O/1125/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003926582

BY M&A STYLES LTD

FOR THE FOLLOWING TRADE MARK:

ACCENTHOME

IN CLASS 17

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 506871

BY NAEEM RASOOL

BACKGROUND AND PLEADINGS

1. M&A styles ltd ("the proprietor") applied to register the trade mark shown on the cover page of this decision ("the Contested Mark") in the UK on 25 June 2023. It was registered on 29 September 2023 for the following goods:

Class 17 Flexible foam; flexible polyurethane foam; flexible foam materials; cut to size foam; foam materials cut to size; foam materials for use in manufacture; foam materials in the form of blocks, sheets, rolls, blanks; shredded polyurethane foams; ether foams; closed cell foams; closed cell polyethylene foams; closed cell cross-linked polyethylene foam; closed cell cross-linked polyethene foam; Flower arrangements (Foam supports for -) [semi-finished products]; Foam for use as heat insulation; Foam for use as heat shields; Foam for use as motor compartment linings; Foam for use in sound absorption; Foam for use in sound insulation; Foam glass for use as an insulating materials; Foam in the form of blocks for use as heat insulation; Foam insulation for use in building and construction; Foam insulation materials for use in building and construction; Foam rubber; Foam sheeting for use as a building insulation; Foam supports for floral arrangements; Foam supports for flower arrangements [semi-finished products].

2. On 4 January 2024, Naeem Rasool ("the applicant") applied to have the Contested Mark declared invalid under section 47 of the Trade Marks Act 1994 ("the Act") based sections 5(2)(a), 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act.

3. Under section 5(2)(b) and 5(3), the applicant relies upon the following trade mark:

ACCENTHOME

UK registration no. UK00003903669
Filing date 21 April 2023.
Registration date 29 September 2023.

Relying upon some of the goods for which the mark is registered, namely:

Class 20 Mattress pads; Cushions; Chair pads; Seat pads; Memory foam pillows; Seat cushions; Chair cushions; Sleeping pads; Latex pillows; Beds, mattresses, pillows and cushions; Cushions (upholstery); Bean bag pillows; Plastic mesh cushioning sheets for lining shelves; Soft furnishings [cushions]; Foam mattresses; Cushions [furniture]; Protective pads, not of metal, for chair legs.[1]

4. Under sections 5(2)(a) and 5(2)(b), the applicant claims that there is a likelihood of direct confusion between the parties' identical marks and the applicant's above goods which are identical and similar to the proprietor's "flexible foam", "foam materials for use in manufacture", "foam materials in the form of blocks, sheets, rolls, blanks", "foam rubber", "foam supports for floral arrangements" and "foam supports for flower arrangements [semi-finished products]".[2]

5. Under section 5(3), the applicant claims that its above goods enjoy a high degree of reputation by virtue of the extensive use made of them, and its public recognition in the UK. The applicant claims that use of the contested mark "could cause detriment to the reputation of the earlier mark by way of degradation, in particular as the applicant will not be able to control the manner" in which the later mark is used, "which may be in a manner which is adverse to the reputation of the earlier mark". The applicant also claims that there would be a clear link between the marks due to the identity of the goods and on the basis that the marks are composed of the dominant and distinctive word "ACCENTHOME". The opponent claims that the distinctiveness of the earlier mark will be eroded and that this would reduce the public's ability to distinguish the goods offered under the earlier mark from other traders, which would result in a loss of sales. The applicant claims that the goods which take unfair advantage of its earlier mark is "flexible foam", "foam materials for use in manufacture", "foam materials in the

[1] The applicant also listed the following terms that it wished to rely upon; "upholstered furniture", "upholstery fabrics", "beds for pets", "booster seats", "seat mattresses", "padded furniture", "furniture coverings of textiles" and "soft furnishings". However, these terms are not listed within the applicant's class 20 specification and therefore they are unable to rely upon them under sections 5(2) and 5(3) of the Act.

[2] The applicant also listed "upholstery foam" and "packing foam in sheets", however, these goods are not contained within the proprietor's class 17 specification.

form of blocks, sheets, rolls, blanks", "roam rubber", "foam supports for floral arrangements" and "foam supports for flower arrangements [semi-finished products]".[3]

6. Under section 5(4)(a), the applicant relies on the **ACCENTHOME** sign, which it claims to have used since 21 April 2023 throughout the UK on "all goods and services in the cancellation applicant's previous registered trademark i.e. ACCENTHOME". I note that all of the goods protected by the applicant's earlier ACCENTHOME mark are the following class 20 goods:

> Mattress pads; Cushions; Nap mats [cushions or mattresses]; Chair pads; Seat pads; Sleeping bag pads; Memory foam pillows; Seat cushions; Pillows; Inflatable neck support cushions; Chair cushions; Sleeping pads; U-shaped pillows; Latex pillows; Beds, bedding, mattresses, pillows and cushions; Inflatable pillows; Air cushions; Japanese floor cushions (zabuton); Baby head support cushions; Cushions (upholstery); Bean bag pillows; Bamboo pillows; Plastic mesh cushioning sheets for lining shelves; Neck support cushions; Throw pillows; Stuffed pillows; Support pillows for use in baby seating; Scented pillows; Soft furnishings [cushions]; Bath kneeling pads; Foam mattresses; Neck pillows; Pet cushions; Cushions (Pet -); Air pillows; Removable mats or covers for sinks; Sinks (Removable mats or covers for -); Bath pillows; Suction pads [fixings]; Head support cushions for babies; Cushions [furniture]; Protective pads, not of metal, for chair legs; Head positioning pillows for babies.

7. The applicant claims that use of the proprietor's mark, on all of its goods contained in paragraph 1, would be contrary to the law of passing off.

8. Under section 3(6), the applicant claims that the proprietor filed its mark in bad faith. The applicant claims that its mark "Foamtouch" predates the proprietor's application, and that the proprietor is aware of the applicant's other marks such as "Foamily", "AK Trading Co." and "INSIEME" and this indicates that the applicant's mark was already known within the relevant industry. The applicant also claims that the similarities

[3] Again, the applicant also listed "upholstery foam" and "packing foam in sheets", however, these goods are not contained within the proprietor's class 17 specification.

between the marks and the goods suggests a deliberate attempt to ride on the reputation and goodwill of the applicant and that “such conduct contravenes the principles of fair competition and constitutes bad faith”.

9. The proprietor filed a counterstatement denying all of the claims made.

10. The applicant and proprietor are unrepresented. The applicant filed evidence in chief and the applicant filed evidence in reply. Neither party requested a hearing, however, the cancellation applicant filed written submissions in lieu. I have taken all of the evidence and the parties’ submissions into consideration in reaching my decision and will refer to them where necessary below.

11. 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 AND PRELIMINARY ISSUE

12. The applicant’s evidence consists of the witness statement of Naeem Rasool dated 15 July 2024, and his statement is accompanied by 3 exhibits (NR-01-NR-03).

13. The proprietor’s evidence in reply consists of the witness statement of Mobeen Farooq dated 16 September 2024. While Mr Farooq does not clarify his connection to the proprietor, within his witness statement he refers to it as “our company”. On this basis, it is reasonable to infer that he is either a director or employee of the proprietor, and, as such, he is duly authorised to file evidence on its behalf.

14. It is noted that under heading 8 of Mr Farooq’s statement, he claims that on review of the invoice evidence provided by Mr Rasool, the invoices are dated before 21 April 2023, being the filing date of Mr Rasool’s mark. Mr Farooq states that “this is significant” as it suggests that the applicant was using and selling products under the

"ACCENTHOME" mark "prior to securing any legal trademark rights to the name" meaning that "any commercial use of the brand name was unauthorised and illegal". Mr Farooq states that this therefore "undermines the credibility of the applicant's claims and highlights that their actions were in violation of trademark law". Lastly, Mr Farooq states that the use of the applicant's mark was before the applicant owned the "valid trade mark registration" for "ACCENTHOME" "demonstrates that the applicant was acting in bad faith by attempting to appropriate a mark they did not have legitimate rights to use".

15. The evidence of use prior to the applicant's filing date of its mark is relevant to its section 5(4)(a) claim. As I will come to discuss, this section protects unregistered trade marks or signs which are used in the course of trade. Many businesses will operate without having their marks registered, and this certainly is not illegal or in violation of the law, nor is it evidence of a party acting in bad faith. This submission therefore does not assist the proprietor, and it will not be considered any further.

PLEADING PRELIMINARY ISSUE

16. Under section D of the Form TM26I, which lists all of section 3 of the Act, the applicant only ticked and filled out the section 3(6) box. However, in its attached statement of grounds, at paragraph 27, the applicant states that "accordingly, the cancellation applicant requests to cancel the proprietor's mark under section 3(1)(b)(c)(d) and 3(3)(a)(b)" of the Act. However, I note that:

1. I was not told how the proprietor's mark is devoid of distinctive character as per section 3(1)(b).
2. I was not told how the proprietor's mark consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services, as per section 3(1)(c).
3. I was not told how the proprietor's mark consists exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade, as per section 3(1)(d).

4. I was not told how the proprietor's mark is contrary to public policy or to accepted principles of morality, as per section 3(3)(a).
5. I was not told how the proprietor's mark 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) , as per section 3(3)(b).

17. As none of the above submissions were made to accompany the aforementioned request, in conjunction with the fact the accompanying section 3 boxes were not ticked under section D of the Form TM26I, I find that they were not adequately pleaded. On this basis, the applicant cannot rely on sections 3(1)(b), 3(1)(c), 3(1)(d), 3(3)(a) or 3(3)(b) and they will not be considered any further.

DECISION

18. Sections 5(2), 5(3), 5(4)(a) and 3(6) of the Act all have application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads 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).
>
> Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> > (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
> >
> > (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.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

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

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

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet

acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) […]

(4) […]

(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(2)(a) and 5(2)(b)

19. Section 5(2)(b) reads as follows:

"5(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

20. The applicant's trade mark qualifies as an earlier mark pursuant to section 6 of the Act. The applicant's earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at section 6A of the Act do not apply.

21. The applicant may rely upon all of its goods without demonstrating that it has used its mark.

Identity of the marks

22. It is a prerequisite of section 5(2)(a) that the trade marks are identical.

23. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ("CJEU") held that:

"54… a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer."

24. The applicant's and proprietor's "ACCENTHOME" word marks are self-evidently identical.

Section 5(2) Case Law

25. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

26. I bear in mind that under section 5(2), the applicant is partially opposing the proprietor's specification. Therefore, the competing goods are as follows:

Applicant's goods	**Proprietors' goods**
Class 20 Mattress pads; Cushions; Chair pads; Seat pads; Memory foam pillows; Seat cushions; Chair cushions; Sleeping pads; Latex pillows; Beds, mattresses,	Class 17 Flexible foam; foam materials for use in manufacture; foam materials in the form of blocks, sheets, rolls, blanks; foam rubber; foam supports for floral

pillows and cushions; Cushions (upholstery); Bean bag pillows; Plastic mesh cushioning sheets for lining shelves; Soft furnishings [cushions]; Foam mattresses; Cushions [furniture]; Protective pads, not of metal, for chair legs.	arrangements; foam supports for flower arrangements [semi-finished products].

27. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

28. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

29. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

30. In *Kurt Hesse v OHIM,* Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

> "… there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."

31. While in its statement of grounds and submissions in lieu, the applicant claims that the parties' goods are identical and similar, I have not been provided with any specific submissions as to why it believes that the parties' goods are identical or similar, nor have they put forward any combination of what goods it relies on for identicality and similarity. I therefore remind myself of paragraph 28 of the appeal to the Appointed Person in *SMARTX* BL O/0911/24 which states that:

> . "… it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identicality). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach for which Mr Wood contends would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on

the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent."

32. Nevertheless, I find I am unable to identify any similarity between the proprietor's class 17 goods and the applicant's class 20 goods, for the following reasons:

Flexible foam; foam materials for use in manufacture; foam materials in the form of blocks, sheets, rolls, blanks; Foam rubber.

33. I do not consider that the applicant's furniture goods in class 20 are similar to the proprietor's above goods which are all types of foam which can be used for padding. Whilst I appreciate that this padding could be used in furniture (and therefore in the manufacture of furniture), such as in sofas and chairs, as set out in *Les Éditions Albert René v OHIM*,[4] it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Canon* and *Treat*.

34. The goods clearly do not overlap in method of use, nature or purpose on the basis that the proprietor's goods are used for padding, whereas the applicant's goods are used to make a room suitable for living, by furnishing a room. The proprietor's goods will be sold by foam specialists and the applicant's goods will be sold by furniture stores, and thus, there is no overlap in trade channels. I therefore find that the users will differ, as the proprietor's goods will be brought by furniture manufacturers, whereas the applicant's goods will be brought by the general public.

35. The goods are clearly not in competition, and I also find that they are not complementary, because they are neither important nor indispensable to one another, and the consumer would not believe that the goods originate from the same undertaking. Therefore, taking all of the above into account, I find the goods are dissimilar.

[4] Case T-336/03

Foam supports for floral arrangements; Foam supports for flower arrangements [semi-finished products].

36. The proprietor's above goods are foam used for floral arrangements. Therefore, these goods do not overlap in nature, method of use or purpose with the applicant's furniture goods which are used to furnish a room. The goods do not overlap in trade channels, as the proprietor's goods would likely be sold by florists, floristry wholesalers and craft stores, whereas the applicant's goods will be sold by furniture stores. The goods are neither in competition, nor complementary, and whilst the goods may overlap in user, this is not enough on its own to establish similarity. Consequently, the goods are dissimilar.

Conclusion of the goods comparison

37. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that (my emphasis):

> "49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. **If there is no similarity at all, there is no likelihood of confusion to be considered.** If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

38. As established in the case law above, for there to be a likelihood of confusion between the marks under sections 5(2)(a) and 5(2)(b), there has to be a finding of similarity between the goods. Since I have determined that they are dissimilar, the invalidation under sections 5(2)(a) and 5(2)(b) fails here.

Section 5(3)

39. Section 5(3) of the Act states:

"5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

40. Section 5(3A) of the Act states:

"Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

41. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42.*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40.*

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation

and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

42. The conditions of section 5(3) are cumulative. Firstly, the applicant's and proprietor's marks must be identical or similar. Secondly, the applicant must show that its earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the applicant's mark being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the registration date of the proprietor's mark, i.e. 29 September 2023.

Reputation

43. In *General Motors*, Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

44. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

45. I note that the following evidence is contained in **exhibit NR-01**:

a) A print out from the UKIPO website which details the registration of Mr Rasool's UK00003903669 ACCENTHOME mark which is being relied upon in these proceedings.
b) A print out from the UKIPO website which details the registration of Mr Rasool's UK00003944717 ACCENTHOME mark, for classes 17 and 24.
c) A print out from the UKIPO website which details the registration of Mr Rasool's UK00003807357 GoTo Foam Mark for classes 17, 20 and 24.
d) A print out from the UKIPO website which details the registration of Mr Rasool's UK00003670926 Foamtouch mark for classes 20 and 24.
e) A print out from the UKIPO website which details the registration of Mr Rasool's UK00003994669 FOAMTOUCH mark for classes 17 and 20.
f) A printout from Companies House in regard to "HAFZAR SITE LIMITED" and "FOAMTOUCH LIMITED". In Mr Rasool's statement, he confirms that he is the director of both companies.

46. Mr Rasool has also provided involves of sales in **exhibit NR-02**. I note that all of the invoices state that the goods have been sold by Hafzar Site Limited, and above the customer's billing address, it states that "for customer support visit www.amazon.co.uk/contact-us". It is therefore reasonable to assume that these invoices have been generated from Hafzar Site Limited's Amazon page.

47. There are 17 invoices dated between 24 April 2023 to 24 September 2023 showing the sale of ACCENTHOME cushion inner pads pack of 4 (throw pillow inserts, square cushion fillers),[5] ACCENTHOME pillow inserts pack of 8 and ACCENTHOME outdoor pillow inserts pack of 2. I note that these invoices are addressed to customers in Bristol, Edinburgh, Romford, Blairgowrie, Kent, Lanarkshire, Suffolk, Cornwall, London, West Bromwich, Cheshire, Sheffield, Manchester, Lancashire and Nottingham. All of the invoices show the sale of one item per invoice, apart from the invoice dated 7 July 2023 which shows 7 cushion inner pads (pack of 4) being purchased. This invoice amounts to £102.97, and the remaining invoices which show the sale of one item per customer varies between £9 and £14.71. I have also been provided with another 10 invoices dated between 12 October 2023 and 4 December 2023, however, these clearly fall after the relevant date. Therefore, the invoices from before the relevant date amount to £355.23.

48. Mr Rasool has also provided me with evidence of advertising costs, for the "ACCENTHOME mark via Hafzar Site Ltd on Amazon, Facebook Marketplace and Google" contained in **exhibit NR-03**. I note that this exhibit does not contain any Facebook Marketplace advertising invoices, however, it contains:

a) 6 Google invoices dated between 1 May 2020 and 31 August 2023 which amount to between £49.24 and £251.18.

b) 4 Google invoices are dated between 1 January 2024 and 31 May 2024, which fall after the relevant date.

c) 26 Amazon invoices dated between 31 March 2020 and 31 August 2023, which amount to between £11.88 to £1,993.05

[5] These appear in different sizes on the invoices, for example 12" x 20" or 18" x 18".

d) 8 Amazon invoices are dated between 30 September 2023 and 30 June 2024, which fall after the relevant date.

49. The applicant submits that its "goods enjoy a high degree of reputation by virtue of the extensive use made and the public recognition in the UK". This means that it must be known by a significant proportion of the relevant public. However, in my view, the evidence has a number of shortcomings in this regard.

50. Firstly, I bear in mind that the above evidence does not show the applicant using its earlier mark. The invoice evidence only shows sales made by Hafzar Site Ltd under the "ACCENTHOME" mark, not the applicant. The advertising evidence shows that advertising services were purchased by Hafzar Site Ltd, and not the applicant. While Mr Rasool confirms in his witness statement that he is the director of Hafzar Site Ltd, I have not been provided with any evidence, for example, in the form of a licencing agreement, to show that Hafzar Site Ltd had permission to trade under Mr Rasool's mark. On this basis, I consider that the opponent has failed to establish use of its earlier mark, and section 5(3) falls at the first hurdle.

51. Nevertheless, even if I was wrong in my above finding, and the applicant was entitled to rely on Hafzar Site Ltd's use of the "ACCENTHOME" mark, I do not consider that the evidence provided would be sufficient in demonstrating a reputation.

52. Firstly, whilst the evidence establishes that Mr Rasool owns multiple trade marks which are registered for classes 17, 20 and 24, I note that in these proceedings, Mr Rasool is only relying upon his UK00003903669 mark which is registered for the class 20 furniture goods contained in paragraph 1 to this decision. Therefore, any evidence which pertains to Mr Rasool's other marks are irrelevant and do not assist him. Secondly, the UKIPO printout for Mr Rasool's UK00003903669 mark does not show use of the mark itself (specifically it does not show use of the mark within the market on furniture goods). Therefore, this evidence also does not assist the applicant.

53. Thirdly, all of the Amazon invoices pertain to cushion pads and pillow inserts. I note that these goods are not contained within Mr Rasool's class 20 specification. While he has protection for pillows and cushions, these items are defined by their

material cover that encompasses the pads and inserts. I find that the cushion pads and pillow inserts are goods which would fall within class 17 of the NICE classification system. On this basis, I find that none of the invoice evidence pertains to the sale of the class 20 goods for which Mr Rasool has protection for.

54. However, in the event I am also wrong in this finding, and cushion pads and pillow inserts are protected by Mr Rasool's class 20 specification, I bear in mind that the evidence is still extremely limited. Mr Rasool does not specify whether the aforementioned invoices are a sample of his invoices, or whether they are all of the sales made by the applicant. Nevertheless, as they are the only evidence of sales before me (which amount to £355.23), I find that the sales made are clearly very low. I also note that I have not been provided with the applicant's market share, but again, based on the sales before me, I find that it would only amount to a very small proportion of the furniture market (which is a very large sector). While I have been provided with evidence that Mr Rasool paid for advertising on Google and Amazon between March 2020 and August 2023, I have not been provided with any examples of what the adverts themselves looked like. I am therefore unable to determine whether the adverts included or showed the class 20 goods that Mr Rasool relies upon under section 5(3), nor have I been provided with any evidence as to how many UK consumers were exposed to this advertising.

55. Therefore, taking all of the above into account, I find that the evidence is not persuasive in showing that a significant part of the relevant public knew of the applicant's earlier mark at the relevant date. The evidence is therefore insufficient to establish a reputation in the UK.

56. Consequently, the invalidation based upon section 5(3) falls at the first hurdle.

Section 5(4)(a)

57. 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,

aa)…

b) …

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

58. 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.”

59. 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).”

Relevant date

60. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated 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.'"

61. While in Mr Farooq's witness statement, he confirms that M&A Styles Ltd has been operating in the market since 2017, he has not provided any evidence of use to support this.

62. On this basis, I have only the prima facie relevant date to consider i.e. 29 September 2023.

Goodwill

63. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

> "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 customers. It is the one thing which distinguishes an old-established business from a new business at its first start."

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

> "27. There is one major problem in assessing a passing 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 that 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; 54 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."

65. 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."

66. As noted above, all of the evidence provided by the applicant shows sales made by Hafzar Site Ltd under the ACCENTHOME mark. While Mr Rasool confirms in his witness statement that he is the director of Hafzar Site Ltd, I have not been provided with any form of licencing agreement to show that Hafzar Site Ltd had permission to trade under Mr Rasool's mark.

67. I also bear in mind that even if the relevant permission was granted for Hafzar Site Ltd to use Mr Rasool's mark (i.e. via a licence), the evidence only shows use of the "ACCENTHOME" sign by Hafzar Site Ltd and not Mr Rasool. On this basis, any goodwill generated would be vested in the company Hafzar Site Ltd. Therefore, taking all of the above into account, I find that the section 5(4)(a) case fails as I have not been provided with any evidence proving the existence of any protectable level of goodwill in the applicant (being Mr Rasool) and his sign at the relevant date.

68. Nevertheless, even if the above evidence showed use of the sign by Mr Rasool, I find that there is a vanishingly low level of use. The invoices only amount to £355.23 which is very low, especially bearing in mind that the furniture market is likely to be relatively large. While I have been provided with advertising expenditure, there is no evidence in regard to the adverts themselves. Therefore, I am unable to determine if they showed use of the "ACCENTHOME" sign on the applicant's furniture goods.[6] I also have no evidence of how many UK consumers were exposed to the applicant's adverts. Whilst I bear in mind that the test for goodwill is less onerous than the test for reputation, I find that due to the significant deficiencies with the evidence, it would not be enough to find any protectable level of goodwill in the applicant and his sign at the relevant date.

69. Therefore, the invalidation based upon section 5(4)(a) is dismissed.

[6] I also bear in mind that as per paragraph 53 above, all the Amazon invoices pertain to cushion pads and pillow inserts, terms which the applicant does not rely upon under section 5(4)(a). Nevertheless, I will proceed in this paragraph as if "pillows" and "cushions [furniture]", which are terms that the applicant relies upon under section 5(4)(a), include cushion pads and pillow inserts.

Section 3(6)

70. 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."

71. 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)."

72. 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?

73. It is also 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). The relevant date in this decision is 29 September 2023.

What, in concrete terms, was the objective that the applicant has been accused of pursuing?

74. In paragraph 20 of his witness statement, Mr Rasool states that the registration of the applicant's "ACCENTHOME" mark predates the application date of the proprietor's mark, indicating that the applicant's mark was known within the relevant industry. He states that the similarities between the marks coupled with overlapping goods

“suggests a deliberate attempt by the proprietor to exploit the reputation and goodwill” associated with the applicant’s mark “contravening fair competition principles”. Mr Rasool states that the proprietor was aware of the applicant’s other marks and applied for the registration of the same marks, which appears to be an attempt to mislead customers and harm the applicant’s business, and that as a result, the registration of the proprietor’s mark has diluted the distinctiveness of the applicant’s brand, “complicating differentiation in the marketplace”.

Was that objective for the purposes of which the contested mark could not be properly filed?

75. I consider that to apply for a mark to mislead customers and harm the applicant’s business could be the basis of a bad faith objection, if proven.

76. Therefore, the key question is whether the applicant has satisfied the burden of proving the existence of the proprietor’s intention which is inconsistent with honest practices.

Was it established that the contested mark was filed in pursuit of that objective?

77. Firstly, I note that in Mr Farooq’s witness statement, he categorically denies any allegation of bad faith, and he states that “there was no knowledge or intention of copying or benefitting from any pre-existing marks” including those of the applicant. He also fully rejects the claim that his mark was registered in an attempt to mislead customers or exploit the reputation of the applicant’s earlier mark.

78. Secondly, Mr Rasool has not provided any further information than what was contained in his statement of grounds, nor has he provided any exhibited evidence to accompany his bad faith claim, for example, to show evidence of proprietor’s intention or the impact of the registration/use of the proprietor’s mark, such as evidence of customers being misled, for example.

79. I bear in mind that the filing of a mark with the knowledge that the applicant owns it, in isolation, may not be compelling because mere knowledge of another party’s use

of a mark (either in the UK or elsewhere) does not establish bad faith.[7] The proprietor may have also reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani.*

80. I also bear in mind that an allegation of bad faith is a serious one, and the burden of proof is on the applicant. Therefore, on the basis that the applicant has not filed any exhibited evidence to support his bad faith claim, I find that he has failed to establish a prima facie case of bad faith. As such, the application based upon section 3(6) of the Act is dismissed.

CONCLUSION

81. The application for a declaration of invalidity has failed in its entirety and the proprietor's trade mark will remain registered.

COSTS

82. The proprietor has been successful and is entitled to a contribution towards their costs. The registrar usually awards costs on a scale published in Tribunal Practice Notice 1/2023. As a matter of practice, litigants in person are asked to complete a costs proforma. The purpose of this is to ensure that the costs awarded do not exceed the amount spent on the proceedings. There is no right to be awarded the amount claimed. This is subject to an assessment of the reasonableness of the claim and must also take account of the registrar's practice of awarding costs on a contributory, not compensatory, basis.

83. On 30 October 2024, the proprietor submitted a costs proforma setting out the costs incurred in defending these proceedings. These consisted of:

Task	**Time**
Notice of opposition	30 hours

[7] *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12 and *Lindt, Koton* (paragraph 55).

Notice of Cancellation	30 hours
Considering forms filed by the other party	20 hours
Filing and preparing written submissions	35 hours
Preparation for the hearing	20 hours
Filing evidence and preparing written submissions, including reviewing the case, drafting arguments and organising exhibits	150 hours
Total:	**285 hours**

84. I bear in mind that the applicant did not file a notice of opposition (Form TM7) nor a notice of cancellation (Form TM26(n) or (I)). Instead, the applicant only filed a Notice of Defence, that being a Form TM8. I am therefore unable to award any contributory costs towards actions which were not undertaken. On this basis, I can only award costs for the Notice of Defence which was filed.

85. While I note that Mr Farooq did not fill out any hours for filing a Notice of Defence within his costs proforma, it is clear that due to the deficiencies of his form (by putting hours spent on Form's he did not subsequently file), that at least some of the hours he attributed to filing a Notice of Opposition and Cancellation should have been attributed to filing his Notice of Defence. On this basis, I shall be awarding Mr Farooq costs for filing this form, whilst bearing in mind that to file a Notice of Defence and to consider the forms filed by the other party are not particularly complex or lengthy tasks.

86. I am also unable to award any contributory costs towards Mr Farooq's claim of 20 hours preparing for a hearing, on the basis that there was no hearing for this case.

87. I also bear in mind that whilst Mr Farooq clearly filed evidence, this only consisted of a 4 page witness statement which was not accompanied by any exhibits. Moreover, Mr Farooq did not file any written submissions in these proceedings. I therefore find that Mr Farooq's claim of 150 hours for filing evidence and preparing written submissions, including reviewing the case, drafting arguments and organising exhibits is significantly, and unreasonably, high. Again, I bear in mind that I am unable to award

any contributory costs towards actions which were not undertaken, and therefore, as Mr Farooq did not file any written submissions, nor did he have any exhibits to organise, I will not be awarding costs for such.

88. Consequently, taking all the above into account, I consider the following figures to be a fair and reasonable award of costs for the tasks undertaken by Mr Farooq:

Task		**Time**
Notice of Defence		5 hours
Considering forms filed by the other party		4 hours
Filing evidence, including reviewing the case and drafting arguments		6 hours
Total:	**15 hours @ £19**	**£285.00**

89. I have adopted the standard rate used to calculate costs for unrepresented parties under The Litigants in Person (Costs and Expenses) Act 1975 (as amended) which sets the minimum level of compensation for litigants in person at £19 per hour. I multiplied this by the time I consider was reasonably spent on defending this application (15 hours).

90. I therefore order Naeem Rasool to pay M&A styles ltd the sum of £285. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 28th day of November 2025

L FAYTER

For the Registrar