O/0995/26

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. UK00004046320 IN THE NAME OF JHX ENTERPRISES LTD FOR THE TRADE MARK:

Great Five

IN CLASS 25

AND

AN APPLICATION FOR INVALIDITY UNDER NO. 508225 BY LUIGI CINQUE

BACKGROUND AND PLEADINGS

1. JHX Enterprises Ltd ("the proprietor") is the owner of the trade mark shown on the cover page of this decision ("the contested mark"). The contested mark was applied for by JBX Enterprises Ltd on 1 May 2024 and was granted registration on 26 July 2024. The contested mark was subsequently assigned to the proprietor on 5 September 2024 and this was confirmed to the Tribunal by way of a TM16 filed on 23 September 2024.[1]

2. The contested mark stands registered for the following goods:

Class 25: Sports shirts; Sports bibs; Headbands; Sports bras; Sports vests; Sports jerseys and breeches for sports; Clothing for sports; Sports clothing; Sports wear; Sports shoes; Sports socks; Sports jerseys; Clothes for sports; Sports garments; Sports headgear [other than helmets]; Sports jackets; Sports singlets; Sports caps and hats; Moisture-wicking sports shirts; Boots for sports; Headbands [clothing]; Headbands for clothing; Footwear for sports; Sports footwear; Moisture-wicking sports bras; Sports caps; Jackets being sports clothing; Sports pants; Sports clothing [other than golf gloves]; Articles of sports clothing; Sport shirts; Tennis sweatbands; Sports over uniforms; Combative sports uniforms; Moisture-wicking sports pants; Cleats for attachment to sports shoes; Sport shoes; Footwear not for sports; Clothes for sport; Athletics vests; Clothing for wear in wrestling games; Sweatbands; Sports shirts with short sleeves; Footwear for sport; Footwear for use in sport; Sports [Boots for -]; Soccer shirts; Boots for sport.

[1] The assignment mentioned was to JHayes Enterprises Ltd but that entity changed its name to JHX Enterprises Ltd. This was confirmed to the Tribunal by way of a Form TM21A dated 15 October 2024.

3. On 17 December 2024, the contested mark was subject to an application for invalidity under section 47 of the Trade Marks Act 1994 ("the Act") brought by Luigi Cinque ("the applicant"). The application is reliant upon sections 5(4)(a) and 3(6) of the Act.

4. Under the section 5(4)(a) ground, the applicant relies on the following unregistered sign:



5. The applicant claims to have been using the above sign throughout the UK since 6 December 2018 in respect of the following goods:

Class 3: Pumice Stones.

Class 21: Lint removers; Pet hair removers.

Class 22: Scoubidou strings for craft and jewellery making.

Class 25: Headbands; Sports headgear [other than helmets]; Headbands [clothing]; Headbands for clothing; Tennis sweatbands; Sports wear; Articles of sports clothing.

6. The applicant claims that his use of the above sign has resulted in a significant goodwill in his business in the UK. It is argued that use of the similar contested mark on the contested goods constitutes a misrepresentation on the basis that consumers will be misled into believing that there is an association between the products of the proprietor and those of the applicant. Consequently, it is claimed

that this misrepresentation will cause damage to the applicant's business by way of customer dissatisfaction, reputational damage and financial harm.

7. Under the section 3(6) ground, the applicant claims that the actions of the proprietor were in bad faith as they demonstrate a clear pattern of misconduct aimed at unfairly targeting the applicant's business and disrupting his legitimate commercial activities. Having considered the pleaded ground under section 3(6), I am of the view that it presents some issues for the applicant but rather than discuss those here, I will explore them further at the relevant point below.

8. The proprietor filed a counterstatement wherein it denied the claims against it on the basis that they lacked legal merit.

9. Neither party is legally represented. Both parties filed evidence in chief with the applicant also filing evidence in reply. No hearing was requested and only the proprietor filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

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 applicant's evidence in chief came in the form of a witness statement in his own name, dated 7 May 2025. The applicant's evidence is accompanied by 116 exhibits and was adduced in order to demonstrate goodwill in his business and to support the claims that the proprietor has acted in bad faith.

12. The proprietor's evidence came in the form of the witness statement of Joe Hayes dated 6 July 2025. Joe Hayes is the Director of the proprietor and their statement is accompanied by 21 exhibits, being labelled Exhibit 0 to 20. The purpose of this evidence was to demonstrate the background of the proprietor's trade mark ownership, commercial use and brand enforcement activity. Further, it discusses an alleged absence of commercial use by the applicant.

13. The applicant filed evidence in reply via his second witness statement dated 30 September 2025. This statement is accompanied by a further 18 exhibits, which are labelled as Exhibits 117 to 134. The purpose of this evidence was to respond to various points raised in the evidence filed by Joe Hayes.

14. To avoid any confusion between the exhibits filed, I will refer to the exhibits that accompanied the applicant's statement with the prefix 'LC' (LC1 and LC2 for Exhibits 1 and 2, and so on) and the exhibits that accompanied Joe Hayes's statement with the prefix 'JH' (JH0 and JH1 for Exhibits 0 and 1, and so on).

15. Whilst I do not intend to discuss the parties' evidence in full, I can confirm that I have taken all of it into account. Further, to the extent I deem it necessary, I will discuss the relevant points at the appropriate stages below.

DECISION

Section 47: legislation

16. Both grounds relied upon by the applicant have application in invalidation proceedings by virtue of section 47 of the Act, which states as follows:

"47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) […]

(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.

[…]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

Section 5(4)(a)

17. Section 5(4)(a) of the Act states as follows:

> "5(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.
>
> 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".

18. Subsection (4A) of section 5 of the Act 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."

19. 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)."

20. 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."

Relevant Date

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

22. The contested mark was applied for on 1 May 2024. It does not have a priority date and while the proprietor has filed evidence of some of its own Amazon listings,[2] these are all from after the relevant date. Therefore, there is no earlier use that could be said to be the start of the behaviour complained about. As such, the relevant date for the present ground is 1 May 2024.

Goodwill

23. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

> "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."

24. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

[2] See JH9 and JH14, for example. On this point, the evidence seems to suggest that this product was originally that of the applicant but, after a complaint by the proprietor to Amazon on 18 October 2024 (see JH7), it was re-assigned to the proprietor (see JH8). It is my understanding that this was a consequence of the existence of the contested mark. For the avoidance of doubt, such evidence is not relevant here because (1) it relates to enforcement activity taken by the proprietor and (2) does not negate the fact that, despite not enjoying the benefit of an earlier trade mark, the applicant may still be protected by an unregistered right under the law of passing off.

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

25. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the

application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

26. 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."

27. Before getting into the applicant's evidence of use, I wish to briefly discuss some points raised by the proprietor in its evidence and submissions. It is noted that, in its evidence, the proprietor claims that its own online searches have shown that the applicant has not engaged in any commercial activity.[3] While this is noted, the evidence on this point is made up of Google search results that are from after the relevant date so are not necessarily reflective of the position as at that time. Even ignoring that point, they are not sufficient by themselves to demonstrate that the

[3] JH15 to JH17

applicant has failed to engage in any commercial activity. I say this because the requirement for demonstrating the existence of goodwill is a burden that falls to the applicant to prove and, as I will discuss below, the applicant's evidence does cover his own commercial activity. Therefore, I fail to see how the proprietor's simple Google searches are of any real assistance and I will say no more about them.

28. I also note that in its submissions, the proprietor argues that the applicant is reliant upon outdated assets or imagery as this evidence reflects historical platform behaviour rather than a commercial identity associated with the applicant. My issue with this claim is that assessments of goodwill are to be based on historical use of the sign relied upon prior to the relevant date. Further, the evidence filed by the applicant is (as I will come to discuss below) clear in that it covers genuine commercial use of the applicant's brand. However, whether that commercial use is at a level sufficient enough to find a protectable goodwill remains to be seen.

Evidence of use

29. The applicant's evidence sets out that he sells goods on Amazon via his 'Great Five' store. Evidence has been provided by way of an email from Amazon Support that confirms that this store was opened on 23 July 2018.[4] Through his store, the applicant has sold a number of goods and I note that these include packs of scoubidou strings[5] (which were first sold on 6 December 2018),[6] headbands (which were first sold on 5 April 2020),[7] pumice stones (which were first sold on 15 August 2020),[8] lint removers (which were first sold on 9 July 2021)[9] and pet hair remover (which were first sold on 2 September 2021).[10]

[4] LC2
[5] Which, to my understanding are strings used for creating crafts or jewellery.
[6] LC1
[7] LC5
[8] LC7
[9] LC8
[10] LC10

30. Of the different products sold, the applicant has provided evidence of turnover for sales in the UK.[11] The turnover is provided by way of confirmation emails from Amazon Support. From my review of the responses from Amazon Support and the evidence regarding the products' SKU/serial numbers (which are discussed in the applicant's narrative evidence), I note the following:

a. In 2018, the applicant's scoubidou strings (pack of 160) accrued a turnover of £419.30 stemming from the sale of 70 units;
b. In 2019, the applicant's scoubidou strings (pack of 160) accrued a turnover of £9,358.27 stemming from the sale of 1,519 units;
c. In 2020, the applicant sold 2,304 units for a total turnover of £13,567.32. The goods for this turnover cover the same scoubidou strings (pack of 160) as discussed above, as well as sports headbands (as both packs of one and of six) and pumice stones. No breakdown per product is provided;
d. In 2021, the turnover stood at £35,015.68 from 5,751 units sold. The goods sold include those listed at point c. above, as well as the applicant's lint remover and pet hair remover (meaning that it covers all of the applicant's goods discussed at paragraph 28 above);
e. In 2022, the turnover stood at £44,464.34 from 8,423 units sold. This evidence covers all of the applicant's goods;
f. In 2023, the turnover stood at £66,362.38 from 12,280 units sold. This evidence covers all of the applicant's goods but no breakdown is provided; and
g. In 2024, the turnover stood at £66,773.44 from 11,988 units sold. This evidence covers all of the applicant's goods.

31. In respect of the above, the relevant date is in May 2024 meaning that a significant portion of the 2024 figures will have fallen after then, rendering them irrelevant to the present assessment. I have no way to calculate the figures for 2024 accurately

[11] See LC14 to LC20

but this is a point I will bear in mind. Further, it is noted that figures for 2025 are provided[12] but these are of no assistance here.

32. The totality of the turnover evidence demonstrates that between 2018 and 2023, the applicant accrued a total turnover of £169,187.29 but I also bear in mind that the figure relevant to my assessment will also include some of the 2024 turnover, which stood at £66,773.44. I have no way to determine an accurate figure but, on balance, I consider it reasonable to suggest that as at the relevant date, the turnover likely stood at somewhere in the region of £190,000. In addition, the unit sales amount to 30,347 for the years 2018 to 2023 whilst bearing in mind that, in 2024, the applicant sold a further 11,988 goods meaning that, on balance, the total relevant unit sales are likely to be around the 35,000 mark.

33. Aside from the years 2018 and 2019 covering the scoubidou strings only, I have nothing before me to suggest how the aforementioned turnover or unit sales are attributable to the relevant goods.

34. The evidence then moves to discuss marketing. In proving his spend, the applicant has filed a range of invoices from Amazon marketing regarding 'sponsored products' and 'sponsored displays' on Amazon UK.[13] I do not intend to discuss these in full but note that they represent the following advertising spend:

Year	**Spend (£)**
2018	1.92
2019	31.70
2020	1,679.60
2021	2,606.46
2022	2,272.18

[12] LC21
[13] LC22 to LC89

2023	4,987.89
2024 (until 1 May only)	2,127.40
Total	**13,707.15**

35. As above, I have no intention of discussing the invoices in detail but note that they show advertising attempts covering all of the applicant's goods. The invoices also show how many clicks the products achieved (being the 'sponsored products' entries) and, in later years, how many views the various campaigns had (for the 'sponsored displays'). The views are often in the tens of thousands or hundreds of thousands whereas the clicks range from being minimal to numbers in the multiple hundreds. In respect of the clicks, I appreciate that the individual numbers shown are lower but I note that there are many invoices that are generated on a frequent basis with each showing multiple entries for these sponsored products. On this point, I note, as just one example, an invoice for the period 4 September 2020 to 25 September 2020 (being just 21 days) showing eight different campaign entries for a total of 317 clicks.[14]

Assessment of the evidence

36. In determining whether the present ground can proceed, I need to first consider whether the applicant's use is sufficient to give rise to the existence of a protectable level of goodwill in his business. If the goodwill exists then I need to determine whether the sign relied upon is distinctive of and/or associated with that goodwill and, if so, what goods the goodwill vests in. Only if these assessments are found in favour of the applicant will I be able to proceed to consider the issue of a misrepresentation and subsequent damage.

37. Taking the above evidence into account, it is clear that the trading activities of the applicant are not at a high level. That being said, under the present ground, small

[14] LC33

businesses which have more than a trivial goodwill can protect signs which are distinctive of those businesses under the law of passing off even though the goodwill and reputation may be small.[15] In addition, I remind myself that longstanding use may also contribute to a finding of the existence of goodwill. On the latter point, the evidence of turnover and advertising spans a period of around six and a half years. I appreciate that this is not particularly longstanding but, clearly, it represents a sufficient period of time as it is clearly not short term. Taking this into account together with the fact that the evidence demonstrates a turnover of approximately £190,000 from around 35,000 unit sales and an advertising spend of almost £14,000, I am content to conclude that the applicant enjoys a protectable goodwill in the applicant's business, albeit not a strong one. Instead, I consider that the goodwill is of a moderate strength.

38. In terms of whether the sign relied upon is distinctive of and/or associated with the applicant's goodwill, I note the following:

a. The one product listing actually shown in the evidence contains clear reference to the 'Great Five' brand.[16] This listing shows the relevant branding on the product image, brand information, manufacturer and as the name of the store operating the listing. This listing also shows the first date available for this listing, being 5 August 2021;
b. The evidence regarding the opening of the applicant's Amazon store (in 2018) confirms that this was the opening date of a store called the 'Great Five Store';
c. The correspondence regarding the first sale dates of the applicant's products also make reference to the 'Great Five' brand. For example, the first sale for the pumice stone in 2020 provides additional details as to the product title for that first sale which shows the wording 'Great Five';[17] and
d. The advertising invoices make reference to the branding.

[15] See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590
[16] See LC9
[17] See LC7

39. Given the above, I am content to conclude that at all material times, the applicant was trading under the name 'Great Five'. While the above examples are use of 'Great Five' in its word only form, I also note that product images have been provided which include the sign relied upon.[18] As a result, I consider that the applicant's sign is distinctive of and/or associated with the goodwill of the applicant.

40. Finally, I must consider in what goods the goodwill vests in. In considering this point, I remind myself that under assessments of goodwill, it is not appropriate to break the business down at the same level of granularity as is done for assessing trade mark use.[19] Therefore, I do not consider that the lack of a breakdown for the turnover/unit sales is as problematic here as it would be under an assessment of genuine use under section 5(2)(b) or 5(3) of the Act, for example. Whilst the evidence does lack a degree of specificity when it comes to the goods sold, there are just five different products covered by the applicant's evidence. These are scoubidou strings, headbands, pumice stones, lint removers and pet hair removers. Clearly this is not a wide range of goods and bearing this in mind together with (1) the above comments regarding a lesser degree of granularity under section 5(4)(a) assessments and (2) the fact that there seems to be a relatively equal focus on the different types of goods in the evidence,[20] I am content to proceed on the basis that the goodwill vests in "pumice stones", "lint removers", "pet hair removers", "scoubidou strings for craft and jewelry making" and "headbands".

Misrepresentation

41. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

[18] See LC91
[19] See paragraph 57 of *BUNNYJUICE* (BL O/0064/24)
[20] On this point, I note, for example, the consistent appearance of all of these types of goods throughout the vast range of invoices provided regarding the applicant's advertising efforts.

"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] R.P.C. 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 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

42. And later in the same judgment:

> ".... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

43. Before considering the question of misrepresentation, I wish to discuss the evidence filed by the parties. It is noted that the applicant has filed evidence that perceives an attempt of misrepresentation by the proprietor. The evidence on this point focuses on the differences between the goods that the proprietor sells down

to the differences in the materials used and even the odour of the products[21] as well as the product packaging used by the parties.[22] It also attempts to speak to the alleged inferior quality of the proprietor's goods.[23] While this is noted, I do not consider that it is particularly helpful because it simply stems from the applicant's own detailed examination of the product and does not demonstrate any wider degree of actual misrepresentation to consumers. In any event, evidence of actual or intended misrepresentation is not necessary under the present ground and, on the contrary, it is common in proceedings before the Tribunal for misrepresentation to be found after consideration of a notional assessment.

44. As for the proprietor, it filed evidence purporting to support the existence of unrelated use of 'Great Five', a lack of distinctiveness or exclusiveness associated with the 'Great Five' brand and confusion between other unrelated products. This comes via a collection of pages showing results of Google searches for the term 'Great Five'.[24] The screenshots primarily relate to a character called 'Great Five' from Power Rangers but I note that they also include results for 'Channel 5' and 'Great Five' scoubidou strings on Amazon. In addition, I note that there are results for the 'Shopping' sub-category which show the video game 'Grand Theft Auto 5'. While noted, this evidence is of no assistance to the present proceedings. I say this for the reasons set out below.

45. Firstly, the searches are from after the relevant date so are not capable of pointing to the position on the market at that time. Secondly, reference to Channel 5 and Grand Theft Auto 5 are, in my view, results of the search algorithm seeking similar results and in no way speak to the impression or understanding of 'Great Five' in the UK. Lastly, I fail to see how the existence of a Power Rangers character named 'Great Five' could be said to be use that would point to a weakening of distinctiveness or a lack of exclusiveness of the applicant's brand. On this point, I

[21] Page 1 of LC93
[22] Page 3 of LC91
[23] Page 5 of LC91
[24] JH15 to JH19

have nothing to suggest the degree of popularity this character enjoys in the UK and, in any event, it is my understanding that Power Rangers is so far removed from the nature of the applicant's business (as covered by the evidence) that I struggle to see how consumers would associate the two beyond mere coincidence. The presence of such a character does not, therefore, create confusion between other unrelated products.

46. While the applicant's sign is figurative, it is dominated by the words 'Great Five'. The contested mark is a word only mark that consists of the words 'Great Five'. I accept that the figurative elements of the applicant's sign will be noticed but, even then, I find that there is a high degree of visual similarity between the sign and the word only mark. Further, as 'Great Five' is the sole aural and conceptual element of the applicant's sign, I am of the view that it is aurally and conceptually identical with the contested mark.

47. Turning to the goods at issue, I remind myself that under the present ground, the question is not related to the identity or similarity of goods but whether the parties operate in the same or similar fields of activity. I remind myself that the contested mark stands registered for the following goods:

Class 25: Sports shirts; Sports bibs; Headbands; Sports bras; Sports vests; Sports jerseys and breeches for sports; Clothing for sports; Sports clothing; Sports wear; Sports shoes; Sports socks; Sports jerseys; Clothes for sports; Sports garments; Sports headgear [other than helmets]; Sports jackets; Sports singlets; Sports caps and hats; Moisture-wicking sports shirts; Boots for sports; Headbands [clothing]; Headbands for clothing; Footwear for sports; Sports footwear; Moisture-wicking sports bras; Sports caps; Jackets being sports clothing; Sports pants; Sports clothing [other than golf gloves]; Articles of sports clothing; Sport shirts; Tennis sweatbands; Sports over uniforms; Combative sports

uniforms; Moisture-wicking sports pants; Cleats for attachment to sports shoes; Sport shoes; Footwear not for sports; Clothes for sport; Athletics vests; Clothing for wear in wrestling games; Sweatbands; Sports shirts with short sleeves; Footwear for sport; Footwear for use in sport; Sports [Boots for -]; Soccer shirts; Boots for sport.

48. Clearly, the best comparator for the above goods lies in the applicant's "headbands". On this point, I consider that the proprietor's terms of "headbands", "sports headgear [other than helmets]", "headbands [clothing]", "headbands for clothing", "tennis sweatbands" and "sweatbands" all exist in the same field of activity as the applicant. I say this because the goods expressly cover headbands or are sufficiently broad enough to cover the same. For example, a tennis sweatband can cover a headband, so clearly such a product exists in the same field as that of the applicant.

49. Further to the above, I note that the contested mark's specification includes a range of even broader sports related goods and I see no reason why the following terms cannot also be broad enough to cover headbands:

> "Clothing for sports; sports clothing; sports wear; clothes for sports; sports garments; sports clothing [other than golf gloves]; articles of sports clothing; sports over uniforms; combative sports uniforms; clothes for sport; clothing for wear in wrestling games"

50. In respect of the above, I will say that, as far as I understand it, headbands are commonly worn in wrestling and other types of sports for the purpose of either absorbing sweat or keeping the participant's hair out of their eyes/face. As such, all of the above terms can be said to duly cover headbands. In this context, I consider that the parties operate in the same fields of activity. Even if I am wrong and a headband is not technically a type of sports clothing (but an accessory), then

I still consider that there remains a degree of similarity in the parties' fields of activity. In support of this point, I find that the above goods and the "headbands" of the applicant are all likely to be produced by the same undertakings on the basis that sports clothing brands also create and sell accessories for sports (such as headbands). Further, such goods will be available via the same sporting goods retailers. While they may not necessarily be placed within close proximity to one another, the user is likely to be the same, namely someone who wears a headband whilst playing or participating in sports is also likely to seek the types of sports clothing covered by the proprietor's terms.

51. This leaves the following goods:

> "Sports shirts; sports bibs; sports bras; sports vests; sports jerseys and breeches for sports; sports shoes; sports socks; sports jerseys; sports jackets; sports singlets; sports caps and hats; moisture-wicking sports shirts; boots for sports; footwear for sports; sports footwear; moisture-wicking sports bras; sports caps; jackets being sports clothing; sports pants; sport shirts; moisture-wicking sports pants; cleats for attachment to sports shoes; sport shoes; footwear not for sports; athletics vests; sports shirts with short sleeves; footwear for sport; footwear for use in sport; sports [boots for -]; soccer shirts; boots for sport."

52. The above goods (save for "footwear not for sports") are all sport related clothing goods and while they are not the same as the applicant's "headbands", I do consider that there is a degree of closeness between the fields of activity. The reasons for this are the same as those provided at paragraph 50 above.

53. This leaves the term "footwear not for sports". While they are not of the same general purpose as the applicant's headbands, I do appreciate that headbands can be worn for fashion purposes in the same way general footwear can be. I appreciate that when compared to the other terms discussed above, there is a

greater distance between these goods and those of the applicant. However, there is still some degree of closeness between such fields of activity. I say this because both terms are general consumer goods that may be found in the same retailers or produced by the same undertakings and bought by the same user. For example, a general fashion retailer will sell footwear and headbands to the same set of consumers.

54. In considering the present issue of a misrepresentation, even considering the fact that the applicant only enjoys a moderate degree of protectable goodwill, the contested mark uses words identical to the sole verbal element in the applicant's sign, being 'Great Five'. Further, the contested mark is registered for goods that exist in the same or sufficiently similar fields of activity that are, in my view, sufficient to warrant a finding that there exists a misrepresentation. I say this because regardless of the type of goods covered by the contested mark's specification, they will be sought by the same sections of the relevant public and all relate to goods that can be worn on the body. Consumers will, in my view, believe it logical that the goods of the proprietor are associated with the goods of the applicant because both parties use the identical wording, thereby pointing to a shared source of origin.

Damage

55. In light of everything I have said above, I find that the risk of damage is easily foreseeable in the form of a loss of sales. The present ground, therefore, succeeds in full. The consequence of this is that the contested mark will be declared invalid regardless of the success of the section 3(6) ground. That being said, I will, for the sake of completeness, proceed to consider that ground below.

Section 3(6): legislation and case law

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

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

57. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

"(i) […]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*"), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45;

[*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky*

CJEU, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to

take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

58. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

59. In considering the question of bad faith, I remind myself that my assessment is to be based on the conduct and/or intention of the proprietor as at the time that the contested mark was applied for, which was 1 May 2024. However, the pleaded case relates to alleged activities of the proprietor after the successful registration of the contested mark. For example, the earliest event complained of in the statement of case was from 19 September 2024 wherein the applicant alleged that the proprietor first reported his Amazon listing for intellectual property infringement. Whilst evidence from after the relevant date may be of assistance if it casts light backwards on the position at that time,[25] the issue here is that the pleaded case makes no reference to the actual intention as at the time of the contested mark's

[25] *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9

filing. As such, simply filing evidence of subsequent enforcement action is of no assistance.

60. I accept that a party actively seeking registration of a trade mark to utilise it as a weapon to restrict another party from using the same or similar mark is a valid reason why that mark could not be legitimately filed. However, the pleaded case makes no mention of such an intention but simply complains of the actions of the proprietor in seeking to remove the applicant's Amazon listings. In short, reporting brands using similar signs on Amazon is not, by itself, an act of bad faith and it is something that is open to a rightful owner of an intellectual property right. In order to support a claim for bad faith, the applicant was required to put forward arguments in support of a claim that this was always the proprietor's intention. However, he did not do so. On the contrary, not to speak to the proprietor's defence, but it may have been the case that the proprietor only became aware of the applicant after it filed its mark. At that time, if it felt that it needed to protect its brand by filing complaints with Amazon, then it was entitled to do so. Lastly, I accept that I found that a misrepresentation exists under the section 5(4)(a) ground above, this was based on a notional assessment and there is nothing before me to categorically prove that this was actually the proprietor's intent. In any event, the pleaded case makes no mention of the proprietor's intention in applying for the mark. As a result, I find that the arguments put forward under the section 3(6) ground are misguided and offer no support to a finding that the proprietor acted in bad faith in actually applying for the contested mark.

CONCLUSION

61. The application has succeeded in full meaning that, subject to any successful appeal of my decision, the contested mark is hereby declared invalid and deemed as if it had never been filed in the first place.

COSTS

62. The applicant has been successful and he is, therefore, entitled to a contribution towards his costs. In the present case, I note that the applicant is unrepresented so in order to claim costs, he was required to file a costs proforma. The applicant returned his costs proforma on 12 November 2025. His claim as to costs is broken down as follows:

Forms	
Notice of Cancellation:	5 hours
Considering the forms filed by the other party:	30 minutes
Preparing evidence/written submissions	
Gathering evidence:	184 hours
Preparing statements:[26]	95 hours 30 minutes
Considering the other side's evidence:	9 hours
Total:	***294 hours***
Other expenses	
Postages fees:	£8.94

[26] From the description given, the evidential tasks also covered the filing of the applicant's evidence in reply.

Official fees:	£200
Total:	***£208.94***

63. I appreciate that the tasks outlined above would have required more of a time commitment on the part of the applicant on the basis that he is unrepresented. However, I am of the view that, save for the 'Forms' section, the time spent on the above tasks is on the excessive side. I say this for the following reasons:

a. I appreciate that the applicant's evidence was detailed, and I note that it involved numerous investigations into his sales on Amazon (by contacting Amazon Support). However, such steps would not have been required if the applicant had kept his own records as to his own sales data. As such, I do not consider that the high amount of time spent contacting Amazon and collating such evidence is something that is reasonably recoverable from the proprietor.

b. It is noted that in the breakdown of his costs (in his continuation sheet which accompanied the proforma), the applicant set out that significant time was spent in contacting multiple law firms, IPO support and CITMA's free legal support service to determine his own course of action. Time associated with seeking legal advice or other types of assistance are not recoverable in proceedings before the Tribunal.

c. I appreciate that the applicant would have been required to consider the evidence filed by the proprietor. However, this was only 55 pages in length and, all things considered, was of very low probative value. I consider that nine hours reviewing the same to be excessive.

d. Postage fees for the filing of the application for invalidity are not recoverable costs in proceedings before the Tribunal.

64. In light of what I have said above, I consider a costs award for the following number of hours to be reasonable:

Forms	
Notice of Cancellation:	5 hours
Considering the forms filed by the other party:	30 minutes
Preparing evidence/written submissions	
Gathering evidence:	15 hours
Preparing statements:	10 hours
Considering the other side's evidence:	3 hours
Total:	***33 hours and 30 minutes***
Other expenses	
Official fees:	£200
Total:	***£200***

65. In relation to the hours expended, I note that the Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for

litigants in person in Court proceedings at £19.00 an hour.[27] I see no reason to award anything other than this. I therefore award the applicant the sum of £836.50 (being 33 and a half hours at £19 per hour plus the official fees set out above) in respect of his costs.

66. I hereby order JHX Enterprises Ltd to pay Luigi Cinque the sum of £836.50. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 10th day of November 2026

A COOPER
For the Registrar

[27] It is noted that the costs have recently been increased to £24 per hour for costs incurred after 1 October 2025. In the present case, all costs were incurred prior to this date so the previous rate of £19 applies to these proceedings.