

O/516/19

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS INVOLVING:

**1) OPPOSITION (NO 411089) BY F AND M MEDIA GROUP
LIMITED TO THE REGISTRATION OF TRADE MARK SERIES
3254228 APPLIED FOR BY MR FRANK KENNEDY**

AND

**2) OPPOSITION (NO 411167) BY MR FRANK KENNEDY TO THE
REGISTRATION OF TRADE MARK 3254411 APPLIED FOR BY
F AND M MEDIA GROUP**

Background and pleadings

1. Mr Frank Kennedy (also known as “Frank Mulla Kennedy” or “Frank Mulla”) applied to register the following trade marks as a series in the United Kingdom on 4 September 2017:



They were accepted and published in the Trade Marks Journal on 22 September 2017 in respect of goods and services in Classes 9, 35 and 41. A full specification can be found in the Annex to this decision.

2. Also on 4 September 2017, F and M Media Group (“F and M”) applied to register the following trade mark in the United Kingdom:

F R A N K I N C E N S E & M Y R R H

It was accepted and published in the Trade Marks Journal on 22 September 2017 in respect of the following services:

Class 41

Video production; Production of musical videos.

3. Each application was opposed by the other party. F and M filed its opposition on 18 December 2017. Three days later, Mr Kennedy filed an opposition against F and M's application. Both oppositions are based upon Sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 ("the Act"), and concern all goods and/or services specified in the applications.
4. A joint hearing was held on 8 May 2018, and a decision issued on 25 May 2018, in relation to the opposition to Mr Kennedy's application and the late filing of the Form TM8 (Notice of defence and counterstatement).¹ Mr Kennedy's Form TM8 and Counterstatement were admitted into the proceedings, which were consolidated on 7 September 2018.

F and M's pleadings

5. Under section 5(4)(a) of the Act, F and M claims that use of Mr Kennedy's mark for all the goods or services in the application is liable to be prevented under the law of passing off, owing to its goodwill attached to the sign **FRANKINCENSE & MYRRH**, which it claims to have used throughout the UK since 2014, in respect of the following services:

Video production; Production of musical videos.

6. Under section 3(6) of the Act, F and M claims that Mr Kennedy made his trade mark application in bad faith. It claims that, at the time of filing, Mr Kennedy was aware of F and M's "prior and extensive use" of the sign and by making an

¹ BL O-329-18

application intended to prevent F and M from legitimately commercialising his business, as well as free riding on the goodwill associated with the sign.

Mr Kennedy's pleadings

7. Under section 5(4)(a), Mr Kennedy claims that use of F and M's mark for all the services in the application is liable to be prevented under the law of passing off, owing to the goodwill attached to the following signs:

**FRANKINCENSE AND MYRRH
FRANKINCENSE AND MYRRH MUSIC GROUP
FRANKINCENSE AND MYRRH MEDIA GROUP
FRANKINCENSE AND MYRRH MANAGEMENT
THE FRANKINCENSE AND MYRRH GROUP**

Mr Kennedy claims to have used all these signs throughout the UK since April 2013 "within all aspect of music, media and management".

8. Under section 3(6) of the Act, Mr Kennedy claims that F and M made its trade mark application in bad faith. It claims that, at the time of filing, F and M was aware of Mr Kennedy's "prior and extensive use" of the sign and by making an application intended to prevent him from legitimately commercialising his business, as well as free riding on the goodwill associated with the sign. He continues:

"The information that I have provided in defence of this section 3(6) shows that the applicant made a public announcement, defaming and slandering my character – to the extent that he even copied in my contact within Universal Studios and many of the necessary contacts that I need to conduct business with. I believe that this was done intentionally and in bad faith. His actions have led to loss of respect and reputation within the music, media and management industry."

9. Both parties filed a defence and counterstatement, denying all the grounds.

10. Both parties filed evidence in these proceedings. This will be summarised to the extent that is considered necessary.
11. F and M filed written submissions on 7 November 2018 and 21 February 2019. Mr Kennedy's witness statement contains his submissions. These will not be summarised but will be referred to as and where appropriate during this decision. Neither party requested a hearing, so this decision has been taken following a careful consideration of all the papers.
12. In these proceedings, F and M is represented by Sheridans, while Mr Kennedy represents himself.

Preliminary issue: evidence

13. Mr Kennedy refers several times to evidence that has not been presented to the Tribunal, but gives an indication of where to get it. For instance, he states that CCTV footage showing attendance at a business meeting may be obtained from the security division of a third party. Any evidence that a party wishes to rely on should be available to the other party in the proceedings, and it is not the role of the Tribunal to undertake an evidence-gathering exercise. In terms of the evidence to be taken into account, I have therefore directed my attention solely to the information provided in the official forms, witness statements and accompanying exhibits.

Evidence

Party A's evidence

14. F and M's evidence comes from Mr Tarandeep Chowdhry, the Sole Director of F and M Media Group Limited, a position he has held since January 2015. He states that within the urban music industry he is also known by his nicknames, Taran Cee or Teeeezy C. His witness statement is dated 6 November 2018.

15. F and M Media Group is a video production company and Mr Chowdhry says that he has made “numerous” videos for UK urban music artists since 2015 under the **FRANKINCENSE & MYRRH** sign.² “Frankincense” and “Frankinsence” are used interchangeably in the Witness Statement. From now on, I shall use the former spelling, as this is the one used in the trade mark application, the Forms TM7 and TM8 and the exhibits.
16. Mr Chowdhry states that his company generates its income exclusively from the videos made under the **FRANKINCENSE & MYRRH** sign. Turnover in 2015 was in excess of £3,000; in 2016, in excess of £10,000; and in 2017, in excess of £20,000. He also provides figures for the number of views on YouTube in the UK of a selection of these music videos. He estimates that this represents about 30% of the total he has produced.

Year	Views
2017 (to September)	27,338,303
2016	6,382,285
2015	251,844

17. Attached as exhibits to the witness statement are screen shots of videos produced by F and M and invoices and quotations for aspects of the video production process. Mr Chowdhry also supplies the texts of emails and a WhatsApp exchange between the parties. I shall not summarise these exhibits here, but will return to them where appropriate in my decision.

Mr Kennedy’s evidence

18. Mr Kennedy’s evidence is dated 5 December 2018.
19. He states that since 29 April 2013 he has been using the signs **Frankincense And Myrrh, Frankincense And Myrrh Music Group, Frankincense And Myrrh Media Group** and **Frankincense And Myrrh Management** for the following

² Witness statement of Mr Tarandeep Chowdhry, paragraph 10.

activities: audio sound recording, distribution, music videos, business consulting, live performances, artist bookings, digital marketing, graphic design, PR, artist development, audio mixing and mastering, video production of music videos, digital online platform maintenance, sound production, location scouting for music videos and photography, set design for video production, brand partnership, artist management, web design, publishing, licensing, brand development, and touring.

20. According to Mr Kennedy's witness statement, services supplied under the sign generated the turnover shown in the table below:

Year	Gross Turnover
2013	Under £2,000
2014	Under £3,000
2015	Under £5,000
2016	Under £7,000
2017	Under £9,000

21. Mr Kennedy also exhibits screen shots of videos, invoices and the texts of letters. As with F and M's evidence, I shall return to these later in my decision, where appropriate.

My approach

22. In consolidated proceedings, there may be an obvious order in which to deal with the claims. That is not the case here. The proceedings concern oppositions to two applications that were filed on the same date. I shall therefore deal with them collectively – not least because both grounds depend on evidence, which in many places is contradictory. I find it convenient to deal first with the section 5(4)(a) ground.

Section 5(4)(a) ground

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

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is likely to be prevented –

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

...

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’.”

24. It is settled law that for a successful finding of passing off, three factors must be present: goodwill, misrepresentation and damage. Her Honour Judge Melissa Clarke, sitting as deputy Judge of the High Court, conveniently summarised the essential requirements of the law in *Jadebay Limited, Noa and Nani Limited t/a The Discount Outlet v Clarke-Coles Limited t/a Feel Good UK* [2017] EWHC 1400 IPEC:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL) namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all these limbs.

56. In relation to deception, the court must assess whether ‘a *substantial number*’ of the Claimants’ customers or potential customers are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

25. *Halsbury's Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, 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.”

Relevant date

26. The relevant date for assessing if section 5(4)(a) applies has been discussed by Mr Daniel Alexander QC, sitting as the Appointed Person, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11. In this decision, he quoted with approval the following summary of the position provided by the Hearing Officer, Mr Allan James, in *SWORDERS TM*, BL O-212-06:

“... 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.”³

27. Both parties claim to have used the mark before the date on which both applications were made, with F and M claiming use from 2014 and Mr Kennedy from April 2013. I will therefore consider first what the position was in 2014 and then whether that was different on 4 September 2017.

³ Paragraph 148.

Goodwill

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

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

29. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership) (REEF Trade Mark)* [2002] RPC 19 (HC), Pumfrey J made the following comments on proving the existence of goodwill:

“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 is not shown on the balance of probabilities that passing off will occur.”

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

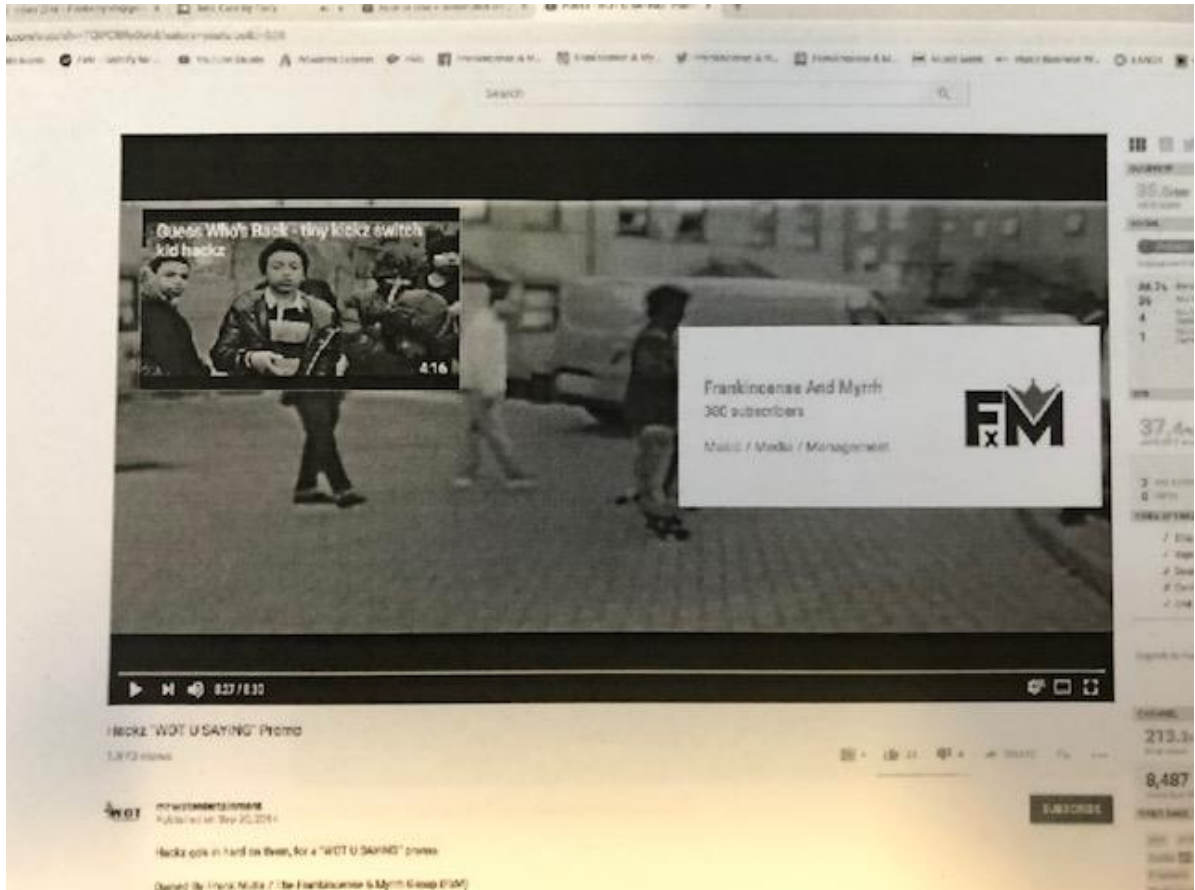
“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed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

Mr Kennedy’s claim to protectable goodwill

31. Mr Kennedy’s evidence includes a series of screenshots from YouTube videos.⁵ In total, there are twelve, with five published at some point during 2014 (two in April, one each in September, October and December) and two in 2015. The remaining screenshots show videos published in 2018. The image below shows one of these earlier videos and how the sign appears. For ease of viewing, I have also magnified the rectangle in which the sign appears.

⁴ Paragraph 8.

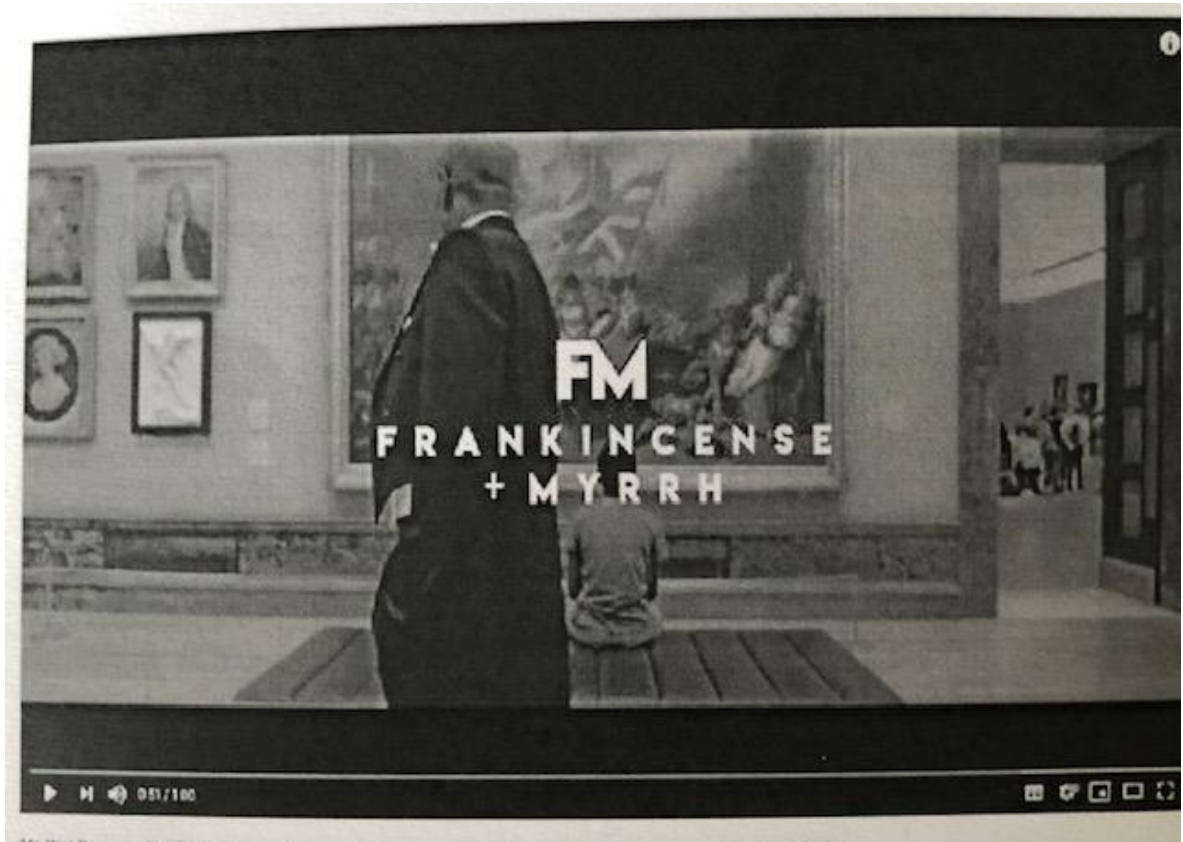
⁵ Exhibit FK2.



32. F and M submits that the sign is “a tag-on link that pops up after the video finishes”⁶ and also that this does not show what someone viewing the video on YouTube

⁶ Submissions in reply of Party A, paragraph 11.

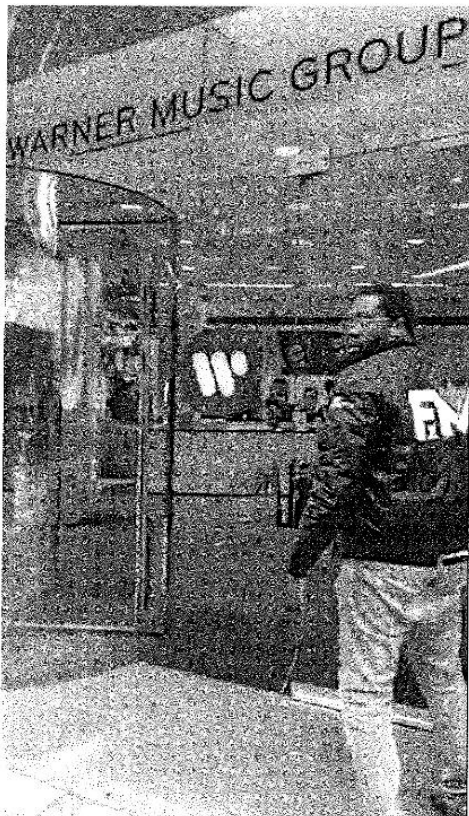
before the date that the screenshot was printed would have seen. On this basis, F and M submits that the screenshots cannot be considered to be use of the sign before the relevant date. It seems to me that the sign is a pop-up, rather than an integral part of the video itself. In the image above, the sign obscures part of the video in a way that I find hard to believe was intended when the video was originally shot and produced. This can be contrasted with a screenshot from a video published in October 2018, where the overlaid text is presented in a more conventional and visually appealing manner.



33. Mr Kennedy also adduces photographs of individuals wearing jackets showing the sign as evidence of use. Mr Kennedy states that the two photographs shown below date from 2013. The first depicts “The Frankincense And Myrrh Group at ‘U Got Jokes’ Showcase at 02 [sic] Indigo in England London (3rd August 2013)”.⁷ What is shown on these jackets is a variant form of the device element of the applied-for mark, rather than the words “FRANKINCENSE AND MYRRH”. The second

⁷ Exhibit FK2, page 18.

shows a man photographed outside an office of Warner Music Group. Here the device is visible on the back of the jacket and there appear to be some letters or logo on the sleeve, although it is hard to make them out. Mr Kennedy states that this image dates from December 2013.⁸



⁸ Exhibit FK2, page 20.

Exhibit FK2 also contains three photographs of a man wearing a similar jacket on which the device is shown. Mr Kennedy states that two of these relate to a community event held in January 2017. The words “FRANKINCENSE + MYRRH” appear with the device on the jacket sleeve and left-chest area in the third of these images. However, Mr Kennedy does not give a date for this particular photograph.⁹ I find that these photographs do not demonstrate use of the sign as claimed by Mr Kennedy. Even if the signs on the jackets were identical, I recall that for there to be protectable goodwill, the earlier use must relate to the use of the sign for the purposes of distinguishing goods or services: see *Wild Child Trade Mark* [1998] RPC 455 (AP). It is not clear to me how the use shown meets this test. The signs do not appear to be used in relation to any of the services in respect of which Mr Kennedy is claiming use (“*all aspects of music, media and management*”).

34. The sign appears on seven invoices, with the first dating from 21 May 2013 and the most recent from 4 November 2016. There is also a copy of an agreement for hire of camera equipment. This is dated 17 June 2017. This is 10 days after the date on which Mr Chowdhry states the first contact between the parties took place. The name of the hirer of the equipment is given as “Frank Kennedy (Frankincense & Myrhh [sic])”¹⁰.
35. Exhibit FK6 contains letters from industry participants dated 1 November 2018, 16 January 2018 and 26 January 2018. These letters – from representatives of Atlantic Records, Inside Success Union and Mr W.O.T. Entertainment respectively – all confirm that Mr Kennedy has supplied services under the sign **FRANKINCENSE & MYRRH** since 2013 (in 2 cases) or 2014 (in the third). These letters are unsigned and their writers have not provided a witness statement or statutory declaration to which the letter would be exhibited. In the circumstances, I must treat these letters as hearsay evidence and so accord them lesser weight.

⁹ Exhibit FK2, pages 16 and 17.

¹⁰ Exhibit FK4, page 12.

36. The rest of the evidence is undated. Screenshots from Apple Music and Spotify show playlists under the name “FRANKINCENSE & MYRRH” and both screenshots contain the device shown in the mark for which Party B has applied. Beyond this, it is extremely difficult to make out the details.¹¹ There are also some scanned images of team business cards which Mr Kennedy states were given to the public around the UK. He adds: “We have built most of our large following from attending many events across the United Kingdom by giving them out to potential clients and partners”. He does not state how many events were attended, when they took place, nor how many cards were distributed.¹² In addition, Exhibit FK4 contains photographs of “our custom-made bomber jackets made for advertising my brand and mark”. These appears to be the jackets shown in the photographs I have already considered. There are two images, taken from different angles, of the jacket on a mannequin. Mr Kennedy states that “Our brand logo and mark are widely noticed within the urban music, media and management industry within the United Kingdom.”¹³ He does not, however, provide any evidence to corroborate this statement.

37. Mr Kennedy does provide some financial information. I shall consider the period up to 2014 first. For 2013, reported gross turnover was under £2000; for 2014, under £3000. I also have before me two invoices from 2013: one, dated 21 May, is for sound recording and related services to the value of £300; the other, dated 25 May, is for artwork to the value of £200. If I also consider 2014, there is a further invoice, dated 30 May, for £300 for sound recording and related services.¹⁴ These are small sums, although I recall that small amounts of goodwill may be protectable: see *Stannard v Reay* [1967] FSR 140 (HC) and *Stacey v 2020 Communications* [1991] FSR 49. On the other hand, it is also established case-law that goodwill must be of more than a trivial nature, as Jacob J (as he then was) set out in *Hart v Relentless Records* [2002] EWHC 1984 (Ch):

¹¹ Exhibit FK2, page 15.

¹² Exhibit FK4, page 15.

¹³ Exhibit FK4, page 16.

¹⁴ Exhibit FK4.

“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.”¹⁵

38. Each case turns on its own facts. Both *Stannard* and *Stacey* concerned relatively localised goodwill. Mr Kennedy claims to have used the signs throughout the UK and it seems to me that in this context the financial information, taken with the absence of other evidence of the sign being used in the course of trade and the relatively broad scope of services in relation to which Mr Kennedy claims to have used the sign, is too small to be anything other than trivial. I find that Mr Kennedy did not have protectable goodwill in connection with its sign when F and M claims to have begun using its sign in 2014.

39. I turn now to a consideration of the position on the later date. Mr Kennedy states that turnover was under £5,000 in 2015, under £7,000 in 2016 and under £9,000 in 2017. Only turnover generated by 4 September 2017 is relevant, and the information is not presented in a level of detail that enables me to work out what

¹⁵ Paragraph 62.

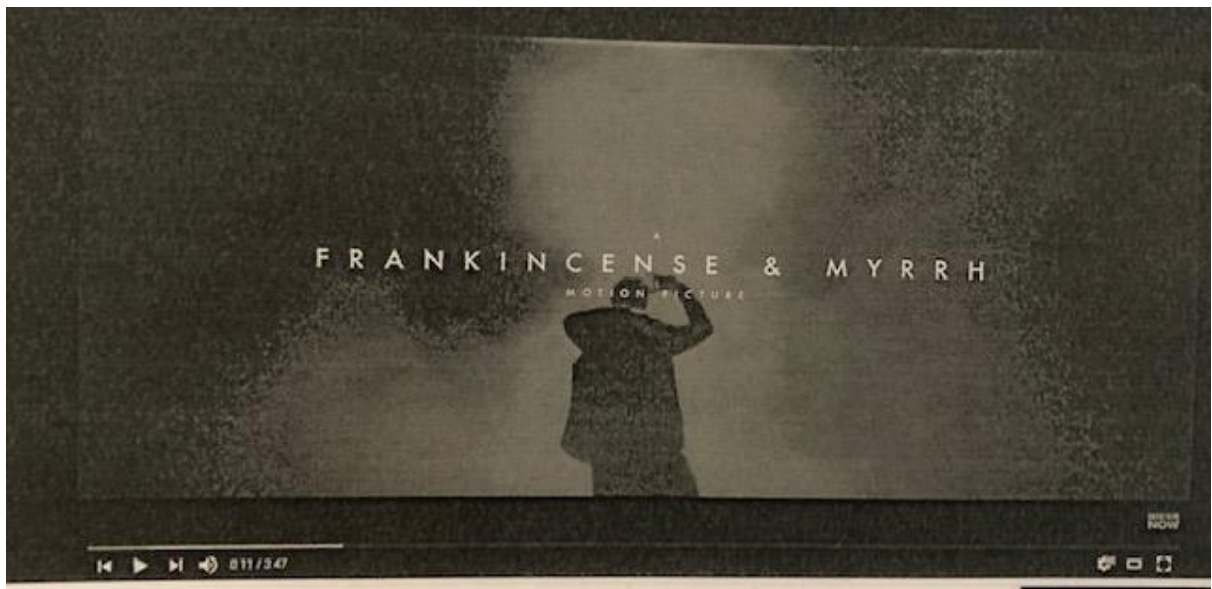
proportion of the £9,000 should be disregarded for the present purposes. A further five invoices are supplied:

Invoice	Date	Services	Amount (£)
FXMMGMT – 000301	4 September 2015	Consulting, project managing	250.00
FXMMGMT – 000302	4 September 2015	Consulting, project managing	800.00
FXMMUSIC – 000101	1 October 2015	Sound recording, mix down of sound recording, mastering of sound recording	300.00
FXMMEDIA – 000201	20 October 2015	Filming, editing, color [sic] grading with changes added	2051.33
FXMMUSIC - 000102	4 November 2016	Sound recording, mix down of sound recording, mastering of sound recording	579.30

40. As with the earlier period, it is the turnover figures and invoice evidence that point most clearly to commercial activity. Even after five years, the turnover is still very low, and there is scant evidence of the sign actually in use on the date the applications were filed. It is appearing as a pop-up on the videos, rather than within the videos themselves, and it is my understanding that such pop-ups can be added at a date other than that on which the video was published. Consequently, this evidence does not assist Mr Kennedy. Given the evidence before me, I am unable to find that, at the relevant date, he had protectable goodwill in any of the following signs: **FRANKINCENSE AND MYRRH**, **FRANKINCENSE AND MYRRH MUSIC GROUP**, **FRANKINCENSE AND MYRRH MEDIA GROUP**, **FRANKINCENSE AND MYRRH MANAGEMENT** and **THE FRANKINCENSE AND MYRRH GROUP**. Consequently, Mr Kennedy's opposition on section 5(4)(a) grounds fails.

F and M's claim to protectable goodwill

41. F and M states that its sign appears at the beginning or end of the videos, as shown in the image below, where it is seen 11 seconds in.¹⁶ This example was uploaded to a channel called “GRM Daily” on 15 November 2016.



A further 16 examples are given.¹⁷ Their publication dates range from 24 May 2015 to 3 September 2017. Only the most recent of these does not include the sign, and all but two of the remaining videos contain the sign in the manner shown above. Paragraph 16 of this decision contains viewing figures for a selection (around 30%) of the videos F and M has produced.

42. The invoices and quotations contained in Exhibit TC-11 in most cases show the sign in capital letters. They represent services both supplied and purchased by F and M. The services bought include rental of camera equipment, filming insurance and use of models – all of which are consistent with the production of music videos.

¹⁶ Exhibit TC-7, page 58.

¹⁷ Exhibits TC-6, TC-7 and TC-8.

43. Exhibit TC-10 contains a poster from an event launching the Viva Foundation on 2 July 2017. The stated mission of the foundation is to “inspire and challenge the next generation to be equipped to excel in the creative and entertainment industries”. Taran Cee (one of Mr Chowdhry’s nicknames) from Frankincense & Myrrh is listed as one of the guest speakers.
44. F and M also provides turnover figures: over £3,000 in 2015, over £10,000 in 2016 and over £20,000 in 2017. As with Mr Kennedy’s evidence, it is unclear what proportion of the 2017 figure was earned before the relevant date of 4 September 2017. These are still relatively small figures, but they show reasonably rapid growth that one might expect to see in a new business as it builds its reputation, rather than the more linear pattern shown by Mr Kennedy’s figures. The turnover was also generated from a narrower range of services restricted to the production of music videos, rather than the wide range of music, media and management services claimed by Mr Kennedy.
45. F and M has shown use of the claimed sign on its videos and this use is supported by the other evidence I have described. In my view, the evidence points to it having, by the relevant date, a more than trivial level of goodwill associated with the sign **FRANKINCENSE & MYRRH** used in connection with *Production of musical videos*.

Misrepresentation

46. The relevant test for misrepresentation was set out by Morritt LJ in *Neutrogena Corporation and another v Golden Limited and another* [1996] RPC 473:

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

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of

members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product].'

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

47. F and M submits that the goods and services covered by Mr Kennedy's application are identical or similar to those in connection with which it has goodwill; that Mr Kennedy's applied-for mark is visually, phonetically and conceptually identical to its own sign; and that there is a likelihood of confusion. F and M submits that misrepresentation is therefore inevitable.
48. Mr Kennedy's specification contains a long list of goods and services. Some of these are clearly identical or similar to those in connection with which I have found F and M to have protectable goodwill. However, the list includes goods and services where it is hard to find any similarity: *spectacles and sunglasses* and *retail services connected with the sale of food products* are two examples.
49. It is settled case-law that the parties are not required to operate within a common field of activity for a passing-off action to succeed. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millett LJ stated at [714] that:

"There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression 'common field of activity' was coined by Wynn-Parry J in *McCulloch v May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Material Co. Ltd v John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles))

and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although ‘the plaintiff and the defendant were not competing traders in the same line of business’. In the *Lego* case, Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘... whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel’s (Berkeley Square) Ltd v G Schock (trading as Annabel’s Escort Agency) [1972] R.P.C. 838 at page 84 per Russell L.J.’

In the *Lego* case, Falconer J. likewise held that the proximity of the defendant’s field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant’s conduct would cause the necessary confusion.

Where the plaintiff’s business is a household name the degree of overlap between the fields of activity of the parties’ respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v McCain Foods (G.B.) Ltd* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'... in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.'

50. The applied-for marks are, in my view, highly similar to F and M's sign, which is entirely contained within those marks, with the only difference being the substitution of "&" by "+". This is a tiny change, which I consider would go unnoticed by the relevant public and so would have no effect upon the distinctiveness of the sign.
51. It seems to me that a substantial number of members of the public would be misled into purchasing some of Mr Kennedy's goods and services in the belief that they are provided by F and M. These goods and services are those that relate to entertainment, videos, music, and equipment used in producing videos and music. I note that F and M has provided evidence of two instances of actual confusion among contacts in the music industry, within the space of a month. I shall have more to say about these when I come to the section 3(6) ground.
52. One of the factors that I must bear in mind in making my assessment is the extent of the goodwill. I have already noted that the turnover figures are relatively small and Mr Chowdhry himself admits that he operates within a particular genre: urban music. Bearing this in mind, it does not seem to me that F and M's goodwill is so extensive as to stretch to clearly dissimilar goods and services, of the types that I identified in paragraph 48 above. I shall return to these, if necessary, after considering the section 3(6) ground.

Damage

53. In *Harrods*, Millett LJ described at [715] the requirements for damage in passing off cases as follows:

"In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where

the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the same defendant. The danger in such a case is that the plaintiff loses control over his own reputation."

54. Where the goods and services are so similar that a substantial proportion of the relevant public would be deceived into thinking that the goods and services supplied by Mr Kennedy were those of F and M, or that there was a connection between the two undertakings, there is a likelihood of damage through substitution. In the case of the goods and services connected with music, videos or entertainment, I consider that such damage is likely.

Section 3(6) ground

55. Section 3(6) of the Act states that:

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

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

"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).”

57. Both parties’ claims are predicated on the other party’s awareness of “the opponent’s prior and extensive use of the earlier sign” at the time that the application for a trade mark was made.¹⁸ In *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, the Court of Justice of the European Union (CJEU) stated that:

“46. the fact that a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that that sign enjoys some degree of legal protection is one of the factors relevant to the determination of whether the applicant was acting in bad faith.

47. In such a case, the applicant’s sole aim in taking advantage of the rights conferred by a Community trade mark might be to compete unfairly

¹⁸ Almost identical wording appears in each Statement of Grounds.

with a competitor who is using the sign which, because of its characteristics of its own, has by that time obtained some degree of legal protection.

48. That said, it cannot be excluded that even in such circumstances, and in particular when several producers were using, on the market, identical or similar signs for identical or similar products capable of being confused with the sign for which registration is sought, the applicant's registration of the sign may be in pursuit of a legitimate objective.

49. That may in particular be the case ... where the applicant knows, when filing the application for registration, that a third party, who is a newcomer in the market, is trying to take advantage of that sign by copying its presentation, and the applicant seeks to register the sign with a view to preventing use of that presentation."

58. I have already dealt with the question of use under section 5(4)(a), so will move on to a consideration of what each party knew at the time that the applications were made.

F and M's account of events

59. Mr Chowdhry states that he first became aware of Mr Kennedy when the latter contacted him on 7 June 2017 to enquire about music videos for his acts. Mr Kennedy's email reads as follows:

"Hey

My name is Frank Mulla i run a music workshop (The Forming Miracles Project) in south London and also do artist development, was referred to you by a friend and I'm a big fan of you guys work and feel your visuals and creative eyes plus input would be much appreciated among the guys I work with. Currently working with an artist called "FOX" who is from Birmingham and "P.M" who is a rapper part of Harlem Spartans based in

south London. Both artist have a very big growing fan base within the UK. ... Outside of the artist development things i do am also working on a media platform which i would love you guys involved if possible. Would love to have a lunch meeting to discuss possible projects needed done by yourselves as well as have an phone conversation as am very old school i guess lol...”¹⁹

60. On 14 June 2017 Mr Kennedy forwarded the tracks for which he wanted videos, and he said he was in the process of getting confirmation to move ahead.
61. Between 11 June 2017 and 1 September 2017, Mr Chowdhry and Mr Kennedy exchanged messages via WhatsApp, where Mr Chowdhry uses the name “Teeezyc”. The record of the conversation is contained in Exhibit TC-14. From this, it appears that the two parties were discussing working together in a possibly more formal way.²⁰
62. On 4 August 2017, Mr Chowdhry told Mr Kennedy that he had heard from an industry contact that Mr Kennedy had played that contact “an audio from a female artist and on the intro ‘Frankincense and Myrrh’ was mentioned”. Mr Chowdhry asked Mr Kennedy to explain “As that’s my brand image and I wasn’t consulted regarding its use”.²¹ Mr Kennedy said that this was supposed to be an off-the-record discussion and that Mr Chowdhry would be told more in the next few days.
63. On 31 August 2017, another industry contact informed Mr Chowdhry that he had received the following email from Mr Kennedy:

“Hey

My name is Frank Mulla i run a music workshop (The Forming Miracles Project) in south London and also do artist development (Frankincense & Myrrh Music Group), was referred to you by Fox and i’m a fan of your

¹⁹ Exhibit TC-12, page 98.

²⁰ See page 12 of the exhibit.

²¹ Page 12.

work that i have seen so far on youtube for other artist you've shot for and feel your visuals and creative eyes plus input would be much appreciated among the guys i work with. Currently working with an artist called 'FOX' who is from Birmingham, a young lady called LAYYAH and 'P.M' who is a rapper part of Harlem Spartans based in south London. Both artist have a very big growing fan base within the UK. ... Outside of the artist development things i do am also working on a media platform which i would love you guys involved if possible. Would love to have a lunch meeting to discuss possible projects needed done by yourselves."²²

64. The same day, Mr Chowdhry sent a message to Mr Kennedy asking him to explain himself:

"why are you using the name Frankincense & Myrrh, you know full well that's my brand and portraying yourself as F&M is misleading."²³

Mr Kennedy did not directly answer this question.

65. Their final messages were as follows:

"01/09/2017, 00:58:29: Teeeezyc: We spoke and you said you understood but youve even got a F&M email, when we first met you presented yourself as an honest individual and youre trying to hijack my brand name.

01/09/2017, 01:15:16: Frank Mulla: Don't really to the back & forth on whatsapp... regarding the hijacking talk dont really feel your tone on that approach especially as we are two very different type of individuals tbh...regarding myles going to buck him in time as I don't appreciate his angle... but with you... will buck you in asap in person and you can speak your mind and hear my say on it

²² Exhibit TC-13. The Witness Statement gives the date of the email to Mr Chowdhry as 31 August 2018. The Exhibit shows that this was 31 August 2017.

²³ Exhibit TC-14, pages 13-14.

01/09/2017, 01:37:05: Teeeezyc: Yes we need to arrange a meeting this has been giving me a headache recently

01/09/2017, 01:37:36: Teeeezyc: And cool, what would you call it bro? Cos youve got an identical company name and email”

66. Three days later, Mr Kennedy filed his trade mark application.

Mr Kennedy’s account of events

67. Party B’s account of the relationship between the two is as follows. In his evidence, Mr Kennedy states that he sent Mr Chowdhry the following letter on 17 April 2015:

“This letter is regarding our ‘Frankincense and Myrrh’ brand which consists of our Record label, Media and management brand. It was brought to my attention you are also using the ‘Frankincense & Myrrh’ name through from our supporters. As your aware of our 3 diversions within ‘Frankincense & Myrrh’ being an independent record label (Artist under us being ‘Gifted Boy, Chaos, Barz Da Star, Riva etc.) media production (music videos for our artist as well as clients) and artist management for our artist. We would really appreciate if you can reframe from usage of our brand as this can be confusing to our artist fans and potential partners in the future, especially as we are building awareness within the UK & Europe market from our artist music and music videos online. We hope you can understand our concern and hope in the future we can possibly even work together on some projects.”²⁴

68. According to Mr Kennedy, this letter was followed by a further letter dated 22 July 2015:

“This letter is regarding our ‘Frankincense & Myrrh’ brand which consist of our Record label, Media and Management brand. We wrote to you back in April regarding our usage of the brand ‘Frankincense & Myrrh’. It

²⁴ Exhibit FK5, page 22.

was to my attention you stopped using the name as agreed which we were happy about but then started using it awhile shortly. We have been using this name since 22nd December 2013 and have built a reputation for high quality music & videos from the acts we represent as well as our good management skills. This has me concern to why you would use the 'Frankincense & Myrrh' name again after we contacted you and we both agreed on the confusion to consumers. As you are aware of our services within 'Frankincense & Myrrh' being an independent record label, media production and dealing with artist management for our artist. We would really appreciate if you can one again reframe from usage of our brand as we stated to you back on 17th April 2015 from our letter. This has become confusing to our artist fans and potential partners intending to join us, especially as we are building awareness within the UK & European market from our artist music online. The people you shoot music videos for don't represent our brand in any shape or form, so you attaching the 'Frankincense & Myrrh' brand to their videos gives false advertising as we don't look after them. We suggest as you're a music video camera boy, you simply state your name which you go by within the Industry as 'Teeeezy' or even put 'Directed by Teeeezy' on the videos produced by yourself for your clients so the public is not assuming that the clients you shoot for are under our management or have any association to the 'Frankincense & Myrrh' brand. We hope you can understand our concern and hope this can be sorted out peacefully and asap."²⁵

69. Neither of these letters is signed. Mr Kennedy has not provided any evidence of a response from F and M, despite claiming that the latter agreed to stop using the name.

70. Mr Kennedy also states that he referred work to F and M between January 2016 and September 2017, but at the date of the witness statement had received no payment of the agreed commission. No evidence is submitted to corroborate this:

²⁵ Exhibit FK5, page 23.

for example, there is no correspondence between the parties on this subject before June 2017 and no texts of agreements that provide for the payment of commission. Exhibit FK5 does contain a copy of a Post Office “Drop and Go Manifest”, showing that a recorded letter was sent by special delivery on 16 July 2016 to the address at which F and M was registered.²⁶ No information is given as to the contents of this letter.

71. It is admitted that Mr Kennedy contacted F and M in June 2017 on behalf of a client. He states that:

“I knew the opponent from our previous encounter from our cease and decess [sic] letters sent to him, despite our previous encounter I had built a business relationship with the opponent as he had stop [sic] using our mark ‘Frankincense and Myrrh’ on his YouTube channel.”²⁷

He adds that he was in the process of negotiating a deal with Warner Music Group and intended to make Mr Chowdhry part of “my Frankincense And Myrrh Media Group”.

72. Mr Kennedy then says that he became aware that F and M had not stopped using his sign and that

“I had full intentions to confront the opponent with my team which I wanted to do in person at my office or in a public area as I did not want to confront him about his actions over a telephone conversation or through any online messages. The opponent caught wind of my awareness of his actions and was trying to cover his tracks through his paper trail he had left online, at this point I was advised to take the necessary steps to register my trademark the proper way through the IPO. Once I did so, I informed the opponent of my actions to protect my rights as founder and original user of the mark ‘Frankincense And Myrrh’,

²⁶ Exhibit FK5, page 25.

²⁷ Written statement and submissions of Mr Frank Kennedy, paragraph 6.

Frankincense And Myrrh Music Group, 'Frankincense And Media Group [sic], Frankincense And Myrrh Management which has been from April 2013.'²⁸

73. I return to the text of Mr Kennedy's email of 7 June 2017 (and reproduced at paragraph 59) which does not suggest any previous interaction between the parties. Mr Kennedy has not directly challenged the authenticity of this email but submits that:

"We believe 'Tarandeep Chowdhry' also known as 'Teeeezyc' will try to deny knowing us from before or having any contact with us from previous communication and even believe he will try to deny ever having work referred to him by myself and my team on the behalf of our clients at the 'Frankincense And Myrrh Group'."²⁹

74. The email states that Mr Kennedy has been referred to F and M by a friend. It does not contain any reference to Mr Kennedy's claimed use of the name "Frankincense And Myrrh", which appears in the later email sent to one of Mr Chowdhry's industry contacts and reproduced in paragraph 63.

75. Mr Kennedy appears to attach significance to the changes in Party A's registered company name. Party A submits that:

"... the act of changing a company name is very common practice and does not support a claim for bad faith."³⁰

A company name is not necessarily the same thing as a sign that distinguishes goods and/or services: sometimes they coincide, sometimes they do not. I consider that I cannot make any relevant inferences from this information.

²⁸ Written statement and submissions of Mr Frank Kennedy, paragraph 6.

²⁹ Written statement and submissions of Mr Frank Kennedy, paragraph 9.

³⁰ Party A's written submissions in reply, paragraph 27.

76. Mr Kennedy also submits that F and M's ownership of the domain name frankincenseandmyrrh.co.uk is an act of bad faith, and that "the domain is just sitting there, unused, other than to extort myself and business".³¹ No evidence has been adduced to corroborate this allegation. The ownership of a domain name is not in itself evidence of bad faith.

My findings

Mr Kennedy's claim

77. It seems to me that there is very scant evidence to support Mr Kennedy's claim that he used the sign before the application date and that F and M was aware of any use. There are several invoices, but these would not be available to a third party. On the basis of the information before the Tribunal, it is not clear to me how F and M could have been expected to know of any use that Mr Kennedy might have made of the sign.

78. My consideration of the issue cannot end there. I must take account of the letters that Mr Kennedy states that he sent to F and M in 2015, two years before the date of the trade mark applications. In assessing this evidence, I bear in mind the comments of Mr Iain Purvis QC, sitting as the Appointed Person, in *TWG Tea Company v Mariage Frères SA*, BL O-131-16:

"The Opponent chose not to seek to cross-examine Mr Bouqdib at the hearing. This does not mean that the Hearing Officer was obliged to accept his evidence on every point. However, in the case of a serious accusation of bad faith, the tribunal should be slow to disbelieve evidence of the accused party which is not challenged in cross-examination unless there are very cogent and persuasive reasons for doing so."³²

³¹ Exhibit FK5, page 16.

³² Paragraph 22.

79. In these proceedings, however, there are two accused parties and it seems to me that it is not possible to believe both accounts of their dealings. According to Mr Kennedy, the parties first entered into correspondence in 2015; according to F and M, this did not happen until June 2017. Both cannot be correct. In *John Williams and Barbara Williams v Canaries Seaschool SLU*, BL O/074/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, commented that:

“I think it is necessary to begin by emphasising that a decision taker should not resort to the burden of proof for the purpose of determining the rights of the parties in civil proceedings unless he or she cannot reasonably make a finding in relation to the disputed issue or issues on the basis of the available evidence, notwithstanding that he or she has striven to do so: *Stephens v. Cannon* [2005] EWCA Civ. 222 (14 March 2005).”³³

80. F and M submits that there is no evidence that the cease and desist letters were sent to it. Furthermore, they are not signed. Mr Kennedy invites me to access the Royal Mail database to find receipts and reference codes as evidence that they were sent. I have already noted that any evidence that either party wished to rely on should have been provided, and it is not the role of the Tribunal to undertake a further evidence-gathering exercise. Even if Mr Kennedy had given the Tribunal these receipts and reference codes, that would merely show that some letters had been sent, not which letters. I find it surprising that Mr Kennedy has submitted only one side of the correspondence. While the second letter states that F and M agreed that consumers would be confused, without any confirmation from that party, such as in a reply to the first letter, this is hearsay. Also, these letters contradict the email from Mr Kennedy to Mr Chowdhry on 7 June 2017, the authenticity of which, as I have already noted, has not been directly challenged. In this email, Mr Kennedy does not refer to any previous dealings between the parties, or even state that he also operates under the “Frankincense and Myrrh” name. The most plausible interpretation of that email is that it is a first contact and that the parties have not previously worked together. On the balance of

³³ Paragraph 21.

probabilities, it seems to me that Mr Chowdhry first became aware of Mr Kennedy in 2017.

81. It is the act of filing an application that is relevant in claims of bad faith. There is no dispute that Mr Chowdhry was aware that Mr Kennedy was using the sign prior to the filing of the trade mark applications. However, it seems clear to me that Mr Chowdhry believed he had a superior right to registration, and I note the comments of Arnold J in *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* [2009] RPC 9 (approved by the Court of Appeal in [2010] RPC 16):

“In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position.”³⁴

82. Mr Kennedy refers to a notice posted on 2 September 2017 by Mr Chowdhry on his Instagram account as evidence of bad faith. This notice alleges that:

“... particular individuals have impersonated employees of Frankincense & Myrrh and these individuals have attempted to portray themselves as owners of Frankincense & Myrrh Music Group.”³⁵

Mr Kennedy is mentioned by name. He submits that this notice is an attempt to cause confusion, and represents an act of defamation. Whether this is defamation

³⁴ Paragraph 189.

³⁵ Exhibit FK5, page 17.

or not is not a matter for this Tribunal. The notice is consistent with a belief by F and M that it has legal rights over the sign and that Mr Kennedy is attempting to pass off his services as those of the other party. In this context, I find that the filing of a trade mark application by F and M is not an act of bad faith. Mr Kennedy's section 3(6) claim therefore falls.

F and M's claim

83. In my view, the evidence points to F and M having used the sign **FRANKINCENSE & MYRRH** in connection with *Production of musical videos*. It seems to me that if, as he states in the email quoted in paragraph 59, Mr Kennedy had seen some of Party A's work, the balance of probabilities is that he is likely to have seen the sign. I must now consider what Mr Kennedy knew at the time that he applied for a trade mark.
84. The key piece of evidence is the transcript of the WhatsApp conversation that took place between Mr Chowdhry and Mr Kennedy. Again, this has not been challenged. The exchange shows that on 4 August 2017, Mr Kennedy knew that Mr Chowdhry was concerned about his use of the name **FRANKINCENSE & MYRRH** without the latter's knowledge or consent, and that Mr Chowdhry believed the name to be his. Mr Chowdhry again expressed his concerns on 31 August 2017, following his receipt of the email reproduced in paragraph 63. Mr Kennedy did not address Mr Chowdhry's questions. At no point in the whole exchange does Mr Kennedy attempt to assert a superior right to the name.
85. Mr Kennedy, according to his own witness statement, informed Mr Chowdhry on 4 September 2017 that he had applied for a trade mark:

"The opponent changed his details on Companies House the same day of submitting his IP trademark application 14 hours after our own application was submitted to the IPO after we made him aware we had

done so when he was within Bolney Meadow Community Centre based within England, London at approximately 1:45 pm.”³⁶

I interpret this statement as meaning that Mr Chowdhry first heard about Mr Kennedy’s application for a trade mark after it had been filed.

86. As Arnold J said in *Red Bull*, quoting *Gromax Plastics Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, bad faith includes not only dishonesty but:

“... some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.”³⁷

87. In my view, filing a trade mark application for a sign that a party knows another party to have used, and claiming to third parties to be conducting business under that sign, while knowing that other party has concerns about such use, and making an application without informing that other party in advance, does fall short of the standards of acceptable commercial behaviour. F and M’s section 3(6) claim succeeds.

88. As F and M has been successful under section 3(6), I do not need to return to the section 5(4)(a) claim to consider the dissimilar goods and services.

Conclusion

89. F and M’s opposition has been successful, while Mr Kennedy’s opposition has failed. The application by F and M Media Group Limited may proceed to registration in respect of all the services in the application.

³⁶ Paragraph 7.

³⁷ Quoted in paragraph 134 of *Red Bull*.

Costs

90. F and M has been successful and is entitled to a contribution towards its costs. In the circumstances, I award F and M the sum of £2700 as a contribution towards its costs. In arriving at this sum, I have taken account of the fact that the proceedings were consolidated. The sum is calculated as follows:

Official fee for filing the notice of opposition: £200

Preparing statement and considering the other side's statements: £400

Preparing evidence and considering and commenting on the other side's evidence: £1800

Preparation of written submissions: £300

Total: £2700

91. I therefore order Mr Frank Kennedy to pay F and M Media Group Limited the sum of £2700. The above sum should 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 04th day of September 2019

Clare Boucher
For the Registrar,
Comptroller-General

Annex

Specification for UK3254228

Class 9

Musical sound recording; audiovisual recordings featuring music and musical based entertainment; downloadable musical sound and downloadable audiovisual recordings featuring music and musical based entertainment; downloadable ringtones; graphics and music via a global computer network and wireless devices; electrical communication apparatus, electrical publishing, record, electrical circuit and CD-ROM to which music program is stored, cinema film, recorded video disc, optical apparatus, Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; CD-ROMs; digital video discs; video tapes and cassettes; records; photographic transparencies and photographic and cinematographic films prepared for exhibition purposes; pre-recorded sound storage media, image storage media and data storage media; audio recordings; video recordings; audio-visual recordings featuring music and musical-based entertainment; musical sound recordings; musical video recordings; motion picture films; animated cartoons; downloadable and streamable audio and video recordings; downloadable and streamable sound recordings and audio-visual recordings featuring music and musical-based entertainment; downloadable and streamable music and music video recordings; downloadable music files; downloadable and streamable digital music provided from the internet or from a computer database; digital music downloadable provided from MP3 internet web sites; downloadable and streamable MP3 files, ring tones, graphics, games, images and video images; screen savers; computer software and programs; downloadable computer software; computer application software; computer games programs; computer application software for mobile communication devices; downloadable electronic publications; downloadable and streamable podcasts in the field of music; electronic storage media; memory cards; eye glasses, spectacles and sunglasses and cases, chains, straps, cords and frames therefor; cameras; holograms; computer mouse mats and pads; telecommunications apparatus; mobile phones; parts and accessories for mobile

phones and personal electronic devices; covers and cases for mobile phones and personal electronic devices; holders adapted for mobile phones; straps for mobile phones; covers and cases specially adapted for PDAs, MP3 players, laptops and gaming devices; headphones; earphones; magnetic or encoded cards; payment cards; telephone cards; magnets; parts and fittings for all of the aforesaid goods.

Class 35

Advice in the field of business management and marketing services in the fields of music, entertainment and media; advertisement; Advertising; business management; business administration; office functions; management services to musicians and recording artists; management and promotion of performing artists; public relations and publicity services; marketing services; promotional services; preparation, publication and distribution of promotional material; production of promotional audio and video recordings; production of advertising films; organisation, arrangement and conducting of events and exhibitions for commercial or advertising purposes; advertising via the Internet; provision of advertising space; provision of space on web sites for advertising goods and services; operation and supervision of membership schemes; organisation, operation and supervision of loyalty and incentive schemes; data processing; Retail services connected with the sale of badges, signs, plaques, ornaments, figurines, works of art, money boxes, key chains, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, CD-ROMs, digital video discs, audio tapes and cassettes, video tapes and cassettes, records, photographic transparencies and photographic and cinematographic films prepared for exhibition purposes, pre-recorded sound storage media, image storage media and data storage media, audio recordings, video recordings, audio-visual recordings featuring music and musical-based entertainment, musical sound recordings, musical video recordings, motion picture films, animated cartoons, downloadable and streamable audio and video recordings, downloadable and streamable sound recordings and audio-visual recordings featuring music and musical-based entertainment, downloadable and streamable music and music video recordings, downloadable music files, downloadable and streamable digital music provided from the internet or from a computer database,

digital music downloadable provided from MP3 internet web sites, downloadable and streamable MP3 files, ring tones, graphics, games, images and video images, screen savers, computer software and programs, downloadable computer software, computer application software, computer games programs, computer application software for mobile communication devices, downloadable electronic publications, downloadable and streamable podcasts in the field of music, electronic storage media, memory cards, cameras, holograms, computer mouse mats and pads, telecommunications apparatus, mobile phones, parts and accessories for mobile phones and personal electronic devices, mobile phone accessory charms, covers and cases for mobile phones and personal electronic devices, holders adapted for mobile phones, straps for mobile phones, covers and cases specially adapted for PDAs, MP3 players, laptops and gaming devices, headphones, earphones, magnetic or encoded cards, payment cards, telephone cards, magnets, jewellery, costume jewellery, precious stones, horological and chronometric instruments, printed publications, printed publicity and promotional material, books, magazines, periodical publications, newsletters, brochures, manuals, letterheads, posters, leaflets, forms, programmes, printed music, music scores, music books, instruction guides, music in sheet form, comic books, catalogues, certificates, menus, stationery, writing paper, writing pads, drawing pads, notelets, note pads, note books, cards, postcards, greeting cards, envelopes, labels, trading cards, collectors' cards, stickers, transfers, decalcomanias, stencils, tickets, gift vouchers, diaries, address books, appointment books, albums, photograph albums, scrap books, folders, wall charts, maps, personal organisers, calendars, paper and cardboard boxes, tablecloths and napkins, place mats and coasters, paper towels, gift bags and bags for packaging, carrier bags, wrapping paper, gift tags, flags and banners, bookmarks, pens, pencils, pencil sharpeners, erasers, rulers, paint brushes, signs and advertisement boards, paper and cardboard, prints and pictures, graphic prints, representations and reproductions, wall art, money clips, trunks and travelling bags, umbrellas, parasols and walking sticks, luggage, cases, garment bags for travel, brief cases, bags, rucksacks, backpacks, holdalls, purses, wallets, card holders, credit card cases and holders, ID card holders, key cases, collars, covers, leads and leashes for animals, picture frames, photograph frames, combs, brushes, glassware, porcelain, pottery and earthenware, drinking vessels, cups,

mugs, bottle openers, corkscrews, flasks, bed and table covers, textile piece goods, textiles for making articles of clothing, household textile articles, towels, clothing, footwear, headgear, articles of outer clothing, t-shirts, shirts, sweatshirts, tank tops, sweaters, cardigans, hooded pullovers, jerseys, sweatpants, track suits, shorts, trousers, pants, jeans, blouses, skirts, dresses, vests, ties, waistcoats, suits, jackets, coats, overcoats, rainwear, sleepwear, underwear, swimwear, socks, hosiery, scarves, gloves, shoes, boots, sandals, flip-flops, slippers, hats, caps, sun visors, headbands, wristbands, belts, badges and patches of textile materials, belt clasps, brooches, buckles, hat ornaments, hair ornaments, shoe ornaments, lanyards for wear, games and playthings, toys, gymnastic and sporting articles, whistles, playing cards, confetti, balloons, party novelties, dolls, action figure toys, food products, confectionery, snack foods, drinks, matches and lighters; information, advisory and consultancy services in relation to all of the aforesaid; promotion of entertainment and events; entertainment promotion services. Distribution of consumer-generated product reviews and advertisements; offering advertising consulting and agency services; providing public relations services; marketing consulting; providing business marketing information, namely, aggregating content from blogs, feeds, and/or news sources; dissemination of advertising matter; promoting the goods and services of others over the Internet through the identification and acceleration of online blogs that refer to said goods and services; providing online directory information services also featuring hyperlinks to other websites; providing searchable online advertising information featuring the goods and services of others; providing searchable, targeted online commercial information directories via the Internet; providing a service that enables consumer-to-consumer referrals and recommendations in the field of general consumer entertainment, merchandise and services via the Internet; providing a service to facilitate the sharing of general product information from consumer-to-consumer via the Internet; providing a service to facilitate the sharing of general entertainment and content to consumer via the Internet; promoting the goods and services of others by means of online consumer-to-consumer communications; promoting the goods and services of others by means of grassroots word-of-mouth marketing via the Internet; direct marketing, namely, organisation of direct consumer-to-consumer promotional and advertising campaigns via global computer networks; advertising and publicity

services; advertising through all public communication means; developing promotional campaigns for business; Advertising; marketing; publicity and promotional services; classified advertising services.

Class 41

Digital video, audio and multimedia entertainment publishing services, Motion picture film production, Music entertainment services entertainment, namely, providing sound and audiovisual recording in the field of music and musical based entertainment; Providing information on musical artists via a website over a global computer network ; arranging tours for musical artists, sports athletes and entertainers; sound recordings; popular culture and events and musical based entertainment; Provision of information on musical artists, sound recordings, popular culture and events and musical based entertainment via a website over a global computer network. Sound recordings, popular culture and events and musical based entertainment; distribution of digital programs, namely, online radio and television programs, music publishing services; desktop publishing for others; multimedia publishing of books, magazines, journals, software, games, music, and electronic publications; producing video for education, culture, entertainment, and sports; provision of studio for audio and visual; provision of amusement facility; rental of cinema apparatus, cinema film, and music instrument; rental of record and recorded magnetic tape, rental of toys; shooting of photograph; rental of camera; rental of optical apparatus. Entertainment; cultural activities; musical entertainment; music performance services; provision of live music; musical concert services; organisation, and production of entertainment and events; organisation, production and presentation of shows, staged events, concerts, live performances, musical performances, theatrical performances, dancing displays, audience participation events and talent shows; organisation of parties and social events; music festival services; entertainment services provided at nightclubs and discotheques; entertainment and education services provided via the Internet and other computer and communications networks; entertainment services provided from a web site featuring music, musical performances, musical videos, photographs, games and other multimedia materials; providing on-line electronic publications, providing on-line music and video recordings, providing digital music from the internet and other computer and communications networks; provision of

digital music from MP3 web sites; information services relating to music; booking and ticketing services for entertainment and cultural events; reservation services for concert and entertainment event tickets; ticket information services for concerts and entertainment events; DJ services; fan club services; arranging, organising and conducting of games, contests and competitions; publishing services; music publishing services; sound recording and video entertainment services; television and radio entertainment services; provision of music studios; provision of recording studio services and facilities; audio and video recording services; music recording services; music production services; film and video production, publication and distribution; production, presentation and distribution of audio and video recordings; information, advisory and consultancy services relating to all of the aforesaid; organisation, arrangement and conducting of conferences, conventions and seminars for commercial or advertising purposes. music performance services; provision of live music; musical concert services; organisation, and production of entertainment and events; organisation, production and presentation of shows, staged events, concerts, live performances, musical performances, theatrical performances, dancing displays, audience participation events and talent shows; organisation of parties and social events; music festival services; entertainment services provided at nightclubs and discotheques; Entertainment services, namely development, creation, production and post-production of website content on a wide variety of topics; providing news on a wide variety of topics; providing information on a wide variety of topics for entertainment, training, education, news and publishing purposes; providing a service that displays trending news and information content based on social media for entertainment purposes via the Internet; providing a service featuring user generated content for entertainment, training, education, news and publishing purposes via the Internet; Multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, and video; Entertainment services, namely, providing a web site featuring video presentations featuring news and information on a wide variety of topics; film production and distribution; provision of entertainment; provision of information relating to entertainment; organisation of entertainment events, competitions, quizzes, games and recreational and cultural activities; all the aforesaid services also provided on-line from a computer database or from the Internet; information

services provided on-line from a computer database or from the Internet relating to popular culture, namely music, fashion shows, social commentary, film and television.