

O-309-20

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

TRADE MARK APPLICATION NOS 3300610 & 3320527

IN THE NAME OF YELLOW BULLDOG LTD AND

OPPOSITION THERETO (UNDER NOS 413152 & 414150 RESPECTIVELY) BY

AP & CO. LTD

&

TRADE MARK APPLICATION NO 3330815

IN THE NAME OF AP & CO.LTD AND OPPOSITION THERETO (UNDER NO.

414473)

BY YELLOW BULLDOG LTD

BACKGROUND

1) This dispute concerns three consolidated trade mark oppositions. The parties to the dispute are AP & CO.LTD ('Party A') and Yellow Bulldog Ltd ('Party B').

The oppositions by Party A to Party B's trade mark applications

2) On 29 March 2018, Party B applied to register the following trade mark:

Trade Mark No: 3300610 ('610')



Class 35: Retail services in connection with the sale of games software, video game programs, video game software, bags adapted to carry video apparatus, computer games programs downloaded via the internet [software], computer games programs [software], computer games software, video game computer programs, video game cartridges, headsets, wireless headsets, batteries, battery charges, cd's, dvd's, mugs, cups, stationery, figurines, bags, holdalls, wallets, clothing, footwear and headwear, t-shirts, caps, video game joysticks, video games apparatus, role playing games, hand held units for playing video games, hand held video games, handheld computer games, hand-held computer games, toys and playthings.

3) On 26 June 2018, Party B made a second application to register the following trade mark (the mark is identical to the above but the retail services in class 35 differ):

Trade Mark No: 3320527 ('527)



Class 35: Retail store services, including online retail services, in connection with candles, special occasion candles, key rings (made of metal), metal statuettes, figurines (of common metal), video games, video game software, computer games, CDs, DVDs, battery charging equipment, disk storage wallets, remote control devices, magnets, gaming peripherals and accessories, cases and covers for mobile phones, tablets, laptop computers and netbooks, lap top bags, lanyards (straps) for mobile phones, Christmas lights, precious metals and their alloys, jewellery, precious and semi-precious stones, horological and chronometric instruments, cufflinks, key chains, coins, clocks and watches, decorative key rings, paper and cardboard, printed matter, bookbinding material, photographs, stationery and office requisites, except furniture, adhesives for stationery or household purposes, drawing materials and materials for artists, paintbrushes, instructional and teaching materials, plastic sheets, films and bags for wrapping and packaging, printers' type, printing blocks, stickers, transfers, posters, notebooks and journals, luggage and carrying bags, suitcases, bags, drawstring bags, messenger bags, travel bags, weekend bags, shopping bags, hiking bags, cosmetic bags, wash bags, hand bags, gym bags, canvas bags, school bags, tote bags, bum bags, game bags, sports bags, leather bags, backpacks, metal and plastic luggage tags, leather luggage straps, wallets, purses, credit card holders, leather key rings, costumes for animals, statues, figurines, works of art and ornaments and decorations made of plastic or wood, storage units, plastic key rings, coat hooks, non-metallic key rings, statues, figurines, plaques and works of art made of glass, gardening articles, tableware, cookware and

containers, glasses, drinking vessels and barware, coin banks, articles for animals and pets, cups, mugs, plastic drink coasters, bottle openers, coasters, cookie jars, incense burners, statuettes, clothing, footwear and headgear, wristbands, jumpers, socks, hats, t-shirts, bathrobes, slippers, caps, beanies, snapbacks, hoodies, onesies, badges for wear, novelty badges, charms (other than for jewellery, keys, rings, or chains), carpets, rugs and mats, artificial ground coverings, floor mats, floor mats made of rubber, sporting articles and equipment, festive decorations and artificial Christmas trees, toys, games, playthings and novelties, video game apparatus, Christmas tree ornaments, Christmas baubles, snow globes, plush toys, peripherals and controllers for game consoles, arcade game machines, and miniature arcade game machines.

4) Both applications were published in the Trade Marks Journal (on 20 April 2018 and 20 July 2018 respectively) for opposition purposes and subsequently opposed by Party A. The latter claims that Party B's applications offend under sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 ('the Act').

5) Under section 5(4)(a), Party A claims that it has used the sign **GEEKCORE** throughout the UK since November 2014 in relation to 'Retail and wholesale services including on-line and mail order retail and wholesale services in connection with the sale of video games, video games cartridges, video game software, video game apparatus, gaming apparatus and instruments, computer games, computer games software, handheld video games, handheld computer games, headsets for video and computer games, batteries, battery chargers, compact discs, digital versatile discs, audiovisual recordings, cases for smartphones and tablet computers, clothing, footwear and headgear, toys, games, playthings, watches, ties, gloves, cufflinks, fancy dress costumes, jewellery, bags, wallets, purses, swimwear, electronic gadgets, usb drives, lighting equipment and apparatus, magazines, comics, printed matter, books, stationery, Christmas decorations, mugs, textile goods, blankets, rugs, towels, bedding, linen, kitchenware products, household and kitchen utensils, cutlery, office equipment, office desk toys and gadgets, posters, stickers, umbrellas, key rings, novelty gift items, food and drink, alcoholic beverages, board games, figurines, plush toys, biscuit containers, cups, corkscrews, cooking apparatus and instruments'. It is claimed that use of Party B's trade mark applications will lead to

misrepresentation and damage to the goodwill vested in Party A's business by virtue of loss of sales.

6) Under section 3(6), Party A claims the following in respect of both of Party B's trade mark applications:

"The Applicant company is fully aware of the Opponent and the Opponent's trading activity under the brand GEEKCORE. The Applicant and the Opponent have had a business relationship for at least 3 years prior to the filing date of the trade mark application subject of this opposition. This business relationship concerns the buying and selling of a wide range of goods. At a meeting in May 2018 the Applicant [Party B] informed the Opponent [Party A] of its intention to re-brand to GEEK STORE. The Opponent objected stating that GEEK STORE would undoubtedly result in confusion with its own brand GEEKCORE.

The Opponent therefore contends that at the time of filing this UK trade mark application the Applicant was fully aware of the rights of the Opponent. In seeking to register and subsequently use a brand so similar to the Opponent's brand, the Applicant has acted in a manner below that expected in honest commercial practices and it has also filed an application in the knowledge of the Opponent's prior conflicting rights. The actions therefore amount to bad faith on the part of the Applicant at the time of filing the application."

7) Party B filed a counterstatement for each of its trade mark applications. In both counterstatements, Party B does not admit that Party A has the requisite goodwill for the purposes of section 5(4)(a) or that there would be misrepresentation or damage. Party B also denies that it had a business relationship with Party A for 3 years prior to the filing date of the contested marks and that use of its marks would result in confusion with Party A's sign. It denies that it has acted in bad faith.

The opposition by Party B to Party A's trade mark application

8) On 10 August 2018, Party A filed an application to register the following trade mark:

Trade Mark No: 3330815

GEEKCORE

Class 25: Clothing, footwear and headgear, belts, socks, gloves.

Class 35: Retail and wholesale services including on-line and mail order retail and wholesale services in connection with the sale of video games, video games cartridges, video game software, video game apparatus, gaming apparatus and instruments, computer games, computer games software, handheld video games, handheld computer games, headsets for video and computer games, batteries, battery charges, compact discs, digital versatile discs, audiovisual recordings, cases for smartphones and tablet computers, clothing, footwear and headgear, toys, games, playthings, watches, ties, gloves, cufflinks, fancy dress costumes, jewellery, bags, wallets, purses, swimwear, electronic gadgets, usb drives, lighting equipment and apparatus, magazines, comics, printed matter, books, stationery, Christmas decorations, mugs, textile goods, blankets, rugs, towels, bedding, linen, kitchenware products, household and kitchen utensils, cutlery, office equipment, office desk toys and gadgets, posters, stickers, umbrellas, key rings, novelty gift items, food and drink, alcoholic beverages, board games, figurines, plush toys, biscuit containers, cups, corkscrews, cooking apparatus and instruments; advertising, marketing and publicity services; provision and operation of customer loyalty card membership schemes.

9) Party A's application was published in the Trade Marks Journal on 24 August 2018 and subsequently opposed by Party B under section 5(2)(b) of the Act. Party B relies upon its trade mark applications, '610 and '527, shown above.

10) Party A filed a counterstatement. It admits that its mark and Party B's marks are similar. It also admits that the parties respective retail services in class 35 are identical or at least similar and that its goods in class 25 are similar to the corresponding retail and wholesale services of Party B. Party A also drew attention to the oppositions it had filed against the two earlier trade mark applications of Party B and requested that all proceedings be consolidated or that the opposition against its mark be suspended pending the outcome of its oppositions under section 5(4)(a) and 3(6) against the earlier applications.

11) All three oppositions were subsequently consolidated. Both parties filed evidence. Party B also filed submissions¹. A hearing took place before me at which Party A was represented by Mr Andrew Marsden of Wilson Gunn and Party B was represented by Mr Jamie Muir Wood, of Counsel, instructed by Groom Wilkes and Wright LLP.

PARTY A'S EVIDENCE

12) This comes from Mr Adam Symonds, co-founder and director of AP & CO. LTD.

13) Mr Symonds states that the domain name www.geekcore.co.uk was registered on 13 October 2009 and Party A was set up on 17 September 2010. Supporting documents are provided showing the registration of the domain name and date of incorporation of the business.²

14) Mr Symonds states that Party A operates under the trading name GEEKCORE and specialises in the on-line retail of a wide range of merchandise particularly licensed products relating to television shows, movies and video games. The products typically include gadgets, clothing, mugs, toys, games, bags, jewellery, costumes, electronic gadgets, plush toys and gaming related goods. Party A has been trading under the name GEEKCORE since as early as 12 November 2014. In support of this, a print from www.geekcore.co.uk is provided, showing the 'About Us'

¹ Dated 13 May 2019 & 7 August 2019

² Exhibit AS1

page. The mark GEEKCORE (stylised) is present at the top of the page. It is undated aside from the print date of 3 April 2019.³

15) Party A operates a Facebook page which was created on 19 November 2014, shortly after it began trading in the UK. There are currently just under 19,000 followers. Various adverts on the page show a puzzle, a hoodie, a baseball cap, a bag, spiced rum, a figurine, a mug and Christmas jumpers. The adverts all appear to be recent, emanating from 2019.⁴

16) Mr Symonds explains that Party A has business relationships with a number of product suppliers. One of the suppliers it has worked with for a number of years is Rubber Road Limited ('RRL'). Party A obtained wholesale products from this company during the three years preceding these proceedings (2015-2018). Mr Symonds states that RRL was the original applicant of trade mark applications '610 and '527 and that those applications were subsequently assigned to Party B. RRL and Party B share the same directors, Benjamin Alun Grant and Matthew Martin Precious. Mr Symonds states that RRL is therefore fully aware of Party A's business and activities under the name GEEKCORE. Prints from the IPO database are provided showing that mark '610 was originally applied for by RRL then assigned to Party B on 12 July 2018. Mark '527, on the other hand, appears to have been filed by Party B (it does not appear that it has ever been in the name of RRL). Prints from Companies House database are also provided showing that RRL has five directors, three of whom are Benjamin Alun Grant, Matthew Martin Precious and Liam Michael Taylor. Party B has three directors, two of whom are Benjamin Alun Grant and Matthew Martin Precious.⁵

17) Mr Symonds explains that, at a meeting on 18 May 2018 with Liam Taylor, the commercial director for RRL, Party A was informed by Mr Taylor that RRL intended to rebrand its retail operations as GEEKSTORE. Formerly, RRL used the brand YELLOW BULLDOG for its retail operations. At the meeting, Party A immediately voiced its concerns and objected to the proposed re-branding, explaining to Mr

³ Exhibit AS2

⁴ Exhibit AS3

⁵ Exhibit AS4

Taylor that GEEKSTORE was simply too close to its own brand GEEKCORE. Following the meeting, Party A sent an email to Mr Taylor on 19 May 2018 explaining further its reasons for objecting to the choice of name. No response was received and following the launch of the GEEKSTORE retail operation and the filing of the trade mark applications it has been necessary to take action by filing the subject oppositions. Mr Symonds provides a copy of his email to Mr Taylor dated 19 May 2018 and a number of other emails between Party A and RRL which he states clearly shows a long business relationship.⁶

18) Mr Symonds states that RRL and Party B have filed the subject applications and commenced trading under the name GEEKSTORE in full knowledge of Party A's prior and longstanding use of the name GEEKCORE and with the intention of benefitting from Party A's business.

19) As evidence of Party A's trading activity, Mr Symonds provides copies of the company's accounts from 2013 to 2018.⁷

20) Mr Symonds also provides prints from the Wayback Machine Archive website, which he states shows the number of captures of Party A's website between 2013 and 2018. Examples of dated pages are also included.⁸ The website pages bear the mark GEEK CORE. There are numerous pages appearing to emanate from 2014 – 2018. There are a wide range of goods listed on the website including various items of clothing such as Christmas jumpers, bath robes and hoodies, toys, figurines, watches, hats, backpacks and novelty mugs. Many of the goods are branded with the names of movies such as Star Wars and Harry Potter or computer games such Nintendo, Minecraft and Street Fighter.

21) A print from Goggle Analytics showing website traffic to www.geekcore.co.uk is provided from July 2013 to March 2019.⁹ The number of users is 1,005,591 and the number of page views is 3,576,586. 30% of visitors to the site are returning visitors.

⁶ Exhibit AS5

⁷ Exhibit AS6

⁸ Exhibit AS7

⁹ Exhibit AS8

For each year there are distinct website traffic peaks in the period leading up to Christmas.

22) Mr Symonds provides a spreadsheet of historical sales transactions and copies of ten invoices (these are said to be examples rather than an exhaustive list of all invoices issued by Party A). None of the invoices give any details or description of the item that was purchased. Mr Symonds states that this information has not been provided for privacy reasons. The invoices are dated from July 2016 to April 2017 and are issued to customers in various UK locations such as Dover, Holyhead, Stoke on Trent, Windsor and Milton Keynes. One is to a customer in the Netherlands. The historical list of sales transactions consists of a list of over 60 pages showing, inter alia, the date of purchase, name of purchaser, amount in £ and country (the vast majority of which are in the UK). Again, there is no indication of the kind of item that was purchased for any of the transactions in the list.¹⁰

23) Mr Symonds states that Party A has a rating of 9.7/10 on Trustpilot. He provides a selection of customer reviews dated 2017-2018. Some of the reviews refer to the kind of product that was purchased which are hats, hoodies and jumpers.¹¹

24) Mr Symonds states that the turnover for Party A has steadily increased since the business commenced trading in 2014. He provides a graph showing Google Ad marketing spend for December 2014 – December 2018 totalling £111, 000. There is also a graph which Mr Symonds states relates to sales from August 2015 to December 2018, totalling £864,172.¹²

25) Mr Symonds provides a copy of the first public Facebook post for GEEKCORE dated 10 February 2015 urging customers to place an order. Also provided are copies of three advertisements on Facebook dated October 2015 and October 2016 for Christmas jumpers. Mr Symonds states that those jumpers were sourced from RRL. The last advertisement from Facebook, dated January 2017, shows a

¹⁰ Exhibit AS9

¹¹ Exhibit AS10

¹² Exhibit AS11

GEEKCORE branded box being offered as a prize in a competition. The box contains various items including a travel mug and toys/figurines.¹³

26) Finally, Mr Symonds provides prints from Party B's website, www.geekstore.co.uk, including internet archive captures. He states that the GEEKSTORE website, which did not commence trading until shortly after March 2018, is highly similar in content, layout and general appearance to Party A's website. The website pages bear the mark GEEK STORE (stylised in the same manner as applications '610 and '527).¹⁴ He states that this supports his belief that Party B has copied Party A's retail operation and is attempting to imitate the latter's retail operation and success.

PARTY B'S EVIDENCE

27) Mr Benjamin Alun Grant is a director of Party B. He provides two witness statements. The first is dated 13 May 2019 and the second, which is in reply to Party A's evidence, is dated 7 August 2019.

28) In his first witness statement, Mr Grant states that Party B has never dealt directly with Party A. Rather, Mr Grant states, Party A is a customer of Centresoft Limited ('Centresoft'), the distribution partner of RRL; an independent company, part of the same group as Party B and which designs and manufactures a wide range of 'geek' products and sells them, wholesale, to customers throughout the world, including to Party B.

29) According to Mr Grant, Party A first contacted RRL on 14 December 2015 because the former wanted to obtain more Christmas jumper stock as Centresoft had sold out. RRL helped them do so, even though it typically only deals directly with its large national account customers.

¹³ Exhibit AS12

¹⁴ Exhibit AS13

30) Mr Grant states that Party B launched its Yellow Bulldog website back in April 2013. The site sold 'Geek Merchandise' to end consumers. The brand YELLOW BULLDOG was fairly successful, but it was difficult to market effectively due to the name being ambiguous and having nothing to do with 'Geek Merchandise'. Mr Grant states that some people even thought the Yellow Bulldog website sold dog food.

31) In November 2017, Mr Grant states that Party B decided to re-brand to something that was much easier for consumers to understand exactly what we sold. He explains that Party B wanted something like GEEK SHOP or GEEK STORE, and the company sought to purchase those domain names from their respective owners. Party B's preference was GEEK STORE because it translates much better in North America (where the word 'shop' is uncommon). On 14 November 2017 the domain name geekstore.com was purchased for several thousand dollars, from Afternic.com. From that date, Party B's website and branding were developed for over six months through to their launch on 21 May 2018. Trade Mark Application '610 was filed during that development period (on 29 March 2018).

32) Mr Grant states that when choosing the new brand, GEEKCORE did not enter Party B's thoughts at any point.

33) I now turn to Mr Grant's second witness statement, which is in reply to the evidence of Party A. Mr Grant reiterates some of the information given in his first statement and makes some submissions on Party A's evidence.

34) In terms of further factual information, Mr Grant states that further to RRL helping Party A to obtain the Christmas jumper stock (referred to in his first statement), the commercial team at RRL engaged with the owners of Party A to help grow their sales by obtaining incremental stock for them through Centresoft (when demand severely outstripped supply on RRL's products). Mr Grant states that he accepts that RRL had a distant 'working relationship' with Party A. However, he states that this was limited to helping to obtain more stock from Centresoft and did not constitute a commercial or transactional relationship. He states that Party A never obtained wholesale products from RRL, despite the claim to the contrary by Mr Symonds.

35) Mr Grant confirms that Mr Taylor did meet with the owners of Party A at offices of Centresoft on 18 May 2018. However, Mr Grant states that Mr Taylor has confirmed to him that this was with the sole intention of helping Party A to grow its sales by presenting RRL's 2018 products to it, ahead of its competitors, in order to assist its sales forecasts for the upcoming Christmas season. This was not done for any other retailer and thus, according to Mr Grant, demonstrated significant goodwill on the part of RRL.

36) Referring back to his first witness statement detailing the development of the brand GEEK STORE, Mr Grant states that Party B's preparations to launch its new branding were at an extremely well-advanced stage when Mr Taylor met with Party A in May 2018.

37) Mr Grant states that Party B did not consider there to be a conflict between the parties' trade marks and that the launch date had already been decided and so Party B proceeded with the new name, GEEK STORE.

38) Mr Grant states that Party A has, over recent months, taken steps to position itself more closely to Party B. He provides prints comparing the layout and appearance of the parties' websites and a print of a Google search which he states shows that Party A has misused 'GEEK STORE' as part of an Adwords campaign to divert business away from his company.¹⁵

APPROACH

39) Party A has conceded in its counterstatement that the respective marks in opposition 414473 are similar and that the respective goods and services are identical or similar. Indeed, at the hearing, Mr Marsden conceded that the marks are *highly* similar and that a likelihood of confusion was inevitable. However, Party A claims that that opposition should not succeed because Party A has established that Party B was passing off at the relevant dates and/or had applied for its marks in bad faith. It therefore makes sense to begin by considering Party A's oppositions to Party

¹⁵ Exhibits BG-01 and BG-02

B's trade mark applications under sections 5(4)(a) and 3(6). If Party A's oppositions fail, Party B's opposition will automatically succeed; conversely, if Party A's oppositions succeed, Party B's opposition will fall away.

SECTION 5(4)(a)

40) Section 5(4)(a) states:

"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, or

(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."

41) 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).”

The relevant date

42) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded 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.’”

43) There is no evidence that Party B made any use of its trade mark prior to the filing date of application ‘610. The relevant date for assessing the passing off claim in respect of that application is therefore the filing date of that mark i.e. 29 March 2018.

44) Mr Grant refers in his evidence to the GEEK STORE website being launched on 21 May 2018. However, there is no evidence showing the nature or extent of such use prior to the filing date of application ‘527. The relevant date for assessing the passing off claim in respect of that application is therefore the filing date of that mark i.e. 26 June 2018.

Goodwill

45) The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

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

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

47) 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.”

48) In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

49) However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though

its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

See also: Stannard v Reay [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA).

50) Party A's evidence is not without deficiencies. I am particularly mindful of the lack of any indication of the kind of goods that were the subject of the invoices and transactions listed in Exhibit AS9. That said, I remind myself that it is not a case of considering each piece of evidence in isolation but rather, I must stand back and view the evidence collectively. There are numerous captures of Party A's website spanning 2014-2018. The primary sign used on that website appears to have been the mark GEEK CORE/GEEKCORE. Over that time the website has listed a variety of goods for sale, many of which accord with those specified by Mr Symonds in his statement (Exhibit AS7). The website appears to have been in operation since at least November 2014. The website traffic data indicates that the website has attracted a steady number of visitors since that time with peaks leading up to the Christmas period every year. Party A has also spent a not inconsiderable some on Google Adword advertising and has generated sales of more than a trivial amount in the four years prior to the relevant dates (Exhibit AS11). Viewing the evidence in the round, I am satisfied that, it is more probable than not that, Party A had a protectable goodwill at both relevant dates of, at least, a moderate level. On the basis of the evidence before me, I accept that the goodwill was in an online retail business connected with the sale of clothing, bags, toys, figurines and novelty mugs (at least) and the sign which was associated with, or distinctive of, that business was GEEKCORE.

Misrepresentation and Damage

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

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

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

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

And later in the same judgment:

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

52) A common field of activity is not a prerequisite to found a passing-off claim (see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)). However, a presence of a common field is clearly a highly important factor.

53) The marks sought to be registered by Party B both look like this:



54) The sign associated with Party A's goodwill is GEEKCORE.

55) At the hearing, Mr Wood confirmed that Party B has taken different positions as to the similarity of the marks and the sign. In its opposition against Party A's application it is implicit in this claim that the respective marks are similar such as to result in a likelihood of confusion (a claim to which Party A has conceded). However, in relation to Party A's claim of passing off, Mr Wood submitted, on behalf of Party B, that the marks and sign are dissimilar, such that there can be no misrepresentation¹⁶. In his submission, even if I were to conclude that the marks and sign are similar, this does not automatically lead to a finding of misrepresentation under the law of passing off, despite Party B's claim that there is nevertheless a likelihood of confusion under section 5(2)(b) between the same marks.

56) I would expect the sign GEEKCORE to be immediately perceived as a distinctive whole but also, at the same time, as two well-known English words conjoined i.e. GEEK and CORE. In terms of the contested marks, the device (of the blue

¹⁶ See also Party B's written submissions dated 13 May 2019 in which it states that the respective marks and sign are "not similar" (paragraphs 12 and 14 therein).

background, the box containing various items and the black circle) is a distinctive element and makes a strong contribution to the overall impression of the mark; it is striking on the eye and takes up a large proportion of the mark as a whole. GEEK STORE is also a distinctive element of the mark (although, within that element, more focus is likely to be placed upon the word GEEK than STORE given the relatively greater descriptive nature of the latter word as compared with the former). I would expect GEEK STORE and the device to have roughly equal impact on the consumer. There is a clear point of similarity between the sign and the contested marks, owing to the common presence of the word GEEK. There are also differences given the presence/absence of the respective words CORE and STORE (although those words do share the same three letters 'ORE') and the presence of the device element in the contested marks which have no counterpart in the earlier sign. I find there to be a low degree of visual similarity between the contested marks and the earlier sign. In terms of the aural aspect, the comparison is between GEEK STORE and GEEK CORE. There is clearly a high degree of aural similarity. Turning to the conceptual position, I would expect GEEK STORE to be perceived as a shop for geeks. GEEKCORE, as a whole, does not have any clear meaning but I would expect the idea of something geeky or geek related to be retained in the consumer's mind. On that basis, I find a medium degree of conceptual similarity.

57) Both of Party B's applications are in respect of retail services (which includes online retail services) connected with the sale of various goods. A number of those retail services (bearing in mind the specific goods to which they relate) are identical to the retail services in which Party A has satisfied me that it has the requisite goodwill. The relative field of activity is, to that extent, therefore identical.

58) I now turn to Party B's retail services which relate to other kinds of goods (e.g. video games, Christmas decorations, homeware, jewellery etc.). Although Party A's evidence has not satisfied me that it has goodwill in online retail services related to all of the types of goods claimed in its notice of opposition, the evidence nevertheless suggests that the nature of its retail business is of one which offers a wide selection of goods. It would be no stretch of the imagination for it to also provide retail services connected with the sale of all the various goods covered by Party B's applications. In particular, I note that a number of Party A's goods tend to

relate to video games/movies (i.e. t-shirts bearing images from said games and movies). There is a clear link here between the nature of the goods in which it has goodwill and Party B's retail services connected with the sale of video games, for example.

59) Bearing in mind the degree of similarity between the earlier sign and the contested marks, the identity, and overlap, between the respective services, together with the moderate level of goodwill in Party A's business, I find that a substantial number of Party A's customers, or potential customers, are likely to believe that the services provided under Party B's marks are the responsibility of Party A. A misrepresentation will arise in respect of all the services applied for. The damage that follows is likely to be in the form of loss of sales for Party A, with customers using Party B's services instead. Damage can also come in other forms. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

"To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me."

60) In all the circumstances, I find that Party B is liable to be prevented from use of the trade marks, the subject of its two applications, under the law of passing-off. The ground under section 5(4)(a) of the act succeeds, in full, against each of Party B's trade mark applications.

61) My finding above means that both of Party A's oppositions have succeeded. It follows that Party B's opposition to Party A's trade mark application automatically fails.

62) In the circumstances there is, strictly speaking, no need to also consider Party A's grounds of opposition under section 3(6) of the Act. I will, however, record here that, I do not consider the ground under section 3(6) to offer Party A any stronger prospect of success than its grounds under section 5(4)(a). If am wrong to have

found that Party A succeeds under section 5(4)(a), it seems to me that I would also be wrong to find that the contested marks were filed in bad faith. The basis of the claim of bad faith is, essentially, that Party B has applied for a mark which it knew was confusingly similar to the sign used by Party A. Had I found that the signs were not, in fact, similar enough to cause misrepresentation, it is implicit in this that I do not consider it would have been an act of bad faith applying to register the contested marks, despite Party B's knowledge of Party A's use of its earlier sign, and I can see no other reason advanced before me as to why, in such circumstances, the marks should nevertheless have been found to have been applied for in bad faith.

63) I also add here that if I am wrong to have found that Party A's oppositions succeed, Party B's opposition would automatically succeed against Party A's trade mark application for GEEKCORE. This is because, as I noted at the outset of this decision, Party A has conceded throughout these proceedings, both in written submission and at the hearing, that there is a likelihood of confusion under section 5(2)(b).

OUTCOME

64) Party A's oppositions against Party B's trade mark applications have succeeded. **Trade Mark applications 3300610 and 3320527 are therefore refused.**

65) Party B's opposition against Party A's trade mark application has failed. **Trade Mark Application 3330815 may therefore proceed to registration.**

COSTS

66) Party A has been wholly successful. It is therefore entitled to an award of costs. In approaching the award, I bear in mind that all three proceedings were consolidated before the filing of evidence and that Party A's pleadings in its two notices of opposition were identical. Using the guidance in Tribunal Practice Notice 2/2016, I award Party A costs on the following basis:

Preparing statements and considering

the other side's statements x 3	£600
Official fee (Form TM7) x 2	£400
Preparing and filing evidence and considering Party B's evidence	£1000
Preparing for, and attending, the hearing	£600
Total:	£2600

67) I order Yellow Bulldog Ltd to pay AP & CO. LTD the sum of **£2600**. This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of June 2020

Beverley Hedley
For the Registrar,
the Comptroller-General