

O/695/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3493116

BY

JORDAN WRIGHT

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 41

Train Wright

AND OPPOSITION THERETO UNDER NUMBER 421433

BY

TRAIN WRIGHT LIMITED

Background and Pleadings

1. On 24 May 2020, Mr Jordan Wright (“the Applicant”) applied to register in the UK the trade mark “Train Wright” numbered 3493116 for services in class 41 as listed below. It was accepted and published in the Trade Marks Journal on 12 June 2020.

Class 41: Personal fitness training services; Personal trainer services; Personal trainer services [fitness training]; Personal training services; Fitness and exercise instruction; Fitness and exercise training services; Fitness training services; Health and fitness club services; Health and fitness training; Health and wellness training; Health club [fitness] services; Health education; Gym activity classes; Gymnasium club services; Gymnasium facilities (Provision of -);Gymnasium services; Gymnasium services relating to body building; Gymnasium services relating to weight training; Gymnasiums; Gymnastic instruction.

2. On 11 September 2020, Train Wright Ltd (“the Opponent”) issued an opposition under section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). It relies upon its unregistered signs TRAINWRIGHT and TRAIN WRIGHT which it is said, have been used throughout the UK and worldwide since 6 January 2020 in relation to “*education services, training services, teaching services, fitness instruction services and coaching services.*” The Opponent claims that as a result of it having acquired goodwill and a reputation amongst the UK public, that the use of the applied for mark would amount to misrepresentation to the relevant consumer who would mistakenly believe that those services originated from the Opponent or were somehow connected with the Opponent by way of a licensing agreement or otherwise. Furthermore, as a result of this misrepresentation, damage will be caused to the Opponent, as a minimum, by way of dilution.

3. The Applicant filed a defence and counterstatement denying the ground of opposition and putting the Opponent to strict proof of its alleged goodwill as from 6 January 2020 in relation to the services relied upon. Furthermore he contends that the signs relied upon by the Opponent are operated by Catalyst Global Limited and as such disputes that the goodwill claimed belongs to the Opponent and not any other

legal entity. The Applicant admits that the signs and services are highly similar and/or identical however denies that any damage or potential damage would be caused by the Applicant's use of the contested trade mark. It is denied that the Opponent or any connected entity has rights under passing off or the right to oppose the application under section 5(4)(a) of the Act.

4. The Applicant contends that he has used his trade mark since June 2018 in respect of the applied for services and as such has generated his own goodwill prior to the claimed use by the Opponent. In the alternative the Applicant claims that it has concurrent rights based on its use since June 2018 and therefore has an absolute defence to a claim in passing off.

5. The Applicant is represented by Howes Percival LLP and the Opponent is represented by Sheridans. Both parties filed evidence and submissions during the evidence rounds. No hearing was requested however both parties filed submissions in lieu. I do not propose to summarise the submissions here however I have taken them into account and will refer to them where necessary later in my decision. This decision is taken following the careful reading of all the papers.

Evidence

6. The Opponent's evidence consists of two statements by Mr Charles Edward Wright ("Mr MW") dated 1 February 2021 and 1 June 2021 respectively, accompanied by exhibits marked MW1-MW21. The Applicant's evidence consists of three witness statements provided by Mr Jordan Wright ("Mr JW"), Mr Jacob Sworder and Mr William Downes-Hall all of which were dated 1 April 2021. Whilst I have read the statements in their entirety, I shall only summarise the pertinent points as set out below.

The Opponent's evidence

Mr MW's First Statement

7. Mr MW is the founder, director and major shareholder of the Opponent company, he is authorised to make the statement on behalf of the Opponent and provides the statement based on information from his own knowledge or from facts taken from the Opponent's records to which he has full access.

8. Mr MW states that in early January 2020 he announced that he would be starting a new fitness education and coaching business in connection with fitness instruction and physical training programmes.¹ He states that the name of his business is TRAINWRIGHT and the brand “#TRAINWRIGHT” was launched on his Instagram account “@wrighty_” to his 1.8 million followers via two posts dated 2 and 3 January 2020.²

9. Mr MW states that in a post uploaded onto his Instagram account on 6 January 2020 he made a further reference to the brand and used the sign when promoting a training session.³

10. Mr MW states that from January 2020 onwards, various online news publications published features about the TRAINWRIGHT fitness programme. On 3 February 2020 the celebrity news website “www.hellomagazine.com” ran a story about the fitness programme referring to the sign. On 15 May 2020 “www.thesun.co.uk” ran an online story about Mr MW’s personal journey with fitness, referring to the sign within this article. On 21 May 2020, Mr MW states that the fitness programme in connection with the brand/sign was announced, in a new collaboration with the BBC where the sign was referred to. Mr MW produces copies of these articles.⁴

11. On 17 May 2020, Mr MW states that he created an Instagram account handle “@trainwright” with the intention of operating his training and fitness instruction services via social media through this medium.

12. On 22 May 2020, the entity TRAIN WRIGHT LTD (the Opponent) was incorporated. Mr MW states that all the goodwill that he generated in connection with the brand/ sign since it was created “has since been assigned to the Opponent”. The Opponent is now the operating entity of the brand/sign, dealing with all business relating to it.

¹ MW1

² MW2

³ MW3

⁴ MW4

13. Mr MW states that as a result of the marketing initiatives via his personal social media channels and third party press coverage, the brand and sign has generated significant goodwill prior to the filing date of the application.

14. In June 2020 the Opponent launched the website platform “https://thisistrainwright.com/” which is run day to day on behalf of the Opponent, by Mr MW’s brand managers, Catalyst Global Ltd.

15. Mr MW states that further goodwill was generated in the brand/sign through promotional marketing efforts from June 2020 to September 2020. Further features about the fitness/educational training programmes, which related to the brand, were published in a number of online publications to include “www.hellomagazine.com” on 29 June 2020 and “www.mirror.co.uk” and “www.express.co.uk” on 17 September 2020.⁵

16. By 20 November 2020, Mr MW states that the Trainwright Instagram page had approximately 45,000 followers and at the time of writing (by which I take to mean the date of his statement namely February 2021) the number of followers had increased to 59,300.⁶

17. The trade mark application was brought to Mr MW’s attention by his brand managers, in late May 2020. Mr MW refers to an Instagram post posted by the Applicant on 1 January 2020 under the account handle @trainwrightonline, which confirms the Applicant is employed as a personal trainer at a local gym located in Swindon.⁷

18. It is Mr MW’s understanding that the Applicant’s Instagram account was originally under the name ‘jordanacw’ until it is said he changed the handle name to ‘@trainwrightonline’ (although he is unsure as to the exact date this occurred).⁸

⁵ MW5

⁶ MW6

⁷ MW8

⁸ MW9

19. Mr MW produces extracts taken from the Applicant's Facebook page at 'www.facebook.com/TrainWrightOnline' which he states has changed its name twice since its creation in 2016. Mr Wright states that the Facebook name was changed from "J-Training – Personal Training/ Fitness Coaching" to "Jordan Wright – personal Training/ Fitness Coaching" on 21 November 2016. Furthermore, the account name was changed again to "TrainWright – Personal/ Online Training" on 22 September 2020. It is contended that this was done, only as a result of the Opponent launching its brand and following the traction it was receiving.⁹

20. Mr MW states that upon reviewing the Applicant's Facebook page, from late December 2017 until November 2019, the Applicant was operating under a different sign in connection with his personal training services, namely a logo comprising the letters 'J' and 'W' in a stylised format encased in a white circle (or sometimes a black circle) with a golden dumbbell device together with the name "Jordan Wright – Personal Training/Fitness Coaching". Mr MW produces screenshots of promotional offers posted by the Applicant on his Facebook Page using this logo dated 28 November 2019.¹⁰

21. Mr MW states that the Applicant only started using the sign TRAINWRIGHT on t-shirts as of 11 March 2020 and produces a screenshot of a post taken from the Applicant's Instagram account from this date.¹¹

22. Mr MW states that the Applicant has only made a concerted effort to move its branding away from the JW logo to TRAIN WRIGHT, from January 2020 onwards, as a direct result of the press attention the Opponent's brand was receiving.

23. Mr MW states that previously the Applicant had adopted identical branding to the TRAINWRIGHT sign, presenting it in a bold capitalised type font which is identical with/highly similar to the Opponent's. Mr MW also asserts that the Applicant adopted a similar price point for a 28 day fitness challenge, and he understands that the Applicant was not promoting similar fitness challenge services prior to the launch of

⁹ MW10

¹⁰ MW11

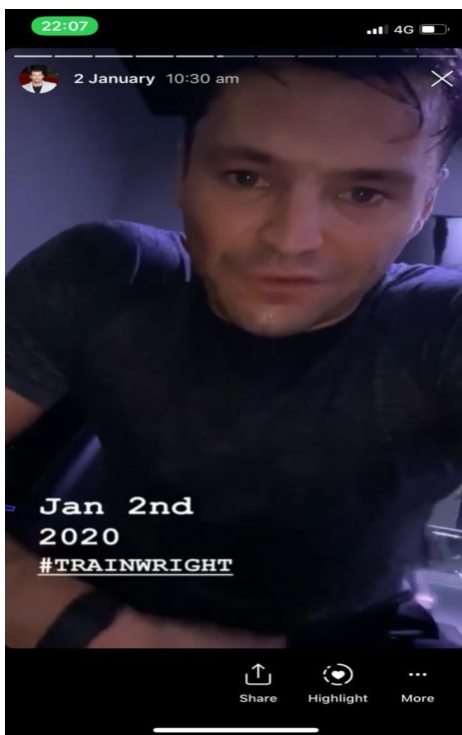
¹¹ MW13

the Opponent's Trainwright website. He states that this is evidence of the Applicant's deliberate attempt to take advantage of potential customers searching for the Opponent's brand.

24. Mr MW notes that the Applicant has changed the JW domain on his website to say 'TRAINWRIGHT est 2016' and changed it further to say 'TRAINWRIGHT est 2018'.¹² Mr MW states that web archives show that the Applicant's website was used as a holding page related to forklift driving services as of 2016 and produces a web snapshot taken on 23 March 2016.¹³

Exhibits MW1-MW16

25. MW2 consists of two screenshots (reproduced below) of posts dated 2 and 3 January 2020 taken from Mr MW's Instagram account "@wright_".



26. MW3 consists of a screenshot of a photograph taken from Mr MW's Instagram account posted on 6 January 2020. The words "@joshwright4444" and "#trainwright" are superimposed on the photograph.

¹² MW15

¹³ MW16

27. MW4 consists of the extracts of the publications referred to. The article published in Hello magazine is dated 3 February 2020 and is headed “Mark Wright shows off incredible results of weight loss after just one month.” The article refers to Mr MW taking to Instagram to show off the results of his recent weight loss. The article concludes with the following quote “FEBRUARY & ONWARDS IS YOUR TIME !! DO IT FOR YOU !! FEEL BETTER, FEEL HEALTHIER !! #**TRAIN**WRIGHT.”

28. The article published in The Sun is dated 15 May 2020 and is headed “Mark Wright reveals how he went from fat to fit – and how you can too with his lockdown workout.” On page 1, underneath a photograph of Mr MW the article states “and tomorrow he will be bringing Sun on Sunday readers an exclusive first look at his new **Train** Wright fitness plan...Mark says staying healthy and fit mentally and physically throughout life is so important... that means daily live Instagram workouts which have featured celebrity mates...My Instagram live workouts are exactly how I **train** and stay in shape.” The word train is emboldened throughout the article. The penultimate paragraph states as follows “Mark is sharing his **Train** Wright fitness plan with Sun readers as he wants to get as many people as possible reaping the benefits of exercise.”

29. The article which appears to be taken from the BBC online portal, is dated 21 May 2020 and is headed as follows:

Train Wright: Mark Wright's trained with Tyson Fury, Pixie Lott & Jamie Redknapp - now it's your turn

21 May 2020 | Sport

83



Mark Wright put Tyson Fury through his paces recently

Train Wright

Dates: 25-29 May

Coverage: Watch all five 40-minute workouts streamed live on the BBC Sport website and mobile app.

30. Within the article, reference is made to one live stream involving Tyson Fury, where it states, 6,000 people tuned in to work out with Mark and Tyson and hear them share stories of their time partying in Las Vegas. Within the article Mr MW explains that “he came up with the idea for Train Wright (it’s a good title) after spending the first couple of weeks of lockdown feeling a bit sluggish and demotivated.” The text concludes “Visit Wrighty’s Instagram account now for a treat. The range of guests is testament to the comprehensive approach to Wright’s workouts.”

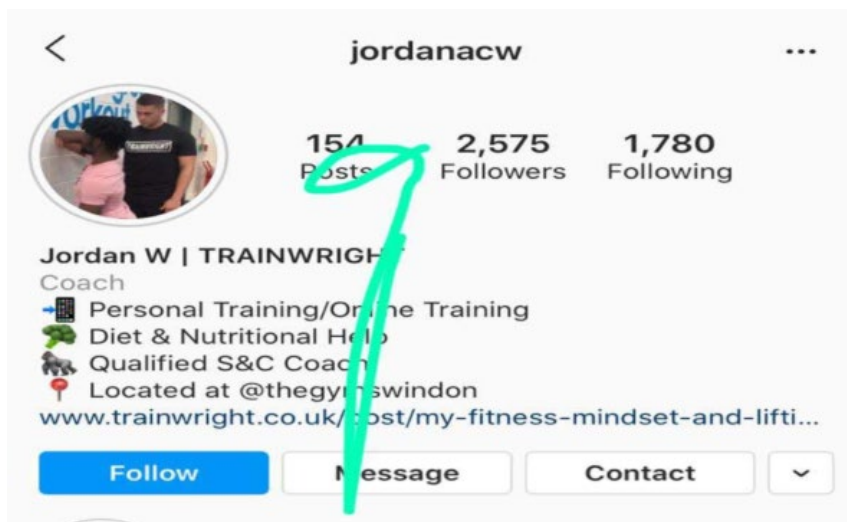
31. MW5 consists of screenshots taken from the online publications The Mirror (dated 17 September 2020), Hello magazine (undated save for a print date of 26 January 2021) and The Express (dated 17 September 2020). The article published in Hello includes the text “Mark has just launched his new fitness programme from home” there

is no reference to the sign within the article. Both articles in The Express and The Mirror refer to Mr MW enjoying yoga as part of his 'Train Wright' training programme. In the article published in The Mirror (Sept 2020) it is headed "Mark Wright tests his flexibility in yoga class.." The text continues "Mark and his brother Johnny tested their flexibility when they committed to a yoga class that formed part of the new Train Wright platform. Promoting the new content in front of his 1.7 million Instagram followers, Mark recorded the group preparing for the class on Thursday... Mark plugged the yoga class and urged fans to check out his new platform. 'We are here finally, filming the yoga element of Train Wright.' he said." A photograph of Mr MW is included overlaid with "@trainwright @joshwright4444 @heatherheartsyoga."

32. MW6 is an undated extract taken from the Opponent's Trainwright Instagram account. It shows 59.3k followers and 185 posts.

33. MW8 consists of copies of the Applicant's Instagram account as at 1 January 2020. It displays the handle trainwrightonline and underneath "The Gym Swindon". The post has 83 likes and 2 comments.

34. MW9 consists of an undated screen shot taken from the "jordanacw" Instagram account. It includes the following text and has 154 posts and 2,575 Followers.



35. MW10 consists of a screenshot taken from the Applicant's Facebook page, setting out the page history and changes as outlined.

36. MW11-MW 13 consist of screenshots taken from the Applicant's Instagram and Facebook accounts namely "@trainwrightonline" and "Train Wright – Personal/Online Training" said to show that the Applicant was operating under a different sign namely the JW/dumbbell logo. The posts display promotional offers available as at 17 December 2017 and 28 November 2019, T shirt sales in 2018 using the JW logo and not TRAINWRIGHT and use of TRAINWRIGHT on t shirts as of 11 March 2020.

The Applicant's evidence

Mr JW's statement

37. Mr JW's witness statement is dated 1 April 2021 and is accompanied by five exhibits marked JW1-5.

38. Mr JW confirms that he is the proprietor of a personal training business which trades under the name TRAINWRIGHT. He states that the facts and information contained within his statement are from his personal knowledge or sourced from others where indicated.

39. Mr JW states that he started working as a personal trainer in or around September 2016 and at this time was selling programmes as well as providing in-person training. As at 2016, JW states that he did not have a brand and offered the services under his own name.

40. In 2018, Mr JW states that he decided to develop a brand under which he would provide his training services, with the intention of eventually opening his own strength and conditioning gym under that brand. He states that he settled upon TRAINWRIGHT as it was a clever word play with his surname.

41. Having settled upon the name, Mr JW states that he purchased the domain name "trainwright.co.uk" at the beginning of June 2018. In support of this Mr JW produces an email dated 7 June 2018 from Nominet, confirming this registration.¹⁴

¹⁴ JW1

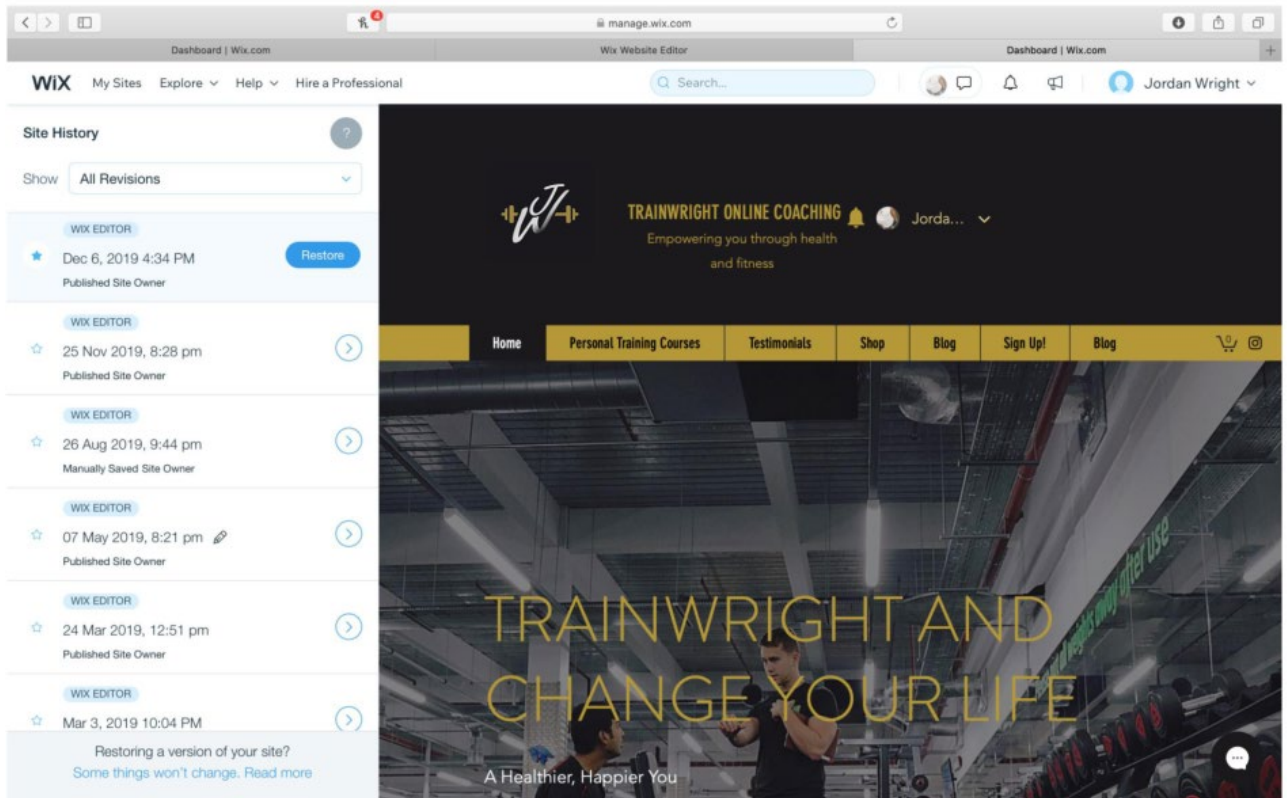
42. Prior to purchasing the domain name and in preparation, Mr JW states that he developed a website to upload to that domain, using a web developer tool called WiX. He produces by way of screen shot a version of the website as of 4 June 2018 and he confirms that this is the version that was first uploaded.¹⁵ Mr JW states that the brand name TRAINWRIGHT is prominently displayed at the top of the page. A further screenshot of the website as at 1 July 2018 is produced. Mr JW confirms that TRAINWRIGHT remains the dominant branding, differing only in the tagline and contrast to the main image making the text TRAINWRIGHT more prominent.¹⁶

43. Further screenshots are produced (an example of which is reproduced below) of the WiX editor versions of the website as at 12 August 2018, 6 September 2018, 23 January 2019, 3 March 2019, 7 May 2019, 25 November 2019 and 6 December 2019.¹⁷ Mr JW confirms that throughout these versions TRAINWRIGHT features as the dominant branding. He states that minor alterations were made during this period in order to promote the brand. He states that on the 6 September 2018, 23 January 2019 and 7 May 2019 versions, he was offering a free training session to increase client uptake and promote the brand under TRAINWRIGHT.

¹⁵ JW2

¹⁶ Page 3 JW2

¹⁷ Pages 4-10 JW2



44. Mr JW states that in early June 2018 he launched the brand TRAINWRIGHT, and since then provided his services under this brand to clients both online and in-person. He confirms that from the outset, in June 2018, clients have been able to purchase online training programmes and face to face training sessions via his website, as evidenced by the 'shop' tab on the website.¹⁸

45. Mr JW confirms that during this time as part of his branding, he used a logo containing his initials and a barbell alongside the word TRAINWRIGHT. He confirms that it was not his intention for the logo to be used as an identifier and from his personal experience it was not in fact used as such. As of June 2018, Mr JW states that he has strived to present his personal training business under the name TRAINWRIGHT and build a reputation under this name particularly since his goal was to open a gym under this brand.

46. Whilst setting up the brand, Mr JW states that he was working out of Buzz Gym in Swindon, where he was and remains a self-employed personal trainer. During this

¹⁸ Page 2 JW1

time, Mr JW confirms that he paid rent to Buzz Gym for the use of the facilities, but was otherwise permitted to run his personal training business under his own brand for his own benefit. He confirms that since June 2018, all of his services have been provided under the TRAINWRIGHT brand, with in-person sessions originally being delivered at Buzz Gym and more recently at The Gym in Swindon.

47. In August 2018, as a result of reaching full capacity and being unable to take on more clients, Mr JW states that he formed an association with Mr William Downes-Hall (another personal trainer) who also operated out of Buzz Gym. Mr JW confirms that Mr Downes-Hall trained one of his clients for him for 3 months. This training was provided under the TRAINWRIGHT brand. Whilst Mr Downes-Hall delivered the sessions, all client interactions, programmes and contact was via the TRAINWRIGHT brand. The association ended as a result of the client's lack of commitment.

48. Mr JW confirms that during this time he had a limited social media presence with an Instagram account and Facebook account under the names Jordanacw and Jordan Wright personal Training/ Fitness Coaching respectively. At that time he focussed his attention on the website and gaining new clients, rather than updating his social media profiles. He refutes the suggestion that he has sought to backdate use of TRAINWRIGHT. Mr JW confirms that on 28 August 2018, despite not updating his profile name, he had used the hashtag TrainWright in a Facebook post.¹⁹ He states that he has consistently presented his business and services under TRAINWRIGHT to clients, which is evidenced by the registration of the domain name as far back as June 2018.

49. Furthermore, most of his communications with clients, are via email and an App, which were marked as being from Trainwright and the services have always referred back to Trainwright. Mr JW produces a selection of the communications he has had with clients prior to January 2020.²⁰ The references to TrainWright, in these communications demonstrate the consistent way in which the brand was presented to clients. Mr JW confirms that when clients purchased sessions they were presented as

¹⁹ Page 11 JW3

²⁰ Pages 12-19 JW3

TRAINWRIGHT sessions and paid to TRAINWRIGHT.CO.UK. To illustrate this Mr JW produced a redacted screen shot of an email from a client which shows the bank transactions.²¹ Mr JW explains that the document shows payment to TRAINWRIGHT.CO.UK for two training sessions dated June 2019 and July 2019. Mr JW confirms that this is representative of how all transactions would have appeared to clients from June 2018.

50. Mr JW confirms that between June 2018 and January 2020 a conservative estimate of his earnings under TRAINWRIGHT was £32,500. This figure is based upon the business having approximately 60-75 clients, generating 15 hours of personal training per week at an average cost of £30 per session. Mr JW confirms that prior to January 2020 he also provided online training via an app to 23 individuals.

51. Mr JW queries the use of the Opponent's Instagram account under the handle @trainwright. He states that whilst it appears to have been set up on 17 May 2020, only one post has been made on this date, with no more posts thereafter until 10 June 2020. Mr JW produces a screenshot of this post.²²

Exhibits

52. JW3 consists of the screenshots taken from Mr JW's Facebook account dated 28 August 2018 where reference is made to the hashtag Trainwright. Screenshots are also produced at various dates during 2019 of the client communications, as outlined, for the purchase of personal training sessions. Reference is made to the emails being sent by Trainwright. Examples of some of those screenshots are reproduced below.

²¹ Page 20 JW3

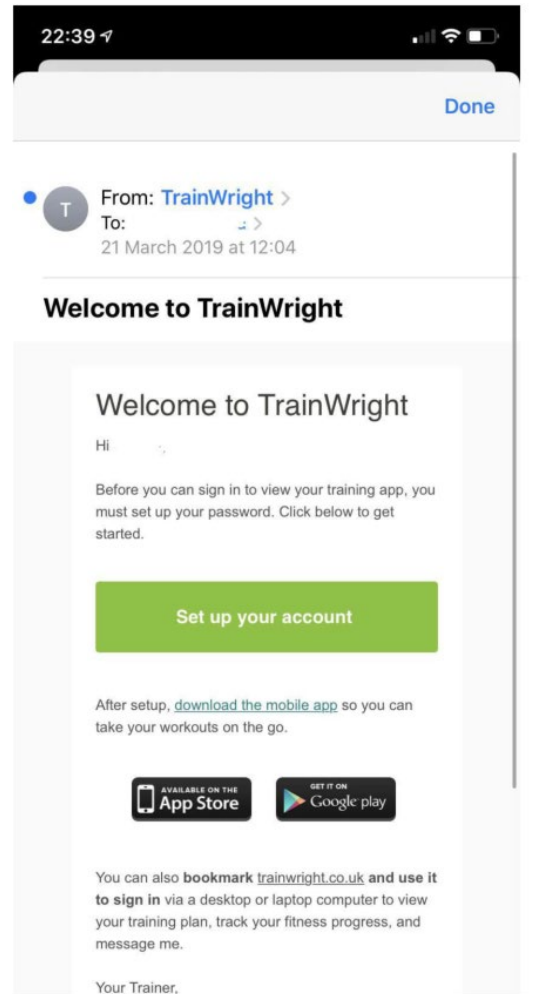
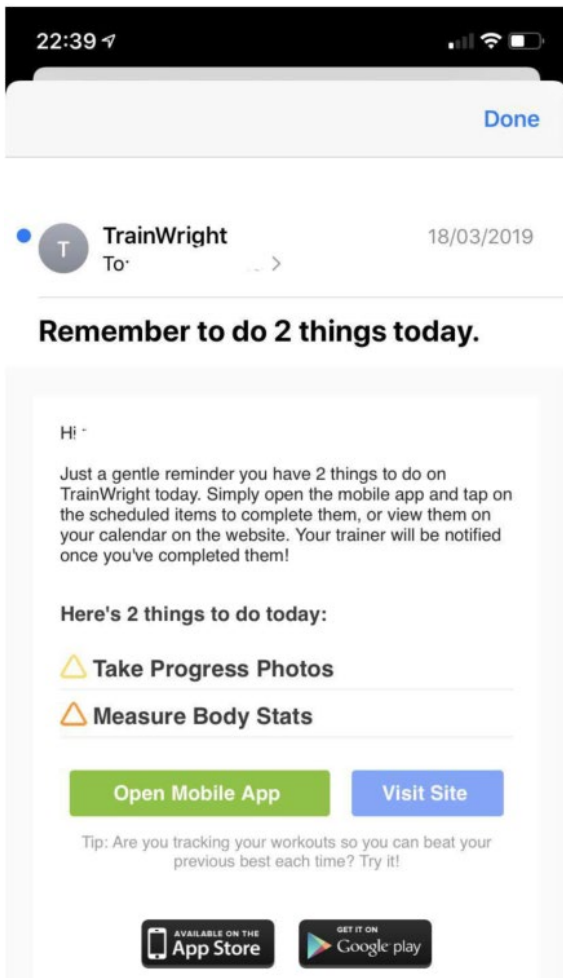
²² Page 22 JW5

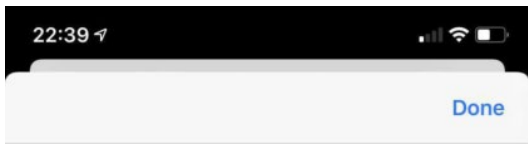
Jordan Wright - Personal Training/Fitness Coaching ...
 28 Aug 2018 · 🌐

For those of you that don't already know, I'm currently in the process of building my very own online fitness community! Here you can find blog posts, free workouts/advice and way more! I'm soon to be adding recipes, nutritional plans and many other things too. Sign up today (link in bio) and receive your very own 5x5 workout. Within the next few months, most of the website will be moving to a subscription based format; But if you sign up now, you'll never have to pay a penny for it! #TrainWright #fitness #gym #motivation #community #workout #instafit



Further screenshots of client communications are produced as follows:





 **TrainWright** 21/03/2019
To: <[redacted]>

A few things to get you started...

Hi <[redacted]>

Welcome to TrainWright.

In order to get started, please print and fill out the PARQ and waiver form attached below. Return them to the front desk or email them back to Jordan.a.c.wright@hotmail.com.

I've also attached your Getting Started Guide/Good Habit Guides to guide you through the online training process.

To check trainer availability, you can visit our website at trainwright.co.uk. We require a 24 hour notice for any cancellations.

For classes and times, you can visit our website at trainwright.co.uk. Class reservations can be cancelled up to 1 hour before the class starts.

Add yourself to our private Facebook group for members at .

If you have any questions about TrainWright, our services or the app, please do not hesitate to let us know.

Follow us on social media!
[Facebook](#) | [Instagram](#) | [Twitter](#)

From: TrainWright <info@trainerize.com>
Sent: Monday, June 24, 2019 11:49 AM
To: <[redacted]>
Subject: A few things to get you started...

Welcome to TrainWright

Hi <[redacted]>

Welcome to TrainWright.

In order to get started, please print and fill out the PARQ and waiver form attached below. Return them to the front desk or email them back to Jordan.a.c.wright@hotmail.com.

I've also attached your Getting Started Guide/Good Habit Guides to guide you through the online training process.

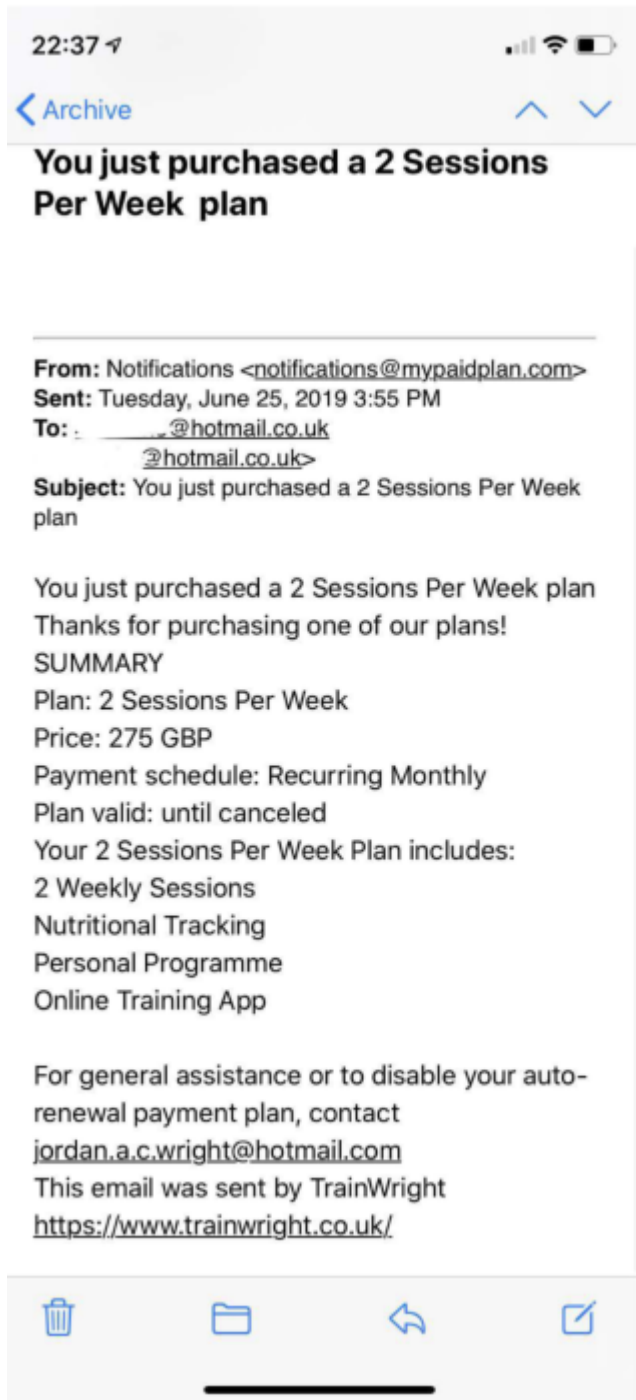
To check trainer availability, you can visit our website at trainwright.co.uk. We require a 24 hour notice for any cancellations.

For classes and times, you can visit our website at trainwright.co.uk. Class reservations can be cancelled up to 1 hour before the class starts.

Add yourself to our private Facebook group for members at .

If you have any questions about TrainWright, our services or the app, please do not hesitate to let us know.

Follow us on social media!
[Facebook](#) | [Instagram](#) | [Twitter](#)



Mr William Downes-Hall's statement

53. Mr Downes-Hall states that he is a personal trainer who has previously worked with Mr JW in or around mid 2018 when they were both working as self-employed personal trainers out of the same gym Buzz Gym in Swindon.

54. Mr Downes-Hall states that he cannot recall the exact date, but around mid 2018, he was approached by Mr JW to work with him and train a client under the brand he was developing namely TRAINWRIGHT.

55. Mr Downes-Hall believes that he was paid 2/3 of the fee paid by the client and provided the in-person training session to the client under the TRAINWRIGHT name. The administration and sign up was handled by Mr JW, which he believes was all done under the Trainwright name although he did not see the documentation itself.

56. When Mr JW introduced the client to Mr Downes-Hall, he states that it was made clear to the client at the first session that the training was provided under the TRAINWRIGHT name. The association lasted approximately 3 months and ended because the client was unreliable.

57. Mr Downes-Hall recalls that in 2018, Mr JW was providing his training services under the brand name TRAINWRIGHT.

Mr Jacob Sworder's statement

58. Mr Sworder confirms that he is an online client of the Applicant and confirms that the contents of his statements are true to the best of his knowledge and belief.

59. Mr Sworder states that he knew Mr JW prior to engaging the services of TRAINWRIGHT as he had trained at his martial arts facility.

60. Mr Sworder recalls that in the Summer of 2019, Mr JW told him that he was setting up an online training platform and showed him a website and an app.

61. Mr Sworder confirms that at the beginning of October 2019 he signed up for a 3 months subscription with the Applicant's TRAINWRIGHT to receive personal training, rather than attending a gym. He confirms that upon checking his records payment was made for this subscription on 8 October 2019 and believes that the sign up process commenced about a week before the payment was made.

62. Mr Sworder states that he chose TRAINWRIGHT because he was impressed with the app that could be used to track everything. The app referred to contained the TRAINWRIGHT branding.

63. Mr Sworder confirms that he has been more or less a continuous user of the Applicant's TRAINWRIGHT online personal training services since October 2019 and that all his interactions have been conducted under the TRAINWRIGHT banner.

Mr MW's second statement - evidence in reply

64. Mr MW states that he invested heavily in an intensive marketing push to launch his brand since his announcement on his channel in January 2020. In an effort to build goodwill in the brand, Mr MW states that he engaged in a series of Instagram live workouts, offered to the public, in order to build awareness of and goodwill in the brand. In support, Mr MW produces screen shots of those Instagram Live workouts dated between 24 March 2020 and 18 May 2020 where the hashtag TRAINWRIGHT was used to identify and promote the brand and the TRAINWRIGHT workout programme.²³

65. Mr MW states that each of those Instagram Live workouts generated hundreds of thousands of views and hundreds of comments (through the hashtag and tagging the brand) and were endorsed by high profile celebrities. The live workout dated 24 March 2020, reached over 450,000 views and the one the following day reached close to 700,000 views.

66. In May 2020, prior to the filing date of the application, Mr MW states that his agents were in commercial discussions with BBC Sport to pay to feature and promote the Opponent's TRAINWRIGHT brand and fitness training programmes as part of its national broadcast services and online streaming platform. A redacted copy of the email chain of those discussions are produced.²⁴

²³ MW18

²⁴ MW19

67. Mr MW challenges the Applicant's claim to the use of the term TRAINWRIGHT through his website since June 2018. He states that he has not been able to locate any public records of such use from 2016 including searches made through the Waybackmachine.com. Mr MW also challenges the Applicant's motives in filing the application, which he believes was in order to divert revenue from the Opponent's brand.

Exhibits

68. MW18 consists of screenshots of a number of posts taken from Mr MW's Instagram account "wrighty_" dated 24 March 2020, 25 March 2020, 1 April 2020, 5 April 2020, 7 April 2020, 23 April 2020, 4 May 2020, 6 May 2020, 12 May 2020, 14 May 2020 and 18 May 2020 (part 1) where the sign is referred to in the form of a hashtag. Those posts posted by Mr MW dated 30 April 2020, 5 May 2020, 14 May 2020, 15 May 2020, 18 May 2020 (part 2) make no reference to the hashtag or sign.

69. This concludes my summary of the evidence. Whilst both parties filed submissions which I have read in full and taken into account in my deliberations, I do not propose to provide a summary but shall refer to them as appropriate during my decision.

Decision

Section 5(4)(a)

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

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

....

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.”

71. Subsection (4A) of Section 5 states:

“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.”

72. For a claim under section 5(4)(a) to succeed the Opponent must demonstrate goodwill, misrepresentation and damage. 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).”

73. 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

74. Ordinarily the relevant date is the date of filing of the trade mark application. However, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, and considered the relevant date where one or both of the parties have used the mark at issue prior to the date of the application. He explained as follows:

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

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

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

passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM O-212-06* Mr Allan 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.’ ”

75. In *Smart Planet Technologies, Inc. v Rajinda Sharm* [BL O/304/20], Mr Thomas Mitcheson QC, as the Appointed Person, pointed out that “*the start of the behaviour complained about*” is not the same as the date that the user of the applied-for mark acquired the right to protect it under the law of passing off. Rather, it is the date that the user of that mark committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when first offer was made to market relevant goods or services under the mark. However, it could also be the date the first public-facing indication was made that sales were proposed to be made under the mark in future.

76. Whilst the filing date of the application is 24 May 2020, the Applicant claims that he has used his trade mark since June 2018 (which pre-dates the Opponent’s use) and therefore argues that the Opponent’s passing off claim must fail. The Opponent submits however that the Applicant has not demonstrated goodwill of his own as at the date claimed and challenges the veracity of the evidence as being inconsistent, regarding the extent and commencement date of the Applicant’s use.

77. Mr JW has filed evidence that he decided to develop a brand in or about 2018 to provide personal training services under it, with the ultimate intention of opening a

gym. He settled upon the name TRAINWRIGHT as it was a word play with his surname and the services he was providing and subsequently purchased a domain name www.trainwright.co.uk. I note the registration certificate regarding this purchase confirms this date as 7 June 2018. In addition, at this same time, Mr JW confirms he developed a website where the dominant branding was and continues to be TRAINWRIGHT. Various screenshots are produced by Mr JW of the WiX editor versions of the website between August 2018 and December 2019. During this period free training sessions were offered to clients in order to increase uptake and promote the brand. I note that the screenshots produced during this period display the applied for mark and a tab with the option to “Book Online/shop” on the home pages. Whilst the Opponent submits that the Applicant was operating under a different brand the website clearly shows use of the applied for mark in the form TRAINWRIGHT ONLINE COACHING in conjunction with the JW Logo. Evidence has also been produced of client communications in 2019, which consistently demonstrate the way in which the brand was being used by the Applicant and how it was presented to clients. The screenshots produced at para 52 above, show sessions being presented and paid to TRAINWRIGHT and TRAINWRIGHT.CO.UK.

78. Mr JW has produced a redacted screen shot of an email from a client showing two payments of £250 to TRAINWRIGHT in June and July 2019. I am told by Mr JW that between June 2018 and January 2020 his earnings were £32,500 based on approximately 60-75 clients. Both Facebook and Instagram entries for the Applicant have been produced by both parties. A number of these posts are undated but there are references to promotional offers in posts dated December 2017 and November 2019, where the applied for mark is displayed alongside the Applicant’s name and previous handles. Mr JW accepts that he has changed the look and names of these mediums, but has always used TRAINWRIGHT alongside his name/handle throughout. The post under the Instagram account [jordanacw](https://www.instagram.com/jordanacw), produced by the Opponent at MW9 for example, although undated, shows the name Jordan W alongside the applied for mark TRAINWRIGHT. This post shows 2,575 followers and includes a reference to the Applicant’s website www.trainwright.co.uk. Mr JW states that his clients were able to sign up for training sessions either online or via an app and on each occasion the sessions were purchased as TRAINWRIGHT sessions. Both Mr Downes-Hall and Mr Sworders confirm the use of the applied for mark by Mr

JW in mid 2018 and the Summer of 2019. Mr Sworder's states that he subscribed to the Applicant's training services in October 2019 and has been a continuous user more or less since.

79. The Opponent challenges the veracity of the Applicant's evidence. In particular, it submits that the inconsistencies with the dates in Mr Downes-Hall and Mr Sworder's statements should place doubt in my mind as to the true date of use as claimed by Mr JW. Furthermore, the social media posts under Mr JW's personal names demonstrate that he has not used the applied for mark for the provision of his services. In addition the Opponent argues that the use claimed by the Applicant has been insufficient to have generated goodwill.

80. I note the comments by Mr Thomas Mitcheson Q.C., sitting as the Appointed Person, in the decision in *Casablanca*.²⁵ He stated that it was unnecessary for the Applicant to have generated goodwill as at the date the behaviour complained of began. He observed as follows:

"34. I consider that adequate guidance to determine the present case can be obtained from the authorities before the Hearing Officer and further discussed before me at the hearing. The guidance in §165 of the *Assos* case emphasises that the party opposing the application or the registration must show that, as at the date of application, a normal and fair use of the Community trade mark would have amounted to passing off. It goes on to say that if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account. The Hearing Officer clearly sought to apply this in §50 of her decision. The question raised by the Opponent is whether she did so correctly and how should the earlier use be taken into account. In particular, does such use, as the Opponent submitted, have to be sufficient to generate its own goodwill?

35. I think it is clear from the remainder of §165 of the judgment of Kitchin LJ that generation of goodwill by the applicant is not required. This is because he

²⁵ O/349/16

goes on to explain that it is the opponent who must show that he had the necessary goodwill and reputation to render that use actionable on the date that it (i.e. the applicant's use) began.

36. This is entirely consistent with the more lengthy discussion of the topic in the decision of Daniel Alexander QC in the Multisys case (*Advanced Perimeter Systems Ltd v Keycorp Ltd* [2012] R.P.C. 14). See the passage at §§35-45 which reviews many of the authorities which were cited to me, including the earlier Croom decision of Geoffrey Hobbs QC. It is correct that, as the Opponent pointed out, §49 of Croom refers to the build up of goodwill (rather than mere use) as justifying the designation of senior user, but it does not appear that the precise point in issue in Multisys or the present case was in issue there, and in any event I consider that I am bound by Assos and I would have followed the later Multisys case anyway.

37. Accordingly the relevance of the activities of the applicant is limited to establishment of the date that the actionable use began. Once that date is established, the only question of goodwill arises in respect of the opponent's activities. As the Applicant in the present case pointed out, self-evidently it would only be in very exceptional circumstances that a party would have established goodwill at the point in time at which it commenced the use complained of. The establishment of goodwill would take much longer. But the authorities recognise that it is the date that the activity commenced which is the crucial one, and so in my judgment it cannot be necessary for goodwill to have been accrued at that time.

38. That does not mean that it is irrelevant what happens after the first alleged date of commencement. Clearly if the activity ceased or changed materially between the date of commencement and the date of application for the trade mark then this must be taken into account, as it may mean that the true date of commencement of the activity complained of is later or that the activity complained of cannot properly be said to have properly commenced at all (if it was later abandoned). This is all a matter of fact and degree and is no doubt why Kitchin LJ expressed it as "*a matter which must be taken into account*"

rather than as being determinative of the issue. However it does not mean that what is required is anything more than the commencement of the activity which is carried on in such a way as to fix the date of assessment. There is no greater requirement to prove goodwill on that date.”

81. Taking account of this decision, it is clear that it is not necessary for the Applicant to have acquired goodwill in order for there to be an earlier relevant date, however, I accept that the Applicant’s evidence must be sufficiently cogent to support his claim that he was first using the applied-for mark as from that earlier date.

82. I am satisfied that Mr JW was using the applied for mark to provide personal training and fitness services as from June 2018. Whilst the use was not extensive at this time, I am satisfied that it commenced from this date as evidenced by the purchase of the domain name in June 2018. I am satisfied that between 2018 and 2019, Mr JW was developing the website and building his reputation with his clients. This use, albeit not substantial, amounted to consistent and continuous use of the applied for mark when promoting his services during 2019, as supported in evidence by the client communications to which I have already referred in paragraph 52 above. I note that the Applicant’s Instagram post (produced by the Opponent at MW8) dated 1 January 2020, displays the handle trainwrightonline and has 83 likes and 2 comments. As at 11 March 2020, Mr JW is seen in a post wearing a t shirt displaying the applied for mark.

83. The Opponent challenges the veracity of the Applicant’s evidence, in particular regarding the date of commencement of use. It raises inconsistencies with Mr Sworder’s and Mr Downes-Hall’s statements. The inconsistencies in these statements can be explained, however, by both witnesses coming into contact with the Applicant’s business at different times. I, therefore, take the statements filed at face value, as I have no reason to believe otherwise. In so far as the Opponent’s claim that the Applicant was promoting his services under his own name, rather than the applied for mark, I note that even in evidence filed by the Opponent, the applied for mark TRAINWRIGHT is used alongside Mr JW’s name. There is no requirement for a business to exclusively use only one trade mark when promoting its goods/services. In reality, businesses often use more than one trade mark together, each being equally

associated with the same business by the consumer. Mr MW states that Mr JW's use has only increased and gained traction, since he and/or the Opponent (his successor in title) started promoting the brand on his channel, which he states is purely as a strategy to gain leverage, rather than genuine use. I do not accept this. The evidence shows that the Applicant has started using his mark earlier than the Opponent's use. Consequently, it cannot be said to have been done to benefit from the Opponent's promotional activities.

84. From the evidence filed, I find that the Applicant has clearly commenced the behaviour complained of in June 2018 and continued to do so up until May 2020. I will, therefore, begin by assessing whether the Opponent had goodwill at the earlier relevant date of June 2018, returning only to the prima facie relevant date of 24 May 2020, if it is necessary to do so.

Goodwill

85. The concept of goodwill was explained as follows in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

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

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The

requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

87. 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.”

88. In its Form TM7 the Opponent pleaded that the sign had been used since 6 January 2020, although Mr MW's statement states that his use commenced slightly earlier in or about 2/3 January of that same year. In any event the 2/3 days variation, will make little difference to the assessment. There is no evidence to suggest that use of the sign by the Opponent/its successors in title commenced any earlier than this.

89. In light of these findings, the Applicant cannot be found to be passing off as of the earlier relevant date, since the Opponent was not in existence at this time, nor had Mr MW started using the sign. The use of the sign by the Opponent/its successor in title did not commence until January 2020, which was some 18 months after the earlier relevant date. Based on the case as pleaded, the Opponent has failed at the first hurdle as there could be no passing off at this earlier relevant date.

90. Consequently, I do not consider that the Opponent/its successor in title has demonstrated goodwill in relation to the services claimed at the earlier relevant date. In order for the Opponent to succeed in its claim it would need to establish goodwill at both the prima facie relevant date and any earlier relevant date. As the Opponent has failed to establish goodwill at the earlier relevant date, it is not necessary for me to go on to consider the position at the prima facie relevant date.

Final Remarks

91. Even if I am wrong in finding that the commencement of the behaviour complained about was June 2018, when the website domain name was purchased by the Applicant, it is clear that by March 2019, the Applicant was communicating with and taking bookings from customers under the mark TRAINWRIGHT. Certainly, by this date the Applicant was engaging in activity that could have been complained about by the Opponent. However, even in those circumstances, this is still some 10 months prior to the Opponent's first use (or first use by its successor in title) according to its own pleaded case. Consequently, my finding would have been the same even by reference to this later relevant date.

92. The Opponent's claim under section 5(4)(a) is unsuccessful

Conclusion

93. The opposition has failed and, therefore, subject to appeal the application may proceed to registration.

Costs

94. As the Applicant has been successful he is entitled to a contribution towards his costs based upon the scale published in Tribunal Practice Notice 2/2016. Applying this guidance I award costs to the Applicant on the following basis:

Considering the notice of opposition and preparing a defence and Counterstatement:	£200
Preparing evidence and considering the Opponent's evidence and submissions:	£800
Submissions in lieu of hearing	£400
Total	£1,400

95. I order Trainwright Ltd to pay Mr Jordan Wright the sum of £1,400 as a contribution towards his costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 23rd day of September 2021

Leisa Davies
For the Registrar