

**O-564-15**

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3054825  
IN THE NAME OF LUVANIS S.A.

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 402687  
BY CHARLES B H JAMES AND LOUISE D B JAMES JOINTLY

## Background

1. On 8 May 2014, Luvanis S.A. (“the applicant”) filed an application for registration of the trade mark CHARLES JAMES under no 3054825. The application has a priority date of 18 March 2014 based on Community Trade Mark 012703864. The application seeks registration in respect of the following goods:

Class 3

Perfumery and fragrances; Cosmetics; Body cleaning and beauty care preparations.

Class 25

Footwear; Headgear; Clothing.

2. Following publication of the application in the *Trade Marks Journal* 2014/025 on 13 June 2014, notice of opposition was filed by Charles B H James and Louise D B James, jointly (“the opponents”). The grounds of opposition are, briefly:

Under section 5(4)(a) of the Trade Marks Act 1994 (“the Act”) on the basis of passing off. The opponents’ claim is made on the basis of their alleged earlier rights in CHARLES JAMES which is said to have been used throughout the UK since 1 January 1930 in relation to printed matter, clothing, footwear, headgear, clothing accessories and retail services relating to the aforesaid as well as exhibitions and fashion shows. Through that use they claim goodwill has been acquired under the sign and that use of the trade mark for which registration is applied would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill;

Under section 3(6) of the Act on the basis that the application was made in bad faith.

3. The applicant filed a counterstatement in which it denied the claims made.

4. Both parties filed evidence with the opponents also filing written submissions. The matter came before me for a hearing on 17 September 2015. At that hearing, the applicant was represented by Mr Amaud de Lummen, its Managing Director. The opponents were represented by Mr Harris of Sipara Ltd, their professional advisors in these proceedings. As he himself stated, English is not Mr de Lummen’s first language and he was concerned that he may “miss a few things” and, despite a warning from me, he occasionally strayed from giving submission (which is appropriate) to giving evidence (which is not). At the conclusion of the hearing and with the agreement of both of them, I gave the parties an opportunity to read the transcript of the hearing when it became available and file additional written submissions. Both parties did file additional submissions, with the latest of them being filed by the opponents on 27 October 2015. I will refer to the submissions as necessary in this decision.

## The evidence

5. Whilst I have reviewed all of it, I do not intend to summarise the evidence in any detail here but will refer to it as necessary in this decision. It consists of the following:

### Opponents' evidence

A witness statement of Louise D B James and Charles B H James (the opponents) dated 19 November 2014 with exhibits A to K;

A witness statement of Tom Priem, who is in the employ of the opponents' trade mark attorneys, dated 27 November 2014, with exhibits TP1 to TP7;

A witness statement of Tom Priem, dated 5 December 2014, with exhibit TPA;

A witness statement of Tom Priem, dated 29 December 2014, with exhibit TP1A;

A witness statement of Colin McDowell, a fashion writer, journalist and academic, dated 5 January 2015;

A witness statement of Claire Wilcox, senior curator of fashion at the Victoria and Albert museum, dated 15 January 2015 with exhibits CW1 to CW3;

A witness statement of Tom Priem, dated 16 January 2015, with exhibits TP1 to TP3;

### Applicant's evidence

A witness statement of Arnaud de Lummen, Managing Director of the applicant company, dated 16 March 2015, with exhibits A to H;

### Opponents' evidence in reply

A witness statement of Louise D B James dated 26 May 2015;

A witness statement of Charles B H James dated 26 May 2015;

A witness statement of Tom Priem, dated 26 May 2015, with exhibits TP6A to TP6D

### **The objection under section 5(4)(a) of the Act**

6. 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.”

7. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

8. The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP).

9. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C. as the Appointed Person considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the

CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

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.’ ”

10. As set out above, the application in suit has a filing date of 8 May 2014 and an earlier priority date of 18 March 2014. No evidence has been filed showing any use of the mark for which registration is applied. That being the case, the relevant date which I take into account is 18 March 2014.

11. The opponents’ claim under this ground is set out in the notice of opposition thus:

“[The opponents] are the son and daughter of the famous fashion designer Charles Wilson Brega James; known to the public as “Charles James”. Charles James was born in 1906 and died in 1978. It is submitted that the Opponent is a beneficiary to Charles James’ estate. The designer was born in the UK and throughout his lifetime built up a substantive level of goodwill in the name CHARLES JAMES; particularly within the clothing/fashion industry.

Throughout his years of work, the designer received awards, including the Coty Award (1950 and 1954) and the Neiman Marcus Fashion Award (in 1953). Even after his death, the designer’s name retains a strong level of reputation and goodwill and is highly recognised within the fashion industry. The designer’s work currently features in the Metropolitan Museum of Modern Art in New York and has been referred to throughout the UK...

At the time of the designer’s death, it is submitted that all goodwill acquired in the CHARLES JAMES name transferred to [the opponents].”

12. The opponents claim the earlier mark relied upon has been used throughout the UK since 1 January 1930 and that it has acquired goodwill through that use. What constitutes goodwill was considered in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL). The court stated:

“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.”

13. In both the notice of opposition and at various points in their evidence, the opponents refer to the goodwill or reputation of the Charles James name, however, as is clear from the above, what has to be shown is goodwill or reputation in a sign in connection with a business.

14. 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.”

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

“[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.”

16. At the hearing, Mr Harris submitted that the late Charles James was a celebrated fashion designer and that matters:

“cannot be viewed just in the context of the United Kingdom. This was a peripatetic individual who moved, as many fashion designers do, internationally...his clientele was international.”

Whilst it may be true that he travelled and had clients in a number of countries, I bear in mind the decision in *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, where Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 47 of the judgment):

“I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.”



He later said, at paragraph 52:

“As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited in paras 21-26 and 32-36 above establish. The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant.”

17. The claimant in that case did not have any goodwill in the UK that would give it the right to prevent BSkyB from using the name "NOW TV" in relation to its internet protocol TV service. This was because the customers for Starbucks' broadcasting services under the name NOW were based in Hong Kong. The services could not be bought here. The fact that the service was sometimes accessed via the internet by Chinese speakers in the UK did not mean that Starbucks had customers here. See also the judgments of the Court of Appeal in *Budweiser* [1984] F.S.R. 413 at 463 and *Hotel Cipriani SRL and Others v Cipriani (Grosvenor Street) Limited and Others*, 2010 EWCA Civ 110 (CA).

18. There is no dispute that the opponents are the son and daughter of the late Charles James. Their claim that they are the beneficiaries of their father's estate is called into question by the applicant in the witness statement of Mr de Lummen on the basis of an extract in a book entitled *The Genius of Charles James* by Elizabeth Ann Coleman, Henry Holt & Co 1984 which indicates the estate was transferred to Mr James' "companion and protégé", Homer Layne. The opponents each subsequently filed witness statements dated 26 May 2015 (as evidence in reply) denying any knowledge as to why this statement was included in the book, denying having given any authorisation for it and stating that it is incorrect. They state that whilst their mother received some of the estate's tangible assets, they are the owners of the claimed goodwill. No evidence is given which shows the source of the information contained in the book and the opponents are the children of the deceased and would be expected to know the details of their late father's estate. The applicant has not sought further to challenge the opponents' claims as set out in their evidence in reply and therefore I go on to consider the substantive matter.

19. The claim under this ground is based on goodwill said to stem from use of the mark CHARLES JAMES in the UK since 1 January 1930. In their notice of opposition, the opponents claim the mark has been used on *printed matter, clothing, footwear, headgear, clothing accessories, retail services relating to the aforesaid, exhibitions and fashion shows*.

20. The opponents' evidence shows (and I do not understand the applicant to challenge this) that the late Charles James was born in the UK in 1906 to an English father and American mother. He moved to the US after being expelled from school and, by 1924, he was living in Chicago, his mother's home town. He began designing hats and, at some later point, moved into other areas of design, primarily women's clothing. In 1926, still in Chicago, he opened his first shop, selling millinery, though he did this not under his own name but under that of a school friend, Charles Boucheron. In 1928, he moved to New York before moving to London around 1929/30 where he later set up a shop in Mayfair. He then spent time between London and Paris before returning to New York and settling there permanently from 1939. He died there in 1978 having retired in the late 1950s or early 1960s.

21. Exhibitions relating to the late Mr James' work are said to have taken place in a number of US museums and in the Victoria and Albert Museum in London. The latter exhibition opened on 3 May 2014 (see witness statement of Claire Wilcox) which is after the relevant date. An exhibition at The Brooklyn Museum took place in 1982. Having acquired material from this exhibition, another took place in the Metropolitan Museum of Art in New York in 2014 (after the relevant date). Both of these exhibitions led to the publication of an accompanying book or catalogue. *The Genius of Charles James* (mentioned above) written by the curator of the Brooklyn exhibition and *Charles James: Beyond Fashion* by Harold Koda and Jan Reeder (MMA). Both contain extracts providing a timeline of the late Mr James or his businesses and extracts from them make up Exhibits TP1-TP3 to the witness statement of Tom Priem dated 16 January 2015.

22. In respect of the MMA exhibition, the extract exhibited at TP3, contains an entry for 1928 which refers to the late Mr James being in New York and designing "hats and custom dresses, from sportswear to eveningwear, under the Boucheron brand". The 1929 entry refers to his return to London and beginning a "four-year period of shuttling between London, Paris and New York".

23. The 1930 entry indicates he had returned to New York where "what is probably the first advertisement featuring his work [appears] when Best & Co promotes nine "slightly wicked" Boucheron hats...". There is also a reference to his work appearing in the 10th May edition of *American Vogue* which also refers to Boucheron hats. The entry goes on to say that he returned to London in June where he opened his salon in Mayfair, a location "he will remain at... for three and a half years".

24. The 1936 entry states that he has employed a Philippa Barnes "a woman...who will be his trusted London-based assistant and amanuensis in the coming years when he bases himself in Paris". Between 1934 and 1937 he is said to have designed costumes, sometimes with other designers, for shows on the London and Paris stages and often for dancers. The 1938 entry states that he is now in Paris full time though, in London, "Philippa Barnes performs all necessary work to keep the business going". The 1939 entry refers to his business's financial difficulties and, given the inevitability of war in Europe, his return to New York, via London, where he remained.

25. In respect of the extract of the book produced in tandem with the Brooklyn exhibition exhibited at TP1 and TP2, the entry for 1928 refers to the late Mr James continuing to sell hats under the trade name Boucheron. The 1930 entry refers to his time in London and states that he was “continuing to design hats as well as garments” and that he was listed in the London telephone directory as “C. Haweis James”. The 1932 entry states he was using the mark “Boucheron of London” and refers to his “constant shuttling between London and Paris”. The 1933 entry makes reference to the work he undertook and states the following:

“Designs garments for H.J. Nicolls & Co., Ltd London; Viyella of Nottingham (4 models for sale through Harrods) · James’s “Taxi” street dress (designed, London 1929 –now redesigned with zipper) marketed in UK by Cable Co., featured in Lightning Zipp Fasteners, Ltd., advertisements, and marketed in USA by Abood Knit Mills and merchandised by Best & Co., Marshall Field & Co., and other quality stores · Best & Co., now selling a wide range of James’s designs · Creative activities broaden to include patented dress clasps, belts, sportswear, and (especially for the American market) linen accessories · Visits to Paris result in sales of about 200 models, some for copying, mostly to American buyers, including Taylor Importing Co., Casino Frocks, Marshall Field & Co., and Roberts Dresses · In November, James is in New York for a showing of his town and country collection (marketed under James’s name by Roberts Dresses) at Alfred Dunhill and Fortnum and Mason.”

26. The only reference to the mark under which goods were sold is the reference to marketing in the US of goods “under James’s name” though the entry also indicates that a label used at that time was “James/15 Bruton St./ London. W”. The 1934 entry refers to his listing in the London phone directory as Charles B. H. James, receiving his first commissions to design stage costumes and him establishing a base in Paris and notes that he “continues selling designs to the trade”. In 1935 he is said to be listed as C.B.H. James in the telephone directory and used a label bearing the text “model by/Charles James” and, in 1936 used a label with “Charles James/15 Bruton St. W1” on it.

27. Whilst not all of his designs reached the manufacturing stage (see TP1, Tom Priem 16 January 2015, page 7 (1956 entry)), there is no dispute that the late Mr James designed and sold hats and clothing for women. It is also not disputed that he had a business in London in the 1930s. Specific evidence of the size of that business is not given though in Exhibit TP3 to Mr Priem’s witness statement referred to above, the entry for 1936 states:

“He counts between thirty and forty women in his client pool...[which] includes Mrs. Eric Loder, widow of Canadian tobacco tycoon Sir Mortimer Davis; the British socialite Doris Blanche Orr, Lady Orr-Lewis, Edith de Beaumont, wife of Count Etienne de Beaumont, an eminent host in Paris; and Vivienne Woolley-Hart, the American-born German baroness...”

28. There is no evidence to show whether and, if so, how many of these “thirty to forty women” were customers in the UK though the extract above would suggest that many were not. In his evidence, Mr McDowell states that “In London the

concentration was on private clients who visited his Atelier in Bruton Street or in the leading hotels where he normally stayed". Mr McDowell states that his clients in the UK included the Countess of Rosse. Other than saying he designed one-off custom couture for his clients, no further information is given.

29. At Exhibit F to the opponents' witness statement of 19 November 2014 is a document headed "List of known clients". The list is taken from *The Genius of Charles James* (see above) and contains the names of individuals as well as stores or companies. In relation to the list of individuals, Mr Harris submitted that whilst he could not tell from the names themselves what nationalities the individuals may have been, some had "on the face of it, British titles". This is not evidence that the individuals were British but, in any event, what nationality a person might have had does not assist in showing whether or not they were UK customers. As for the stores or companies on the list, in most cases a location (town or city) is provided. Some of them are shown to be located in the UK. The list includes companies such as Imperial Chemical Industries (Birmingham, England) but I can see no information in the evidence, nor have I been directed to anything within it, which shows whether this and some of the other named companies were ones the late Mr James sold to or bought things from. The evidence does provide some detail of the dealings the late Mr James had with some of the companies on the list. For example, in his evidence, Mr McDowell states he "designed day dresses for the Viyella label", presumably those referred to earlier (Priem, 16 January 2105, Ex. TP1) which were sold through the Harrods store. What is not shown is whether those dresses were offered for sale under the Viyella or Charles James (or some other) mark.

30. The evidence does not paint a picture of the late Mr James being a successful businessman. There are references throughout the evidence to his lack of business acumen, the failures of a number of businesses and his chaotic and profligate lifestyle. In relation to his time in the US, there are also references to him sometimes taking several years to create a single dress, his failure to deliver garments within the required timescales and to instances, when garments had been delivered, of him taking them back at will. There are also references to the bailiffs entering his London shop to seize goods. None of this assists, however, in showing what the position was in relation to the use claimed under the mark in the UK. The only specific financial details I can see within the evidence relates to one of his businesses (exhibit B page 30-Charles James Manufacturers) in 1954. At this time he was based in the US. There is no indication of what mark may have been used at that time or what customers he might have had, the outgoings (\$310,266) are almost three times that of his income (\$112,963) and the figures are given in dollars so do not assist in showing what the position might have been had any of that figure been shown to relate to customers in the UK.

31. It is clear from the evidence that the late Mr James was a designer. Whilst he may have been known by some as a designer, no claim is made in these proceedings to any trade under the mark in respect of design services. I can see nothing (and have not been referred to anything) within the evidence which shows any trade in the UK relating to printed matter, footwear, clothing accessories and associated retail services, exhibitions or fashion shows as claimed. Such trade as has been referred to in the evidence relating to the UK appears to have centred on clothing and headgear.

32. Whilst the evidence shows the late Mr James was designing hats and garments, particularly in the 1930s to 1950s period, it also shows him and his work to be overwhelmingly US based. He is said to have had a number of businesses over the years. Whilst there is some evidence of him having had a shop or salon in the UK in the early 1930s and carrying on business here later into the decade, there is no indication of what goods, specifically, might have been sold nor is there anything which shows when or under which mark any such goods or services were supplied or the volume supplied. In the 1930s, hats and dresses are said to have been sold through a number of third party shops in the UK and, at some point, he produced designs for other businesses but, again, the evidence lacks any detail as to the volume of goods or services supplied. There is no evidence of any turnover in the UK or of specific UK customers and no evidence e.g. from the trade or from customers (the latter perhaps not surprising, given the time lapse). There is no evidence of any advertising or other promotional activity in the UK. Whilst Mr McDowell and Ms Wilcox have made witness statements which refer to the late Mr James and their familiarity with his work, they are professionals with detailed knowledge of the history of fashion and so can be expected to know of the existence of a particular designer and his/her work in whichever country he/she may be located. Their evidence does not assist in showing what the position was in the relevant market as a whole, nor do they give any specific evidence of the extent of any trade in the UK under the mark as claimed. As set out above, there is a reference to a label bearing the mark CHARLES JAMES having been used in 1935 but there is nothing which shows how that label was used or on what goods it might have been used. Apart from this single reference, there is no evidence to show that any specific goods or services may have been supplied to UK customers under the mark CHARLES JAMES. In contrast, the evidence indicates that the late Mr James' shop in the US traded under his school friend's name rather than his own and that he continued using the Boucheron mark, for some time at least, in the UK. There is no evidence that whatever trade he might have had in the UK continued after the 1930s, at least 75 years (and several generations) ago. Taking the evidence as a whole, it does not show the requisite goodwill in the earlier right relied upon in the UK in relation to any of the goods and services claimed nor does it show that any goodwill still existed at the relevant date. Absent goodwill, the objection based on grounds under section 5(4)(a) of the Act must fail.

### **The objection under section 3(6) of the Act**

33. Section 3(6) of the Act states:

“3 (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

34. 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.

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)."

35. In the relevant box on the form which is the notice of opposition, the opponents' claim under this ground is put in identical terms to those claimed in the ground I have already dealt with. An objection under section 3 of the Act requires something more than a claim that an earlier right exists. Whilst there is nothing on the form itself which makes such a claim, in an attachment to that form, the opponents claim:

"...At the time of filing the Application, the Applicant was fully aware of the reputation and goodwill in the CHARLES JAMES name. It is submitted that the Applicant is seeking to prevent the Opponent from registering the mark themselves and/or has selected the mark for registration as it became aware that it had not been registered by the Opponent. It is submitted that the Applicant has also gone to the effort of registering a large number of deceased third party artist and/or fashion designer names, including (but not limited to) MAGGY ROUFF, CALLOT SOEURS, ROSE BERTIN, SONIA DELAUNAY, MAINBOCHER and HERBERT LEVINE. These actions by the

Applicant show a pattern of abuse by the Applicant in making filings for names which it has no interest in...

It is submitted that in making the Application, the actions by the Applicant are dishonest and/or contrary to acceptable commercial behaviour...”.

36. At the hearing, Mr Harris submitted that there were three strands to the objection: “that the business model itself applied by the applicant....is designed to take the goodwill in an existing name and appropriate it to the applicant;...there is a clear case of opportunism here which we will say you can infer was prompted by a desire to exclude the opponents from the market; and then, finally, I will address you briefly on intention to use”.

37. In its counterstatement, the applicant denies the allegations. It claims it was not aware of, and found no evidence of, any earlier rights in “Charles James” in the United Kingdom. It claims that it has not acted dishonestly but filed the application with the intention of using the mark. In his witness statement, Mr de Lummen states:

“Before filing its UK application, [the applicant] searched for potential earlier rights in the country but found no trace of commercial use of “Charles James” as a trade mark, brand name, company name or business name since at least 1940. [The applicant] concluded that earlier rights, if there had been any, fell into the public domain almost 75 years ago.”

38. Mr Harris criticised the applicant’s approach and referred me to the case of *Jules Rimet Cup Ltd v Football Association Ltd* [2008] F.S.R. 10 where Mr Wyand Q.C. sitting as a deputy High Court judge stated:

“If a defence is going to be run on the basis that legal advice has been sought and followed I think it is incumbent on the party running that defence to disclose all the relevant facts including the instructions given and the full advice received, In the absence of that, the fact of legal advice having been sought is relevant but cannot be conclusive in a case such as this.”

39. Mr Harris submitted that, by analogy, the same applies in the current proceedings. He submitted that as the applicant has said it carried out searches but did not find any earlier rights then “it is incumbent on the applicant to disclose what exactly it did by way of investigation and what it knew about the history of CHARLES JAMES and the likelihood of any rights arising from it, so that appropriate conclusions can be reached.”

40. In my view, the situation in this case can be distinguished from those set out in *Rimet* not least because in the facts in that case were, briefly, that whilst some unspecified legal advice had been sought, the application for registration had been made in the knowledge that an earlier, residual goodwill existed. The applicant here disputes the existence of the opponents’ claimed goodwill. It is not, of course, a matter for the applicant to prove there is no goodwill. Instead, it is a matter for the opponents to show the claimed goodwill exists. I have already found that the opponents have not shown there is any such goodwill in the mark CHARLES JAMES



in respect of the goods and services claimed, however, for completeness, I go on to consider the other aspects of the opponents' objection under this ground.

### **Intention to exclude the opponents from the market**

41. In his witness statement dated 27 November 2014, Tom Priem, states that in April 2014, the opponents entered into discussions with a third party, The Weinstein Company ("Weinstein") for the latter company to licence and use the CHARLES JAMES name. A preliminary licence agreement between the parties is said to have been executed on 5 May 2014 with a public announcement also being made that same day. At Exhibit TPA to his witness statement dated 5 December 2014, he exhibits what he says is a copy of the agreement. It consists of 9 pages, all but one of which is completely redacted. The first page is presented in letter form and half of it is redacted. It is headed "The Weinstein Company, LLC" and is dated 5 May 2014. It refers to the licensing of a US trade mark application and "any and all copyrights, publicity rights, trademarks, trade names and any and all other intellectual property relating to the name or designer known as "Charles James", as well as any related artwork, logos and designs owned or controlled by Licensor and any and all other related materials (e.g. dresses, etc.) owned or controlled by Licensor that are in Licensor's possession...". The parties are given as Charles and Louise James on the one hand and Branded Partners, LLC on the other. All parties are US based.

42. At TP1, Mr Priem exhibits copies of eight articles which were published around that time which refer to the licence agreement. They are dated between 5<sup>th</sup> and 7<sup>th</sup> May 2014. Two of the articles appear to be from UK-based websites (vogue.co.uk and fashion.telegraph.co.uk) with the remainder being US publications. None give any indication that the parties' had any intentions as regards the UK. The article from pagesix.com includes the following text:

"Sources say James' family is in possession of their father's designs and archives. The Weinstein deal would, according to a source, "create an exclusive couture house" and cover all licensing rights, including a fragrance".

The article from hollywoodreporter.com includes the following text:

"Given that this will be Weinstein's second attempt at relaunching a fashion house – one that isn't necessarily widely recognized outside the style community, mind you – it will be interesting to see how the film producer will bring couture gowns back on the U.S. market".

43. Mr Priem points out that the application was filed just three days after the public announcement. At the hearing, Mr Harris submitted that the inference from this is that the applicant was aware, when it filed the application, that "the opponents' interest [in the mark] had been instigated". He also submitted that the applicant's filing pattern around that time is relevant as this application was part of a "flurry" of filings. He referred to Exhibit I which sets out a list of other applications for the same mark which were filed by the applicant. There are twelve applications listed. The earliest of them is a US application which has a filing date of 27 November 2008. There is also the CTM from which the current application claims priority, which has a

filing date of 18 March 2014. The remainder, which includes the current application, are US, Benelux, Hong Kong and South Korean applications and all have filing dates between 8<sup>th</sup> and 16<sup>th</sup> May 2014.

44. In his witness statement, Mr de Lummen accepts that, as with any other application for registration, “one of the purposes of the UK filing was to prevent third parties from obtaining rights” in the mark but he denies that it was filed with any abusive purpose. Instead, he submitted, it was “meant to complement an existing and prior portfolio”. He states that the opponents are US citizens “who have never conducted any trading business in fashion, either in the USA or in the UK”. The opponents first sought to register CHARLES JAMES as a trade mark in the US on 20 April 2014 which coincides with the initialisation of the Weinstein/opponents’ discussions referred to by Mr Priem. Mr de Lummen submits the opponents are trying to create rights where none exist. In contrast, he refers me to the respective dates of the parties’ applications in the US and points out that the applicant’s CTM application predates its UK application by some two months.

45. At the hearing, Mr Harris acknowledged the fact that the application has a priority date from the CTM application which predates the public announcement but submitted:

“Simply having a priority date does not excuse a bad faith filing. Even if you rely on your priority date, if your reason and intention for filing the application is prompted by a bad faith motive, it is an absolute objection and the application must fail. That point is by reference to the actual date of application, not the priority date. The priority date gives reference to relative rights, not to bad faith.”

46. There is no dispute that the applicant filed for registration of the mark (and did the same in four other countries) within days of the announcement that the parties concerned had entered into what it calls a preliminary licence agreement. There is no evidence that the applicant saw or was otherwise aware of the announcement but even if it did, this does not, of itself, show that in making the application for registration, it did so in bad faith, even it knew that the opponents had not sought to register the mark themselves in the UK. This is particularly the case given that, as also shown on the list at Exhibit I, this was not the first application for registration of the mark which it had made or which stood in its name. The exhibit shows that the applicant had made an application for registration of the same mark as a Community trade mark two months before the announcement was made. It also shows that an application for registration of the mark in the US was made by its predecessor in business in 2008.

47. At the hearing, Mr Harris also sought to dismiss this earlier US application. The parties do not dispute that the US application was made by a company they refer to as The Watelin company (“Watelin”). Mr de Lummen, in his witness statement, states that the applicant is a successor in business to Watelin. At the hearing, Mr Harris criticised Mr de Lummen’s evidence and submitted:

“The impression given there (and clearly intended to be given there) is that this was, if you like, the acquisition of independent third party rights. It was put, by way of reply evidence, that this omitted to reveal a rather important

piece of information, which is that the Watelin company is actually connected directly by one of its key signatories, Guy Watelin, to Mr de Lummen. Guy Watelin de Lummen is the father of Mr de Lummen. So, it is not a clean portfolio at all; there is a clear connection.”

48. Mr Harris further referred me to the witness statement of Tom Priem dated 26 May 2015 wherein he makes reference to “related US proceedings”. No details of which proceedings these might be are given but Mr Priem gives details of a question asked of the applicant. The question asks the applicant to “describe in detail” the relationship between it and Watelin, “including any business, family or personal relationship between its respective officers, directors, employees or agents”. At TP6B, Mr Priem exhibits the response he says was received which makes it clear that the applicant has “General Objections to this Interrogatory”. The response goes on to explain that the applicant “took over the business operation of Watelin in 2009 and eventually absorbed that company and acquired all of its assets.” It also explains that Mr de Lummen was the manager of Watelin and is one of the three directors of the applicant. Mr Harris submitted that the response shows “a desire” not to disclose the familial relationship between Mr de Lummen and his father or that there is a family connection either between the two businesses or between the portfolio of marks. He submitted that “the failure to give full, proper, candid answers to the issues before them suggests that they understand that these are inconvenient issues that they do not wish to address”.

49. As indicated above, I have not been told which US proceedings may have led to the interrogatory being asked. More importantly, both the opponents, and Mr Harris on their behalf, fail to explain how this is relevant to the current proceedings. Neither Mr de Lummen nor the applicant make any claim that Watelin is or was an independent third party nor does Mr de Lummen deny that his father was an officer of that company. In stating that the applicant is the successor in business to Watelin, it seems to me that Mr de Lummen accepts there is some sort of connection between them. The fact remains that the US application was made in November 2008, several years before the opponents and Weinstein entered into their agreement and before the opponents filed their own US application. It is clear the applicant’s predecessor had an earlier interest in the mark and, in my view, the connection between Watelin and the applicant, if anything, only serves to increase the likelihood of the applicant itself having had an earlier interest in the mark. Whilst the timing of the filing of the application comes shortly after the public announcement of the opponents’ intentions, which may be seen by some as something of a coincidence, it does not show that the application was made in bad faith.

50. In their witness statement, dated 19 November 2014, the opponents state:

“The Applicant is known in the industry for acquiring the intellectual property of fashion brands. The Applicant’s business is controlled by a French individual called Arnaud de Lummen.”

51. At Exhibit J, the opponents provide a list of applications for marks said to have been made by the applicant. One is the current application, the remaining 11 are for community trade marks which have since become registrations. The opponents state that these trade marks consist of the names of deceased designers or design

houses and extracts taken from the Wikipedia website which form part of the same exhibit, support this.

52. At Exhibit K are three press articles about Mr de Lummen. The earliest is from the New York Times and is dated 27 August 2006. Entitled "Revival of the Fittest" it describes the fashion house of Madeleine Vionnet which closed in 1939 but which "changed the course of design", though "few outside fashion ... know her name".

53. The article refers to Mr de Lummen's plans to "reintroduce her house early next year". It goes on to state "Eighteen years ago, his father, Guy de Lummen, who had developed a reverence for Vionnet while heading the ready-to-wear department at Balmain, bought the rights to her name and spent two decades exploring ways to re-establish the brand....Two years ago, de Lummen fils took over the effort to start a clothing line." The article goes on to give details of the hiring of named designers and the fact that the company's "first runway collection for Vionnet will be shown in October 2007" with "a line of luxury ready-to-wear...that will be distributed in January through Barneys New York and at the Vionnet studio in Paris."

54. The next in date is from the Financial Times of 26 September 2013. Entitled "Arnaud de Lummen awakens vintage luxury brands from their slumber" it includes the following:

"Arnaud de Lummen, 36, has spent the past few years buying up the intellectual property and trademark rights to Mainbocher, the house that invented the strapless bodice and designed Wallis Simpson's wedding dress, but which closed its doors in 1971 –as well as the rights to about 15 other classic brands, with the intention of reviving the names and selling them on. He is banking on the belief, long the foundation of the modern luxury industry (see: Dior, Balenciaga), that reviving an old name that retains its recognition value is simpler than launching a new one. Other "sleeping beauties", as Mr de Lummen calls his brands, include...

"Brands can go dormant but they do not necessarily lose their value" Mr de Lummen says. "Some are too old-fashioned, but there are some that are timeless."

55. The article goes on to give some details of what it says are Mr de Lummen's activities in relation to his revival of the Vionnet house stating that he "spent two years putting Vionnet's team together...got Barney's to agree to buy almost \$2m of goods a year for the first two years" before selling it the following year. There is also mention of his work reviving Moynat "the 19<sup>th</sup>-century trunk maker, again assembling a small team to get things started" before selling it on.

56. The latest of the articles, published in fashionista.com on 27 September 2013, is entitled "36-year-old fashion mogul plans to reignite fallen fashion houses". It refers to Mr de Lummen and his "enterprising idea to start buying up 16 sidelined yet revered old school fashion houses to return them to their former glory, and eventually sell them off and make a fortune."

57. Attached to his witness statement dated 29 December 2014 at TP1A, Mr Priem exhibits an article published on the businessoffashion.com website which is dated 11

December 2011. It is entitled: “Sleeping Beauty Brands: Myth or Magic Formula?”. Again, it refers to Mr de Lummen’s “business of turning forgotten fashion brands – including Schiaparelli, Vionnet, Moynat and, now, Paul Poiret –into assets ready for relaunch...”. It goes to states that “According to De Lummen... “Without heritage, there cannot be a traditional luxury brand.” This, and the fact that these brands are largely forgotten outside of expert circles, means that the ‘prince charming’ –the investor who decides to revive the brand –has significant creative room to manoeuvre. In fact, De Lummen’s model depends on a degree of forgetfulness on the part of the consumer, who will ideally perceive the ‘revival’ of a brand such as Paul Poiret, which has been effectively dormant for 80 years, as a continuation of the brand’s original story.”

58. In his witness statement of 27 November 2014, Mr Priem refers to the applicant’s CTM for the mark Paul Poiret which it applied for in May 2012 and was registered in September the same year. Mr Priem states that the rights in the name are now being offered for sale. At TP5 and TP6 he exhibits material relating to the potential sale. TP5 is an article published in the New York Times on 28 October 2014 and TP6 is a press release issued the same day and taken from the paulpoiret.com website. The documents make it clear that the applicant has taken several years to acquire the various rights to the Paul Poiret name around the world and is seeking interest from potential purchasers of the various trade marks and archives. TP6 also includes an extract taken from the Telegraph.co.uk website published on 20 November 2014. It states:

“De Lummen is responsible for the initial revival of former couture house Vionnet in 2006, 67 years after it had closed, and luxury trunk maker Moynat. He had previously hoped to do the same for Poiret, drawing up a revival plan mirroring that used for Vionnet. “Personally, my dream would have been for John Galliano to be the designer,” he said. “However, we eventually decided to limit our role in this preliminary state of the revival and to now identify the right partner or investor who will lead the relaunch.” Though hoping for an outright sale, it is thought that de Lummen will also consider joint venture opportunities or offers to license the brand with an option to purchase. If the reserve price is not met, Luvanis “will happily keep Poiret”.”

59. At the hearing, Mr Harris submitted that the applicant’s business model “is to seek out and register dormant heritage brands, secure them and then assign them as complete packages to interested investors” as “Reviving an old brand is simpler than launching a new one”.

60. It is clear that the applicant has made applications for, and been granted, community trade marks which consist of names of nine long-deceased designers or long-defunct design houses. There is some evidence that it has spent some time buying up some existing rights for some of these marks. Whilst there is some evidence that, in one case, it has announced an offer for sale of the rights to one of these names without, apparently, having used it in the intervening two years, there is also some evidence that other marks which it has registered have been brought into use with sales being made (e.g. Vionnet, Moynat). In some cases, the goods have been promoted using articles sold by the original producers of those goods. The opponent submits that it can be inferred from this that the applicant is, in essence,

admitting the original marks have existing goodwill and is trading off that. As I have already indicated, the evidence shows the applicant has bought various earlier rights from the prior rights holders. Whilst there is no evidence the applicant has bought any prior rights in this case, the opponent has not shown that any such rights existed, or existed in the UK. I do not consider the evidence shows that the applicant applied for the mark in suit with no intention to use it.

61. Taking all matters into account, the opposition based on grounds under section 3(6) of the Act fails.

### **Summary**

62. The opposition fails on each ground on which it was brought.

### **Costs**

63. The applicant having succeeded is entitled to an award of costs in its favour. I take into account that a Case Management Conference (“CMC”) took place following a request by the opponents of an extension of the period to file evidence. The applicant did not attend that CMC and was not represented but did file submissions in lieu of attendance. Whilst I granted the request, Mr Harris, who attended the CMC on the opponents’ behalf, admitted that the information given on the original request was inaccurate. In the circumstances I consider it appropriate to grant an award of costs in respect of the preparation of the applicant’s submissions. I also note that the applicant represented itself throughout. The applicant is entitled to a contribution to the cost of the business time diverted to defending this opposition, up to a maximum of £20 per hour, however, I do not consider it reasonable or proportionate to seek a breakdown of its costs in relation to these proceedings and, taking all matters into account, I make the award on the following basis:

For reviewing the notice of opposition and filing a counterstatement:	£150
For filing and reviewing evidence:	£500
For filing written submissions in lieu of attendance at the CMC:	£100
For preparation for and attendance at the substantive hearing:	£200
<b>Total:</b>	<b>£950</b>

64. I order Charles B H James and Louise D B James, jointly, to pay Luvanis S.A. the sum of £950. This sum is to be paid within fourteen days of the expiry of the

appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 2nd day of December 2015**

**Ann Corbett  
For the Registrar  
The Comptroller-General**