O/1201/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3954137

BY ASIM ALI AKHTAR

TO REGISTER:

AS A TRADE MARK IN CLASSES 30 & 43

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 445486 BY

IMRAN ALI

BACKGROUND AND PLEADINGS

1. On 7 September 2023, Asim Ali Akhtar ("the applicant") applied to register the trade mark shown on the cover page of this decision in the United Kingdom in respect of the following goods and services:

> *Class 30*
>
> *Ice cream; Cream (Ice -); Ice cream confectionery; Ice milk [ice cream]; Ice cream drinks; Yoghurt based ice cream [ice cream predominating]; Dairy ice cream; Ice cream cakes; Ice cream sandwiches; Ice cream desserts; Ice cream confections; Ice cream bars; Sauces for ice cream; Ice cream gateaux; Ice cream powder; Non-dairy ice cream; Ice creams; Imitation ice cream; Ice cream cones; Ice cream with fruit; Fruit ice cream; Ice cream powders; Powders for ice cream; Vegan ice cream; Ice cream substitute; Ice cream mixes; Ice cream stick bars; Ice cream cone mixes; Frozen confectionery containing ice cream; Ice; Fruit ice creams; Powder for making ice cream; Ice, ice creams, frozen yogurts and sorbets; Ice creams flavoured with chocolate; Cream pies; Ice creams containing chocolate; Soya-based ice cream substitutes; Powders for making ice cream; Mixtures for making ice cream; Ice confectionery; Instant ice cream mixes; Soy-based ice cream substitute; Ice lollies; Ice-cream; Ice for refreshment; Mixtures for making ice cream confections; Substances for binding ice cream; Ice cream (Binding agents for -); Cream puffs; Ice lollies being milk flavoured; Cream buns; Ice candy; Mixtures for making ice cream products; Truffle cream sauces; Cream crackers; Fruit ice; Cooling ice.*
>
> *Class 43*
>
> *Ice cream parlors; Ice cream parlour services; Cafe services; Coffee shops; Coffee shop services; Take-away restaurant services; Coffee bar services; Fast-food restaurant services.*

2. On 24 January 2024, the application was opposed by Imran Ali ("the opponent"). The opposition is based on sections 5(4)(a), 5(4)(b) and 3(6) of the Trade Marks Act 1994 ("the Act") and concerns all the goods and services in respect of which registration is sought.

3. Under section 5(4)(a), the opponent claims to have used the following signs (together, "the signs") in Glasgow since December 2014 for the goods and services listed below:

Cookiez n Creamz ("the word sign")

("the first logo")

("the second logo")

Goods and services

Ice cream, ice cream confectionery, ice cream drinks, milkshakes, yoghurt based ice cream dairy ice cream, ice cream cakes, ice cream sandwiches, ice cream based desserts, desserts, confectionary, sauces for ice cream, non-dairy ice cream, imitation ice cream, cones for ice cream, fruit ice cream, vegan ice cream, ice cream substitute, ice cream mixes, frozen confectionery containing ice cream, frozen yogurts and sorbets, ice confectionery, ice lollies, cream cakes, cream puffs, binding preparations for ice cream [edible ices], soya based ice cream products, ice cream mixes, ice lollies being milk flavoured, mixtures for making ice cream products, fruit ice, ice cream parlours, ice cream parlour services, take-away food and drink services, cafe services, coffee shop services.

4. The opponent claims to have acquired goodwill under the signs. According to the opponent, use of the contested mark would constitute a misrepresentation to the public that would damage the goodwill in its business. Consequently, use of the contested marks would be contrary to the law of passing off.

5. Under section 5(4)(b), the opponent claims to be the owner of the copyright in the first and second logos, which he asserts are identical, or at least highly similar, to the contested mark. The author of the logos was Gary Murray of Depikt Design, who was a UK resident in May 2014, when they were created. The opponent claims that copyright in the logos was assigned to him on 15 May 2014.

6. Under section 3(6), the opponent claims that the applicant knew of the use of the opponent's use of the signs and the reputation that they had secured at the time of the application. The opponent had been a director of the applicant's business COOKIEZ N CREAMZ RUTHERGLEN LTD, incorporated on 20 April 2022, and had resigned when the working relationship between the two parties broke down. The opponent asserts that the application was filed in order to prevent him from registering his own trade mark, and therefore it was made in bad faith.

7. The applicant filed a defence and counter-statement on 30 April 2024. He admits that the parties have known each other *"a considerable period of time"* and about 10 years earlier had started a business together, trading *"substantially"* as the Cookiez n Creamz business. He claims that he devised the "Creamz" element of the contested mark and that "Cookiez" was a term known to the parties and to others. He admits that the design for the logo was devised by a third party. In 2018, the parties decided to end their business relationship. The applicant claims that the opponent was unable to obtain banking facilities for a business and that the relationship finally came to an end in May 2022. It was agreed that the applicant would purchase the opponent's interest in the business, including all the assets such as the contested mark. The opponent says that the applicant paid the agreed sums to him and that he therefore obtained sole ownership of the copyright in the logos. He believes that the final payment was made in late 2022. In December 2022, according to the applicant, the opponent became director of a new business, adopted the name and used the signs that the applicant had acquired. The applicant claims that the agreement between the parties means that there is no passing off and that the opponent is in breach of the said agreement.

8. Only the opponent filed evidence. I shall summarise this briefly below and refer to it as necessary during the course of my decision. Neither party filed written submissions.

9. In these proceedings, the opponent was represented initially by Scintilla Intellectual Property Ltd, who withdrew from representing the opponent before he had filed his evidence. The applicant is represented by Campbell & McCartney Solicitors.

10. Neither party requested to be heard. I have taken this decision following a careful consideration of all the papers before me.

EVIDENCE

11. The opponent's evidence comes from the opponent himself, Mr Ali. It is dated 28 August 2024 and is accompanied by three exhibits. The evidence goes to the relationship between the two parties, the claims to use and the creation and ownership of the logos.

RELEVANCE OF 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.

DECISION

Section 5(4)(a)

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

> "A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented–
>
> > (a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met
>
> …"

14. Subsection 4(A) is as follows:

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

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

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

16. In *Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 220, Kitchin LJ (as he then was) said:

> "165. … Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc*). In my

> judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the [contested] trade mark would have amounted to passing off. But if the [contested] trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began."

17. The parties are in dispute about the history of the business. Unfortunately, I do not have any direct evidence from the applicant, Mr Asim Ali Akhtar, but just a counter-statement in the Form TM8 which was signed by his legal representative, albeit by a named individual. The facts set out in this counter-statement are therefore hearsay. There is nothing to corroborate the statements that the parties had been operating a business that *"was effectively a partnership"* or that they formed a limited company.

18. In his witness statement, Mr Ali denies that the applicant was involved in what he describes as his business as early as 2014. He refers me to Exhibit 3, which contains a copy of a lease dated 30 July 2014 between Beech Properties (Glasgow) Limited (the landlord) and Mr Ali (the tenant). The property was 33 Nelson Street in Glasgow and the permitted use was as an ice cream/dessert parlour.[1] It does not record the name under which the business was operated. I consider that the fact that Mr Akhtar was not mentioned on the lease is not necessarily inconsistent with his playing a role in the business.

19. Mr Ali states that the parties entered into a partnership to open a second branch of the Cookiez N Creamz business. He says that the applicant was *"temporarily"* permitted to use his logo and branding while he was director. This partnership lasted between 20 April 2022 and 19 May 2022. Mr Ali says he resigned as director and told Mr Akhtar that he could no longer use the name.[2]

[1] Clause 6.1: see Exhibit 3, page 9.
[2] Witness statement, paragraph 7.

20. The opponent has made a witness statement which contains a signed statement of truth. Furthermore, this evidence has not been challenged by the applicant. In *Phipson on Evidence*, 20th edition, the editor states:

> "In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point."

21. This point was considered by the Supreme Court in *TUI UK Ltd v Griffiths* [2023] UKSC 48, at paragraphs 42-70. In paragraphs 61-67 of its judgment, the Supreme Court expressly identified circumstances where previously unchallenged evidence can properly be rejected, despite the absence of cross-examination or prior notice. That said, there is no challenge at all from the applicant in the present case. This does not mean that I have to accept everything that Mr Ali says. In particular, it is the task of this tribunal to assess the evidence to determine whether it is sufficient to support the claims made. For reasons that shall become apparent, my assessment would be the same whether the relevant date is 2014, 20 April 2022 or the date of application for the contested mark (7 September 2023).

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

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

23. Mr Ali says in his witness statement that *"**Cookiez N Creamz** has been a well-recognized brand since its creation in **2014**"*.[3] The opponent has, however, provided no information on sales figures, photographs of any of the signs in use on premises, or advertising. Earlier in my decision, I noted that three exhibits had been filed and have already mentioned the third of these. The first contains a document entitled "Transfer of Copyright"; the second is correspondence relating to a cash payment and has been filed in response to a claim made as to the ownership of the copyright. There is no narrative evidence in the witness statement concerning the sales made by the business or how the signs have been used. This means that, in respect of the claim to goodwill, there is just an assertion.

24. 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 than the enquiry under s. 11 of the 1938 Act (see *Smith Hayden & Co Ltd's Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to

[3] Paragraph 8.

satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

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

> "8. [The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

26. I do not have the evidence that would enable me to find that there is any goodwill in a business using any of the signs relied upon. Therefore, this ground fails.

Section 3(6)

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

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

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

“240. The general principles are these:

(i) …

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

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation in the European Union, and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*Malaysia Dairy*, para 29; *Sky CJEU*, para 73).

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

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

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*Hasbro*, paras 39 and 40; *Koton*, para 47).

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

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

(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; *Deutsches Patent- und Markenamt*, 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 89/04 (*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 the 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)."

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

(a) An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies. However, Arnold J (as he then was) said that *"cogent evidence is required due to the seriousness of the allegation"*. This means that it is not enough to establish facts which are as consistent with good faith as bad faith:

Red Bull GmbH v Sun Mark Limited & Anor [2012] EWHC 1929 (Ch), paragraph 133;

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

(c) Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors*, [2008] EWHC 3032 (Ch), paragraph 167.[4]

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

(a) What, in concrete terms, was the objective that the party alleged to have acted in bad faith has been accused of pursuing?
(b) Was that an objective for the purposes of which the contested application could not properly be filed?
(c) Has it been established that the contested application was filed in pursuit of that objective?[5]

31. The opponent's claim is that the applicant knew of his use of the signs and the reputation that they had earned, and that the application was made in order to prevent him from registering the sign as a trade mark. In *Lindt*, the Court of Justice of the EU ("CJEU") said that the knowledge of the applicant that an opponent used an identical or similar sign for an identical or similar product or service capable of being confused with the contested mark and that the intention was to prevent the opponent from continuing to use the sign were factors that should be taken into account when determining whether an application had been made in bad faith. However, the assessment should take account of all relevant factors.

32. In *Holzer y Cia de CV v EUIPO*, Joined cases T-3/18 and T-4/18, the General Court ("GC") held that there is a presumption of good faith on the part of the applicant.

[4] Approved by the Court of Appeal in *Hotel Cipriani Srl & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2010] EWCA Civ 110.
[5] Paragraph 8.

However, the objective circumstances of a particular case may lead to the rebuttal of that presumption: see paragraph 36. It is for the opponent in the first instance to persuade me that there is a *prima facie* case of bad faith. The opponent's task is made all the harder by the lack of any evidence showing its own use of the signs. While there is no dispute that at some point, the two parties were involved in a business, the evidence does not show any use of the signs or sales of goods or services made under it. Therefore, I am unable to find that the opponent has established a *prima facie* case of bad faith on the part of the applicant.

33. The section 3(6) ground fails.

Section 5(4)(b)

34. Section 5(4)(b) of the Act is as follows:

> "A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> …
>
> (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (aa) above, in particular by virtue of the law of copyright, or the law relating to industrial property rights.
>
> …"

35. In deciding this ground, I must address the following questions:

- Is the earlier mark a work under the Copyright, Designs and Patents Act 1988 ("CDPA") and therefore capable of being protected by copyright?
- Who is the owner of the work and when was it created?
- Does the work meet the qualification criteria for copyright protection?
- Would use of the contested mark constitute an infringement of any copyright?

Whether the logos are works under the CDPA

36. Section 1 of the CDPA states that:

"Copyright is a property right which subsists in accordance with this Part in the following descriptions of work-

(a) original literary, dramatic, musical or artistic works,

(b) sound recordings, films or broadcasts, and

(c) the typographical arrangement of published editions.

37. Section 4 of the CDPA is as follows:

"(1) In this Part 'artistic work' means-

(a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,

(b) a work of architecture being a building or a model for a building, or

(c) a work of artistic craftsmanship.

(2) In this Part-

…

'graphic work' includes-

(a) any painting, drawing, diagram, map, chart or plan, and

(b) any engraving, etching, lithograph, woodcut or similar work;

…"

38. In *Griggs Group Ltd v Evans* [2003] EWHC 2914 (Ch), Peter Prescott QC, sitting as a deputy judge of the High Court, said:

"18. … a drawing is capable of being a 'work'. So if an artist uses his skill and labour to draw a word or phrase in a stylised way, as in the case of a logo, his drawing is capable of being an original work, protected by copyright law."

39. I consider that the logos are graphic works and capable of being protected by copyright.

Ownership of the works and their creation

40. The opponent claims that the author of the logos was Gary Murray of Depikt Design. This claim is not denied by the applicant so I accept it. The opponent then states that the ownership of the copyright was transferred to him. Exhibit 1 is a document entitled "Transfer of Copyright" dated 15 May 2014. It shows the second logo and is signed by Mr Murray on behalf of the designer. The client is shown as Mr Ali. Under the terms of the document, the ownership in the second logo is transferred to Mr Ali, who is also given permission to change, modify and adapt it, so long as he does not use, modify, alter, replicate or borrow any of the previous or unused logos or ideas shown during the course of the project.

41. The applicant has not made any submissions on this document or filed any evidence in response to it. He said in his counter-statement that, after the business relationship broke down, the parties agreed that the applicant would purchase the opponent's interest in the business, including all assets, such as the copyright in the logos. The applicant states that the agreed sums (totalling £15,140.00) were paid to the opponent and *"Final payment was made it is believed in late 2022"*. Later, the applicant says that the sums were £11,390.00 on 9 March 2022, £2,500.00 on 8 April 2022, £700.00 on 27 April 2022, £250.00 on 11 May 2022 and £300.00 on 28 September 2022. Mr Ali denies that these payments were related to the business or the rights owned by it. He claims that the payment of £11,390.00 related to salvage following a car accident. Exhibit 2 contains an email from his solicitor, dated 4 March 2022, which he claims confirms this. Although the sums are the same, the dates are not consistent. Mr Ali's solicitor states that he has already received the £11,390.00; but the sum referred to by the applicant was paid later than this, on 9 March 2022.

42. The picture presented by both parties is not entirely clear. The applicant had the opportunity to challenge the statements made by Mr Ali, but chose not to do so. If there had been a transfer of assets, I would have expected there to be documents to prove that this had taken place and that it would not have been difficult for the applicant to file them as evidence. Similarly, I would have expected the opponent to file evidence

that the payments were related to the goods that he lists in paragraph 13 of his witness statement, such as a waffle machine and a slush machine. In contrast, Exhibit 1 appears to me clearly to transfer the copyright in the second logo to Mr Ali. I therefore accept that the second logo was created by Mr Murray in May 2014 and that ownership was transferred to the opponent on 15 May 2014. I have already said that the facts in the counter-statement are hearsay, while Mr Ali's witness statement has a signed statement of truth. For this reason, and bearing in mind the lack of any response to Mr Ali's denials, I also accept that on the balance of probabilities the opponent was the owner of the second logo on the date of application for the contested mark.

43. I have no evidence on the creation or use of the first logo. I shall therefore continue my assessment of this ground on the basis of the second logo only.

Whether the second logo meets the qualification criteria for copyright protection

44. Section 153 of the CDPA states that copyright does not subsist in a work unless certain conditions are met. These are set out in the subsequent sections of the Act and relate to the citizenship or residence of the author at the time the work was created or published, or the place where it was first published. The opponent has claimed that Mr Murray was a UK resident at the time the second logo was created. This claim has not been denied by the applicant and so I am prepared to accept it. I find that copyright subsists in the second logo.

Whether use of the mark would constitute an infringement of the copyright in the second logo

45. Section 16 of the CDPA is as follows:

> "(1) The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom-
>
> (a) to copy the work (see section 17);
>
> (b) to issue copies of the work to the public (see section 18);
>
> (ba) to rent or lend the work to the public (see section 18A);

(c) to perform, show or play the work in public (see section 19);

(d) to communicate the work to the public (see section 20);

(e) to make an adaptation of the work or to do any of the above in relation to an adaptation (see section 21);

and those acts are referred to in this Part as the 'acts restricted by the copyright'.

(2) Copyright in a work is infringed by a person who without the licence of the copyright owner does, or authorises another to do, any of the acts restricted by the copyright.

(3) References in this Part to the doing of an act restricted by the copyright in a work are to the doing of it-

(a) in relation to the work as a whole or any substantial part of it, and

(b) either directly or indirectly;

and it is immaterial whether any intervening acts themselves infringe copyright."

46. Section 17 of the CDPA provides that:

"(1) The copying of the work is an act restricted by the copyright in every description of copyright work; and references in this Part to copying and copies should be construed as follows.

(2) Copying in relation to a literary, dramatic, musical or artistic work means reproducing the work in any material form.

This includes storing the work in any medium by electronic means.

(3) In relation to an artistic work copying includes the making of a copy in three dimensions of a two-dimensional work and the making of a copy in two dimensions of a three-dimensional work.

…

(6) Copying in relation to any description of work includes the making of copies which are transient or are incidental to some other use of the work."

47. In *Designers Guild Ltd v Russell Williams (Textiles) Ltd (t/a Washington DC)* [2000] 1 WLR 2416, Lord Millett set out at [2425]-[2426] the approach to assessing whether artistic copyright has been infringed:

"The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges to have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are too commonplace, unoriginal or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying.

…

Once the judge has found that the defendant's design incorporates features taken from the copyright work, the question is whether what has been taken constitutes all or a substantial part of the copyright work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It depends upon its importance to the copyright work. It does not depend upon its importance to the defendant's work, as I have already pointed out. The pirated part is considered on its own (see *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, 293, *per* Lord Pearce) and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose."

48. The second logo and the contested mark are shown in the table below:

Second Logo – the copyright work	Contested Mark
	

49. It will be perceived that the words “Cookiez n Creamz” are presented in an identical stylised typeface overlaid across a purple ring, which contains the words “MILKSHAKES”, “ICE CREAM”, “SUNDAES” and “CAKES” in white, all separated by a white dot. The words are within two thin white lines. The only differences between the logo and the mark are that the logo is placed on a circular black background in the mark and rotated anti-clockwise by around 30 degrees, and that the shade of purple is slightly different. In my view, the contested mark incorporates a substantial part of the copyright work.

50. The applicant claims that he had access to the copyright work before the date of application for the trade mark. The burden therefore passes to the applicant to satisfy me that the similarities did not result from copying. As the basis of the defence is that the applicant had acquired the copyright, and the applicant has not satisfied me that he did so, I find that the use of the contested mark is liable to be prevented by the law of copyright.

OUTCOME

51. The opposition is successful under section 5(4)(b). Subject to a successful appeal, Application No. 3954137 is refused registration.

COSTS

52. The opponent has been successful and is entitled to a contribution towards his costs. As he was unrepresented at the end of the proceedings, the Tribunal sent him a proforma to complete if he intended to request costs. The opponent was informed

that, if the proforma was not completed and returned, costs, other than official fees arising from the action, may not be awarded. He did not return the proforma. However, as he was represented for the pleadings stage of the proceedings, I consider that it is appropriate to make an award from the scale set out in Tribunal Practice Notice No. 1/2023. It is calculated as follows:

> *£350 for preparing a statement and considering the other side's statement;*
> *£200 for official fees for filing a TM7.*
> ***£550 in total***

53. I therefore order Asim Ali Akhtar to pay Imran Ali the sum of £550. 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 22nd day of December 2025

Clare Boucher,
For the Registrar,
Comptroller-General