

**O-162-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3055252  
IN THE NAME OF CHIA LOVE LTD  
OF THE FOLLOWING TRADE MARK IN CLASS 32:**

**Chia Love**

**AND  
OPPOSITION UNDER NO. 402885  
BY  
JACK JAWORSKI**

## BACKGROUND AND PLEADINGS

1. On 12 May 2014 Chia Love Ltd (the applicant) applied for the trade mark shown on the cover page of this decision in respect of the following goods:

Class 32

Non-alcoholic fruit drinks; Smoothies [non-alcoholic fruit beverages]; Non-alcoholic beverages; Beverages (Non-alcoholic -); Non-alcoholic fruit juice beverages; Non-alcoholic drinks.

2. On 17 September 2014 Jack Jaworski (the opponent) filed an opposition under sections 5(4)(a) and 5(4)(b) of the Trade Marks Act 1994 (the Act). In summary the grounds are:

Section 5(4)(a): The applicant's use of the mark 'Chia Love' for Non-alcoholic fruit drinks; Smoothies [non-alcoholic fruit beverages]; Non-alcoholic beverages; Beverages (Non-alcoholic-); Non-alcoholic fruit juice beverages; Non-alcoholic drinks amounts to passing off.

Section 5(4)(b): Copyright for Chia Love is the opponent's and has not been transferred to the applicant at any time.

3. On 16 April 2015 the opponent filed a request to add a ground under section 3(6). The request was allowed. In summary the opponent pleads the following, which is reproduced as written:

Section 3(6): The applicant has also been recently promoting the 'Wow Chia' brand which has also led us to believe that they have no interest in using 'Chia Love'. It seems clear that the applicant's intention was simply to file for the trademark to block another party from the market and that they had no genuine interest to use it...Furthermore, we have good reason to believe that the applicant was previously aware that we were using the 'Chia Love' name and they made no effort to engage in communications with us prior to filing the application. Business records of Eleventh House (such as emails) also support the view that Oliver Dickinson accepted he was working for Eleventh House Ltd and happily discussed the Chia Love brand in line with this...

It is also clear from the applicant's current online presence that they no longer have any intension to use Chia Love. Since filing, they have applied and been granted a new trade mark for 'Wow Chia' and have updated their online profiles and brands accordingly.

To date, there has been no such attempt to promote the Chia Love brand on their part.

4. The opponent relies upon the following signs in respect of the all of the grounds pleaded:



And

Chai Love

5. The opponent states that the signs were first used online (and therefore throughout the UK) on 29 March 2014. In respect of the claim under 5(4)(a) he states that the signs have been used in respect of 'Non-alcoholic fruit drinks; Smoothies [non-alcoholic fruit beverages]; Non-alcoholic beverages; Beverages (Non-alcoholic -); Non-alcoholic fruit juice beverages; Non-alcoholic drinks'.

6. The applicant filed a counterstatement denying the grounds of opposition and defending its application.

7. Both sides filed evidence. Neither party requested a hearing or filed written submissions in lieu of a hearing.

## **EVIDENCE**

### **Opponent's evidence**

Witness statement by Jack Jaworski, dated 23 July 2015 and exhibits JJ1-JJ22

8. Mr Jaworski is the CEO at Eleventh House Ltd, a position he has held since 2013. The key points addressed in his witness statement are as follows:

*2. the trade mark Chia Love was first used in the United Kingdom by EHL in the year 2014 to represent Class 32 products such as non-alcoholic beverages, and that this was to the knowledge of Chia Love Ltd (hereinafter the Applicant).*

*3. ...at the beginning of January 2014, I began creating my own chia based beverages.*

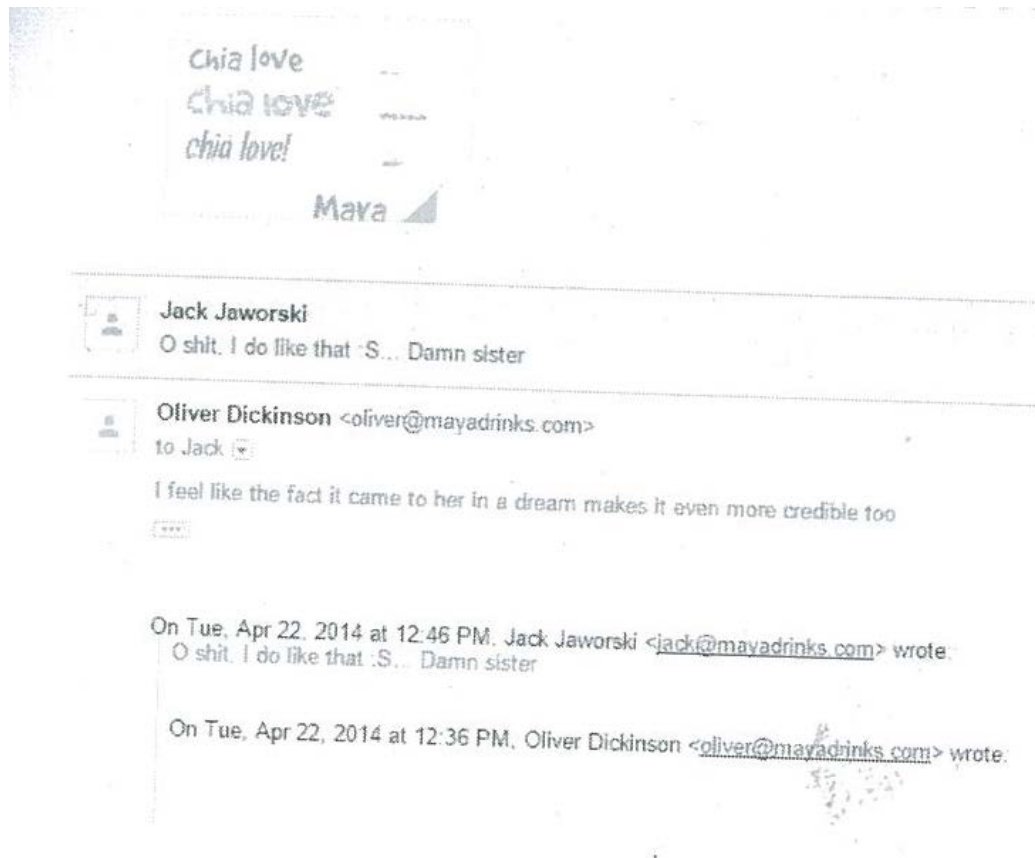
*At the time, I was living with Mr Oliver Dickinson and Surgeon Dr Kam Wa Jessica Mok. Mr Dickinson sold himself as a bright and enthusiastic entrepreneur who would be able to bring in venture capital and Dr Mok had a big interest in products which could improve health of the general public.*

*4. I asked both Mr Dickinson and Dr Mok to join EHL [Exhibit JJ1].*

9. Exhibit JJ1 is an email from Dr Mok to 'Ollie', dated 15 August 2014 (after the relevant date). It expresses disappointment at 'Ollie' stealing Jack's idea.

5. ...we firmly agreed to progress with a brand name of Chia Love [Exhibit JJ2-5]. Initial concepts and logos were provided by Sarah Jaworski [Exhibit JJ5] who was under contract to EHL (March, 2014). These were also shared with the Applicant [Exhibit JJ2-5] and Dr Mok...

10. Exhibit JJ2 is dated 22 April 2014 consists of a document containing three lines of a conversation. It is not clear on which platform this took place. The opponent describes it as, 'Business communications deliberating between brand names'. It appears as follows:



11. Exhibit JJ3 is an email, dated 4 March 2014, from Jack Jaworski to Oliver Dickinson sending an attachment for him to look at. In response, Mr Dickinson says:

*"Well done bunny A, you've done a good job here..."*

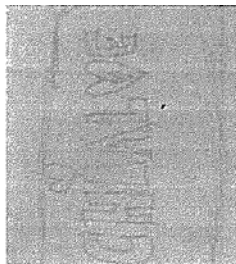
*I do think there is a risk that it could get too busy (Aztec patterns etc), and I THINK we should just take one or two elements of the Aztec theme and incorporate it with something more modern and clean cut. But the designer can work that one out. Love your idea of using the colour of the juices to give the appearance of sunsets etc."*

12. The middle section of the message is Mr Dickinson's views on the development of the brand and how to approach it.

13. Exhibit JJ4 is a chain of email correspondence between the opponent and the applicant. The email addresses are @mayadrinks.com. The conversation concerns bottling and labelling chia drink products and the wording of the business cards. An email from Oliver Dickinson to the opponent, dated 28 April 2014, reads:

*“My thoughts on the biz cards would actually be to have them addressed/marked as ‘Chia Love’ instead of ‘Eleventh House’. Right now and for the foreseeable future the Chia Drinks will be our sole product, in terms of networking people are much more likely to remember us as Chia Love seeing as that’s what we’ll be talking about.”*

14. Exhibit JJ5 is described by the opponent as the ‘original Chia Love concept’ which was sent to the applicant on 20 March 2014



*10. As we progressed with the business and the work picked up at the beginning of May 2014, Mr Dickinson who had been going missing for long periods of time was struggling to perform and we raised our concerns [Exhibit JJ9].*

*11. After a period of time, he informed us that his heart was no longer in the business and that he would instead concentrate on Oliver John — a glasses company which he told us was taking off [Exhibit JJ10]. Mr Dickinson also specifically communicated that he would not be pursuing anything ‘Chia’ related but that he was additionally setting up a wedding business and estate agent in South Africa and we wished him the best of luck. We continued to have an amicable relationship with the applicant and spoke on a regular basis.*

15. Exhibit JJ9 is an email dated 1 May 2014 from the opponent to Oliver Dickinson. It includes the following:

*“I am working full time on several global projects with Barclays and HSBC so really do only have time for scheduled calls or even days if you prefer which I can book off to dedicate to this. Unfortunately, I am back working normal hours and it is taking some adjusting. I am going to be juggling my current job with other responsibilities so I really do need more structure. Otherwise, it’s comes [sic] across that there is not so much urgency with your focus also on Oliver John and we don’t need reminding how quickly we need to get this done now.”*

16. Exhibit JJ10 is a reply email dated 2 May 2014 from Oliver Dickinson to the opponent stating the following:

*“...Quite simply, I’ve subsequently come to the conclusion that the best thing for us to do is indeed dissolve. It means that you can focus on your own projects and I can focus on Oliver John which is moving quite quickly now and needs my attention. You’d mentioned this outcome once before so I’m hoping that it’s in-line with what you’d like to happen anyway.*

*RE continuing on with Chia – I don’t have any intention of doing that right now.”*

The opponent’s statement continues:

*12. It should be very clear at this stage that the Applicant was perfectly aware that we were still using Chia Love as a brand name and intended to register for the trade mark as per our “To Do” lists also uploaded to the business account Google drive [Exhibit JJ11]. We gave the Applicant no reason to believe otherwise and it is certainly not something that we were ever asked.*

*13. However, we later found out that only a couple of days after parting with us, Mr Dickinson incorporated Chia Love Ltd with Companies House (confirmed by certificate of incorporation). The Applicant then registered for the Chia Love trademark with the IPO office 72 hours later.*

*14...we believe that the application was made in bad faith, We would like to once again highlight within a couple of days of the Applicant telling us they no longer had an interest in EHL and the nature of its business, they incorporated Chia Love Ltd and filed for the trade mark. Notwithstanding Mr Dickinson’s prior knowledge at the time of the Application, he proceeded without communicating this to either myself or Dr Mok despite regularly updating us on his other business affairs.*

*15. On the balance of probabilities, and business records it is clear there was an attempt to mislead us as we were still engaging with Mr Dickinson on a daily basis (as per chat conversations). He would even ask us for updates on our business. At no time were we informed about Chia Love Ltd despite us checking up on how Mr Dickinson was getting on. There was no reason to hide this information from us unless the Applicant intended to “Pass Off” the newly incorporated Company and Brand as EHL.*

*16. We believe that this dishonesty and behaviour fell short of the standards of acceptable commercial behaviour observed by professionals in this field...*

*23. When we went to file our trade mark we were absolutely stunned to find that some other company had already applied for this. At the time, there were zero companies offering chia based beverages in Europe due to the Novel Food status of the seeds it is not openly permitted. Any companies who wish to sell a chia seed based drink must go through a lengthy*

*extension of use application process with the Advisory Committee for Novel Foods and Processes (ACNFP).*

*24. We had been in regular contact with the UK Food Standards Agency and ACNFP and they were not aware of any other applicants at that time.*

*25. When we discovered that Mr Dickinson was behind the filing we felt absolutely betrayed and heartbroken. We delivered the initial TM7A.*

*26. We then received a surprise response from the Applicant in August which stated:*

*“To start with you never even liked the name, and it took so much persuasion from me for you to grow to like it. I even had to execute a bloody survey in an attempt to compel you. I figured after a while that you just gave in to pressure from me, particularly because you didn’t even have any interest in registering it as a company name. Why on earth you would continue to like it after we had separated is therefore beyond me” [Exhibit JJ8].*

*27. This statement is completely unfounded and untrue as confirmed by business records [Exhibit 112-5] between myself and the Applicant in which I express my delight for the name...*

*32. Unfortunately, following our opposition, the Applicant has for whatever reason decided not to withdraw the trade mark. This is against the above statements received by the Applicant in which they state that they no longer intend to use it...*

*37. As inferred from these surrounding circumstances, the Applicant’s intention has been to simply block and considerably delay our entry to the market.*

*38. It also particularly worries us that the Applicant may have attempted to retain the Chia Love name knowingly in order to carry over any of our good faith with the ACNFP, manufacturers, and suppliers. The Applicant clearly setup business in order to compete directly with EHL. In both the same region, and also product category.*

## **Applicant’s evidence**

### Witness statement of Oliver Dickinson dated 19 October 2015

17. Mr Dickinson is the CEO of Wow Food and Drinks Ltd (formerly Chia Love Ltd), a position he has held since 2014. The main points arising from Mr Dickinson’s statement are as follows:

*“4...Mr Dickinson has never been a part of Eleventh House Ltd. JJ1, for example, has nothing to do with Mr Dickinson being emailed to join Eleventh House Ltd. Mr Dickinson has never been a part of Eleventh House*

*Ltd and Mr Jaworski has never and will never be able to provide evidence to support otherwise. We were friends having 'round the pub table' ideas. We decided and both agreed to part ways (not just me, not just Jack but both of us), and in doing so we both left all and any ideas on the table; they belonged to nobody. Not me, not Mr Jaworski. I later decided to go back to the pub and formally register the name Chia Love. Mr Jaworski didn't even think to do the same for an entire 2 months after that. If Mr Jaworski had gone back to the pub and registered one of those names before me then frankly I would have just accepted it because nobody owned anything.*

*5. In paragraph 5 Mr Jaworski states that they planned 'to register for the trade mark once final branding had been developed', why on earth a company would want to spend significant time and money in to developing a brand before even registering the mark is frankly bizarre and again to me this shows how Mr Jaworski is retrospectively distorting his evidence and timeline to support his case."*

## **Opponent's evidence in reply**

### Second witness statement by Jack Jaworski, dated 10 November 2015

18. Mr Jaworski's second statement is largely a repeat of the first witness statement. He denies that the parties were engaged in 'pub conversations' and refers me to the audit trail filed with his first witness statement.

## **Preliminary issues**

19. Both parties refer to settlement negotiations between them. Clearly, a settlement has not been reached. Neither the application nor the opposition has been withdrawn and the matter now falls to be decided.

## **The 5(4)(b) claim**

20. 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."



21. The relevant date in these proceedings is the date on which the application was made, namely 12 May 2014. The earlier right relied upon appears to be copyright, though I note that the opponent also refers to designs at a number of points in the statement of grounds. A clear pleading in respect of designs has not been made and in any event, the subject mark is two plain words so a design right, even if one existed, would not assist.

22. In its counterstatement the opponent makes the following point with regard to copyright:

*“It is our belief that any claim Mr Jaworski [the opponent] makes regarding owning copyright for ‘Chia Love’ should be ignored. This is because the words ‘chia love’ are not artistic enough to automatically qualify for copyright.”*

23. With regard to the copyright claim, the mark applied for and the words relied upon by the opponent are the plain words, ‘Chia Love’ with no graphic element. Section 1, Section 3(1) and Section 4(1) of the Copyright, Designs and Patents Act 1988 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.”

3 - Literary, dramatic and musical works.

(1) In this Part—

“literary work” means any work, other than a dramatic or musical work, which is written, spoken or sung, and accordingly includes—

- (a) a table or compilation other than a database
- (b) a computer program
- (c) preparatory design material for a computer program; and
- (d) a database;

[...]

(2) Copyright does not subsist in a literary, dramatic or musical work unless and until it is recorded, in writing or otherwise; and references in this Part to the time at which such a work is made are to the time at which it is so recorded.

(3) It is immaterial for the purposes of subsection (2) whether the work is recorded by or with the permission of the author; and where it is not recorded by the author, nothing in that subsection affects the question whether copyright subsists in the record as distinct from the work recorded.

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”

(2) In this Part—

[...]

“graphic work” includes—

- (a) any painting, drawing, diagram, map, chart or plan, and
- (b) any engraving, etching, lithograph, woodcut or similar work;

24. The mark, ‘Chia Love’ is a combination of two words. Therefore, it cannot be considered to be a literary work because its creation does not imply sufficient literary skill or labour (Francis Day & Hunter Ltd v Twentieth Century Fox Corp [1940] AC 112 PC).

25. The mark at issue consists of no original features in respect of style, presentation or colour. The mark does not consist of a “painting, drawing, diagram map, chart or plan” or “any engraving, etching, lithograph, woodcut or similar work” Consequently, there is no artistic contribution. Therefore, neither is the word mark ‘Chia Love’ an “artistic work” within the meaning of the CDPA.

26. In light of the above, the words ‘Chia Love’ do not qualify for protection as a graphic work and would not be considered a literary work under the CDPA.

27. The opponent also relies on a stylised heart device. Even if the opponent established that the graphic heart logo was protected under the law of copyright, the plain words would not infringe it and therefore a claim under this section of the Act cannot succeed.

**28. The opposition in respect of section 5(4)(b) fails.**

### **The 5(4)(a) claim**

#### **The law**

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

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade...

(b) ...

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

30. 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.”

31. Parker J in *Burberrys v J C Cording & Co Ltd* [1909] 26 RPC 693 said:

“The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other’s injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade or good-

will which will be injured by its use. If the use of a word or a name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business.”

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

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 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.”

33. Commenting on *South Cone* 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.”

### **The relevant date**

34. Whether there has been passing off must be judged at a particular point (or points) in time. In the decision of the Court of Appeal in *Roger Maier and Assos of Switzerland SA v ASOS plc and ASOS.com Limited* [2015] EWCA Civ 220 it was stated:

“165. ...Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation

or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury- Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

35. The above related to a community trade mark, however, the same applies to a UK national trade mark.

36. The filing date of the subject trade mark is 12 May 2014. There is no evidence or claim by the applicant that it has used its mark prior to this. Accordingly, the matter need only be assessed as of that date.

### **Goodwill**

37. The first hurdle for the opponent is to show that it had the required goodwill at the relevant date. 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.”

38. In *Hart v Relentless Records* [2003] FSR 36, 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

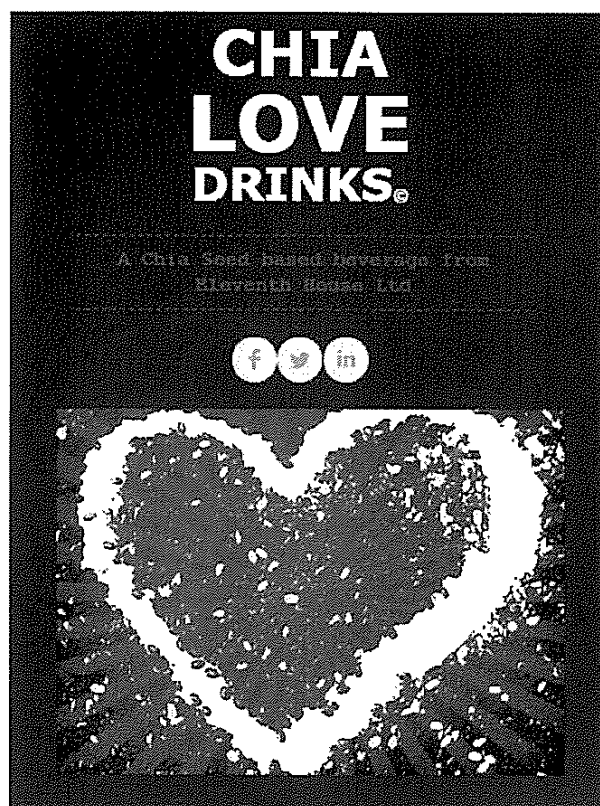
significant reputation' (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

39. 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."

40. 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)

41. The only example of the signs relied on by the opponent is provided at JJ22 and is described as, 'our current branding'. No date is provided to indicate when these signs were first used. Since the exhibit is attached to a witness statement dated July 2015 and uses the words, 'our current branding', it is likely to be after the relevant date. It appears as follows:



42. In order to get its claim under section 5(4)(b) off the ground the opponent must show that it had a protectable goodwill at the date of application, in this case 12 May 2014. The evidence filed by the opponent does not show a single example of the signs

relied on in this opposition being used in respect of any goods. No sales figures or advertising figures have been provided, no invoices have been filed and there are no examples of packaging or marketing materials. I have no indication from the evidence that any drinks have ever been produced or put on the market or that anyone has been exposed to the signs outside the sphere of the parties to these proceedings. There is no indication that the opponent has created or sold a single drink in class 32, or that there are any customers for its goods.

43. I therefore find that the evidence does not show use of the opponent's mark at all, in respect of any goods and certainly does not show that the opponent had any goodwill at the relevant date necessary to succeed under the law of passing off. **The opposition under section 5(4)(a) therefore fails at the first hurdle.**

### **The 3(6) claim**

44. 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.”

45. The law relevant to this ground was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited*<sup>1</sup> in the following terms:

“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].

---

<sup>1</sup> [2012] EWHC 1929 (Ch)

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)."

46. In accordance with the comments of Arnold J. at paragraph 131 of *Red Bull*, the position must be judged at the date on which the application for registration was made, which in this case is 12 May 2014.

47. The tests I must apply in making an assessment under section 3(6) are well established. I must firstly determine what the applicant's knowledge was at the relevant date. Having made such a finding, I must determine whether, in light of that knowledge, the application was made in bad faith.

48. It is clear from the evidence provided by both sides that these parties, or at least the opponent and the controlling mind behind the applicant, namely Oliver Dickinson, had known of each other before the events complained of. It is not disputed that the parties discussed a proposal to create a brand under which they would operate a business selling drinks which contain chia seeds, nor is it disputed that 'Chia Love' was the proposed name for that venture.

49. The parties' business relationship ended in May 2014. The evidence shows that they had entered into discussions regarding the content of business cards and that authorisation would be needed to sell drinks containing chia seeds. The evidence does not show that prior to the end of the parties' business relationship a business or brand had been created or that any goods had been produced or sold or that any marketing had been carried out, or packaging designed.

50. The applicant's knowledge at the relevant date was that he had been involved in discussions regarding a business under the name Chia Love, but not that the proposal had been taken any further or that a business under that name had been launched. Having determined the applicant's knowledge at the relevant date I must decide whether, in light of the evidence, the applicant applied for the trade mark 'Chia Love' in bad faith. In its pleadings the opponent states the following with regard to section 3(6) of the Act:

*"Section 3(6): The applicant has also been recently promoting the 'Wow Chia' brand which has also led us to believe that they have no interest in using 'Chia Love'. It seems clear that the applicant's intention was simply to file for the trademark to block another party from the market and that they had no genuine interest to use it...Furthermore, we have good reason to believe that the applicant was previously aware that we were using the 'Chia Love' name and they made no effort to engage in communications with us prior to filing the application. Business records of Eleventh House (such as emails) also support the view that Oliver Dickinson accepted he*

*was working for Eleventh House Ltd and happily discussed the Chia Love brand in line with this...*

*It is also clear from the applicant's current online presence that they no longer have any intension to use Chia Love. Since filing, they have applied and been granted a new trade mark for 'Wow Chia' and have updated their online profiles and brands accordingly.*

*To date, there has been no such attempt to promote the Chia Love brand on their part."*

48. The opponent seeks to rely on the fact that the applicant has not yet used or promoted the mark 'Chia Love'. Should the applied for mark become registered, the applicant has five years from that date in which to use the mark in respect of the goods for which it is registered. Consequently, not having used the mark to date is not a relevant factor in these proceedings and is not a relevant factor in making a finding under section 3(6) of the Act.

49. As far as I can understand it, the opponent also seems to imply under this ground that the applicant owed him, and also the company Eleventh House Ltd, some sort of duty. The exact nature of this duty is not clear. The applicant denies being employed by or involved in Eleventh House Ltd in any way and states that the opponent will not be able to prove otherwise. Indeed, no evidence has been provided which shows the applicant to have had any fiduciary, directorial or employee role within Eleventh House Ltd. Consequently, even if the ground were clearly and specifically pleaded, I am unable to conclude the extent to which any duty owed has been breached as the existence of that duty has not been proven by the opponent.

50. The clearer bad faith claim under this ground appears to be that the applicant has no intention to use the mark and that by registering it he seeks to prevent the opponent from trading. In other words, a fettering argument. The only reasons advanced as proof that the applicant does not intend to use the mark is that the applicant has other business interests and has registered the sign, 'Wow Chia'. There is no restriction on the number of registered trade marks or signs that may be used by an individual or business. Having a number of registrations does not in itself indicate that the applicant does not intend to use the Chia Love mark nor is it sufficient, in itself, to prove that the applicant has acted in bad faith. In my view, registering a second mark containing the word 'Chia' may suggest an intention to trade in a number of 'Chia' branded goods rather than being indicative of no intention to trade in them at all.

51. With regard to the fettering argument there is no evidence to suggest that the opponent has established a business under the mark 'Chia Love' or that any goods have been created or sold under the mark. A 'to do list' is included in evidence which the opponent provides as an example of preparing to launch the brand. There is nothing filed to show that any of those tasks had been completed or to show when the list was created and by whom. The evidence, in its totality, does not show that on the date of application the opponent had a business capable of being 'fettered'.

52. It may be that the opponent's behaviour could be considered distasteful or sharp business practice, but that in itself is not sufficient for a finding that the opponent has

acted in bad faith. In *Red Bull GmbH v Sun Mark Ltd*<sup>2</sup>, Amanda Michaels, sitting as the Appointed Person, stated that:

“47. Where an allegation of bad faith is made, it should be properly and specifically pleaded, and before a finding of bad faith will be made the allegation must also be supported by the evidence.”

53. In this case the evidence provided by the opponent does not support such a claim.

**54. I find that the opposition in respect of section 3(6) fails.**

## **CONCLUSION**

**55. The opposition fails under sections 5(4)(a) and 5(4)(b) and 3(6) of the Act.**

## **COSTS**

56. Chia Love Ltd has been successful and is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. I have taken into account that no hearing has taken place and that neither side appointed a professional representative. I award costs on the following basis:

<i>Preparing statements and considering the other side's statements -</i>	<i>£300</i>
<i>Filing and considering evidence -</i>	<i>£500</i>
<b><i>Total</i></b>	<b><i>£800</i></b>

57. I order Jack Jaworski to pay WOW FOOD AND DRINKS LTD<sup>3</sup> the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 30th day of March 2016**

**Ms AI Skilton  
For the Registrar,  
The Comptroller-General**

---

<sup>2</sup> *BL O/068/10*

<sup>3</sup> *Formerly CHIA LOVE LTD*