

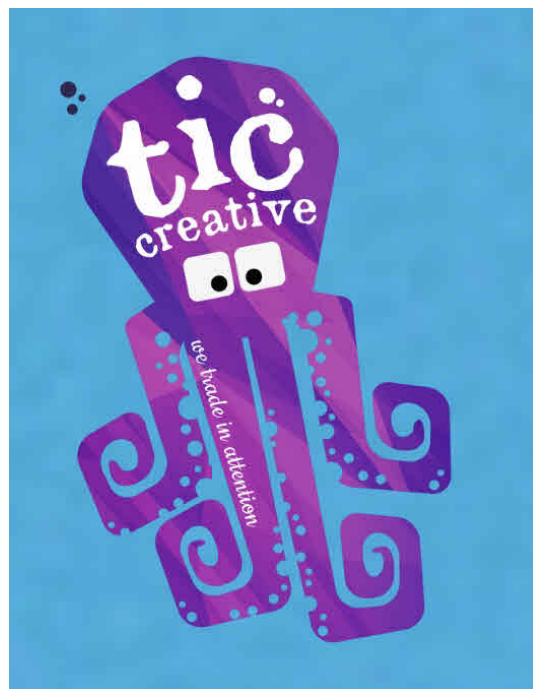
O-554-22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3548587

BY TIC CREATIVE LTD

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 35

AND

AN OPPOSITION THERETO UNDER NUMBER 424482

BY TIC PRINT & DESIGN LIMITED

## BACKGROUND AND PLEADINGS

1. On 26 October 2020, Tic Creative LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 19 February 2021 and registration is sought for the following services:

Class 35     *Design of advertising logos*

2. On 17 May 2021, TIC PRINT & DESIGN LIMITED (“the opponent”) opposed the application based upon section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the sign **TIC** which it claims to have used throughout the UK since 2014 in relation to *printing and design services*.

3. According to the opponent, the use of the applicant’s mark would constitute a misrepresentation to the public that would damage the opponent’s goodwill. Therefore, use of the applicant’s mark would be contrary to the law of passing off pursuant to section 5(4)(a) of the Act.

4. The applicant filed a defence and counterstatement denying the claims made.

5. Only the opponent filed evidence. A hearing took place before me on 19 April 2022. The applicant was represented by Ian Bartlett of Beck Greener LLP and the opponent by Aaron Wood of Brandsmiths.

## EVIDENCE

6. The opponent filed evidence in the form of a witness statement and one exhibit from Terry Cella, Director of the opponent company. Mr Cella’s witness statement is dated 25 November 2021, in which he gives the following evidence:<sup>1</sup>

---

<sup>1</sup> Paragraphs 5 – 18.

- The opponent company was founded in September 2014, has since grown to six employees and offers the following services: graphic design; promotional design and printing; bespoke commercial printing; and print management services under the TIC mark;
- Services are provided to businesses across London and Kent, but also to customers in: Cornwall, Devon, Hampshire, Yorkshire, Lancashire, Cheshire, Cardiff, Essex, Sussex, Berkshire, Lincolnshire, Cumbria, Perth and Kinross;
- The opponent’s marketing spend has been, on average, £3,000 per year since 2014. The “modest” spend is described as being due to the low cost of marketing on Facebook and LinkedIn;
- Some of the marketing spend is allocated to attending trade shows, including three in Kent and East Sussex in 2017, one in 2018 (location not in evidence) and one in 2019 (again, location not in evidence);
- The opponent company won Printing Service of the Year in the London and South East category at the Prestige Awards for the period 2020/21;
- Mr Cella has been a member of Business Network International since 2014 and attends weekly events to present and market the opponent’s range of services;
- Since 2016 Mr Cella is or has been a member of the Federation of Small Businesses, Business Junction (London’s largest independent business network) and BBN Networking, all of which involved attending networking events and business meetings to present the opponent’s services.

7. I have been provided with the following sales figures:<sup>2</sup>

<b>Year ending</b>	<b>Revenue (£)</b>
30 September 2015	1,717
30 September 2016	17,645
30 September 2017	37,744
30 September 2018	60,570
30 September 2019	61,365
30 September 2020	54,088

---

<sup>2</sup> Paragraph 10 of the witness statement.

8. Mr Cella explains that revenue in the year ending 30 September 2020 was adversely affected by the Covid pandemic and that he was expecting it to be in excess of £70,000.<sup>3</sup>

9. Exhibit TC1 contains four separate pieces of evidence: extracts of marketing material which is circulated to prospective customers;<sup>4</sup> printouts of web pages from the opponent's website;<sup>5</sup> printouts of the TiC Media – Printing Facebook page;<sup>6</sup> and printouts of the TiC Media LinkedIn page.<sup>7</sup>

10. The marketing material and web pages are undated: a point I will return to later in this decision. The marketing material, which appears to be a brochure or leaflet, refers to TiC Media (included in word-only format and stylised versions, shown below) as experts in design, print and signage. The material lists a range of printing services and design services, and the company's contact details include an address in Kent.



*Stylised 'TiC MEDIA' 1*



*Stylised 'TiC MEDIA' 2*

---

<sup>3</sup> Paragraph 11 of the witness statement.

<sup>4</sup> Pages 1 – 15.

<sup>5</sup> Pages 16 – 19.

<sup>6</sup> Pages 20 – 23.

<sup>7</sup> Page 24.

11. The web pages refer to TiC Media (again, in word-only and stylised versions) and its design and print services in Bexley. There is one undated testimonial visible, written by a client who had business cards, roller banners and brochures produced by Tic Media.

12. The printouts from the opponent's Facebook page show that it was created in September 2014, is 'liked' by 2,100 people and 'followed' by 2,179 people. The pages are undated but are likely - given the format in which the dates are written on the Facebook posts and Mr Wood's submissions at the hearing - to have been printed for the purpose of filing evidence in these proceedings in or around November 2021. As such, the 12 posts which are visible on the Facebook page and dated throughout October and November (likely 2021, though the year is not shown) were created after the relevant date. Despite Mr Cella's submission that the Facebook page has a "substantial following",<sup>8</sup> the posts have attracted very little engagement: one 'like' and one 'share' per post at the most.

13. The LinkedIn page is not dated, nor can I see what date it was created. What is visible are two posts to its 466 followers.

14. That concludes my summary of the evidence insofar as I consider it necessary.

## **DECISION**

### **Legislation**

15. Section 5(4)(a) states:

“(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-

---

<sup>8</sup> Paragraph 20 of the witness statement.

(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.”

16. Subsection (4A) of Section 5 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.”

### **Relevant law**

17. 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**

18. In *Advanced Perimeter System 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, 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.’”

19. The applicant has not filed evidence that it has used the contested mark prior to the application date. Consequently, the relevant date for this opposition is the date of the application, i.e. 26 October 2020.

## **Goodwill**

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

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and 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.”

21. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] R.P.C. 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.”

22. 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.”

23. In *Smart Planet Technologies, Inc. v Rajinda Sharma* [BL O-304-20], Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] R.P.C. 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

24. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

“The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi’s witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of “reCUP” ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca’s Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

## The existence of goodwill

25. The case law above indicates that to be useful the evidence must be directed to the relevant date. The only documentary evidence supporting the witness statement includes marketing material, web pages and social media printouts, all of which is undated. Mr Wood addressed this at the hearing and, referencing Mr Cella's witness statement, made the following submissions:<sup>9</sup>

"[...] paragraph 4, it is said by Mr. Cella that the purpose of the statement is to set out the evidence of their prior goodwill and that is also reflected later on at the bottom of that same page [...] where the heading says evidence of use prior to filing of contested mark. Of course, the applicant has not sought to cross-examine Mr. Cella about any of the evidence, but what we do have in the final skeleton are suggestions that actually you cannot rely upon the evidence because the pages of evidence are not dated and they are not shown to definitely be before the relevant date. We would say that it is clear from both that paragraph and that heading that Mr. Cella had his mind turned to that prior date, or to the relevant date, and so the evidence will have been marshalled based upon that. I do not think that is an incredible suggestion to make, and of course it was open to the applicant at any point either to ask to cross-examine him or, as we will come on to say, to have done some of their own research."

26. The fact that the opponent was aware of the relevant date does not allow me to assume that the evidence he has filed is directed to that date.

27. Turning to Mr Wood's criticism of the applicant not choosing to cross-examine Mr Cella, I refer to *Robot Energy Limited v Monster Energy Company* [BL O/308/20]. Ms Emma Himsworth, as the Appointed Person, reviewed the case law covering the weight to be attached to a witness's evidence in the absence of cross-examination, as set out in *Pan World Brands v. Tripp* (EXTREME) [2008] RPC 2, *Williams and Williams v. Canaries Seaschool SLU* (CLUB SAIL) [2010] RPC 32 and *Advanced Perimeter*

---

<sup>9</sup> Transcript of the Stenograph Notes of Marten Walsh Cherer Ltd. made at the Hearing before Ms Venables on Tuesday 19 April 2022.

*Systems Ltd v. Keycorp Ltd* (Multisys Trade Mark) [2012] RPC 14 at paragraphs [17] to [22]. Ms Himsworth stated that:

“73. As was made clear in the decision in CLUB SAIL grounds of opposition cannot be rejected automatically on the basis that the witness who sought to refute them was not cross-examined. It is necessary to form a view as a matter of judgment whether the evidence is sufficient to establish the relevant fact which requires, as the Hearing Officer correctly said, the decision taker to consider the evidence as a whole. That the Hearing Officer took this view is entirely consistent with the guidance set out in CLUB SAIL (and EXTREME and MULTISYS). This includes weighing up in particular (1) the power of one side to produce the evidence and the other to contradict it; and (2) the plausibility of the positions that have been adopted in the context of the evidence as a whole which entails where the parties have elected to proceed without cross-examination accepting that the evidence of one witness might be found to have been disproved or displaced by the evidence of another.”

28. Whilst the circumstances of the *Robot Energy* case differ to the case before me, the premise is the same. It is not open to me to automatically reject the applicant's submissions because it chose not to cross-examine Mr Cella. Neither does the absence of cross-examination require me to find that Mr Cella's evidence is directed to the relevant date simply because it is listed in his witness statement under the heading “EVIDENCE OF USE PRIOR TO FILING OF CONTESTED MARK”. In any case, there is no specific reference in the witness statement to the dates of any of the evidence and so there would have been nothing, in this regard, for the applicant to prove or disprove on cross-examination. It is for me to consider the evidence as a whole and form a judgment as to whether it is sufficient to establish the opponent had goodwill at the relevant date. I note the reference to the website being in “largely the same format since 2016”, but where there is no mention of dates, I am not willing to accept that everything in the exhibit is from prior to the relevant date on the basis that reference to the documents are made under a generic heading intending to cover numerous paragraphs in the witness statement. The evidence is neither dated nor explained in the witness statement as coming from a particular date and cross-

examination would not have resolved that. In my judgment, the undated evidence is not adequately explained for me to be satisfied it is directed at the relevant date.

29. In order to establish goodwill, it is necessary to demonstrate that there are customers or clients in the jurisdiction for the services in question.<sup>10</sup> The only evidence that identifies actual customers of the opponent company is one testimonial on the opponent's website. Mr Cella states that the opponent has clients across the UK and has provided sales figures for the years 2015 to 2020. I accept these figures as evidence of customers, however, with no breakdown of the figures I cannot attribute a particular portion of the figures to any of the services listed in Mr Cella's witness statement as being offered by the opponent. In addition, the figures are small and with no corroborating evidence such as invoices of sales, it is unclear if the related orders are from repeat or unique clients.

30. Mr Cella's reference to his attendance at networking events is not determinative: there is limited detail about what his attendance entailed, i.e. did he have stands at the events? How many potential clients attended? What and how much marketing material was distributed? I accept he attended these events but with no supporting evidence it is impossible to determine what proportion of the relevant public were exposed to the TIC sign.

31. In relation to the promotion of the TIC sign I turn now to the marketing spend and marketing material. The opponent has spent a fairly small amount on marketing since 2014; Mr Cella has attributed this to the fact the opponent chooses to market on social media. Significantly more Facebook and LinkedIn evidence could have been filed to support this. As explained in my evidence summary, the social media pages display posts after the relevant date, none of which attracted engagement from more than one account/individual. Further, the marketing material at exhibit TC1 is not explained: how many copies were produced? How and when were they distributed? The extent of the opponent's efforts to promote its services under the TIC sign is simply not clear.

---

<sup>10</sup> *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31

32. The opponent has provided evidence of a small and growing business and I acknowledge that it has had success at a recent awards ceremony, however, what I have been provided with is not enough to illustrate protectable goodwill associated with the sign TIC. Determining whether there is goodwill is a multifactorial assessment. I must take account of the reach of the evidence, the length of time the relevant public has been exposed to the sign and how intensive the use has been, as well as the amount of money invested promoting the sign. The evidence filed is simply not sufficient for this purpose: it builds a picture that is too incomplete to find that it had goodwill at the relevant date. One would imagine that it would be a relatively simple task to provide more detailed documentary evidence and, for the evidence that is filed, to ensure it is dated prior to the relevant date.

33. The opponent has failed to establish that there was any goodwill in the sign TIC in the services relied upon at the relevant date and, therefore, the opposition based upon section 5(4)(a) falls at the first hurdle.

## **CONCLUSION**

34. The opposition under section 5(4)(a) has been unsuccessful. The application will proceed to registration.

## **COSTS**

35. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £1,200, calculated as follows:

Considering the other side's statement of grounds and preparing a counterstatement	£200
Considering the other side's evidence	£400 <sup>11</sup>

---

<sup>11</sup> This amount is below the scale minima due to the applicant not filing evidence.

Preparing for and attending a hearing	£600
Total	£1,200

36. I therefore order TIC PRINT & DESIGN LIMITED to pay Tic Creative LTD the sum of £1,200. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 28<sup>th</sup> day of June 2022**

**E VENABLES**  
**For the Registrar**