those marks stand registered.

15. Under section 5(4)(a), American RV Club claims to have used the signs **AMERICAN RV CLUB** and **ARV CLUB** throughout the UK since 1993 for the following services:

> *Club services [entertainment]*
>
> *Recreational camps; Recreation services; Information (Recreation -); Recreational services; Recreational facilities; Recreation information; Recreation information services; Recreational park services; Providing recreational facilities; Recreational camp services; Recreation facilities (Providing -); Providing recreation facilities; Providing facilities for recreation; Recreational facilities (Provision of -); Arranging group recreational activities; Provision of recreation information; Organisation of recreational activities; Tuition in recreational pursuits; Provision of recreational areas; Organising of recreational events; Provision of recreational events; Sporting and recreational activities; Recreation and training services; Recreation (Information relating to -); Organisation of recreational tournaments; Club recreation facilities (Provision of -); Organisation of group recreational activities; Providing leisure and recreation facilities; Providing facilities for recreational activities; Services for providing recreational facilities; Providing facilities for recreation activities; Services for providing recreational facilities; Providing facilities for recreation activities; Conducting of exhibitions for recreation purposes; Festivals (Organisation of -) for recreational purposes; Providing information relating to recreational activities; Arranging the provision of recreation facilities; Arrangement of conventions for recreational purposes; Services for the provision of recreational facilities; Provision of facilities for outdoor recreational activities.*

16. American RV Club claims that it, rather than Mr and Mrs Harper, has acquired goodwill associated with these signs, that Mr and Mrs Harper's marks are identical to the earlier signs and that the goods and services covered by those marks are identical or highly similar to the services for which the signs have been used. It argues that there is a misrepresentation likely to lead the public to believe that services provided by Mr and Mrs Harper are those of American RV Club or are otherwise associated with it. Such a misrepresentation is likely to cause harm to its goodwill.

17. Under section 3(6), American RV Club claims that Mr and Mrs Harper's actions have fallen short of acceptable standards of commercial behaviour as they applied to register the 355 and 020 marks in the knowledge that the marks were the established trading names of American RV Club. Mr and Mrs Harper had been members of the club since 2009 and Mr Harper was banned from it for a year starting from 1 September 2022. The applications for the 355 and 020 marks were made on 26 September 2022 and 5 October 2022 respectively, a few weeks after Mr Harper's suspension from the club. Both Mr and Mrs Harper were subsequently banned for life.

18. Mr and Mrs Harper filed a defence and counterstatement in each of these invalidations. They put American RV Club to proof of the existence of goodwill and of the claims made, and denied that there was misrepresentation and that the 355 and 020 marks had been applied for in bad faith.

19. The matters were consolidated on 17 May 2024. It had been confirmed that Mr Jacobs is connected to American RV Club as Vice Chairman and they agreed to be jointly and severally liable for any costs should they be unsuccessful in these proceedings.

HEARING AND REPRESENTATION

20. The matter came to be heard by me on 6 August 2026. Mr Jacobs/American RV Club were represented by Mark Kingsley-Williams of Trade Mark Direct. Mr and Mrs Harper did not attend the hearing or file written submissions in lieu of attendance. In these proceedings, they have been represented by Stevens Hewlett & Perkins.

EVIDENCE AND SUBMISSIONS

The first evidence round

21. Mark Jacobs, the Vice Chairman of American RV Club, gave evidence in the form of a witness statement dated 15 July 2024. It is accompanied by 10 exhibits which include extracts from the minutes of Annual General Meetings ("AGMs") of American RV Club from 1995 to 1998 and 2023 and agendas from 2014 to 2022; the Club's Constitution and Byelaws and Code of Conduct; images of the Club's magazine; letters concerning the suspension of Mr and Mrs Harper's membership and the circumstances surrounding that decision.

22. On behalf of Mr and Mrs Harper, evidence was given by Raymond Sullivan, Chairman of American R.V. Club, also known as ARV Club, since 1 January 2023.[3] His witness statement is dated 17 July 2024 and is accompanied by 13 exhibits, including a Board Resolution of American R.V. Club confirming that the registrations owned by Mr and Mrs Harper are held in trust for the Club and a selection of Facebook posts.

23. Mr and Mrs Harper also filed written submissions dated 17 July 2024.

The second evidence round

24. Mr Jacobs filed a second witness statement dated 10 October 2024. This is accompanied by three exhibits, one of which is a witness statement from James Bruce dated 9 August 2024. Mr Bruce says that he has been a member of American RV Club since its inaugural meeting in 1993 and has held various positions on the Committee, including that of Chairman. He states that during this time neither Mr Harper nor Mr Sullivan has served on the committee and that Mr Harper has not been asked to be a trustee of the club name or any form of the name. Exhibit MJ3A contains signed proforma witness statements from 38 club members saying that they do not recognise Mr Sullivan's organisation, that the club they joined has been in existence since 1993, and they do not recognise Mr and Mrs Harper as members of the club.

[3] I have used the same punctuation and format as Mr Sullivan uses in his witness statement.

25. Mr Jacobs/American RV Club also filed written submissions dated 14 October 2024.

26. Mr Sullivan filed a second witness statement dated 9 December 2024, accompanied by six exhibits. He gives an account of the events surrounding the appointment of Mr Jacobs to the position of Vice Chairman of American RV Club and the relationship between the two men and their families. He also replies to some of the statements made by Mr Jacobs in his first witness statement. The exhibits include WhatsApp messages between Mr W, Chairman of the American RV Club, and the daughter of Mr and Mrs Harper in connection with administration of the club's Facebook account.

27. There is a witness statement from Mr Terry Crook and Mrs Jean Crook dated 11 October 2024. These individuals say that they are members of the American R. V. Club, also known as ARV Club,[4] and give their account of an interaction they witnessed between Mr Harper and Mr W on the morning of the 2022 AGM and their response to it.

28. There is also a witness statement from Mr Kevin Jones, dated 12 October 2024, who says that he was a member of American RV Club from 2001 and served on its committee between 2020 and 2022. He gives his account of the events that took place before the 2022 AGM, the allegations made against Mr Harper and says that he has never seen Mr Harper behaving in the way alleged in the pleadings of Mr Jacobs/ American RV Club.

Summary of the evidence and findings of fact

29. I have read all the evidence and submissions and set out below the chronology of the events leading up to these proceedings. Where matters remain disputed, or I am setting out a witness's interpretation of events, I shall make this clear. At this stage, I note that the evidence bundle contained allegations of a personal nature and exhibits related to those allegations. I shall only refer to the evidence that I deem relevant for the determination of the invalidations and oppositions.

[4] Again, I have used the witnesses' format of the club name.

30. Because both parties are claiming rights in identical or near identical names, I shall refer to the club as the “American RV Club” when I am considering events prior to the first of the applications for the registered marks that are the subject of the invalidation proceedings. For events after this date, I shall refer to “the Jacobs club” (the club of Mark Jacobs and American RV Club) and “the Sullivan club” (the club of Mr and Mrs Harper). I have chosen these names on the basis that Mr Jacobs and Mr Sullivan are the principal witnesses for the parties.

31. A club was set up in 1993 under the name “American RV Club”. Its purpose was to organise events for members who are owners of American-style RVs. These events included weekend meetings at campsites. The club produced a magazine and used social media to communicate with members. A sample cover of the magazine is reproduced below:[5]



32. Mr Jacobs states that since 1993 the club has had nearly 1000 members. I understand this to be a cumulative figure, rather than an indication of the number of members at the relevant date of either the oppositions or invalidations.

[5] Exhibit MJ2.

33. Mr and Mrs Harper joined this club in 2009, with Mrs Harper eventually serving on the committee as treasurer. She resigned from this position at the AGM in August 2022.

34. Prior to the AGM, Mr Sullivan states, there were some concerns raised that the Chairman (Mr W) was not following proper procedures with regard to the club's Constitution and Byelaws.[6] Mr and Mrs Crook state that they were discussing their concerns over how the club was being administered with Mr Harper when Mr W came over and *"became aggressive"*.[7] Mr Jones also says that Mr W's actions and his proposals to change the Constitution to allow a member to be banned without having the right to be heard, led him to resigning from the Committee in 2022.[8] These are the witnesses' accounts. I note that they have not been challenged by Mr Jacobs/American RV Club. I accept that there was some conflict between Mr W on the one hand and Mr and Mrs Harper and Mr Sullivan on the other. This is relevant in understanding the context in which Mr and Mrs Harper made the applications for the 020 and 355 marks.

35. On 26 August 2022, the Secretary of American RV Club was sent a letter from a firm of solicitors instructed by Mr and Mrs Harper and their daughter (who I shall refer to as Ms Harper), who was also a member of this club.[9] The letter sets out their complaints about alleged breaches of the club's Rules. According to the letter, Ms Harper had been re-elected to the committee at the AGM on 13 August 2022, but a few days later the other members of the committee had been asked if they wished Ms Harper to retain her role as another person within the committee wished to take it over. Ms Harper was later informed that she had been voted off the committee. They allege that was not done in line with the club's Rules. Furthermore, proposed changes to the rules that the Committee had discussed at its meeting on 11 August were not put to the AGM and so had no effect. These changes included the ability to expel members without giving them a right to be heard.

36. It appears from an email from a Mr M dated 23 June 2020 that Ms Harper had been Facebook Administrator from shortly after that date, and that a conflict involving Mr M and Mrs Harper had preceded his decision to hand over *"the control of the ARV Page*

[6] Mr Sullivan's second witness statement, paragraph 2, page 1.
[7] Witness statement of Terry Crook and Jean Crook, paragraph 2.
[8] Witness statement of Kevin Jones, paragraph 3.
[9] Exhibit MJ5.

& The ARV Group".[10] Moving forward to 2022, I see that WhatsApp messages from Mr W (the Chairman) and Ms Harper sent between 13 August and 18 August 2022 show that there was disagreement over the administration of the club's Facebook page and Ms Harper was requested following the vote to hand over the login and password details to the new office-holder.[11]

37. On 9 September 2022, Mr W wrote to Mr Harper to inform him that a special committee meeting had been held to discuss his conduct which was alleged to be contrary to the club's constitution. He referred to a solicitor's letter sent on Mr Harper's behalf and indicating his unhappiness with the club. (I consider that it is likely that this letter was the one summarised above.) Mr W said that the committee had decided to suspend Mr Harper's membership for one year with effect from 1 September 2022. He concluded by saying that the committee would consider Mr Harper's readmission in September 2023 if they received a letter of apology 30 days prior to the committee meeting in August 2023. A similar letter was sent to Mrs Harper. In addition, this letter stated that banking records and details that she had held as treasurer had not yet been handed over to the new treasurer and requested that this be done.[12]

38. On 11 September 2022, Mr W wrote to Mr Sullivan, explaining that he understood from Mr Jacobs and his wife that there was *"a strong rift"* between the respective families and that he needed to maintain harmony in the club. (The reasons for any rift are not material to these proceedings.) Mr W therefore asked Mr Sullivan to relinquish his membership.[13] Mr Sullivan says that the club's Constitution was not followed in this matter.[14] He adds that *"It is my opinion and the opinion of the Registrants [Mr and Mrs Harper] that because the Constitution was not followed by GW [the Chairman], with regards to the expulsion of myself and the Registrants from the Applicant, that we remained members."*[15] However, it must be noted that neither Mr nor Mrs Harper has given evidence in these proceedings. I treat Mr Sullivan's statement as his account of their asserted position, but give it little weight.

[10] Exhibit MJ8.
[11] Exhibit RS14.
[12] Exhibit MJ4.
[13] Exhibit RS15.
[14] Second witness statement, paragraph 2, page 2.
[15] Ibid, page 3.

39. On 26 September 2022, Mr and Mrs Harper filed the application for the 355 mark. This was followed on 5 October 2022 by the applications for the 020 mark and for UKTM No. 3838755 for **AMERICAN R.V. CLUB**, which was subsequently surrendered on 17 December 2024.

40. Mr Sullivan states that he became the Chairman of American R.V. Club on 1 January 2023. I shall refer to this club from now on as "the Sullivan Club", while I shall refer to the other club as "the Jacobs Club", on the basis that Mr Sullivan and Mr Jacobs are the principal witnesses for each party. The evidence shows that, from this point, the parties were operating clubs independently of each other.

41. Mr Sullivan's evidence includes Facebook postings advertising events put on by the Sullivan Club. The earliest of these posts is dated 25 September 2022.[16] Mr Sullivan states that the following events took place:[17]

Date	Where Event Held	Attendees
30.12.2022 – 02.01.2023	Riverside country Park, North Devon	12
16.03.2023 – 19.03.2023	Polstead Camping & Caravan Club site, Colchester, Essex	12
07.04.2023 – 11.04.2023	Graveney Hall, Faversham, Kent	26
20.04.2023 – 23.04.2023	Peterborough Showground	26
09.06.2023 – 18.06.2023	Stratford upon Avon Showground	12
19.06.2023 – 26.06.2023	Berkeley Heath Gloucestershire	100+
27.07.2023 – 30.07.2023	Welland Steam Rally Worcestershire	29
10.08.2023 – 13.08.2023	Balloon festival Bristol	16
10.08.2023 – 13.08.2023	Newbury showground	38
18.08.2023 – 20.08.2023	Three Counties Showground, Malvern	20
07.09.2023 – 10.09.2023	Shepton Mallet Showground	34
03.11.2023 – 07.11.2023	Berkeley Heath Gloucestershire	30
09.03.2024 – 13.03.2024	Waldegraves Holiday Park, West Mercia	8
28.03.2024 – 02.04.2024	Canterbury Camping and Caravan Club	10
16.05.2024 – 20.05.2024	Newbury Showground	10
24.05.2024 – 27.05.2024	Laughton Showground	10
13.06.2024 – 17.06.2024	Newark Showground	13
20.06.2024 – 02.07.2024	Basingstoke Canal Centre	17

[16] Exhibit RS2.
[17] Mr Sullivan's first witness statement, paragraph 6.

42. The two Facebook posts reproduced below and exhibited as part of Mr Sullivan's evidence show use of both "Arv Club" and "American R V Club":[18]



Arv Club
Admin 25 Sep 2022 ·

NEW YEARS EVE

We are having a get together for new year at the Riverside Caravan and Country Park. We will be there from 30/12/2022, we already have 5 units booked, if you are interested, please contact Nicky on 01769 579269.

£189 for 3 nights including:
- NYE dinner
- NYE entertainment
- Electric
- can take up to 2 dogs
- extra dogs are £3 per night

After the 03/01/2023, it will be £28 per night if anyone wishes to stay longer!

The group booking name is 'Harper' - just quote this upon booking

Please have a look at the website linked below:

http://exmoorriverside.co.uk

exmoorriverside.co.uk
Riverside Caravan & Camping Park & Country Club - Riverside Caravan & Camping Park & Country Club



American R V Club
Admin Arv Club · 23 Nov 2022 ·

CHRISTMAS MARKETS 🎄

Here are a few Christmas markets/events in the next coming weeks/ month:

- Christmas at Kew (16th Nov-8th Jan) and nearest campsite is in Chertsey

- Bath Christmas Market (24th Nov-11th Dec) and nearest campsite is in Devizes

- The Laterns in Chester (11th Nov-23rd Dec) and nearest campsite is in Delamere Forest

- Longleat Festival of Lights (5th Nov-8th Jan) and camping on site

If anyone else knows of anymore in your area, please add to the comments!

Like Comment Send

[18] Exhibits RS2 and RS3.

43. On 20 January 2023, Mr and Mrs Harper sent a WhatsApp message to Ms P, the Secretary of the Jacobs Club, informing her of Mr and Mrs Harpers' ownership of the intellectual property rights of **American Recreational Vehicle Club**, **American Recreation Vehicle Club**, **American R V Club** and **ARV Club** and requesting that the Jacobs Club desist from using any of these names in the future.[19] The message does not explicitly refer to the ownership of the 355 and 020 marks.

44. On 21 April 2023, the Jacobs Club held a "Pre-Emergency Committee meeting". The minutes record that the committee was told that Mrs Harper had had the banking mandate reverted to the position prior to the 2022 AGM (at which she had resigned). The name of the current treasurer had been removed from the account. It was also reported that the printers of the club's magazine had used the club membership list to send out a *"spoof magazine on behalf of the Harpers"*. Mr and Mrs Harper's suspension was upgraded to a lifetime ban.[20]

45. Extracts from the allegedly spoof magazine can be found in Exhibit MJ10. This has an identical cover to the one that I have reproduced above from August 2022, except that it shows the date of the issue as February 2023. On page 7 of the magazine, it is stated that it was compiled by Ms Harper with the help of Kevin Jones. It contains an article from the daughter of the founders of the club (N) and a piece from Mr Harper entitled "Proposed Vote on the Future of The Club". Mr Harper accuses members of the committee of bullying behaviour and refers to the removal of his daughter from the committee. There are also veiled allegations about behaviour of club members. The proposal is that a postal vote is taken on the future of the club. The options given were *"Club to carry on with present committee but using a different club name"* or *"Club to carry on with name of American RV Club, but with interim committee (to be announced) AGM to take place by end of Sept 2023 retaining club assets"*. Votes were to be cast by post to an address in Bristol with a closing date of 28 February 2023. Mr Sullivan says:

> "In the Applicant's club magazine issued in February 2023 (submitted as Exhibit MJ10), Mr William Harper proposed, due to the unconstitutional behaviour of GW and MJ [Mark Jacobs], that a vote on the future of the

[19] Exhibit RS12.
[20] Exhibit MJ6.

> Applicant should take place, and it was agreed that a separation should take place whereby there would be two clubs going forwards. Since Mr William Harper was still a member of the Applicant, he could put forward this vote, showing no bad faith on the part of the Registrants."[21]

46. However, Mr Sullivan does not say how many votes were cast and the proportion supporting each of the given options. Neither does he say who it was that agreed that there should be two clubs or which of them would use the names "American RV Club" or "ARV Club". He does say that since Mr Harper's vote on the future of the club, the Jacobs Club has been referred to as *"The Original American RV Club"* or *"ARVO/ARV (Original)"* when booking onto rallies, while the Sullivan Club has used *"ARV Club"* for bookings.[22] I shall say more about the magazine and its bearing on the issue of passing off in due course.

47. On 25 April 2023, Mr W wrote to Mr Harper informing him that *"Due to the constant and ongoing harassment against the American RV Club"*, the committee had unanimously decided to upgrade the year-long suspension to a life ban. A similar letter was sent to Mrs Harper. It also said:

> "As the elected chairman of the American RV Club and on behalf of all the members, I have the task of asking you to return the club's bank account by removing your name from the account. This account belongs to the American RV Club and holds the member's [sic] money of which you are not entitled to and have never been entitled to."[23]

DECISION

48. I shall deal first with the applications for invalidation. This is because their outcome affects whether Mr and Mrs Harper's earlier registrations can support the section 5(2)(b) ground in the oppositions. I shall then determine the oppositions.

49. 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

[21] Second witness statement of Mr Sullivan, paragraph 2, page 3.
[22] Second witness statement, paragraph 2, page 3; Exhibits RS18 and RS19.
[23] Exhibit MJ4.

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 that predate the UK's withdrawal from the EU.

The Invalidation Applications

50. The relevant parts of section 47 of the Act are as follows:

> "(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).
>
> …
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –
>
> …
>
> (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
>
> unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> …
>
> (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."[24]

[24] Subsections (2A) to (2G) apply where the earlier right is a trade mark in relation to which the conditions set out in sections 5(1), 5(2) or 5(3) obtain.

Section 5(4)(a)

51. Section 5(4)(a) of the Act states that:

> "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 or 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 4(A) is met
> >
> > …"

52. Subsection 4(A) is as follows:

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

53. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off at [406]:

> "First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the

defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

54. *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 are 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."

Relevant dates

55. The dates when Mr and Mrs Harper applied to register the 355 and 020 marks (26 September 2022 and 5 October 2022 respectively) are the relevant dates for the purposes of this ground. However, if Mr and Mrs Harper had used the marks prior to the application, it is necessary to consider what the position would have been at the date of the start of the behaviour complained about. This is because if an applicant for registration was not passing off when it began to use the sign, a continuation of the same trade under the same sign is unlikely to amount to passing off at the date of the application for the mark: see *Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 220, paragraph 165.

56. Given that both parties claim to have been using the signs **AMERICAN RV CLUB** and **ARV CLUB** since 1993, and Mr and Mrs Harper also claim to have used the signs **AMERICAN RECREATIONAL VEHICLE CLUB** and **AMERICAN RECREATION VEHICLE CLUB** since the same date, I need to determine which, if either, of these claims can be proved. The evidence shows that a single club operated until the dispute commenced in 2022. I find that the Jacobs Club represents the continuation of that club. I say this for the following reasons. First, the Jacobs Club continued with the same governance structure and officers that had been in place in the 1993 Club prior to the dates on which Mr and Mrs Harper applied for the 355 and 020 marks. Secondly, the minutes of the meetings from 2023 and 2024 show that the Jacobs Club continued to operate as the 1993 Club, with AGMs and entertainment being organised and magazines being sent out.[25] Thirdly, it is the Jacobs Club that retained the certificate of exemption granted by the Secretary of State for Environment, Food and Rural Affairs

[25] Exhibits MJ1 and MJ7.

under the Caravan Sites and Control of Development Act 1960 to "The American RV Club" on 1 February 2021.[26] Fourthly, the timings of the formation of the Sullivan Club do not support a finding that this club was the continuation of the 1993 Club. Mr Sullivan became Chairman only on 1 January 2023 and does not explain the governance (if any) prior to this date. I also note that this appointment predates the vote organised by Mr Harper in February 2023 and there is nothing to tell me how Mr Sullivan became Chairman. Fifthly, there is no evidence to explain the result or legal effect of the February 2023 vote. I find that, taken cumulatively, these facts establish that the Jacobs Club was the continuation of the 1993 Club and therefore the senior user. Furthermore, there is no evidence that Mr and Mrs Harper were using the signs at issue before making the applications for the 355 and 020 marks. Therefore, the relevant dates are 26 September 2022 and 5 October 2022 respectively.

Goodwill

57. The Jacobs Club must therefore show that it had goodwill in a business at the relevant dates and that the signs relied on were associated with, or distinctive of, that business. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at [224]:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

58. First, though, I shall address the question of the basis on which the Jacobs Club claims to own the goodwill. I note that the aforementioned club is an unincorporated association. The editors of the 6th edition of *Wadlow on Law of Passing Off* consider the ownership of goodwill in associations in sections 3-394 to 3-399 of that work and

[26] Exhibit MJ2A.

cite as authority the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Williams and Williams v Canaries Seaschool SLU*, BL O/074/10, [2010] RPC 32. Mr Hobbs considered the law and cited the observations of the Court of Appeal in *R v L(R) and F(J)* [2008] EWCA Crim 1970 on the wide variety of types of unincorporated association, which covered *"any collection of individuals linked by agreement into a group"* (paragraph 11) and noted that such associations had no legal identity separate from their members (paragraph 12). Mr Hobbs said:

> "27. I consider that the starting point for the purposes of analysis in the present case is the general proposition that the goodwill accrued and accruing to the members of an alliance such as I have described is collectively owned by the members for the time being, subject to the terms of any contractual arrangements between them: *Artistic Upholstery Ltd v Art Forma (Furniture) Ltd* [2000] FSR 311 at paras. 31 to 40 (Mr Lawrence Collins QC sitting as a Deputy High Court Judge). …"

59. In a later decision, *UNITED SIKHS Trade Mark*, BL O/0329/24, Mr Iain Purvis KC, sitting as the Appointed Person, said:

> "11. … Such an association obviously has no legal personality of its own, simply existing as an agreement between members. Without legal personality, the association or charity cannot itself own any property. Any property including goodwill which is associated with the association will therefore be owned by the members in accordance with the terms of the agreement between them."

60. The 1993 Club had a constitution, the full version of which is attached to the solicitor's letter in Exhibit MJ5. The constitution makes no explicit provision in relation to the ownership of assets. Consequently, it appears to me that the ownership of any goodwill vests in the members of the Jacobs Club collectively.

61. The law of passing off may protect a small goodwill, although not one that is *"of trivial extent"*: see *Hart v Relentless Records* [2002] EWHC 1984 (Ch), paragraph 62. In *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*, BL O/304/20, Mr Thomas Mitcheson QC, sitting 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 doing so, he concluded that:

> "34. ... 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."

62. The evidence indicates that the Jacobs Club is fairly small. Mr Jacobs states that it has had nearly 1000 members over the thirty years since its inception. Membership is restricted to owners of RVs, with time-limited temporary membership open to those considering buying one. I have no evidence on the number of such vehicles in the UK. Nevertheless, the evidence shows prolonged public-facing activity in the form of meetings and rallies and the distribution of a magazine. The club also communicated with members under its name. I am therefore satisfied that the Jacobs Club has built up a protectable, albeit small, goodwill in the provision of *Club services*, which include the organisation of recreational activities, for owners of recreational vehicles. I also consider that the sign **AMERICAN RV CLUB** is distinctive of that goodwill, while noting that the words are likely to be in common use in the particular specialist sector. I shall return to this point below. The only evidence showing use of the sign **ARV CLUB** prior to the relevant date is the email from Mr M referred to in paragraph 36 above. Internal use alone does not establish that the sign denoted the Jacobs Club's business to customers or potential customers. I therefore find that it has not been established that there was any independent goodwill under the sign **ARV CLUB**.

Misrepresentation

63. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc*

[1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

> 'is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product].'

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 RPC 97 at page 101."

64. The services of Mr and Mrs Harper's two marks all relate to recreational activities and, in my view, are ones that may be provided by a club. Consequently, I consider that the parties' services operate in a common field of activity. Mr and Mrs Harper's marks are also registered for a selection of vehicles in Class 12. The specifications differ slightly across the marks, but they both cover RVs and the 355 mark also contains general terms (such as *Vehicles* and *Automotive vehicles*) that would cover RVs. While the fields of activity are not the same, this is not essential for a finding of passing off: see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA). I find that there is a relationship between the fields, in that they would be targeted towards the same specialist public. I remind myself that it is the Jacobs Club's customers or potential customers that must be deceived: see *Neutrogena*, at [493]. This means people who own RVs or who are interested in buying one.

65. The 355 mark is a series that consists of two marks, **AMERICAN RECREATIONAL VEHICLE CLUB** and **AMERICAN RECREATION VEHICLE CLUB.** I shall compare these marks to the earlier sign **AMERICAN RV CLUB**. The first and last words of the marks and sign are identical. I consider that the customers of potential customers of the Jacobs Club would understand the abbreviation "RV" to refer to "recreational vehicle". I therefore find that the marks and sign are visually similar to a medium degree, aurally similar to a medium degree and conceptually identical.

66. Turning to the 020 mark, I remind myself that I found that the Jacobs Club had not established that there was independent goodwill in the sign **ARV CLUB**, which is identical to the 020 mark. However, that sign would, in my view, be perceived by the customers or potential customers of the Jacobs Club as an abbreviation of the full name **AMERICAN RECREATIONAL VEHICLE CLUB** or **AMERICAN RV CLUB**.

67. Earlier in this decision, I noted that the marks and signs contained words that would be fairly common in the industry. In *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, Lord Simonds stated that:

> "Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered."

68. He also said:

> "Confusion innocently caused will yet be restrained. But, if the intention to deceive is found, it will be readily inferred that deception will result. Who knows better than the trader the mysteries of his trade?"

69. Mr Sullivan in his second witness statement says that, in his opinion, he and Mr and Mrs Harper remained members of the club formed in 1993. In my view, the use of "ARV Club" and "American Recreational Vehicle Club" on Facebook shown in Mr Sullivan's evidence, together with the distribution to members of the 2023 magazine containing Mr Harper's proposals for the future of the club, constitute evidence from which an intention to present the Sullivan Club as the continuation of the club formed in 1993 may be inferred.

70. The magazine was compiled by Ms Harper and Mr Jones, neither of whom were members of the committee of the club formed in 1993, although their precise membership status of that club at that time is unclear. The Committee positions include that of a Magazine Officer, who, it is reasonable to infer, would be the obvious person

to be responsible for compiling an issue of the magazine. In addition, the use of the Jacobs Club's membership list for the distribution of this magazine was referred to the Information Commissioner's Office as a breach of the General Data Protection Regulation, which supports the conclusion that it was not an official publication of the Jacobs Club.

71. Considering the evidence as a whole, I find that a substantial number of the Jacobs Club's customers or potential customers would be likely to believe that the services offered under Mr and Mrs Harper's marks were those of the Jacobs Club. The relevant public is a limited specialist group and the parties operate in the same or closely related fields. The 355 mark is similar to one of the signs distinctive of the Jacobs Club's goodwill; and the 020 mark, **ARV CLUB**, would be understood in context by this specialist public as an abbreviation of **AMERICAN RECREATIONAL VEHICLE CLUB**. Although the wording is descriptive or allusive and the public may therefore notice comparatively small differences, the differences here are, in my view, insufficient to distinguish the parties' activities. The surrounding presentation of the later club as a continuation of the original organisation reinforces that conclusion. I therefore find that use of the 355 and 020 marks would amount to a misrepresentation.

Damage

72. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett LJ described the requirements for damage in passing off cases at [715]:

> "In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. ..."

73. I consider that damage through substitution is likely. Both clubs seek members and participation from the same limited specialist public and offer the same, or similar club and recreational activities, such as meetings and rallies. A person who believes that the Sullivan Club is the Jacobs Club may direct membership subscriptions, rally

attendance or other custom to the Sullivan Club instead of the Jacobs Club. That diversion would damage the attractive force of the Jacobs Club's goodwill.

74. The invalidations succeed in their entirety under section 5(4)(a) of the Act.

Section 3(6)

75. Section 3(6) of the Act is as follows:

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

76. In *Skykick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, the Supreme Court considered the following case law: *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07; *Sky plc & Ors v Skykick UK Limited & Anor*, Case C-371/18; *AS v Deutsches Patent- und Markenamt*, Case C-541/18; *Malaysia Dairy Industries Pte. Ltd v Ankenævnet for Patenter og Varemærker*, Case C-320/12; *Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P; *Hasbro, Inc v European Union Intellectual Property Office (EUIPO)*, Case T-663/19; *pelicantravel.com sro v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-136/11; and *Psytech International Ltd v OHIM*, Case T-507/08. Lord Kitchin summarised the law as follows:[27]

> "240. The general principles are these:
>
> …
>
> (ii) The date for assessing whether an application to register an EU 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 in the European Union, and must be interpreted in the context of Directive 89/104 in the same

[27] I have included only the subparagraphs relevant to these proceedings.

manner as in the context of Regulation 40/94 (*Malaysia Dairy*, para 29; *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 EU law of trade marks, namely the establishment and functioning of the internal market, and 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*, 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*, 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).

…"

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

(a) An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies. However, Arnold J (as he then was) said that *"cogent evidence is required due to the seriousness of the allegation"*. This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited & Anor* [2012] EWHC 1929 (Ch), paragraph 133;

(b) It is necessary to ascertain what the applicant knew at the relevant date: see *Red Bull*, paragraph 137; and

(c) Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors*, [2008] EWHC 3032 (Ch), paragraph 167.[28]

78. According to Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are as follows:

(a) What, in concrete terms, was the objective that the party alleged to have acted in bad faith has been accused of pursuing?

[28] Approved by the Court of Appeal in *Hotel Cipriani Srl & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2010] EWCA Civ 110.

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

(c) Has it been established that the contested application was filed in pursuit of that objective?[29]

79. The Jacobs Club alleges that Mr and Mrs Harper applied to register the 355 and 020 marks in the knowledge that they were the established trading names of the Jacobs Club. However, it does not make any allegations about the objective that Mr and Mrs Harper had in mind when they made the applications. Rather, it says in its pleadings that:

> "Another relevant factor is the Defendant's intention. The Registry or Court will need to ascertain whether the Defendant's application was simply filed to block another party from the market and whether the Defendant had any genuine intention to use the trade mark itself. Again, the Defendant's intention can be inferred from the surrounding circumstances (as it is unlikely a party would admit to having less than noble intentions).

80. Mr and Mrs Harper argue that American RV Club did not particularise its bad faith claim sufficiently to permit a proper defence. I agree. American RV Club pleaded Mr and Mrs Harper's knowledge of its trading names and referred in general terms to possible blocking and an absence of genuine intention to use, but it did not identify in concrete terms the improper objective said to have been pursued by each contested application. The burden of establishing bad faith rests initially on the party making the allegation. It is not for the Tribunal to formulate an unpleaded motive from the evidence, particularly where the applicant's objective is central to the ground and the allegation is serious. The section 3(6) claims therefore fail because they were not adequately pleaded and it would not be fair to Mr and Mrs Harper for me to formulate a statement of their intention on the basis of such pleadings.

The Oppositions

81. The invalidation applications have succeeded under section 5(4)(a). Pursuant to section 47(6) of the Act, the registrations of the 355 and 020 marks are deemed never

[29] Paragraph 8.

to have been made. Therefore, they can no longer constitute earlier marks supporting Mr and Mrs Harper's claims under section 5(2)(b), which fall away and so do not require determination.

Section 5(4)(a)

82. The legislation and relevant case law is set out in paragraphs 51-54 and 57 above.

83. I have already cited Lord Macnaghten's description of goodwill in *Inland Revenue Commissioners v Muller & Co's Margarine*: *"It is the benefit and advantage of the good name, reputation and connection of a business."* The evidence relied upon by Mr and Mrs Harper concerns activities undertaken through a club. Mr and Mrs Harper have brought the oppositions in their own names but have not established that any goodwill was assigned to them. The Board Resolution states that the trade mark registrations are held by Mr and Mrs Harper in trust for the club. This concerns the 355 and 020 marks, and a further mark that was surrendered during the course of these proceedings. It has nothing to say about goodwill.[30] On the pleaded case and evidence, Mr and Mrs Harper have not shown ownership of the goodwill necessary to bring the claims under section 5(4)(a) of the Act. Therefore, those claims cannot succeed. In any event, for the reasons that I have given earlier in this decision, they are not the senior user of the signs and would not have been able to prevent the senior user from using the mark.

Section 3(6)

84. The case law and legislation are set out in paragraphs 75-78 above.

85. Mr and Mrs Harper's claim under this ground is that Mr Jacobs has sought to register marks to which he is not entitled and that he has filed the applications in a deliberate attempt to block Mr and Mrs Harper from securing rights to which they are entitled, to disrupt their business or gain leverage over it, and to mislead consumers. I have already found that American RV Club, of which Mr Jacobs was the Vice-Chairman, was the continuation of the club formed in 1993. In addition, I note that Mr Jacobs says that he was acting with the full authority of the club.

[30] Exhibit RS12.

86. In *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2008] EWHC 3032 (Ch) (approved by the Court of Appeal in [2010] EWCA Civ 110), Arnold J (as he then was) stated:

> "189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. …"

87. On the basis of the evidence that I have summarised earlier in this decision, I consider that Mr Jacobs reasonably believed that he was entitled to apply to register the 064 and the 065 marks. I find that Mr and Mrs Harper have not succeeded in establishing a *prima facie* case of bad faith.

88. The oppositions fail under section 3(6) of the Act.

CONCLUSIONS

89. The applications to invalidate UKTM Nos 3836020 and 3833355 are successful. Subject to successful appeals, these marks are declared invalid and, pursuant to section 47(6), the registrations are deemed never to have been made.

90. The oppositions to Application Nos 3871064 and 3871065 are unsuccessful. Subject to successful appeals, these applications may proceed to registration.

COSTS

91. Mr Jacobs and American RV Club have been successful in these proceedings and are, jointly and severally, entitled to an award of costs. Costs are usually awarded by reference to a published scale, the latest version of which can be found in Tribunal Practice Notice No. 1/2023. However, the Tribunal also has the discretion to make an award of off-scale costs to deal proportionately with unreasonable behaviour. Mr Kingsley-Williams for Mr Jacobs and American RV Club submitted that this was an instance in which off-scale costs would be appropriate. I indicated at the hearing that,

particularly given the non-attendance of Mr and Mrs Harper, I would invite submissions in writing should Mr Jacobs and American RV Club be successful.

92. I therefore invite Mr Jacobs and American RV Club to make these further submissions, which should be filed with the Registry, and copied to Mr and Mrs Harper, within 14 days from the date of this decision. Mr and Mrs Harper will then have a period of 14 days from receipt of those submissions to file their own comments, which should be copied to the other side. I will consider both parties' submissions and issue a costs decision. The appeal period will be set at that point.

Dated this 5th day of November 2026

Clare Boucher,
For the Registrar