O-409-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3042711 IN THE NAME OF SABAH MAULADAD TO REGISTER THE TRADE MARK

MOCCIANI

IN CLASSES 14 AND 25

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 402330 BY SAID NAAM (PRIVATE) LIMITED

BACKGROUND

1) On 17 February 2014, Sabah Mauladad ("the applicant") applied under the Trade Marks Act 1994 ("the Act") for registration of the mark MOCCIANI. The application is in respect of the following list of goods:

> **Class 14:** *Jewellery, costume jewellery, precious stones.*
>
> **Class 25:** *Clothing, footwear, headgear.*

2) On 21 March 2014, the application was published in the Trade Marks Journal and on 20 June 2014, Said Naam (Private) Limited ("the opponent") filed notice of opposition to the application. The Registry raised issues with the grounds originally pleaded and following an exchange of correspondence between the Registry and the opponent, the grounds of opposition were limited to the following:

a) the application offends under Section 3(6) of the Act because the application was made following publicity campaigns for the opponent's product range launched on the Internet. The opponent "suspects" that the applicant had complete knowledge of the opponent's popularity and product range and goodwill in the Asian community. It is claimed that the specific intention of the applicant is to trade off the reputation of the opponent's business;

b) the application offends under Section 5(4)(b) of the Act because it infringes the opponent's various copyright registrations in Pakistan. In particular, it relies upon the following:

- Copyright Registration No. 27229-Copr dated 10 June 2011;
- Copyright Registration No. 28393-Copr dated 3 February 2012, and;
- Copyright Application No. 2013/2296 dated 7 August 2013.

3) The applicant filed a counterstatement denying the opponent's claims and claims that the URLs referred to by the opponent relate to third party websites, that the publicity campaigns referred to by the opponent commenced in December 2011, after advertising featuring the applicant's mark had commenced. The applicant claims her use pre-dates the copyright registrations/applications relied upon by the opponent.

4) Both sides filed evidence and both sides ask for an award of costs. No hearing was requested, but the opponent filed written submissions in lieu of a hearing. It also provided written submissions at the time it filed its evidence. I keep these submissions in mind and I will refer to them if relevant. I make this decision following a careful perusal of all the papers.

Opponent's evidence

5) This takes the form of a witness statement by Zahid Hussain, Chief Executive of the opponent. I summarise Mr Hussain's evidence insofar as I consider it necessery. He provides evidence as to the level of sales and promotion in Pakistan. Sales total the equivalent of nearly £1.6 million between 2011 and 2014. The first ten of Mr Hussain's exhibits are in the form of copies of correspondence and various certificates relating to the opponent's trade marks in Pakistan and Afghanistan for MOCCIANI and stylised forms of the same.

6) Exhibit 11 consists of a copy of a certificate of registration of copyright, number 27229-Copr and dated 18 October 2012, issued by the Government of Pakistan and in respect of the following artistic work:

7) Exhibit 12 consists of a copy of a certificate of registration of copyright, number 28393-Copr and dated 18 October 2012, issued by the Government of Pakistan and in respect of the following artistic work:

8) Exhibit 13 consists of an application for registration of copyright made to the Pakistan Central Copyright Office and dated 7 August 2013 and in respect of the following artistic work:

Applicant's evidence

9) This takes the form of two witness statements. The first of these is by Nicholas Francis Preedy, registered Trade Mark Attorney at Nucleus IP Limited, the applicant's representative in these proceedings. Mr Preedy includes some submissions in his statement that I will not summarise here, but I will keep them in mind.

10) At Exhibit NFP4, Mr Preedy provides the same documents provided in Ms Mauladad's Exhibit 2 and Exhibit 4 (see below) as evidence of use, albeit small, in the UK, prior to the claimed first use of the opponent's mark.

11) The second witness statement is by the applicant, Ms Mauladad. Ms Mauladad states that she used MOCCIANI in the UK for the first time in 2007 and that he obtained the domain name mocciani.com on 27 January 2007. To support this she provided, at his Exhibit 1, a copy of an email, dated 27 January 2007, from a company called pickaweb.co.uk that states that it has processed a domain name registration for mocciani.com. A screen shot of a page claimed to be from the applicant's website mocciani.com (but there is no indication of this on the screen shot itself) at her Exhibit 2 shows a stylised form of the mark and the page carries a copyright notice with the year 2007. Exhibit 3 consists of a copy on an email confirmation confirming that her London Fashion Week registration was complete. It is dated 11 September 2008 and records Ms Mauladad's company as "Mocciani". Design illustrations are provided at Exhibit 4 all bearing creation dates in 2008 and 2009 or bear a copyright notice from that time. Several of these design illustrations feature a stylised form of the word "Mocciani".

Opponent's evidence-in-reply

12) This takes the form of a witness statement by Mirza Saad Anjum, Legal Consultant at Renaissance Solicitors LLP, the opponent's representatives in these proceedings. He refers to the opponent's use in "Pakistan and many other parts of the world" and explaining that goods sold under the mark are available at outlets "in all big cities of Pakistan".

13) Mr Anjum states that the applicant's company "Mocciani Limited" was only incorporated April 2014 and is currently dormant. This is confirmed by the extract from the Companies House website provided at Exhibit 2.

14) Mr Anjum states that his Exhibit 6 illustrates that the applicant is trading under the mark BIBI SAAB. This exhibit consists of a screen shots from the website luxuryneckwear.blogspot.co.uk providing biographical information about Ms Mauladad and referring to luxury neckwear she has designed. It is undated, but a printed interview with Ms Mauladad, dated 5 December 2013 is provided in the same exhibit. This is entitled "Just a Platform" but it is not clear if this is the

name of the publication the interview appeared in. Ms Mauladad is described as "the founder & designer of luxury neckwear brand *BIBI SAAB*".

DECISION

Section 5(4)(b)

15) Section 5(4)(b) of the Act states:

> "5. –(1) ...
>
> (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) ...
>
> (b) By virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.
>
> 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."

16) The relevant date in these proceedings is the date on which the application was made, namely 17 February 2014. The earlier right relied upon is copyright and the applicant must have been in a position to prevent use of the proprietor's mark under the law of copyright at that date.

17) The opponent relies on two copyright registrations and one copyright application all in Pakistan in respect of the artistic works shown in paragraphs 6, 7 and 8, above. Original artistic works created in Pakistan are protected under UK copyright law[1]. The works relied upon by the opponent are graphic works and thus capable of qualifying for protection as an artistic work by virtue of Section 1(1) of the Copyright, Designs and Patents Act 1988.

18) Section 1 and Section 4(1) of the Copyright Act state:

> "(1) 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."

[1] The latest list of the countries in which such protection is granted is contained in the Copyright and Performances (Application to Other Countries) Order 2008, S.I. 2008/677.

and

> “4. Artistic works.
>
> (1) In this Part “artistic work” means-
>
> (a) A graphic work, photograph, sculpture or collage, irrespective of artistic quality,
> (b) ...
> (c) A work of artistic craftsmanship”

19) A helpful summary of the main principles of copyright law and artistic works was given by District Judge Clark in *Suzy Taylor v Alison Maguire* [2013] EWHC 3804 (IPEC):

> 6. I will set out the law in greater detail than usual to assist the unrepresented Defendant, who did not attend the hearing, in understanding it. Section 1 of the CDPA provides for copyright to subsist in original artistic works. An "original artistic work" is a work in which the author/artist has made an original contribution in creating it – for example by applying intellectual effort in its creation.
>
> 7. Artistic works are listed in s.4(1) CDPA and include "a graphic work… irrespective of its artistic quality". Graphic work is defined in 4(2) as including "(a) any painting, drawing, diagram map, chart or plan and (b) any engraving, etching, lithograph, woodcut or similar work…".
>
> 8. For an artistic work to be original it must have been produced as the result of independent skill and labour by the artist. The greater the level of originality in the work the higher the effective level of protection is, because it is the originality which is the subject of copyright protection. If the work includes elements which are not original to the artist then copying only those elements will not breach that artist's copyright in the work. It is only where there is copying of the originality of the artist that there can be infringement.
>
> ...
>
> 13. Lord Hoffman went on to set out the correct approach for a court concerned with determining an action for infringement of artistic copyright, which is the approach I shall follow:
>
> > *"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 defendants work… The pirated part is considered on its own… and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose.""

21) Therefore, an "artistic work" is one where "the author/artist has made an original contribution in creating it" and must result from "independent skill and labour by the artist". As Mr Preedy asserts in his witness statement, copyright cannot exist in a single word. I agree. A single, unstylised word is not an "artistic work". A word, even if invented, is not original to the artist and is not an "artistic work" within the meaning of Section 1 of the Copyright Act. A single word may qualify as an "artistic work" if it is visually embellished in some way such as in its form of stylisation or additional matter. In this case there are a number of features in the design of the opponent's signs that may allow them to be considered an "artistic work" and therefore protectable under copyright law from unauthorised copying. These features include the reduced size of the letter "O" relative to the rest of the word and the "dash" device that appears above that letter. However, none of these features are present in the applicant's mark. Therefore, even if I were to accept that the copyright registrations and application relied upon by the opponent constitute an earlier right (a point disputed by the parties), there is nothing in the applicant's mark that conflicts with the rights protected by these copyright registrations and application.

22) In light of this, I find that the applicant's mark does not infringe the opponent's copyrights in Pakistan. Therefore, the opposition fails, insofar as it is based upon Section 5(4)(b) of the Act.

Section 3(6)

23) 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."

24) The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

> "130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)
>
> 131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].
>
> 132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].
>
> 133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].
>
> 134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

> "41. … in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.
>
> 42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.
>
> 43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.
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> 44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

> 45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 48)."

25) The opponent's case is based on the premise it "suspects" that the applicant had complete knowledge of the opponent's popularity in Pakistan and that it is the specific intention of the applicant is to trade off the reputation of the opponent's business. Mr Anjum submits (at paragraph 7 of his witness statement) that the applicant's evidence that it was using the name "Mocciani" when she registered for London Fashion Week in September 2008 is conclusive of nothing. I do not agree. When considered together with evidence that she registered the domain name mocciani.com in August 2007, that she was using the mark on the Internet in 2007 (see screen shots bearing a copyright notice to that effect) and that she produced design illustration in 2008/9, some of which showed a stylised form of the word "Mocciani" the impression is that the applicant had the name "Mocciani" in mind as a business idea before the opponent became established in Pakistan. This points away from the claim that the applicant only came up with the name when she became aware of the opponent's use in Pakistan. The fact that the company is currently dormant and that the web site is not in use does not change this conclusion, neither does the fact that the applicant appears to currently trade under the mark BIBI SAAB. Whilst this evidence is not overwhelming, I consider that it is sufficient to rebut the unsubstantiated claims made by the opponent.

26) Further, even if I am wrong in reaching the above conclusion, I keep in mind that trademarks are territorial in nature and that there is no evidence that the opponent uses its mark in the UK. Therefore, it is free for third parties, including the applicant to register and use it here. There is no claim that the applicant was aware of plans by the opponent to launch its "Mocciani" goods in the UK or even that it has such plans. Rather, there is merely a vague claim that the opponent "suspects" that the applicant is aware of its reputation under the mark "Mocciani" in Pakistan. Even if this was so, and the applicant was aware of its use of the mark in Pakistan, the filing of the application in the UK does not amount to bad faith in the absence of any knowledge that the opponent intended to launch the mark in the UK.

27) I conclude that the applicant has not acted in bad faith when filing her application on 17 February 2014 because it appears that she had thought of the mark as long ago as 2007, suggesting that it was devised independently of any knowledge of the opponent's use of the mark outside the UK and because there is no evidence or claim that she is pre-empting any plans by the opponent to enter the UK market.

28) In conclusion, I find that the application was not made in bad faith and the opposition fails insofar as it is based upon this ground.

COSTS

29) The applicant has been successful and is entitled to a contribution towards her costs, according to the published scale in Tribunal Practice Notice 4/2007. I take account that both sides filed evidence and that no hearing took place. I award costs as follows:

Considering other side's statement and preparing counterstatement	£300
Preparing and considering evidence	£700
Total:	**£1000**

30) I order Said Naam (Private) Limited to pay Sabah Mauladad the sum of £1000 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 27TH day of August 2015

Mark Bryant
For the Registrar,
the Comptroller-General