O/1102/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003897935
BY LAWRENCE PHILLIPS
TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASSES 32 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 442152
BY EMPRESA DE ÁGUAS SANTA CLAUDIA LTDA.

Background and pleadings

1. On 06 April 2023, Lawrence Phillips ("the applicant") applied to register the mark shown on the cover page of this decision in the UK. The specification for which the mark seeks registration stands as follows:

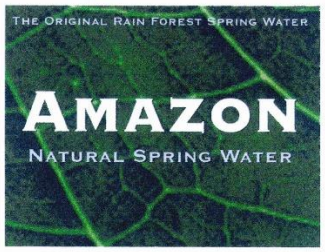
> **Class 32:** *Water; Waters [beverages]; Mineral water; Drinking water; Drinking mineral water; Aerated water [soda water]; Bottled water; Preparations for making carbonated water; Carbonated water; Sparkling water; Still water; Table water; Soda water; Tonic water; Flavoured water; Flavoured mineral water.*
>
> **Class 35:** *Advertising; Business management; Business administration; Office functions; all of the aforesaid connected with the sale of water, waters [beverages] mineral water, aerated water, bottled water, carbonated water, preparation for making carbonated water, drinking water, drinking mineral water, sparkling water, still water, table water, soda water, tonic water, flavoured water and flavoured mineral water, which geographically originate from Amazon region of South America; Retail services connected with the sale of water, waters [beverages] mineral water, aerated water, bottled water, carbonated water, preparations for making carbonated water, drinking water, drinking mineral water, sparkling water, still water, table water, soda water, tonic water, flavoured water and flavoured mineral water, which geographically originate from the Amazon Region of South America; Wholesale services connected with the sale of water, waters [beverages] mineral water, aerated water, bottled water, carbonated water, preparations for making carbonated water, drinking water, drinking mineral water, sparkling water, still water, table water, soda water, tonic water, flavoured water and flavoured mineral water, which geographically originate from the Amazon Region of South America.*

2. The application was accepted and published for opposition purposes on 28 April 2023.

3. On 26 July 2023, the application was opposed by Empresa de Águas Santa Claudia Ltda ("the opponent") under Sections 5(2)(b), 3(3) and 3(6) of the Trade Marks Act 1994 ("the Act").

4. Under Section 5(2)(b) the opponent relies upon the following trade mark and the goods and services covered by the same as shown below:[1]

UK00902322006



Mark Description/Limitation
Colour Claimed : Dark green; middle green; light green; white; blue.

Filing date: 30 July 2001
Registration date: 09 October 2002

Class 32: *Mineral and aerated waters.*

5. The trade mark relied upon by the opponent qualifies as an "earlier trade mark" in accordance with Section 6 of the Act because it was applied for at an earlier date than the filing date of the applied-for mark. Since the opponent's mark had been registered for more than five years at the date the contested mark was filed for registration, it is subject to the use conditions contained in Section 6A(3) of the Act.

[1] Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's earlier mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

6. Under Section 5(2)(b), the opponent claims that the marks are similar and that the goods and services are identical or similar, leading to a likelihood of confusion. In addition, the opponent claims to have *"proper reasons for non-use"* stating as follows:

> *"[The opponent] and associated companies had proper reasons [for] non-use of its registered mark in the United Kingdom, and the reasons were outside its control:*
>
> *- issues with the registration of the trade mark in the country of origin - Brazil - lasting until 2018;*
> *- financial issues throughout the relevant period;*
> *- COVID restrictions on export and production in 2019 and 2020;*
> *-despite financial issues, these have been overcome by successfully launching the Brazilian products and making effective and serious preparations for selling in the United Kingdom by complying with the export PEIEX program which was launched for and specifically affects the Owner's region of the Amazon.*
>
> *The Owner has therefore had throughout the period in question proper reasons for not using the mark in the United Kingdom."*

7. Under Section 3(3) the opponent formulates the claim as follows:

> *"**Section 3(3)(b) intent to deceive the public as to origin***
>
> *Section 3(3) (b) provides that "A trade mark shall not be registered if it is of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)". Since the trade mark applicant has not applied to export water from the Amazon, the water sold will be obtained from another source and therefore the trade mark will deceive the public as to the geographical origin of goods of class 32. The public will associate the goods marked with the contested mark as water from the Amazon region of South America, whilst the goods are mentioned generally as water and other related products and no evidence has been seen of any license to export from the Amazon [….]. Therefore, the mark is deceptive for all goods of class 32."*

8. Under Section 3(6) the opponent formulates its claim as follows:

> *"The earlier mark was well known to the applicant at the time of filing as the applicant has filed a cancellation action with respect to the earlier mark. The applicant has not only been aware of the earlier mark but has decided to copy the configuration of the earlier mark including the green leaf pattern. At the same time, it is believed that the applicant may not have established a license to export water from the Amazon region or might try to usurp the work of the earlier trade mark owner to apply for a license once the mark is registered. The Opponent therefore requests that evidence of any application to obtain an export license from the Amazon is provided. In the absence of any such evidence and in the light of these facts, the applicant's conduct clearly falls short of the standards of acceptable commercial behaviour in this industry. Therefore, the application was filed in bad faith".*

9. The applicant filed a Form TM8 including a counterstatement denying the claims. In particular, the applicant argues that:

- About the alleged reasons for non-use, none of the factors listed by the opponent constitutes an insurmountable obstacle beyond the opponent's control and with a direct relationship to the trade mark so as to make its use impossible in the UK. This is flagrantly insufficient to demonstrate proper reasons for non-use. First, any issue with registration of the trade mark in Brazil would not affect the use in the UK of a trade mark validly registered in the UK. Second, financial issues are not considered a proper reason for non-use, as they are not beyond the opponent's control. Third, a simple mention of "COVID restrictions" in 2019 and 2020 is exceedingly generic to be considered as grounds for non-use and, in any event, would only cover 2 years of the 21 years of non-use which occurred long after the expiration of the 5-year period for use of the trade mark (09 October 2007). Last, the opponent's fourth bullet point only mentions "*launching the Brazilian products"* which, as shown in cancellation action no. 505475, was a poorly disguised attempt to simulate marketing of mineral water bottles by donating small quantities to various local parties, *and "complying with the export PEIEX program"*, which is a voluntary

(non-mandatory) program offered to first-time exporters and covers the entire Brazilian territory, and is not specific to the Amazon region as the opponent once again falsely states.

- About the claim of bad faith: the opponent's allegation that the earlier mark was known to the applicant at the time of filing because the applicant has filed a cancellation action with respect to the earlier mark, is simply false. The cancellation action was, in fact, filed in 2023 (cancellation no. 505475), while the applicant's trade mark was developed in 2021, as shown by the application no. 202123868 made on 05 October 2021 to the Intellectual Property Authority of Ukraine. Therefore, the applicant did not know the opponent's trade mark at the time the applicant's trade mark was created. Moreover, the opponent tries to mislead the Tribunal by alleging that there is a requirement for *"a license to export water from the Amazon region"*. No such license exists, as shown by the expert witness statement of Brazilian attorney Neimar Batista (exhibit XX), which was also filed in the cancellation action. Therefore, the opponent's request for evidence of an application to obtain an *"export license from the Amazon*" is absurd and made in bad faith in an attempt to mislead the Tribunal.

- About the claim that the mark is deceptive: the opponent again attempts to mislead the Tribunal by alleging that the applicant would be required to file an application to export water from the Amazon. As demonstrated in the expert witness statement by a Brazilian attorney, there is no *"export license"* required to export mineral water from the Amazon region. Therefore, the sole basis for the allegation of intent to deceive the public is an absurd creation of the opponent to mislead the Tribunal. So much so that the applicant itself has not produced, neither in its statement of grounds nor in the cancellation action no. 505475, evidence of such *"license to export water from the Amazon region".* No such license exists.

10. Along with the counterstatement, the applicant filed copy of a legal opinion confirming that in Brazil "*the export of mineral water by companies duly licensed for mining and trading of the product, as well as duly authorized by the competent*

governmental bodies to carry out their activity, does not suffer any limitation or imposition of a specific "export license".

11. Only the opponent filed evidence, although both parties filed written submissions. A hearing was arranged pursuant to a request by the applicant and took place before me on 8 May 2025 by video conference. Mr Leonardo Schneider appeared for the applicant. The opponent, who has been represented by ip21 Limited throughout the proceedings did not attend the hearing, nor did it file written submissions in lieu.

EU Law

12. 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.

The evidence

13. The opponent's evidence in chief consists of a witness statement from Afranio Pio de Souza dated 3 April 2024. Mr de Souza is the managing partner at the opponent's company and his evidence is accompanied by eight exhibits being those labelled Exhibits 1 – 8. The opponent also filed submissions dated 13 May 2024. In addition to its evidence in chief, the opponent filed evidence in reply in the form of a witness statement from Fernando Mattos de Souza Filho dated 19 August 2024. Mr de Souza Filho is a partner and shareholder of a third-party company called Real Bebidas da Amazonia and his evidence is accompanied by two exhibits, being those labelled Exhibits 1 – 2.

14. The applicant did not file any evidence during the evidence rounds, though on 9 June 2024 he filed written submissions.

15. I do not intend to summarise the opponent's evidence (or the submissions of the parties, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY POINTS

16. Before dealing with the main substance of the case, there are two preliminary points to be made.

17. First, although the present opposition originally included a Section 5(2)(b) ground, that ground has fallen away in the light of the fact that the only earlier right relied upon by the opponent has been revoked for non-use from a date which is earlier than the application date of the contested mark. The decision which revoked the opponent's earlier trade mark no. UK00902322006 (BL-O/0846/24) with effect from 10 October 2007 was issued on 2 September 2024; since it has not been appealed, that decision now stands as binding between the parties. Thus, the grounds left are that the applied-for mark is deceptive under Section 3(3)(b), and it was filed in bad faith under Section 3(6).

18. Second, along with his skeleton argument, Mr Schneider filed two annexes containing evidence about:

1) The date of incorporation of Amazon Spring Waters Recursos Minerais S/A, a Brazilian company of which the applicant is a director. As Mr Schneider confirmed during the course of the hearing, this evidence was filed for the purpose of supporting the applicant's defence against the bad faith objection based on Section 3(6), with a view of demonstrating the date of incorporation of the applicant's Brazilian company in order to show that the name AMAZON has been part of the company's name since 2005 (and the applicant did not misappropriate the opponent's sign).

2) Screenshots from the Amazon UK website showing that the applicant's product label discloses an environmental initiative, namely a 5% donation per litre to

Amazonian reforestation initiatives. This evidence was filed for the purpose of supporting the applicant's defence against the Section 3(3)(b) ground, with a view of showing that the use of the word "Amazon" serves an environmental branding function, and is not deceptive.

19. Having had sight of the above material, on the 6 May 2025, the opponent requested the applicant's submissions to be struck out as inadmissible. As I anticipated in an email sent to the parties on 7 May 2025, I considered the admissibility of the above evidence as a preliminary issue at the hearing, and I confirmed that it was not admitted. This is because (a) the evidence did not appear to be material to the issues I have to determine and (b) matters that are not reflected in the applicant's mark (as texts included in the product label) are outside the grounds I have to decide. Further, no reasons were provided as to why the evidence was not filed earlier.[2]

20. With this in mind, I now turn to the grounds.

Section 3(6)

21. 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."

22. 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).

[2] *Property Renaissance Ltd v Stanley Dock Hotel & Ors* (2016) EWHC 3103 (CH))

(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)."

23. In *SkyKick*, Lord Kitchin considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

"152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another.

> Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.
>
> 153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 […]."

24. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

> (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
>
> (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
>
> (c) Was it established that the contested application was filed in pursuit of that objective?

25. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani*

(Grosvenor Street) Limited and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

26. The opponent's case on bad faith is that the earlier mark was well-known to the applicant at the time of filing the contested application. In this connection, the opponent relies upon the fact that the applicant filed a cancellation action against the opponent's earlier mark (on 19 October 2022), prior to the filing date of the applied-for mark (06 April 2023). In addition, the opponent argues that the applicant decided to copy the configuration of the earlier mark including the green leaf pattern. The opponent also alleges that the applicant did not establish that it obtained a licence to export water from the Amazon region and states that the applicant might try to usurp the work of the earlier trade mark owner to apply for a licence once the mark is registered. In this connection, the opponent requests that the applicant provides evidence of any application it might have made to obtain an export licence from the Amazon saying that in the absence of any such evidence and in the light of these facts, it should be concluded that the application was filed in bad faith.

27. Before I turn to the evidence before me, it is worth noting that the opponent filed its evidence in chief on 3 April 2024 – this is prior to the decision of 2 September 2024 which revoked the earlier mark for non-use. This might explain why Mr de Souza's witness statement focuses on the asserted reasons for non-use – however, such evidence is no longer relevant given that the issue of proof of use within the originally pleaded Section 5(2)(b) has fallen away. Nevertheless, insofar as Mr Souza's evidence can be relevant to the question of whether the applicant had knowledge of the earlier mark and wanted to benefit from it and/or from the opponent's efforts to obtain a licence (as I understand the pleadings under Section 3(6)) it is as follows.

28. The opponent is a Brazilian company called Empresa de Águas Santa Claudia Ltda which was established in 1964 in Brazil. Whilst Mr de Souza provides evidence of labels used by the opponent in relation to bottles of water and other beverages products going back to 1964, none of the labels or products display the mark Amazon. Instead, the marks featuring on the products is Santa Claudia (the latter being the opponent's company name) and Real Bebidas (this is part of the company name Real Bebidas da Amazonia Ltda which, Mr de Souza says, is a company authorised to use

the now-revoked earlier mark). Copies of pages from the opponent's website (translated in English) say that in 1966 the opponent launched an Amazonian flavoured soft drink, extracted from the guaraná fruit, the Guaraná Real – however, this does not mean that the drink was sold under the mark 'AMAZON'; on the contrary, the way I read this evidence is that it was sold under the mark Guaraná Real. The same website also says that the company Real Bebidas produces among others, a soft drink called the Guaraná Real da Amazônia, that the company is a very successful beverage company in the State of Amazonas (Brazil) and that it aims to solidify its presence through the distribution and exportation of its products both at national level and in international markets. However, the fact that a company which was authorised to use the opponent's now-revoked mark incorporating the word AMAZON is a successful company in the Amazon region and might still be interested in the mark AMAZON, is neither here nor there in establishing that the applicant applied for the contested mark in bad faith. Similarly, the evidence (unsupported) that the opponent might have obtained protection for a mark nearly identical to the now-revoked earlier mark on 1 February 2018 in Brazil, and that the grant of such protection meant that the product could be duly authorised for export abroad, including in the UK, cannot establish any element of bad faith about the applicant's knowledge, intentions or actions. In this connection, as it will be recalled, the opponent's only argument about the applicant having knowledge of its now-revoked earlier mark is that the applicant must have known of the earlier mark because it filed a revocation action against it before applying for the contested mark. Lastly, Mr de Souza says that the opponent launched the AMAZON spring water in Brazil in 2022, and achieved significant sales in December 2022 (i.e. three months prior to the filing date of the applied-for mark on 06 April 2023) and that, at the date of the witness statement, the opponent's exportation plan was being drafted taking into account the special conditions of transportation of goods from Brazil to the UK.

29. In addition to the above evidence, the opponent filed evidence in reply in the form of a witness statement by Mr Filho. Mr Filho says that in March 2022 (i.e. nearly one year prior to the applicant filing the contested mark) the representative of the applicant made an attempt to negotiate with the representatives of Real Bebidas da Amazonia Ltda (i.e. the company Mr de Souza says was authorised to use the now-revoked earlier mark) the purchase of the "Amazon Natural Spring Water" brand or the licence

for using the said mark. A copy of an email (in Portuguese with an English translation) is produced which shows that on 29 March 2022 the applicant's representative, Mr Schneider, contacted someone at an email address ending with '@real-am.com.br' stating as follows:

> *"As we spoke on the phone, the company I represent would be interested in acquiring or licensing the "Amazon Natural Spring Water" brand.*
> *Could you please check with the management if there is interest in this negotiation and how much it would cost?"*

30. Copies of further emails[3] show that Mr Schneider chased a response on 3 May 2022 confirming that he was acting for a company called Amazon Spring Waters Recursos Minerais S.A. and again on 18 May 2022 and 14 June 2022. Having received no response, on 28 June 2022, Mr Schneider wrote again saying as follows:

> *"Dear Dr. Viviane, my client requested that I inform you that in view of Real's apparent lack of interest in negotiating the trademark, she is hiring a specialized professional in the United Kingdom to evaluate the request for cancellation of the trademark due to disuse within the legal term applicable in that jurisdiction. If you're interested in talking, I'd be happy to help".*

31. Having been told that the CEO was abroad and would return to the company the following week, when the possibility of marketing the brand would be discussed, and having received no further response, on 11 July 2025, Mr Mr Schneider sent another email stating as follows:

> *"Please, has there been any feedback from the board since our last contact 2 weeks ago? As I said, if there really is no interest in the negotiation, my client will be obliged to follow up on the issue of cancellation due to disuse. I look forward to hearing from you as soon as possible, please."*

[3] Exhibit 1

32. Lastly, Mr Filho provided evidence that the applicant is the president of a Brazilian company called AMAZON SPRING WATERS RECURSOS MINERAIS S/A with the document only showing the printing date of 18 July 2024.

33. During the course of his oral submissions, Mr Schneider contended that the opponent's evidence showing that he had contacted the company authorised to use the now-revoked earlier mark and attempted to purchase the same mark prior to filing an application for cancellation against it, somehow implies that such conduct would amount to bad faith, but there is no legal basis or precedent to suggest that it does. In this connection, Mr Schneider defended his position by saying that it was merely an encouraged commercial approach to try to negotiate the purchase of a trade mark the applicant was interested in.

34. Further, Mr Schneider argued that the revocation of the now-revoked earlier mark undermines the opponent's position of any reasonable expectation of maintaining trade mark rights and also undermines any claim that the applicant acted dishonestly by seeking to register its own right because the opponent's trade mark has never been used anywhere, in contrast with the case-law in which bad faith had been found because, generally, it is required that there is an active brand which is not, clearly, the case here.

35. Lastly, Mr Schneider pointed out that the opponent relies on the absence of a licence to export water from the Amazon region, the existence of which has not been proven. In this connection, Mr Schneider stated that the applicant has shown that there is no such licence, by filing evidence by a Brazilian lawyer showing that that such a licence does not exist. I am not sure what evidence Mr Schneider refers to as no evidence was filed by the applicant in these proceedings; it is possible that it intended to refer to the legal opinion which was attached to the counterstatement. However, it matters not because the opponent did not file any evidence capable of establishing that under Brazilian law there is a requirement to obtain a licence to export water from the Amazon region. Accordingly, since the opponent did not prove the fact claimed, the applicant need not disprove it.

36. The most the evidence establishes is that:

a) On 29 March 2022, a year before the applicant filed the contested mark (on 6 April 2023), the applicant's legal representative, Mr Schneider, contacted a company called Real Bebidas da Amazonia Ltda, offering to purchase the brand "Amazon Natural Spring Water" or alternatively, to purchase a licence for using the said trade mark in the UK.

b) Real Bebidas da Amazonia Ltda is the company which was authorized to use the now-revoked earlier mark. Whilst it is not clear when such authorization was granted, the exchange of emails between Mr Schneider and Real Bebidas da Amazonia Ltda strongly suggest that the latter was the entity authorised to use the mark in Brazil when contacts were made.

c) Mr Schneider acted on behalf of a company called AMAZON SPRING WATERS RECURSOS MINERAIS S/A of which the applicant, Mr Lawrence Phillips, is a director.

d) Mr Schneider made several attempts to discuss the purchase of the now-revoked earlier mark and having received no response from Real Bebidas da Amazonia Ltda, on 19 October 2022, the applicant filed an application to revoke the opponent's earlier mark. The opponent's earlier mark was then revoked for non-use on 2 September 2024 with effect from 10 October 2007.

e) On 6 June 2023, the applicant filed an application to register the contested mark.

37. The conclusion I draw from the above is that when the applicant filed the contested mark (on 6 April 2023), he knew of the existence of the opponent's earlier mark, having filed a revocation for non-use against it (on 19 October 2022). Prior to filing the revocation for non-use, the applicant's representative approached the Brazilian company which was authorized to use the earlier mark expressing an interest in purchasing the brand and explaining that "*the trademark would only be for use abroad, especially in the UK"*. Further, although the opponent's earlier mark had been registered in the UK for over 20 years it had never been used and was revoked for non-use from 10 October 2007. Consequently, taking into account the retrospective

effects of the revocation, when the applicant applied for the contested mark on 6 April 2022, the opponent had effectively no business and no registered trade mark rights (or alternatively it was the owner of a trade mark that was vulnerable to revocation).

38. Bearing in mind all of the above, it seems to me that the way the applicant behaved is in line with decent commercial practices. What the applicant has done is what many businesses would do in similar circumstances, that is to say having received no response to an attempt to purchase a non-used trade mark, it informed the registered owner or licencee (in this case the company which was authorized to use the mark) of its intention to seek revocation of the registration. The fact that applicant applied for the contested mark prior to the revocation action being concluded, is not an indication of bad faith since had the opponent managed to defend the revocation, it could have continued to rely on its mark in the opposition to oppose the contested mark. Pursuing an interest in a trade mark vulnerable to revocation for non-use using the legal means offered by the trade mark system is not, in my view, bad faith. There was no dishonest or unscrupulous conduct when applying for the trade mark; rather, in my view, the applicant followed all of the correct legal procedures to obtain the registration in the circumstances of the case. The bad faith claim fails.

Section 3(3)(b)

39. Section 3(3)(b) of the Act is as follows:

> "3.— Absolute grounds for refusal of registration
> […]
> (3) A trade mark shall not be registered if it is—
>
> (a) contrary to public policy or to accepted principles of morality, or
>
> (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)."

40. The opponent's case under this ground is that the applied-for mark will deceive the public as to the geographical origin of the goods because the applicant has not applied to export water from the Amazon, and the water sold will be obtained from another source. Consequently, the opponent states, the trade mark will deceive the public as to the geographical origin of the goods in class 32. In particular, the opponent states that the public will associate the goods marked under the contested mark as water from the Amazon region of South America, whilst the goods might come from different geographical places and argues that no evidence has been produced of any licence to export water from the Amazon.

41. The first thing to note is that the applied-for specification in class 32 does not restrict the goods to products which geographically originate from the Amazon region of South America, whereas the specification in class 35 does; the latter, in fact, restricts the applied-for services to advertising; business management; business administration; office functions; retail and wholesale services all connected with the sale of water which geographically originates from the Amazon region of South America. This is important because the opponent's case is that the contested mark is deceptive (the opponent does not argue that the mark is descriptive) and that the applicant has not produced any evidence which demonstrates that it has obtained a licence to export the goods in the UK. Consequently, leaving aside the issue of the licence, the descriptiveness of the mark not being at issue, the Section 3(3)(b) can be easily dismissed in relation to the services based on the finding that (i) the specification has been limited to services connected with goods originating from the Amazon region (ii) the opponent has not provided any evidence in support of its claim that the export of spring/mineral water from the Amazon region is subject to the imposition of a specific "export licence" and (iii) even if the opponent had managed to prove that the requirement of such a licence applies to the applicant's goods (and services related to the goods), once the mark is registered the applicant has a five-year grace period to obtain the licence in order to export the goods to which the services relate.

42. Whilst the comments above are important to understand my conclusions below, in the context of this ground, the opponent does not mention the applied-for services at all. Admittedly, when answering the question "*States which of the applicant's goods or services you oppose under Section 3 grounds"* the opponent ticked the box *"all goods*

and services", however, in the statement of grounds, the opponent clearly directs the Section 3(3)(b) objection to the applied-for goods in class 32, leaving out the services in class 35. It follows that since (i) the objection under Section 5(2)(b) has fallen away; (ii) the ground under Section 3(6) has failed; (iii) the ground under Section 3(3)(b) is restricted to the goods in class 32, and (iv) even if not restricted to the goods, the Section 3(3)(b) ground would have failed in relation to the services for the reasons I set out at paragraph 41, the applied-for mark can proceed to registration in relation to the services in class 35. To summarise my conclusions in relation to the services, the Section 3(3)(b) has not been pleaded in relation to the applied-for services in class 35, but even if it had, the mark could not be deceptive because the goods to which the services relate are limited to goods originating to the Amazon region and the issue of the license is irrelevant (because the requirement of a license is not proven, or the license can be acquired after the contested mark is registered).

43. Turning to the goods, the comments I have made above (i.e. that the opponent did not produce any evidence to show that the export of spring/mineral water from the Amazon region is subject to the imposition of a specific "export licence" and that even if the opponent had managed to prove that the requirement of such a licence applies to the applicant's goods, the applicant has a five-year grace period from the day the mark is registered to obtain the necessary licence in order to export the goods) equally apply to the goods. Admittedly, given the way the Section 3(3)(b) has been pleaded in relation to the goods, I could dismiss the case on that basis. However, that leaves the question of whether the contested mark would still be deceptive if used in relation to goods not originating from the Amazon region (e.g. water produced in the UK) not because of the licence issue, but because the specification in class 32 does not restrict the goods to water originating from the Amazon region. In my view the answer to this question is 'no'. I say this because, whilst the word 'Amazon' in the application may be perceived by the average consumer as a reference to the rainforest, it does not have a reputation for water or for any of the goods covered by the contested specification in class 32, and it is unlikely to have a reputation in the future. Whilst descriptiveness and deceptiveness are two separate grounds of opposition, in my view there is an overlap here to the extent that if the Amazon is not well-known in the UK for the production of water, the word AMAZON in the contested mark will not be perceived as a geographical reference to the origin of the goods, and the mark cannot be deceptive.

44. The ground under Section 3(3)(b) also fails.

CONCLUSION

45. The opposition has failed under all grounds and the applicant's mark will proceed to registration.

COSTS

46. The applicant has been successful and would therefore be entitled to a contribution towards his costs based upon the scale published in Tribunal Practice Notice 1/2023. Although Mr Schneider appeared on behalf of the applicant at the hearing, the applicant did not file a Form TM33 to appoint him (or anyone else) as his representative in these proceedings. By way of an official letter dated 9 January 2025, the Tribunal informed the applicant that if he intended to make a request for an award of costs he needed to complete and return a costs pro-forma by 6 May 2025 (i.e. 2 working days before the hearing). The same letter advised the applicant that if the proforma was not completed and returned, no costs, other than official fees arising from the action (excluding extensions of time), would be awarded.

47. Accordingly, since no costs proforma has been filed by the applicant and no official fees have been paid by the applicant in these proceedings, I do not consider it appropriate to make an award of costs.

Dated this 25th day of November 2025

TERESA PINTO
For the Registrar