

O/812/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATION NO. 3503307

BY SIMPSON PERFORMANCE PRODUCTS, INC.

TO REGISTER:

BANDIT

AS A TRADE MARK IN CLASSES 9, 18 & 25

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 422832 BY ANDREAS FREUNDLIEB

AND

IN THE MATTER OF UK REGISTRATION NO. 3258521

IN THE NAME OF ANDREAS FREUNDLIEB

IN RESPECT OF THE FOLLOWING TRADE MARK

BANDIT

AND

AN APPLICATION FOR A DECLARATION OF THE INVALIDITY THEREOF

UNDER NO 503732

BY SIMPSON PERFORMANCE PRODUCTS, INC.

BACKGROUND AND PLEADINGS

1. Simpson Performance Products, Inc (“Simpson”) applied to register **BANDIT** as a trade mark in the United Kingdom on 22 June 2020. The application was accepted and published on 20 November 2020 in respect of the following goods:

Class 9

Safety clothing for the motor sports industry, in particular safety helmets, suits, gloves, shoes and socks for protection in the event of accidents and fire; racing harnesses.

Class 18

Backpacks, suitcases, briefcases, bum bags, handbags, bags and wallets, luggage tags, leather shaving kits, and travel bags, all also made of leather.

Class 25

Jackets, gloves, pants, headwear, motorcycle clothing, protective motorcycle clothing, all also made of leather.

2. On 19 January 2021, the application was opposed by Andreas Freundlieb (“AF”). AF is the managing director and sole shareholder of Bandit Helmets GmbH, founded in 1998. The opposition is based on sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods in the application.

3. AF relies on UK Trade Mark (“UKTM”) No. 3258521, **BANDIT**, which has an application date of 22 September 2017 and a registration date of 23 February 2018. It stands registered for *Safety helmets* in Class 9. He claims that the marks are identical and that the applied-for goods are either identical or similar to the goods covered by his registration. Consequently, he claims that there is a likelihood of confusion on the part of the public and that the application should be refused in its entirety.

4. On 29 March 2021, Simpson filed a defence and counterstatement denying the claims made. It stated that the parties had been involved in a long-standing dispute in

Germany and the EU over the ownership of the BANDIT trade mark and that proceedings were currently pending.

5. Also on 29 March 2021, Simpson applied for a declaration of invalidity against UKTM No. 3258521, based on sections 5(4)(a) and 3(6) of the Act.

6. Under section 5(4)(a), Simpson claims to have used the sign **BANDIT** throughout the UK since 1987 for *Safety helmets* and to have established a substantial goodwill in relation to the sale of those goods. It asserts that use of AF's mark would constitute a misrepresentation that would lead the general public to believe that Bandit Helmet' goods were those of Simpson, or that there was some connection between them, and as a result of this misrepresentation, Simpson would suffer significant damage.

7. Under section 3(6), Simpson claims that AF was fully aware that Simpson was using an identical mark for identical products in the UK at the time of the application and that he made this application in order to prevent Simpson from continuing to use its sign in the UK and thus to force its products from the market. It noted that:

“AF's awareness of the BANDIT mark and the use of such brand for an innovative helmet design by Applicant is apparent from the simultaneous copying of the helmet design itself since 1996, when AF started his business in Germany. Such conduct has been recognised by the German courts as evidence that AF has acted in bad faith with the aim to exploit the Applicant's reputation in the BANDIT mark and its innovative helmet design.”¹

8. AF filed a defence and counterstatement denying, and putting Simpson to proof of, the claims made.

9. The matter came to be heard before me by videolink on 7 July 2022. Simpson was represented by Charlotte Blythe of Counsel, instructed by K & L Gates LLP. AF was not represented at the hearing, but filed submissions in lieu of his attendance on 5 July 2022. He has been represented in these proceedings by Kilburn & Strode LLP.

¹ Statement of grounds, paragraph 19.

EVIDENCE AND SUBMISSIONS

10. AF's evidence in chief comes from Mr Freundlieb himself. His witness statement is dated 20 August 2021 and it is accompanied by seven exhibits adduced as evidence of sales his company has made to customers in the UK. There is also a copy of a decision of the German Supreme Court in proceedings between the two parties, and a machine translation of that decision, which was dated 27 May 2021. AF has provided a witness statement from Nora Fowler, a trade mark attorney at Kilburn & Strode, who states she is bilingual in English and German. Ms Fowler re-exhibits the German Supreme Court decision and its translation and states that the English version is an accurate translation of the original.

11. Simpson also filed evidence on 20 August 2021 in the form of a witness statement from Chuck Davies, the president of Simpson Performance Products, Inc. He states that he has been working for the company since 2008 under various titles. His evidence goes to the history of the company and the Bandit helmet, the disputes between the parties, and Simpson's use of the Bandit sign in the UK. There are also witness statements from Dr Julia Lena Goetz and Dr Daniel Schumann, both German citizens who state they have a working knowledge of the English language. They confirm that translations of German court decisions are "*true working translations of the original documents.*"²

12. AF filed evidence in reply, in the form of a second witness statement dated 22 October 2021 with a single exhibit. This exhibit contains email correspondence from 2009 and 2010 between Mr Freundlieb and a UK retailer.

13. Both parties filed submissions during the evidence rounds. AF's are dated 23 August 2021; Simpson's are dated 18 March 2022. As I have already noted, AF also filed written submissions in lieu of attendance at the hearing. I shall refer to them where appropriate during the course of this decision.

² Witness statements of Dr Goetz and Dr Schumann, paragraph 3.

FACTUAL BACKGROUND

14. Simpson is a US-based company specialising in safety equipment for motorsports. In 1979 it launched a safety helmet under the “Bandit” name in the US. Mr Davies states that these helmets had “*a particularly striking and aggressive design*”.³ He adds that they were worn by famous motorsport participants between 1979 and the early 1980s. Exhibit CD3 includes several photographs, including the one reproduced below which shows Formula 1 World Champion Alan Jones.⁴



15. Mr Davies says that the helmets were first distributed in the UK in 1987. Extracts from mail order catalogues from a distributor called Demon Tweaks dating from 1987, 1993, 1994 and 1996 show Simpson Bandit helmets available for purchase by UK consumers.⁵ Marketing material from another distributor, Road & Stage Motorsport, shows a Simpson Bandit helmet on sale for £265. However, this is undated.⁶

³ Witness statement of Chuck Davies, paragraph 7.

⁴ Page 11.

⁵ Exhibit CD4.

⁶ Exhibit CD11.



16. During the period 2012 to 2019, Simpson sold 1342 Bandit helmets to UK-based consumers, earning 372,016.⁷ It is not clear whether the revenue is in US dollars or sterling. The sample invoices to Simpson’s distributors dating from 21 February 2012 to 26 May 2020 in Exhibit CD24 are in US dollars.⁸ The helmets could also be bought online from McGill Motorsport and Simpson Racing in 2015, as shown by screenshots obtained via the Wayback Machine.⁹

17. AF’s goods have also been available in the UK. His evidence shows sales between 1999 and 2014 and that at least one distributor (Custom Cruisers (UK)) has sold both parties’ goods. The earliest invoice to a UK customer is dated 1999 and shows sales of €10,563.08.¹⁰

The trade mark disputes

18. In 1996, AF filed an application to register “BANDIT” as a trade mark in Germany for helmets in Class 9. Simpson responded by filing an application for “BANDIT SX”

⁷ Exhibit CD23.

⁸ The exhibit also contains several invoices with dates later than the date on which AF applied for UKTM No. 3258521.

⁹ Exhibits CD18 and CD19.

¹⁰ Exhibit AF6, page 49.

for safety helmets in Class 9, which was duly opposed by AF.¹¹ AF applied for an EU Trade Mark (“EUTM”) for “BANDIT” for helmets and other safety equipment and motorcycle clothing in June 1999.

19. In 2001, the Munich district court held that AF could not rely on the 1996 German trade mark because the application for that mark had been made in bad faith.¹² Ms Blythe then noted that AF successfully appealed this decision.¹³ The following year, Simpson entered into an agreement with Bandit Helmets regarding use of the Bandit trade mark in Germany. At some point, the agreement appears to have broken down, although it is not clear from the evidence exactly when or why this happened.

20. In September 2012, Simpson became aware that AF had contacted one of its UK suppliers (Custom Cruisers (UK)) requesting them to refrain from using the BANDIT trade mark. AF’s email was dated 6 September 2012 and reads as follows:

“I saw in web that you are selling Simpson Helmets now.

Please note that ‘BANDIT’ is our registered trademark in Europe.

Please remove BANDIT from all your Helmets which are not from us within 12 hours. If we should find any product, described or marked as BANDIT which is not ours, we will start legal action and set free a bunch of advocates against you or who ever should should offer such goods that might be mixed up with our Helmets.”¹⁴

21. The distributor replied the same day:

“Hi Andy you copied Simpson as did Speed Products before you- and registered Trade Mark Bandit helmets- ? we are not just advertising your

¹¹ In paragraph 10 of Mr Davies’s witness statement, he states that the mark applied for by Simpson was “BRANDIT SX”. However, in the documentary evidence, this is shown as “BANDIT SX”. I therefore believe that “BRANDIT SX” is a typographical error.

¹² Exhibit CD6, page 32.

¹³ Skeleton argument, paragraph 8(g).

¹⁴ Exhibit CD8, page 2.

helmets we are selling Simpson Bandit Model NOT BRAND- a model is not a brand?? you will have a lot of work on ebay as there must be 300 other people in UK alone including Moorspeed who sell Bandit and Simpson ? when will it end ? without Simpson making original you would not sell any helmets as when they search for Simpson Bandit your come up too- and yours are a lot cheaper- I can understand you registering Bandit as a brand but not as a model- (ie sub brand) will look into this with trading standard UK”¹⁵

22. AF responded:

“it is my Brand and if come over the fact that someone is using it for other Helmets I will have to start the legal action. In Germany, anyone who sells his Helmet call it ‘Model B’. I had quite some legal fights with other Helmets including MOMO (who als have a ‘model F’ now), Ruby and Simpson (who had to cancel their trademark).”¹⁶

23. The UK distributor forwarded this correspondence to Simpson:

“Hi what a Knob read this- ! I spoke to trading standards they say in UK you can get his registration overturned as you can prove that you had the design in production years before he diid and he copied you – like his Bandit street is old superbandid – it is bad enough he ripped your designs off but then to stop original manufacturers using their own name is ridiculous”.¹⁷

24. However, as Mr Davies notes, “*this matter went no further*”.¹⁸

25. In 2016, AF began trade mark infringement proceedings against Simpson Europe AB to cease supplying helmets in Germany under the BANDIT sign. The Regional Court of Düsseldorf decided in favour of AF, but Simpson Europe successfully

¹⁵ Exhibit CD6, page 2.

¹⁶ Exhibit CD6, page 1.

¹⁷ Exhibit CD6, page 1.

¹⁸ Paragraph 14.

appealed the decision in August 2020. The case went up to the Supreme Court, who referred it back to the Court of Appeal on 27 May 2021, on a procedural point. In her skeleton argument, Ms Blythe says that the Higher Regional Court of Düsseldorf suspended the proceedings in 2022, pending the resolution of the action described in the following paragraph.¹⁹

26. Simpson Europe has also initiated cancellation proceedings against AF's German trade mark. The hearing on the German trade mark is due to take place on 29 September 2022.²⁰

27. Finally, an application was made by Simpson for the cancellation of AF's EUTM. No date has been given for the commencement of these proceedings at the European Union Intellectual Property Office ("EUIPO"), although I note that Mr Davies describes the German and EU proceedings as having been commenced in parallel to the infringement action.²¹ AF's written submissions of 23 August 2021 say:

"The Supreme Court decision also notes that the Applicant [i.e. Simpson] had agreed in the 2001 settlement to no longer use the BANDIT trade mark, and to cancel the German registered rights to the mark BANDIT SX owned by the Applicant. The Opponent's EUTM for BANDIT has since been allowed to stand for some 16 years without challenge, giving the Opponent a monopoly to the BANDIT mark in the EU and UK."²²

28. Annexed to AF's written submissions in lieu of a hearing is the EUIPO file information for that EUTM. This states that an application for revocation or for a declaration of invalidity was made on 25 July 2017, around two months before the application date of AF's contested UKTM. I have not carried out any independent research to identify whether this was Simpson's application or one by another party. However, as it is the only one from around this time, and all 8 entries are shown, I infer that it was. This EUTM has now expired and both parties have filed applications for an

¹⁹ Paragraph 8(i)(iv).

²⁰ Simpson's skeleton argument, paragraph 8(j).

²¹ Witness statement, paragraphs 17 and 18.

²² Paragraph 51.

EUTM for BANDIT. Each of these has been opposed by the other party and the proceedings are pending.²³

29. Both parties have adduced in evidence some of these decisions. At the hearing, Ms Blythe acknowledged that they are not binding on me, but stated that Simpson relied on them as factual summaries of what the parties were doing at various points in time.²⁴

DECISION

30. I find it convenient to deal with Simpson's application to invalidate AF's UKTM first. If this is successful, the opposition falls away.

The invalidation

Section 5(4)(a)

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

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

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

..."

32. Subsection 4(A) is as follows:

²³ Paragraph 8(l).

²⁴ Transcript, page 7.

“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.”

33. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”²⁵

Relevant Date

34. In *Advanced Perimeter Systems v Multisys Computers Limited*, BL O-410-11, Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Allan James, acting for the Registrar, in *SWORDERS Trade Mark*, BL O/212/06:

²⁵ Page 406.

“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.”²⁶

35. AF claims that it had been using the contested sign in the UK before the date of application. The earliest evidence of sales in the UK is an invoice dated 1 July 1999.²⁷ I am aware that Exhibit AF4 contains some sales figures from 1998, but the geographical location of these sales is not stated, and so I cannot assume that they were made in the UK. I therefore find that the relevant date is 1 July 1999.

Goodwill

36. Simpson must show that it had goodwill in a business at the relevant date and that the sign relied upon, **BANDIT**, is associated with, or distinctive of, that business. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

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

²⁶ Quoted in paragraph 43 of BL O-410-11.

²⁷ Exhibit AF6, page 49.

37. Ms Blythe accepted that Simpson had provided no sales figures from the date it claimed to have begun to use the sign in the UK (1987) to the relevant date. The evidence that she drew my attention to as supporting a claim to goodwill consisted of the catalogues and marketing material to which I have referred in paragraph 15 above. She submitted that the undated item from Ripspeed Road & Stage Motorsport showed prices comparable to those in the 1987 and 1990 Demon Tweaks brochures and so it would be reasonable to make “a soft inference” that this exhibit predated the relevant date.²⁸

38. The other evidence that Ms Blythe relied on consisted of extracts from online forums in which users discussed Simpson’s Bandit helmets. The thread in Exhibit CD12 dates from 2007, which is, of course, after the relevant date, but Ms Blythe drew my attention to the following message from a user based in Gloucester:²⁹

Yowsa Yowsa, Been riding with Simpson Super Bandits since the first one came out (Bandit 1981...still have it, although lining is shot & two others

over time....) & fat daddy covers all bases... 🍻🍻🍻

The first Bandit made to the left....



²⁸ Transcript, page 14.

²⁹ Exhibit CD12, pages 3-4.

39. The message thread in Exhibit CD13 comes from 2017. One user states that “*I bought a Bandit in 1990 and that was £300 plus £50 for a black visor*”.³⁰ The remaining text of their message, and the fact that the thread is prompted by the question “*Anyone use a Simpson helmet for road use?*”, lead me to infer that it is a Simpson Bandit to which they are referring. The sterling price suggests a UK sale.

40. Ms Blythe also submitted that the wearing of Simpson Bandit helmets by famous racing drivers would have enabled Simpson to build up goodwill much more easily when it began selling in the UK. I pressed her on whether the sign itself had been used in this context. In the image reproduced in paragraph 14 above, the SIMPSON sign is clearly visible, but I cannot see the BANDIT sign anywhere in the photograph. She replied:

“I think we have to accept that the images that you have seen, the helmets do not say BANDIT on them, they say SIMPSON on them, but our submission is this. This is the Simpson BANDIT helmet and that is what the helmet was known as, even if it did not have BANDIT printed across the helmet. It was a Simpson BANDIT helmet and it was known as such. We do not really rely upon these images per se. What we rely upon is the fact that famous Formula 1 drivers were wearing these helmets in the late 1970s and 1980s. Therefore, the Simpson BANDIT helmet was getting worldwide coverage, in the broadcasts of the races and the press coverage of the drivers, et cetera.”³¹

41. There is, however, no evidence to support this last sentence. What I have been shown is discussion of two sales, the offering of helmets under the earlier sign in catalogues dated 1987, 1993, 1994 and 1996, and a further undated catalogue that may also date from the 1990s. The Supreme Court made clear in *Starbucks (HK) Limited & Anor v British Sky Broadcasting Group Plc & Ors* [2015] UKSC 31, that goodwill involved the presence of customers in the UK for the goods in question.³² Lord Neuberger went on to say that “*As to what amounts to sufficient business to*

³⁰ Exhibit CD13, page 8.

³¹ Transcript, page 16.

³² Paragraph 47.

amount to goodwill, it seems clear that mere reputation is not enough...”.³³ Starbucks was one of the authorities reviewed by Thomas Mitcheson QC, sitting as the Appointed Person, in *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*, BL O/304/20. He said 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.”³⁴

42. I find that the evidence does not show that Simpson had established a protectable goodwill in the UK at the relevant date, and so the section 5(4)(a) claim fails.

Section 3(6)

43. Section 3(6) of the Act is as follows:

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

44. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121, the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, *Hasbro, Inc. v EUIPO*, Case T-663/19, *pelicantravel.com s.r.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-136/11, and *Psytech International Ltd v OHIM*, Case T-507/08. Floyd LJ summarised the law as follows:³⁵

³³ Paragraph 52.

³⁴ Paragraph 34.

³⁵ Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts, although the UK has left the EU.

“The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]³⁶.

³⁶ Paragraph 67.

45. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the 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?

46. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *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). The relevant date here is 22 September 2017.

47. Simpson's case of bad faith is that AF was aware that the applicant was using an identical sign for identical products in the UK at the time of the application. It alleges that AF must have known of such use on account of his copying of Simpson's helmet design since 1996, when his business was established. Simpson notes that this has been accepted in proceedings in the German courts and that AF's aim was to exploit the Simpson's reputation. AF's objective in filing the application for a trade mark in the UK was, alleges Simpson, to prevent Simpson from continuing to use the BANDIT sign in the UK.

48. I accept that the evidence shows that at the relevant date Simpson was using the sign in the UK for safety helmets. They were offered for sale on websites, as noted in paragraph 16 above, and of the invoices in Exhibit CD24 18 show sales under the sign between 2012 and the relevant date. The correspondence between AF and the employee of Custom Cruisers in 2012 is evidence that AF knew that Simpson had been using the sign in the UK before the relevant date and that, at least in the view of that employee, Simpson had been selling helmets under the BANDIT name longer

than AF. At this point, I remind myself that section 3(6) is a free-standing ground and the failure of the invalidation under section 5(4)(a) does not mean that this ground must also fail: see *MR MIYAGI'S Trade Mark*, BL O/171/22, paragraphs 58 and 65-68.

49. There is – perhaps unsurprisingly – no direct evidence that AF copied Simpson's design of helmet. Ms Blythe submitted that an inference may be drawn from AF's use of the name "BANDIT" and the choice of the same design of helmet.³⁷ The editors of *Copinger and Skone James on Copyright*, 18th edition, make the following comments on establishing proof of copying (with footnotes removed):

"Direct evidence of copyright is rarely available and reliance frequently has to be placed on inference drawn from circumstantial evidence. The basis of secondary proof of copying normally lies in the establishment of similarities between the claimant's work and the defendant's work, combined with proof of the possibility of access by the author of the defendant's work to the claimant's work. Inferences may properly be drawn from the surrounding circumstances and from the nature of the similarities themselves. It is good practice for the claimant to particularise at an early stage in an action the alleged points of similarity between his work and the defendant's work. The existence of a striking general similarity coupled with evidence of the opportunity to copy will establish a prima facie case of copying which the defendant then has to answer. The evidential burden shifts to the defendant who may then seek to adduce evidence of some alternative explanation for the similarities between the two works, for example, evidence of independent creation or common source."³⁸

50. Mr Davies describes the Simpson Bandit design in his witness statement:

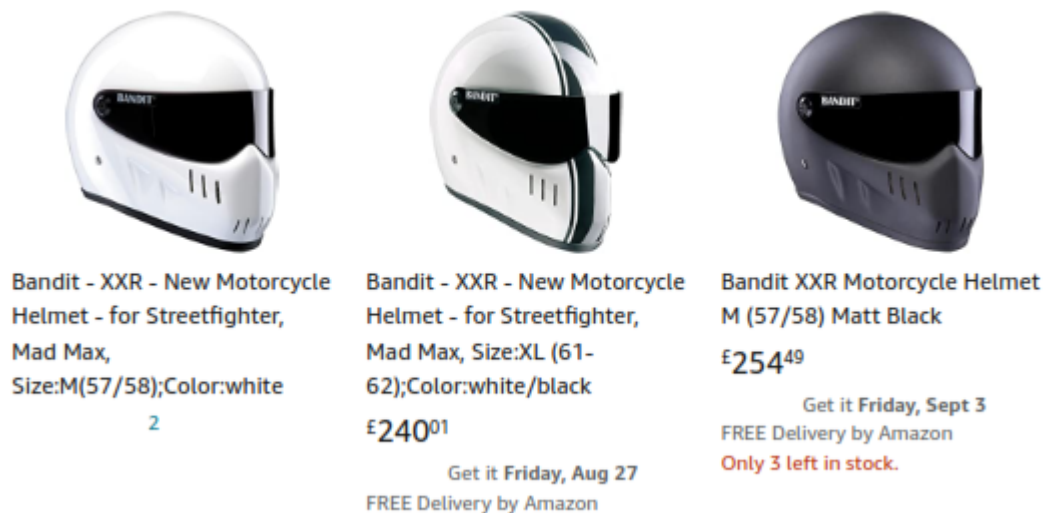
"The most striking features of the helmet are an angular, strongly protruding chin section with air inlets and the framing of the eye area by a curved line that extends in the middle to above the nose."³⁹

³⁷ Transcript, page 5.

³⁸ Paragraph 21-394.

³⁹ Paragraph 7.

52. There are few images of AF's goods in evidence and they are all undated. The following excerpt from Amazon listings, retrieved on 19 August 2021, shows three of AF's helmets, which it will be seen share the same angular, protruding chin section, air inlets and eye framing as Simpson's Bandit helmets.⁴¹ In 2021, AF was selling helmets whose shape bore a striking general similarity to that of the early Simpson's Bandit.



53. What was the position at the relevant date? The evidence suggests a view among some members of the trade that AF's helmets looked like copies of the Simpson Bandit. The employee of Custom Cruisers made this point in the 2012 correspondence I have already cited.⁴² Earlier than this, a 2000 article in German magazine *MOTORRAD*, that was quoted in the Munich District Court decision, said:

“The streetfighter helm par excellence, with a tendency to cult object, is the Simpson Bandit, other manufacturers have taken the Simpson program as their model, for example, the company Bandit, whose XX model looks like an exact copy of the Simpson RX 8. The classic Simpson Bandit with the distinctive angular chin has been around since the seventies.”⁴³

⁴¹ Exhibit CD22, page 23.

⁴² See paragraph 21 above.

⁴³ Exhibit CD6, pages 35-36.

54. The court found that the Simpson Bandit helmets had been on sale in Germany since 1987, and had been advertised in specialist press, including *MOTORRAD*.⁴⁴ On this basis, I consider that there is proof that AF, being a competitor, had the possibility of access to these images of Simpson's helmets. In my view, Simpson has made out a prima facie case of copying.

55. Simpson claims that the objective of copying the helmet and the name BANDIT was to exploit its reputation. The evidence of the online forum discussions show that Simpson's Bandit helmets had a reputation among a section of the public based on their distinctive appearance and "*street cred*".⁴⁵ Given that, as is stated in these discussions, the helmets were not legal for road use for much of the period during which they were sold, I accept that they were aimed at a niche market of motorcyclists.

56. The particular issue I have to decide is whether the application for a UK trade mark was made in bad faith. AF notes that at the time of application he was trading in the UK, and I accept that the evidence, although a little confusing, shows that this was the case. He also points to the ownership of an EUTM which could have been used for the very purpose for which Simpson claims he filed the application for the UKTM, namely preventing Simpson from selling its helmets in the UK under the BANDIT sign. Ms Blythe submitted that the timing of the application for the contested mark was highly suspicious, coming as it did after the litigation between the parties had commenced. Indeed, the application was made around two months after an application had been filed to cancel the EUTM.

57. In my view, it is reasonable to infer that AF will have been aware that his marks were under attack and that the Munich Court had found on the facts that Simpson had been selling helmets under the BANDIT sign in Germany and the EU before the establishment of his business and that he had made that German application in bad faith. Therefore, there was the possibility that the EUTM might be cancelled.

⁴⁴ Page 34.

⁴⁵ Exhibits CD12 and CD13.

58. In the light of the prior trade by Simpson, the evidence of its reputation, the establishment of a prima facie case of copying and the ongoing litigation, I consider that Simpson has established a prima facie case that the application for a UKTM was made in bad faith to exploit Simpson's reputation and helmet design and prevent Simpson from continuing to sell Bandit helmets in the UK.

59. AF has filed no evidence to rebut this case. The written submissions put forward the proposition that he applied for a UK trade mark because of the uncertainty about continued protection of EUTMs in the UK following the vote in the 2016 referendum to leave the EU. Ms Blythe submitted that such an argument should have been made in evidence, rather than in submissions. I agree. AF has provided no plausible explanations in evidence for making the application for the trade mark, or for his choice in helmet design and name. In the absence of such explanations, the presumption of good faith is rebutted and the section 3(6) ground is successful.

Outcome of the invalidation

60. The application for invalidation of AF's mark has been successful. The result of this is that there is no earlier right and the opposition falls away.

OUTCOME

61. Simpson has been successful and UKTM No. 3258521 is declared invalid.

62. Trade Mark Application No. 3503307 will proceed to registration.

COSTS

63. Simpson has been successful in these proceedings. It is therefore entitled to a contribution towards its costs, based on the scale published in the Tribunal Practice Notice 2/2016.

<i>Preparing statements and considering AF's statements:</i>	£600
<i>Preparing evidence and considering AF's evidence:</i>	£1200
<i>Preparing for and attending the hearing:</i>	£800
<i>Official fees:</i>	£200
TOTAL	£2800

64. I therefore order Andreas Freundlieb to pay Simpson Performance Products, Inc. the sum of £2800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 21st day of September 2022

**Clare Boucher,
For the Registrar,
Comptroller-General**