

O/474/20

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003354360

IN THE NAME OF SENSO-REX LTD

FOR THE FOLLOWING TRADE MARK:

GRAVITY

IN CLASS 10

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 502497 BY GRAVITY PRODUCTS LLC

BACKGROUND AND PLEADINGS

1. SENSO-REX LTD (“the proprietor”) is the owner of trade mark registration no. 3354360 for the mark **GRAVITY** (“the Contested Mark”). The Contested Mark was filed in the UK on 18 November 2018 and was registered on 8 February 2019. It stands registered for the following goods:

Class 10 Therapeutic weighted blankets; Blankets for medical purposes.

2. On 12 March 2019, Gravity Products LLC (“the applicant”) applied to have the Contested Mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The applicant relies upon sections 5(2)(a), 5(2)(b), 5(4)(a) and 3(6) of the Act.

3. Under section 5(2)(a) of the Act, the applicant relies upon the following trade marks:

GRAVITY

IR designating the EU no. 1410443

Registration date 5 June 2018

Designation date 5 June 2018

Priority date claimed 19 January 2018 (United States of America)

Relying upon all goods for which the earlier mark is registered, namely:

Class 24 Bed blankets.

(“the First Earlier Mark”)

G R A V I T Y

IR designating the EU no. 1410681

Registration date 5 June 2018

Designation date 5 June 2018

Priority date claimed 22 January 2018 (United States of America)

Relying upon all goods for which the earlier mark is registered, namely:

Class 24 Bed blankets.

(“the Second Earlier Mark”)

4. Under section 5(2)(b) the applicant relies upon the Second Earlier Mark only. Both earlier marks are pending registrations.

5. The applicant claims that there is a likelihood of confusion because the marks are identical or similar and the goods are identical or similar.

6. Under section 5(4)(a) of the Act, the applicant relies upon unregistered rights in the signs shown in paragraph 3 above. The applicant claims to have used these signs throughout the UK since April 2017 in relation to “blankets; weighted blankets; duvet covers; pillow covers”.

7. Under section 3(6) of the Act, the applicant claims that the Contested Mark was filed in bad faith on the basis that the proprietor had prior knowledge of the applicant’s use of the signs relied upon and that the purpose of the registrations was to disrupt the applicant’s business.

8. The proprietor filed a counterstatement denying the claims made.

9. The applicant is represented by Kilburn & Strode LLP and the proprietor is unrepresented. Both parties filed evidence in chief. The applicant also filed evidence in reply. No hearing was requested but both parties filed written submissions in lieu. I have read the parties submissions in full and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

EVIDENCE

Applicant’s Evidence in Chief

10. The applicant filed evidence in the form of the witness statements of Emma Victoria Wilson dated 23 September 2019 and Michael Grillo dated 20 September 2019.

11. Ms Wilson is the Chartered Trade Mark Attorney acting on behalf of the applicant in these proceedings. I have read Ms Wilson’s evidence in its entirety, but summarise it here only to the extent that I consider necessary.

12. Ms Wilson has provided a print out from Companies House confirming the directors of the proprietor.¹

13. Ms Wilson has provided various documents relating to other proceedings between the parties and, she states, associated third parties.² The majority of these date from August and October 2018. All of these (apart from those concerning the present proceedings) relate to EUIPO proceedings. Ms Wilson has also provided a range of protest letters in relation to other proceedings concerning the applicant.³ Only 2 of these appear to have been sent by one of the directors of the proprietor, both of which are identical and dated 7 August 2018. The letter states:

“Our company distributes Gravity blankets in the UK. Registering the exclusive right to use the trade marks under numbers 1410443 and 1410681 by Gravity Products LLC will impede our possibility to conduct commercial activity. We file opposition to the registration of the exclusive right to use the “Gravity” trademark in class 10 and 24. In addition, we would like to point out that the term “gravity blanket” is a generic name and just as the name “down blanket” should not be reserved for the use of only one company.”

14. Ms Wilson has provided a print out of an internet search dated 19 September 2019 for the term “bed blankets”. Ms Wilson notes that the results show a range of blankets including weighted blankets and bed blankets.⁴ Ms Wilson also states that the results show “blankets for medical purposes”, however, I see no examples of these in the search results. The only reference I have identified is under the heading “related searches” which states “blanket bed in hospital”.

15. A print out from the proprietor’s website has been provided which is undated save for the print date of 20 September 2019.⁵ The print out describes the proprietor’s goods as follows:

¹ Exhibit EVW2

² Exhibits EVW3 to EVW5

³ Exhibits EVW8

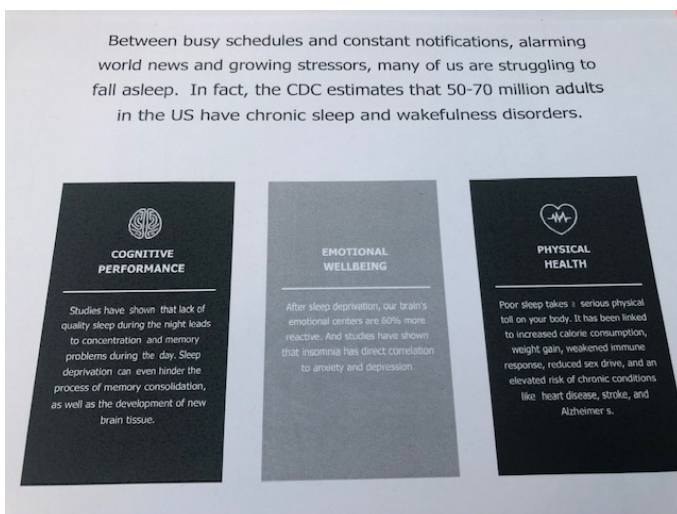
⁴ Exhibit EVW6

⁵ Exhibit EVW7

“A gravity blanket® is a high quality handmade blanket that can help with sleep disorders, restlessness, as well as developmental disorders such as ADHD, Down Syndrome, Asperger syndrome or autism.”

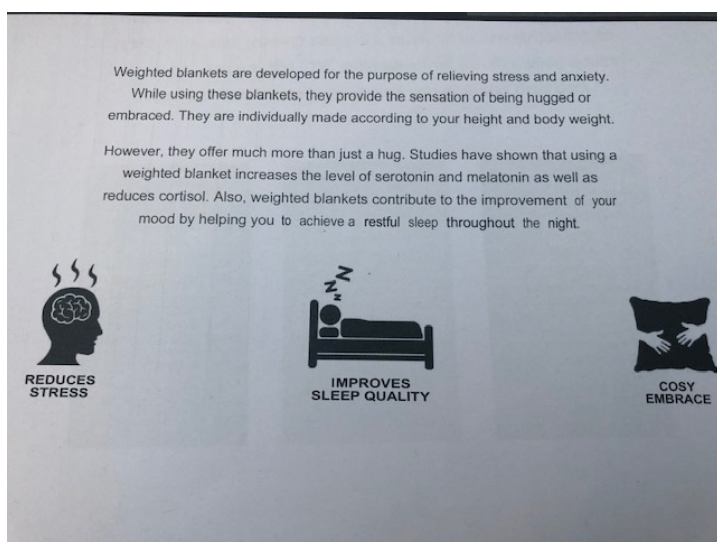
Ms Wilson notes that this demonstrates that the term “blankets” can be used to describe all types of blankets, irrespective of their specific use.

16. Ms Wilson has provided print outs from both the applicant’s website and the proprietor’s website, both of which are undated.⁶ She states that there are a number of similarities between them, including layout, format, text and stylisation. These images are from the applicant’s website:



⁶ Exhibit EVW10

These images are from the proprietor's website:



17. Ms Wilson has provided print outs from an Internet Archive in relation to the applicant's and proprietor's websites.⁷ Ms Wilson states that the applicant's website has been in use since early 2017. These print outs list the respective web addresses for each site and display a calendar. The print out for the proprietor's website (gravityblankets.co.uk) states "saved 8 times between August 10, 2018 and January 2, 2019". The print out for the applicant's website states "saved 205 times between April 24, 2017 and August 18, 2019". It is not clear to me what these results are

⁷ Exhibit EVW11

intended to indicate. No explanation is provided as to what is meant by “saved” and no images of the actual websites as at those dates are provided.

18. Mr Grillo is the co-founder and CEO of the applicant, a position he has held since April 2017. Mr Grillo explains that the applicant offers a range of wellness products, includes a weighted blanket for sleep, stress and anxiety sold under the GRAVITY mark.

19. An email exchange between Mr Grillo and Mr Goliszek, the proprietor’s Director, which took place on 21 May 2018, confirms that the proprietor was made aware of the applicant’s claim to rights in the name GRAVITY.⁸ An email from Mr Goliszek to Mr Grillo states:

“Can you indicate me the legal documents confirming the registration of the trademark. By creating out GravityBlankets Europe store and brand, we reviewed all registries of registered trademarks and we did not find an entry on the “GravityBlankets” brand protection.

Also note that all materials used on our site are our own and our own materials. The logotype also differs from yours to the extent required by trademark law.

Please note that we operate in Europe. We do not plan to expand our operations to America. That’s why I do not see a conflict of our interests here.

I see, however, the possibility of cooperation. As far as I know, you are not now able to open your sales to Europe.

We are interested in cooperation. We can handle your orders from Europe if you have one.

Our factory is located in Poland and we have great production capabilities.

⁸ Exhibit 1 to the witness statement of Mr Grillo

I am sorry that we met in this situation. However, I hope that it does not close us the way of further cooperation.”

20. Mr Grillo explains that the applicant was notified in March 2019 that the proprietor had filed a take-down notice with Amazon, claiming that the goods sold on the applicant’s Amazon platform were infringing the proprietor’s trade mark.⁹ Mr Grillo states:

“4. Given the knowledge by Senso-Rex Ltd of Gravity Products LLC’s earlier rights, their numerous applications and registrations, oppositions, fake letters and Amazon take down notice clearly constitute an attempt at guerrilla tactics to under Gravity Products LLC’s business and disrupt their presence in the marketplace.”

Proprietor’s Evidence in Chief

21. The proprietor filed evidence in the form of the witness statement of Mateusz Goliszek dated 23 December 2019. Mr Goliszek is a Director of the proprietor. I have read Mr Goliszek’s evidence in its entirety and summarise it only to the extent that I consider necessary. Mr Goliszek explains that he is also the Director of a business called Synapsa Med Sp. Z o.o (“Synapsa”). Mr Goliszek states that Synapsa was originally incorporated in 2013 as Vulgaris Magistralis Sp. Z o.o and changed its name to Synapsa in 2016.

22. Mr Goliszek explains that Synapsa owns shares in the proprietor company and that Synapsa has been using the Contested Mark since 2013 in relation to medical and therapeutic weighted blankets in the EU. Mr Goliszek has provided a range of documents to demonstrate this, however, they are mostly in another language, have no clear connection to the proprietor and/or are undated.¹⁰ Notwithstanding this, I note that what Mr Goliszek describes as “sales statements”, records sales in relation to “kolderka Gravity” as early as 2016. Although this document is entirely in Polish, I will

⁹ Exhibit 2 to the witness statement of Mr Grillo

¹⁰ Attachments 2, 3, 4 and 7 to Mr Goliszek’s statement

return to the relevance of this below. I note that there is a page in English which shows a “Senso-Rex Gravity Blanket” for sale.¹¹ However, this is undated. A print out has also been provided which shows a “Gravity blanket” available for sale on amazon.co.uk.¹² This shows that the product was first made available in March 2018. Unfortunately, the page showing sales connected with this platform is in extremely small font and illegible.

23. Mr Goliszek has provided a leaflet which displays the mark “GRAVITY”, as well as images of blankets.¹³ The leaflet is in another language, but it is clearly dated 2016 and refers to Synapsa. Further documents have been provided, but these are either not translated or are not clearly linked to the proprietor.

24. Mr Goliszek has provided a print out from the applicant’s website which is dated December 2019.¹⁴ It displays a post marked “8 months ago” (presumably, around March 2019) which states “Currently, we are only shipping to the US and Canada for orders made on our website.” It goes on to state “for those located in the UK, we are now available on Amazon EU”.

25. Mr Goliszek has also provided a print out that he states is the applicant’s product for sale on Amazon.¹⁵ This confirms that the product has been available for sale since 26 March 2018. However, there does not appear to be any clear link with the applicant. The printout itself is dated December 2019 and I note that the print out states that there are “6 customer reviews”. The three visible reviews are dated 23 June 2019, 13 November 2019 and 10 July 2019.

Applicant’s Evidence in Reply

26. The applicant filed evidence in reply in the form of the second witness statement of Ms Wilson dated 7 May 2020. I have read Ms Wilson’s statement in its entirety and summarise it here only to the extent that I consider necessary.

¹¹ Attachment 3 to Mr Goliszek’s statement

¹² Attachment 5 to Mr Goliszek’s statement

¹³ Attachment 3 to Mr Goliszek’s statement

¹⁴ Attachment 9 to Mr Goliszek’s statement

¹⁵ Attachment 10 to Mr Goliszek’s statement

27. Ms Wilson notes that much of the proprietor's evidence is in Polish. As such, Ms Wilson notes that it has not been possible for the applicant to validate or comment upon this evidence.

28. Ms Wilson notes that although the proprietor claims to have launched the sale of products under the Contested Mark in 2013, no evidence has been provided to support this claim. Ms Wilson also notes:

“6. In paragraph 2 of Mateusz Goliszek's witness statement, the Registrant claims that Vulgaris Magistralia sp. z o.o changed its name to Synapsa z.o.o in July 2016. Polish attorneys have confirmed from a check of the Polish company's register that the name changed on 2nd September 2016 and that the scope of the business also changed. The scope of the business prior to 2nd September 2016 included IT services, IP services and agriculture. This casts doubt on the Registrant's claims that this entity was using the GRAVITY mark in connection with blankets in 2013.”

29. Mr Wilson also states:

“8. [...] The Registrant claims that “kolderka” translates as “blanket”. However, this actually translates as quilt or small duvet. The Polish word for blanket is “koc”, as shown in Exhibit EVW11.”

30. Ms Wilson states that the applicant filed evidence of use of the mark relied upon in their “original submissions e.g. the article from The Independent”. However, no such article has been filed in evidence in these proceedings. It is not clear to me, therefore, what this is a reference to. Ms Wilson goes on to state that sales in the UK occurred through the “Kickstarter” campaign.

31. Ms Wilson has provided a spreadsheet which she states details sales of blankets made through that campaign.¹⁶ The orders are all dated 2017 and display the words

¹⁶ Exhibit EVW3

“gravity-blank” in the “item” column. The addresses all indicate locations around the UK and the total amount of units ordered is over 300.

PRELIMINARY ISSUES

Translations

32. When the proprietor filed its evidence on 18 December 2019, its covering email stated as follows:

“We need much more time to translate evidence from various languages to English. It is necessary to show the time and scope of Gravity trademark use.

We are convinced that additional 2 months will be enough.”

33. Subsequently, the proprietor filed a Form TM9R requesting a 12 month extension of time in which to file the translations required. This was not originally copied to the applicant.

34. Once the Form TM9R had been copied to the applicant, on 5 February 2020, the Tribunal wrote to the proprietor to note that multiple documents filed were in a foreign language. The letter stated: “For the content of these documents to be considered a translation must be provided. The translation must be provided by a person competent to do so. The translator must provide a witness statement to which they refer to the exhibits and explain their suitability to provide translation.” It went on: “Some of the exhibits are unclear when printed due to their size. Please could a clearer copy be provided.” A deadline of 24 February 2020 was set for the proprietor to respond.

35. On 19 February 2020, the proprietor requested a hearing to challenge the Tribunal’s preliminary view. A Case Management Conference (“CMC”) was held on 20 April 2020. Following the CMC, the proprietor’s request for an extension of time was refused. The Hearing Officer stated:

“In reaching this view, I have borne in mind that the original deadline for the registered proprietor to file its evidence was 23 December 2019. It is now over four months since that date. Nowhere in the registered proprietor’s submissions does it give an indication that there has been any progress at all as regards the gathering of translations in relation to the evidence already filed. It should not take four months to translate documents, let alone twelve months. I have borne in mind the current COVID-19 situation. However, the impact of that situation did not hit until March 2020 and therefore I do not see why it would have impeded the proprietor’s ability to provide translations of the evidence it has already filed, and by the granted extension deadline of 24 February 2020.

The registered proprietor states, in its submissions in lieu (paragraphs 3 and 4), that it has had difficulty in obtaining evidence of use of the trade mark registration from the previous shareholders of its business. It is said that those individuals are purposefully withholding that information from the registered proprietor. The registered proprietor states that it is “preparing lawsuit” against those individuals to obtain the required evidence of use and that it is expected that those legal proceedings should be concluded within twelve months. However, as Ms Wilson pointed out, there had been, prior to the written submissions in lieu, no mention of this issue on the Form TM9R. Furthermore, the registered proprietor has not given any information regarding the nature of the legal proceedings, where they are to take place nor any supporting documentation to show that they have yet been launched or even discussed with relevant legal representatives. I am not therefore prepared to delay the instant proceedings on that basis.

As to the registered proprietor’s contention that the instant proceedings should be suspended for twelve months because the two earlier marks of the applicant relied upon under Section 5(2) of the Act are subject to opposition at EUIPO, this is noted. However, the applicant also relies upon other grounds under Section 5(4)(a) and 3(6) of the Act. There is, therefore, currently no reason to suspend.”

36. These proceedings have, therefore, proceeded on the basis of the evidence initially filed by the proprietor and without the translations required to consider all of the documentation relied upon.

Status of the Earlier Marks

37. As noted above, the earlier marks relied upon for the purposes of the application based upon sections 5(2)(a) and 5(2)(b) of the Act are pending applications. They have not yet been registered. Consequently, any decision in the applicant's favour based on these marks could only be provisional, subject to successful registration of the earlier marks relied upon.

Evidence of Polish Attorney

38. As noted above, Ms Wilson has given evidence that a Polish Attorney has confirmed a change in the business scope of the proprietor, as recorded on the Polish Companies Register. This appears to me to be hearsay evidence. No explanation is given as to why the Polish attorney could not have given evidence him/herself. In any event, to the extent that the prior use of the applicant is relevant to these proceedings, it is the activities actually undertaken and not the scope recorded on any Register which is relevant to that assessment.

Other EU Rights

39. In his written submissions in lieu, the proprietor states:

“7. We draw your attention to the fact that after Brexit, Gravity word trade mark EUTM-017982729 will become valid UK trade mark. Synapsa Med sp. z.o.o will be entitled enterprise to use Gravity trade mark with reference to Therapeutic weighted blankets and Blankets for medical purposes within territory of UK.”

40. It is, of course, correct that an eligible EU registration will automatically become a UK national right following the end of the transition period. However, this does not impact upon the question of the validity of the Contested Mark; they are separate

registrations. I do not, therefore, consider that this line of argument assists the proprietor.

DECISION

41. Sections 3 and 5 of the Act have application in invalidation proceedings because of the provisions set out in section 47. The relevant legislation is set out below:

“47. –[...]

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

[...]

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) ...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.”

Sections 5(2)(a) and 5(2)(b)

42. Section 5(2) of the Act reads as follows:

“(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the trade mark is protected

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

43. As the earlier marks had completed their registration process less than 5 years before the date on which the invalidation application was made, they are not subject to proof of use. The trade marks upon which the applicant relies qualify as earlier trade marks pursuant to section 6 of the Act as they were filed prior to the Contested Mark.

44. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of trade marks

45. The respective trade marks are shown below:

Applicant's trade marks	Proprietor's trade mark
<p data-bbox="360 1133 628 1223">GRAVITY (First Earlier Mark)</p> <p data-bbox="272 1294 719 1442">G R A V I T Y (Second Earlier Mark)</p>	<p data-bbox="1027 1133 1171 1162">GRAVITY</p>

46. The applicant relies upon both earlier marks for the purposes of its claim under section 5(2)(a). As it is a prerequisite of section 5(2)(a) that the marks be identical, I will begin by assessing whether they are identical within the meaning of the case law.

47. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ("CJEU") held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer”.

48. Both the First Earlier Mark and the Contested Mark consist of the word GRAVITY. These marks are, self-evidently, identical.

49. In its pleadings, the applicant states:

“12. The Applicant's GRAVITY mark is slightly stylised in relation to the third letter which replaces the normal letter A by omitting the horizontal line across the middle of the letter. As this is an immaterial difference, visually the marks are identical. If not identical, they are highly similar. Aurally and conceptually, the marks are identical. Overall, the marks are identical. Further, or in the alternative, the marks are highly similar.”

50. The Second Earlier Mark consists of the letters GR-VITY, with an upside down V shape representing the letter “A”. Clearly, the mark is intended to represent the word GRAVITY, which is the same as the Contested Mark. However, I do not consider that the change to the letter A will go unnoticed by the average consumer. Consequently, I do not consider these marks to be identical. The application for invalidation based upon section 5(2)(a) in relation to the Second Earlier Mark must, therefore, fail.

51. I will now consider the similarity of the Second Earlier Mark to the Contested Mark for the purposes of the application based upon section 5(2)(b). It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

52. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

53. Visually, the marks both share the common letters GR-VITY. The point of visual difference is that the letter A appears in the Contested Mark, but its counterpart in the Second Earlier Mark is an upside down V-shape. Although these elements differ, they still share a degree of visual similarity. Overall, I consider the marks to be visually highly similar.

54. Aurally, the Contested Mark will be given its ordinary English pronunciation i.e. GRA-VIT-TEE. Taking into account the propensity of the average consumer to attempt to identify words in trade marks, I consider that the upside down V-shape in the Second Earlier Mark is likely to be interpreted as the letter A. Consequently, I consider the Second Earlier Mark will be pronounced identically to the Contested Mark. The marks are aurally identical.

55. Conceptually, the Contested Mark will be attributed its ordinary dictionary meaning i.e. the force which causes things to drop to the ground. Although the word itself does not appear in the Second Earlier Mark (because the letter A is replaced with an upside down V-shape), I consider that this word will still be identified in the Second Earlier Mark. Consequently, I consider the marks to be conceptually identical.

Comparison of goods

56. The competing goods are as follows:

Applicant's goods	Proprietor's goods
<u>Class 24</u> Bed blankets.	<u>Class 10</u> Therapeutic weighted blankets; Blankets for medical purposes.

57. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

58. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

59. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

60. I note that the applicant has filed evidence relating to an internet search for the term “bed blankets”. For the avoidance of doubt, the results returned by a search engine are not relevant to my assessment of the similarity of the goods. No explanation or evidence has been provided as to what algorithm is used to identify those search results and, in any event, I am required to undertake the assessment based upon the factors outlined in the case law set out above. Ms Wilson notes that the term “blankets” is broad enough to cover all blankets, irrespective of their use. That may well be the case. However, neither mark covers “blankets” per se and so I do not consider this line of argument to assist the applicant.

61. The uses of the goods overlap to the extent that they are both used as a covering. However, their specific uses differ to the extent that the proprietor’s goods are used

for therapeutic or medical purposes, whereas the applicant's goods are used to cover a bed. The users of the goods are likely to overlap, in that both could be used by members of the general public. However, the proprietor's goods will also be used by medical professionals. The physical nature of the goods is likely to be very similar, although the proprietor's goods may have some additional properties that make them suitable for their purpose (such as being made of particular materials). There may also be overlap in method of use. I do not consider it likely that there will be overlap in trade channels. Given the different specific purposes of the goods, I do not consider it likely that they will be in competition, nor do I consider them to be complementary.¹⁷ Overall, I consider this to amount to between a medium degree of similarity.

Average consumer and the nature of the purchasing act

62. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

63. The average consumer for the goods will be either a member of the general public or a medical professional. Various factors will be taken into consideration for both the proprietor's and applicant's goods, such as suitability for purpose, durability and

¹⁷ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

material. I recognise that for medical goods, additional therapeutic considerations may play a part. The cost of the purchase is likely to vary, but will not be particularly high. Taking all of this into account, I consider that at least a medium degree of attention will be paid during the purchasing process.

64. The average consumer will purchase the goods either by self-selection from a retail outlet or a specialist provider, or from their website or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, given that orders may be placed over the telephone and advice may be sought from retail assistants.

Distinctive character of the earlier marks

65. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

66. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use made of it.

67. The applicant has not pleaded that its marks have acquired enhanced distinctive character through use, nor do I consider the evidence filed to support such a finding. The only documents filed by the applicant that relate to actual use of the earlier marks, are print outs of the applicant’s website and information about orders placed in 2017. I recognise that the orders from 2017 are geographically widespread in that they have been delivered to addresses around the UK. However, no information about market share is provided. Orders of over 300 blankets are not, to my mind, likely to represent a significant proportion of the market. Further, no information about advertising expenditure has been provided. I note that the proprietor has also filed evidence about the applicant’s use in the form of a print out from Amazon, which states products have been available since March 2018. However, it is not clear how many sales have been made. Only 6 reviews are recorded, and the only visible reviews are dated after the relevant date. I do not consider the evidence filed to be sufficient to justify a finding of enhanced distinctive character.

68. I have, therefore, only the inherent position to consider. The First Earlier Mark consists of the ordinary dictionary word GRAVITY. This word does not appear to have any connection with the goods for which the mark is registered. I recognise that there is some reference in the evidence to the fact that ‘gravity blankets’ is a term used to describe weighted blankets. However, this is only a comment made in a letter in relation to other proceedings, and no evidence has been filed to support this finding. I consider the mark to be inherently distinctive to a medium degree. The Second Earlier Mark consists of the letters GR-VITY, separated by an upside down V-shape. I consider that this is likely to be seen as representing the letter A and, overall, the mark

will be seen as representing the word GRAVITY. I consider the Second Earlier Mark to be inherently distinctive to a slightly higher than medium degree.

Likelihood of confusion

69. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

70. I have found the First Earlier Mark and the Contested Mark to be identical. I have found the Second Earlier Mark and the Contested Mark to be visually similar to a high degree and aurally and conceptually identical. I have identified the average consumer to be a member of the general public or a medical professional who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that at least a medium degree of attention will be paid during the purchasing process. I have found the First Earlier Mark to be inherently distinctive to a medium degree and the Second Earlier Mark to be inherently distinctive to a slightly higher than medium degree. I have found the goods to be similar to between medium degree.

71. Taking all of the above factors into account, particularly the fact that the marks are identical or highly similar, I consider that there is a likelihood of direct confusion. Bearing in mind the interdependency principle, I consider that the similarity between

the marks is sufficient to offset the fact that there is only between a medium degree of similarity between the goods. For the avoidance of doubt, I consider this to be the case even where a higher degree of attention is being paid. In my view, the marks are likely to be mistakenly recalled or misremembered as each other.

72. The applications for invalidity based upon sections 5(2)(a) and 5(2)(b) are successful.

Section 5(4)(a)

73. Section 5(4)(a) of the Act states as follows:

“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, where the condition in subsection (4A) is met,

aa)...

b) ...

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

74. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

75. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant Date

76. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether

the position would have been any different at the later date when the application was made.”

77. The first relevant date is clearly the date of filing of the Contested Mark i.e. 18 November 2018. However, there is also some reference in the evidence to the proprietor having used the Contested Mark as early as 2013. This claim is challenged by the applicant.

78. At best, the proprietor’s evidence shows use of the Contested Mark in the UK on Amazon in March 2018. I note that there is an example of a leaflet which is dated 2016 and which displays the Contested Mark. However, there is no information provided about where or how widely this leaflet was distributed (if at all). The leaflet is in a different language and, to my mind, cannot therefore represent use in the UK. I also note that there is use on the “sales statements” as outlined above. These show use of the Contested Mark in relation to “kolderka”. Both parties have confirmed that this word, in Polish, means either blanket or quilt. However, as this document is entirely in Polish, I cannot identify the location of any customers and I see no reason to conclude that this represents use in the UK. To my mind, these are far more likely to represent use in Poland. Consequently, I will consider the position under section 5(4)(a) as at 18 November 2018 and March 2018.

Goodwill

79. The House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“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 customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

80. 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.”

81. 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.”

82. The applicant's evidence regarding the use that has been made of the signs relied upon is very limited. Its evidence in chief provides only confirmation that it had a website available as early as April 2017. I note that the applicant's website is a ".com" website as opposed to a ".co.uk" website. I also note that the proprietor also filed evidence of the applicant's product available for sale on Amazon. Whilst this print out states that the product was available from March 2018, the printout is dated December 2019 and the only visible reviews are from after both relevant dates. It is not, therefore, clear whether there was any actual trading on Amazon prior to the relevant date. In its evidence in reply, the applicant filed evidence of actual sales. The spreadsheet provided shows sales of over 300 blankets sold under the GRAVITY marks. In its written submissions in lieu, the proprietor states:

"The weighted blankets from Kickstarter program could be sold only to consumers or clients within territory of United States. None of the blankets were bought by European consumer or client."

However, the document provided by the applicant does list UK addresses for the customers who placed the orders in 2017. The proprietor notes the limited scope of this evidence, both in terms of the quantity of the sales and the time period to which they relate. Even a small business which has more than trivial goodwill can protect signs which are distinctive of that business under the law of passing off.¹⁸ However, I agree entirely that these sales are far from extensive. These sales appear to relate to only 4 order numbers, despite having different delivery addresses. I have no evidence regarding advertising and these sales relate to a period of only around 1 month in April/May 2017, some 9/10 months prior to the first relevant date, and 18 months prior to the second relevant date. As noted in the case law cited above, the burden is on the applicant to prove goodwill. I am not satisfied, based on the evidence filed, that it has done so.

83. The claim based upon section 5(4)(a) fails.

¹⁸ *Stacey v 2020 Communications* [1991] FSR 49

Section 3(6)

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

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

85. The relevant case-law covering trade mark applications made in bad faith can be found in the following cases: *Chocoladefabriken Lindt & Sprüngli*, CJEU, Case C-529/07, *Malaysia Dairy Industries*, CJEU, Case C-320/12, *Koton*, CJEU, Case C-104/18P, *Sky v Skykick*, CJEU, Case C-371/18, *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16), *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch), *Copernicus-Trademarks v EUIPO*, General Court of the EU, Case T-82/14, *Daawat Trade Mark, The Appointed Person*, [2003] RPC 11, *Saxon Trade Mark*, [2003] EWHC 295 (Ch), *Mouldpro ApS v EUIPO*, General Court of the EU, Case T-796/17, *Alexander Trade Mark, The Appointed Person*, BL O/036/18, *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and *Sky v Skykick* [2020] EWHC, 990 (Ch).

86. The law appears to be as follows:

- (a) While in everyday language the concept of ‘bad faith’ involves a dishonest state of mind or intention, the concept of bad faith in trade mark law must be understood in the context of trade: *Sky* CJEU.
- (b) Applying to register a trade mark without an intention to use it is not bad faith *per se*. Therefore, it is not necessary for the trade mark applicant to be using, or have plans to use, the mark in relation to all the goods/services covered by the specification: *Sky* CJEU.
- (c) The bad faith of the trade mark applicant cannot, therefore, be presumed on the basis of the mere finding that, at the time of filing his or her application, that

applicant had no economic activity corresponding to the goods and services referred to in that application: *Sky CJEU*.

- (d) However, where the trade mark application is filed without an intention to use it in relation to the specified goods and services, and there is no rationale for the application under trade mark law, it may constitute bad faith. Such bad faith may be established where there are objective, relevant and consistent indications showing that the applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark: *Sky CJEU*.
- (e) This may be the case where the exclusive right was sought as part of a strategy of using widely cast trade mark registrations as legal weapons for use against others in opposition proceedings and/or for the purposes of blocking applications by third parties: *Sky EWHC* and *Copernicus-Trademarks v EUIPO*.
- (f) A trade mark may be applied for in good faith in relation to some of the goods/services covered by the application, and in bad faith as regards others: *Sky CJEU*.
- (g) This may be the case where the trade mark applicant has included a specific term in the specification, such as 'computer games', with no intention of using the mark in relation to any such goods, simply to obstruct third parties from using or registering the same mark, or similar marks. It may also be the case where the applicant has included a broad term, such as 'computer software', with the intention of using the mark in relation to a particular sub-category of such goods/services, but no intention of using the mark in relation to all the other (sometimes very different) sub-categories of goods/services covered by the broad term, with the objective of obstructing third parties from using or registering the mark in relation to such goods/services: *Sky EWHC*.

(h) In deciding whether there was a rationale for registering the trade mark in relation to any particular term, it is necessary to bear in mind that trade mark proprietors have a legitimate interest in seeking protection in respect of goods or services in relation to which they may wish to use the trade mark in future (even if there were no plans to use the mark in relation to the goods/services at issue at the time of filing the application): *Sky EWHC*. It is therefore relevant to consider whether the goods/services in the contested application are related to those for which the mark has been used, or for which the applicant had plans to use the mark.

87. The following points are apparent from the pre-*Sky* case-law about registering trade marks in bad faith:

(a) Although it may be a relevant factor, the mere fact that the trade mark applicant knew that another party was using the trade mark in another territory does not establish bad faith: *Malaysia Dairy Industries*.

(b) Similarly, the mere fact that the trade mark applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55). The trade mark applicant may have reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.

(c) However, an application to register a mark is likely to have been filed in bad faith where the trade mark applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat*, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited*.

(d) An application may also have been filed in bad faith where the trade mark applicant acted in breach of a general duty of trust as regards the interests of another party, including his or her own (ex) company or (ex) partners, or a party

with whom there is, or had recently been, a contractual or pre-contractual relationship, such as a licensor, prospective licensor or overseas principal: *Saxon, Mouldpro*; or where a legal agreement prohibits such a filing.

88. The correct approach to the assessment of bad faith claims is as follows. According to *Alexander Trade Mark*, the key questions for determination in such a case are:

(a) What, in concrete terms, was the objective that the trade mark applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

89. The trade mark applicant's intention (i.e. objective) is a subjective factor which must be determined objectively by the competent authority. An overall assessment is required, which must take account of all the factual circumstances relevant to the particular case: *Lindt*.

90. The matter must be judged at the relevant date, which is the date of the application for registration: *Lindt*. In this case, the relevant date is 18 November 2018.

91. It is necessary to ascertain what the trade mark applicant knew at the relevant date: *Red Bull*. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani*.

92. A statement on the application form that the mark is in use, or there is a *bona fide* intention to use it may, if untrue, provide evidence supporting a bad faith case, but is not sufficient by itself to justify the refusal or cancellation of the registration: *Sky* CJEU.

93. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies

(i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

94. In its Statement of grounds, the applicant states:

“34. The Applicant uses the marks GRAVITY and GRAVITY (stylized) in connection with blankets and weighted blankets, which is in fact known to the Registrant. As will be evidenced in these proceedings, at the date of application, the Registrant was aware of the Applicant’s earlier trade mark rights in the mark GRAVITY and GRAVITY (stylized). This knowledge is evidenced by a number of actions, including, but not limited to:

- Correspondence between Gravity Products LLC and Senso-Rex Ltd dated 21 May 2018 onwards.
- Four oppositions filed by Synapsa Med Sp.Z. o.o. on 17 October 2018 to the Applicant’s two EU designations. The signatory for these oppositions is Joanna Goliszek, a Director of Senso-Rex Ltd.
- Two oppositions filed by Senso-Rex Ltd on 17 August 2017 to the Applicant’s two EU designations.
- Protest letters filed in relation to the Synapsa oppositions, most notably:
 - 17/08/2018 – protest letter to both designations from Joanna Goliszek, Director of Senso-Rex Ltd.
 - 14/09/2018 – protest letter and list of signatures from Workers Union at Synapsa Med Sp Z.o.o.
- Opposition by Agnes Muller to EU designation No. 1410681 GRAVITY (stylized) enclosed a letter by Niu Chan, which was identical as submitted by Senso-Rex Ltd in its oppositions.

35. All respective actions and complaints by the Registrant to the Applicant’s EU designations were dismissed by the EUIPO. The activities outlined above predate the 18 November 2018 filing date of the UK Trade Mark Registration No. 3354360 GRAVITY.

36. Assessing dishonest intent on the part of the Registered Proprietor is subjective. The Registrant sought the Registration in an attempt to circumvent the Applicant's earlier rights and disrupt their business. As will be shown in evidence, an Amazon take-down notice filed by Mateusz Goliszek (a Director of Senso-Rex Ltd) claimed that the Applicant had infringed the Registration. The Applicant's Amazon sales listings were removed as a result of the notice. The take-down notice is being contested.

37. In light of the Registrant's knowledge of the Applicant's earlier rights at the date of filing UK Trade Mark Registration No. 3354360 GRAVITY, and the various actions of Senso-Rex Ltd and its Directors, the Applicant submits that the Registration was made in bad faith. It is submitted that the Registration is liable to be invalidated within the terms of section 47(1) of the Act, by reference to section 3(6) of the Act."

95. In response to this, the proprietor claims to have been using the Contested Marks in the UK since 2013. As noted above, the earliest possible evidence of use of the proprietor's mark in the UK dates back to March 2018. However, whilst it is not clear which area the use relates to, there is evidence of use dating back to 2016 as outlined above. The proprietor submits:

"13. [...] [The Applicant] commenced the use of Gravity trade mark in 2017 within territory of United States, four years after Synapsa Med sp. o.o. started using Gravity trade mark in European Union, in particular Poland and United Kingdom in 2013. [The Applicant] started using Gravity trade mark in US on April 2017 and within territory of UK in March 2018.

14. We also note that industrial [sic] property rights are sort of territorial rights. [The Applicant] first use of Gravity trade mark within territory of US in April 2017. However he did not show any evidence to prove it. In our opinion the use within territory of US does not create the right to Gravity trade mark within territory of European Union and UK. The system of industrial [sic] property rights protects trade marks within the territory where they are being used or registered. [The Applicant] has not shown that he was using Gravity trade mark within territory

of European Union and UK earlier than Senso-Rex Ltd or Synapsa Med z.o.o. All evidence shown by [the Applicant] reveals the use within US. [...]"

96. Clearly, there was correspondence between the parties regarding their respective interests in the Contested Mark prior to the relevant date. However, it appears that throughout these conversations, the proprietor indicated that it considered itself to have prior rights in the Contested Mark which pre-dated the applicant's use within the EU. As the proprietor notes, it (correctly) understood these issues to be territorial. To my mind, this does not appear to be a case of the proprietor seeking to pre-empt the applicant's expansion into the UK market or seeking to register a mark that it knew that someone else had already been using. Rather, this appears to be a case of two unrelated parties both believing that they have the prior rights in the Contested Mark and both taking the steps that they considered necessary to protect those rights. As noted above, the evidence by both parties in terms of use is limited. As explained above, I am unable to conclude that the applicant did in fact have earlier unregistered rights in the Contested Mark in the UK at the relevant date(s). Taking all of this into account, I do not consider the proprietor's actions to amount to bad faith.

97. I note the applicant claims that there is similarity between the parties' respective websites. The proprietor, in its written submissions in lieu, notes that both have been created through WordPress software and that is the source of the similarity. I agree with the proprietor that there does not appear to be any similarities between the websites that suggests one is a copy of the other, other than the fact that both are using the same trade mark. I do not consider this line of argument to assist the applicant.

98. The application based upon section 3(6) of the Act fails.

CONCLUSION

99. This is a provisional decision because the earlier marks relied upon have not yet achieved protection and the application for invalidation has succeeded only on the basis of sections 5(2)(a) and 5(2)(b) of the Act.

100. When the status of the earlier marks changes to protected or refused, wholly or partially, I will issue a supplementary decision which will include a decision on costs. The appeal period will run from the date of the supplementary decision.

DIRECTION TO THE APPLICANT

101. I direct that the applicant inform me when the status of the earlier marks changes to protected or refused, wholly or partially.

Dated this 25th day of September 2020

S WILSON

For the Registrar