

O/865/22

TRADE MARKS ACT 1994

**IN THE MATTER OF THE UK TRADE MARK APPLICATION NO. 3529485
IN THE NAME OF UNITED SIKHS FOR THE TRADE MARK**

UNITED SIKHS

IN CLASS 35, 36, 41, 42, 43, 44 & 45

AND

**OPPOSITION THERETO UNDER NO. 422916
BY UNITED SIKHS**

Background and pleadings

1. United Sikhs (a US NGO charity) (“the applicant”) applied to register the trade mark number 3529485 for the mark UNITED SIKHS in the UK on 3 September 2020. The application claims partial priority from US application number 88904605 filed on 7 May 2020. It was accepted and published in the Trade Marks Journal on 23 October 2020 in respect of services in classes 35, 36, 41, 42, 43, 44 and 45. A full list of the services as filed is set out at Annex A to this decision.

2. UNITED SIKHS (a UK unincorporated association and charity) (“the opponent”) opposes the trade mark on the basis of Section 5(4)(a) and section 3(6)¹ of the Trade Marks Act 1994 (“the Act”).

3. The opposition under section 5(4)(a) is on the basis of its alleged earlier rights in the sign UNITED SIKHS. It claims to have been providing the services set out below under this sign throughout the UK since 2 November 2002, and that on this basis it has acquired goodwill under the sign in respect of the same services as follows:

Arranging promotion of humanitarian aid, disaster-relief and other charitable projects and events; promotional and public awareness campaigns; management of fund-raising campaigns; information, advisory and consultancy services relating to all of the aforesaid.

Charitable fund raising; arranging finance for humanitarian and charitable projects; organising of charitable collections; arranging charitable fundraising events and activities; providing information relating to charitable fundraising; information, advisory and consultancy services relating to all of the aforesaid.

Education; providing of training; sporting and cultural activities; arranging and conducting of conferences, seminars, symposiums, exhibitions, workshops and events; organisation of events for cultural, entertainment and sporting purposes; providing educational information relating to charitable causes;

¹ The opposition initially included section 5(6) of the Act, but this was subsequently dropped.

providing on-line electronic publications; information and advisory services relating to all of the aforesaid services.

Provision of food, drink and temporary accommodation in relation to humanitarian aid and disaster relief services; information, advisory and consultancy services in relation to the aforesaid.

Medical services in relation to humanitarian aid and disaster relief services; information, advisory and consultancy services in relation to the aforesaid.

Legal services; lobbying for political and humanitarian purposes; information, advisory and consultancy services in relation to the aforesaid.

4. The opponent claims that use of the trade mark applied for would therefore be a misrepresentation to the public and which would result in damage to the aforementioned goodwill.

5. Under section 3(6) of the Act, the opponent claims it has operated as a registered charity in the UK since November 2005, and as a charitable organisation since November 2002 under the UNITED SIKHS mark. The opponent states that the UNITED SIKHS is a U.N. affiliated charity with 10 chapters around the world, including a UK and a US chapter, each of which work collaboratively to achieve the common goals of the charity, but states that the operations are restricted jurisdictionally unless agreed otherwise. The opponent (the UK chapter) states it discovered the applicant (the US chapter) had applied for the UK trade mark when it sought to file this itself. The opponent states it incorporated a limited company to hold the property on 3 September 2020, and on the same day the applicant filed the application. The opponent states it had also discovered the applicant had launched competing operations in the UK. The opponent pleads the applicant's filing of the mark in the UK without notifying the opponent "...marked a radical change in practice" and claims the Application was filed as a blocking mechanism, and that the behaviour falls short of the standards of acceptable commercial behaviour.

6. The applicant filed a counterstatement denying the claims made. The applicant states that the charity was set up in 1999 in New York, and that its UK chapter, namely the opponent, was set up in 2002 by Hardayal Singh, a member of the Board of Trustees of the charity, with the assistance of others including Mejjindarpal Kaur, a current member of the Board of Trustees of the opponent, and that the applicant provides funding to enable the UK chapter to operate. The applicant claims the UK chapter, namely the opponent, has no exclusive right to use the name or logo in the UK, and they do not own the goodwill arising from their activities in the UK. The applicant states that the applicant's Board of Trustees acting in the best interests of all stakeholders internationally has oversight in all regions to ensure cohesion, and that each Chapter follows rules meant to protect them and the UNITED SIKHS name, logo and reputation as a whole. The applicant states it took advice from outside counsel regarding formalising an international corporate structure, but that previously arrangements had relied on trust. They state the applicant's UNITED SIKHS Board of Trustees is being replaced by a commonwealth of all chapters under UNITED SIKHS International. They state they became concerned the opponent was losing focus and became aware of changes to the composition of opponent's Board of Trustees, including the removal of Hardayal Singh. It was due to these concerns the applicant filed the applications as part of an international filing programme. The applicant therefore denies the application was filed in bad faith under section 3(6) or that the opponent owns the goodwill to bring an opposition under section 5(4)(a).

7. Both sides filed evidence in these proceedings. A Hearing took place on 3 August 2020. Both sides are professionally represented. The applicant is represented by Clifford Chance LLP, and appointed counsel for the hearing, namely Alice Hart of Three New Square chambers. The opponent is represented by Morgan Lewis & Bockius UK LLP, and also appointed counsel for the hearing, namely Beth Collett of 8 New Square chambers.

8. Although the UK has left the EU, 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

9. The evidence filed within these proceedings is relatively extensive, and I do not intend to summarise this in great detail at this stage. However, the evidence has been considered in full and I will refer to it as appropriate within this decision, and the witness statements and exhibits filed by both parties are outlined below:

Opponent's evidence in chief

- Witness statement of Mejindarpal Kaur, Chair and Trustee of UNITED SIKHS (Charity Number: 1112055) dated 2 September 2021. This statement introduces 49 exhibits, namely Exhibit MK1 – Exhibit MK49

Applicant's evidence

- Witness statement of Hardayal Singh, a founding member and a member of the Board of Trustees of UNITED SIKHS (US), dated 17 November 2021. This statement introduces 15 exhibits, namely Exhibit HS1 to Exhibit HS15.
- Witness statement of Harpreet Singh, a member of the Board of Trustees of UNITED SIKHS (US) since 2017, dated 16 November 2021. Ms Singh states she was involved in the meeting to create the original UNITED SIKHS in the Service of America organization in 1998 (whose name is now UNITED SIKHS).
- Witness statement of Dabinderjit Singh Sidhu, the Principal Adviser to the Sikh Federation (UK), secretariat support to the All Party Parliamentary Group for British Sikhs and a founding member of the Sikh Network set up in 2014, dated 15 November 2021. Mr Singh Sidu states he has been an internationally known Sikh activist for the last two decades.
- Witness statement of Sukhvinder Singh, currently employed as Equality, Diversity and Inclusion lead within a UK University and is on the Leadership Panel of the Sikh Federation UK on a voluntary basis, as well as being a policy adviser and board member of the Sikh Network, sitting on the Advisory Panel

of Sikh Council UK and an adviser for Sikh Helpline UK, dated 17 November 2021.

- Witness statement from Ravjeet Singh, Chair of the Metropolitan Police Sikh Association and Executive Director for National Sikh Police Association in the UK and member of the UNITED SIKHS until 2012, dated 17 November 2021. The statement introduces two exhibits, namely Exhibit RS1 – Exhibit RS2.
- Witness statement from Gurpal Singh, a member of the gurdwara and head of operations at the National Sikh Museum in Derby, and now operations manager for the UK Chapter under management of the Applicant, dated 17 November 2021. The statement introduces one exhibit, namely Exhibit GS1.
- Witness statement from Narpinderjit Mann, a volunteer for the UK Chapter of the United Sikhs since 2008, dated 17 November 2021. The statement introduces a single exhibit, namely Exhibit NM1.
- Witness statement of Jasmeet Singh, member of the board of the UNITED SIKHS, India Chapter since 2019 and Treasurer in the Executive Committee of UNITED SIKHS, India Chapter, dated 18 November 2021. Ms Singh states she has been in contact with the UNITED SIKHS since 2001.
- Witness statement of Sukhwinder Singh, a member of the board of the UNITED SIKHS Canadian Chapter, dated 17 November 2021.
- Witness statement of Gurvinder Singh Madaan, a member of the board and National Director (Humanitarian) of the UNITED SIKHS Australia Chapter since 2016, dated 16 November 2021.
- Witness statement of Singhara Singh Mann, the current president of the French UNITED SIKHS chapter, dated 17 November 2021. This statement introduces one exhibit, namely Exhibit SS1.

Opponent's evidence in reply

- A second witness statement of Mejindarpal Kaur, dated 1 February 2022. The statement introduces thirty-one exhibits, namely Exhibit MK50 – Exhibit MK81.
- Witness statement of Harjot Kaur, a Trustee of UNITED SIKHS UK Chapter, dated 1 February 2022. The statement introduces two exhibits, namely Exhibit HK1 and Exhibit HK2.
- Witness statement from Gurmeet Kaur, dated 1 February 2022. Ms Kaur states she is known worldwide by Sikh and Punjabi community as the author of the children's book series Fascinating Folktales of Punjab and the dual-language edition of the illustrated biography of Jaswant Singh Khalra, the iconic human rights activist from Punjab.
- Witness statement of Amarjit Kaur, former president of UNITED SIKHS Belgium, dated 1 February 2022.
- Witness statement of Davinder Singh Prit, and solicitor, and a trustee of Gurudwara Guru Nanak Darbar since February 2016.
- Witness statement of Sunil Shukvir Singh, President of UNITED SIKHS Malaysia, dated 1 February 2022.²
- Witness statement of Gurdial Singh, dated 1 February 2022. Mr Singh states he runs the Damesh Academy, which runs empowerment camps for the community and is a founder member of the Gurdwara Singh Sabha, Bobigny, the first Gurdwara in France.

² I note the 'signed' section on this witness statement appears to be blank, although a printed name is included next to the section marked 'name'. However, having considered the evidence, and for reasons that will later become apparent, I do not consider this statement will have an impact on the outcome of any aspect of this decision or the decision overall, and as such I do not intend to request that a signed statement be submitted at this time.

Legislation

10. 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-

(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.”

11. 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.”

Section 5A

12. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

13. 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).”

The relevant date

14. 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, 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.’ ”

15. The witness statement of Ms Mejindarpal Kaur states that Mr Hardayal Singh began to run “parallel projects in the UK, without the involvement of the opponent” beginning after 2018.³ I also note that in the witness statement of Gurpal Singh provided by the applicant, Mr Singh states he is now operations manager for the UK Chapter under management of the applicant, that he was appointed by the applicant in December 2019 and he has managed UK humanitarian work and worldwide projects. Gurpal Singh states that there have been operations run by the applicant since 2019, stating “a full list of activities can be seen below, which lists initiatives that my team, rather than Ms. Kaur, are responsible for in the UK”. The first is dated ‘December 2019’. In his witness statement, Gurpal Singh states:

“When the COVID-19 pandemic hit, Naprinderjit Mann and I approached Ms. Kaur about funding for the food bank to address the emergency shortage of provisions caused by the pandemic. Her response was that we had to raise our own funds for this work. Ms. Kaur refused to acknowledge the urgent need and the limited time available to act. I turned to the Applicant for help, and since have been out of contact with Ms. Kaur. When Ms. Kaur has since been involved in local projects, she has often argued with the local team and withdrawn her assistance.”

16. It appears the parties agree to an extent that there have been parallel projects taking place in the UK and run by the applicant since December 2019. It is not entirely clear if these projects have taken place with the permission or collaboration of the opponent, or if they have been run completely independently of the same. For completeness, I will therefore keep in mind the position in December 2019 in addition to the position at the partial priority and the filing date of the application in this instance, those being 7 May 2020 and 3 September 2020 respectively.

³ See paragraph 14 of Mejindarpal Kaur’s second witness statement

Goodwill

17. Goodwill is described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 233 as below:

“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.”

Is there goodwill?

18. It does not appear to be in dispute that a charitable unincorporated association has been operating under the sign UNITED SIKHS in the UK in 2002. Further, I note from the opponent's evidence, particularly Exhibit MK9 that the organisation was registered as a charity in the UK in 2005.

19. It is also shown within the opponent's evidence that between 2005 – 2019, the organisation operating under the sign in the UK received an income £830,260.⁴ It is stated in the witness statement provided by Ms Kaur, the Chair and Trustee of opponent, that 92% of this money was raised from individuals, third parties and grant providers.⁵

20. The scope of the work carried out under the sign is said to be global, with UK based donations also supporting projects abroad.⁶ Ms Mejjindarpal Kaur explains in her witness statement at paragraph 25 that the opponent has played a role including a leadership role in humanitarian disaster relief action globally. A 'Charity Overview' from a 'gov.uk' website for the opponent is provided at Exhibit MK15 provides details as follows:

⁴ See Exhibit MK12 comprising the Annual Charity Commission Accounts Summary in addition to paragraph 19 of the witness statement of Mejjindarpal Kaur.

⁵ See paragraph 19 of the witness statement of Mejjindarpal Kaur.

⁶ See paragraph 23 of the witness statement of Mejjindarpal Kaur.

UNITED SIKHS



Charity reporting is up to date (on time)

Charity number: 1112055

Charity overview

Activities - how the charity spends its money

1. The promotion of diversity and equality and relieving the charitable needs of those who have suffered discrimination. 2. The relief of people and communities who are suffering hardship as a result of natural disaster. 3. The relief of poverty; 4. The advancement of education; 5. The advancement in life of young people; 6. The provision of counselling and other advice to those in need.

Income and expenditure

Data for financial year ending 31 December 2019

Total income: £36,239

Total expenditure: £33,811

People



3 Trustee(s)

15 Volunteer(s)

21. A number of articles are provided from the United Sikhs website⁷ at Exhibit's MK18 – MK34. These articles are dated between 2005 and 2018⁸ and are said by Ms Kaur to indicate the scope of the projects undertaken by the opponent during that time. These include:

- Meeting with New Scotland Yard Police to discuss security step-up measures following the London Bombings, and launching a Hate Crime Incident Report facility in conjunction with other Sikh organisations in 2005;⁹
- Organising a school bag appeal with London schools for the benefit of victims of a South Asian earthquake in 2005.¹⁰

⁷ The ownership and shared use of this website will be discussed in more detail later in this decision.

⁸ Where dates are not provided in the articles themselves these are outlined at paragraph 26 in the witness statement of Ms Kaur.

⁹ See Exhibit MK18

¹⁰ See Exhibit MK20

- Involvement in the Tsunami and Hurricane Katrina disasters.¹¹
- Backing a successful legal challenge in the High Court to the exclusion of a school girl for wearing a Sikh religious bangle in 2008.¹²
- Writing to a Coventry school on behalf of Sikh parents to successfully request the reversal of a policy of banning the Sikh head dress patka in 2008.¹³
- Engaging their legal team to reverse the ban on the wearing of a kirpan whilst sitting AS and A Level exams in 2009.¹⁴
- Liaising on behalf of, supporting and seeking donations for school fees and legal fees for a student after his North London school who stated he could no longer wear his Kirpan 2009.¹⁵
- Requesting intervention from the Polish Prime Minister in relation to the problems faced by Sikhs being asked to remove their turbans at Polish airports in 2010.¹⁶
- Supporting a prison officer following his dismissal for wearing a Kirpan in 2011.¹⁷
- Writing to the Prime Minister (David Cameron) requesting he calls on India to abolish the death penalty and free Balwant Singh Rajoana 2012.¹⁸
- Arranging an exhibition to showcase Sikh identity and arranging free community meals at the London Olympics in 2012.¹⁹
- Providing assistance to elderly flood victims in Yorkshire in 2016.²⁰
- Working with UK automotive retailer Halfords to ensure Sikhs may wear Kirpan on their premises in 2016.²¹
- Providing 'winter warmer' parcels including warm clothing to less fortunate families during winter in 2017.²²

¹¹ See Exhibit MK20

¹² See Exhibit MK21 & MK22

¹³ See Exhibit MK23

¹⁴ See Exhibit MK24

¹⁵ See Exhibit MK25

¹⁶ See Exhibit MK26

¹⁷ See Exhibit MK27

¹⁸ See Exhibit MK28

¹⁹ See Exhibit MK29 & MK30

²⁰ See Exhibit MK31

²¹ See Exhibit MK32

²² See Exhibit MK33

- Providing support to a Sikh TV Anchor who did not receive regular service on a BA flight and took the case to mediation in 2018.²³

22. Further, the witness statement of Narpinderjit Mann provided by the applicant confirms she worked for the UK Chapter since 2008 and assisted in the running of a successful UK help desk under the sign, which assisted with various issues from immigration advocacy and other matters to homeless assistance, which between 2008 and the time of the statement assisted over 5000 people.²⁴

23. An award was presented to UNITED SIKHS at the 'Sikhs in Charity' award at the first Sikh award in 2010.²⁵ In addition, there is evidence showing the opponent collaborating with the applicant and other chapters to help fund international projects, such as the Right to Turban fund mentioned by both the applicant and the opponent on a number of occasions.

24. There is no doubt in my mind from the sum of the evidence that, prior to December 2019 and the priority and filing date of the application, there will have been goodwill in the UK in respect of charitable services, legal liaison and political lobbying services, and that this goodwill will have been distinguished by the sign UNITED SIKHS. Indeed, it does not appear that the existence of goodwill in the name is in dispute by the parties. Instead it is the ownership of this goodwill that is disputed. The applicant states in its counterstatement as follows:

"UNITED SIKHS denies that the goodwill attaching to the Applicant's Mark belongs to the Opponent and not to UNITED SIKHS. The Opponent was set up under the auspices of UNITED SIKHS and uses the UNITED SIKHS name and logo with the permission of UNITED SIKHS. The Applicant has provided funding and support for the Opponent's activities and much of the Opponent's contact with the public in the United Kingdom is via the website and social media channels set up and controlled by UNITED SIKHS.

²³ See Exhibit MK34

²⁴ On the contrary, Mejjindarpal Kaur for the opponent states the helpdesk was set up in 2010 at paragraph 33 of her second witness statement.

²⁵ See paragraph 29 of Ms Kaur's statement as supported by Exhibit MK43

UNITED SIKHS contends that it, and not the Opponent, owns the goodwill in the Applicant's Mark.”

25. The question to be answered at this stage is therefore who is the owner of the goodwill as distinguished by the sign in the UK.

The standing of the opponent

26. Before I proceed to consider the question of where the ownership of the goodwill lies, it is prudent that I address another point of dispute between the parties, and that is the standing of the opponent to bring the opposition in the name of ‘United Sikhs’. Within its submissions filed during the evidence rounds, the applicant argued:

“8. As an unincorporated association, the opponent does not have legal personality. Its assets and liabilities are those of its members (Cross J in *Neville Estates Ltd v Madden* (1962) Ch 83).

9. The fact that it registered with the Charity Commission in 2005 does not provide it with a legal personality independent of its members.

10. The Opponent's evidence and submissions say very little about the basis on which "the Opponent" purports to act, nor who, in legal terms is claimed to be the owner of any goodwill that would entitle it to oppose the Applicant's application.”

27. At the hearing, Ms Hart for the applicant expanded on these arguments, making reference to the *Artistic Upholstery Ltd v. Art Forma (Furniture) Ltd* [2000] FSR 311. Paragraphs 31 and 32 of *Artistic Upholstery* read as below:

“IV. Unincorporated associations

31. An unincorporated association is not, of course, a legal person. In *Currie v. Barton*, *The Times*, February 12, 1998, CA, O'Connor L.J. said, in relation to unincorporated associations, the law “does not recognise that those bodies

have any corporate or separate legal existence. They cannot be sued or sue in their own names. You cannot make a contract with the body, because in law it does not exist. It consists of all its members.”

32. The rights of members as between themselves are contractual. In *Re Bucks Constabulary Widows and Orphans Fund Friendly Society (No. 2)* [1979] 1 W.L.R. 936, 952, Walton J. said that judicial opinion:

...is now firmly set along the lines that the interest and rights of persons who are members of any type of unincorporated association are governed exclusively by contract; that is to say rights between themselves and their rights to any surplus assets.”

28. Ms Hart submitted that as per the referenced case law, whilst charities may accumulate and hold goodwill, charitable unincorporated associations cannot hold goodwill in their own name.

29. The opponent did little to answer these assertions prior to the hearing. However, at the hearing, Ms Collett addressed this initially by stating that the opponent’s primary position is that charities can own goodwill (the implication being that the opposition may be filed in the name of United Sikhs), and that its secondary position was that the opponent may file the opposition in the name of the United Sikhs provided it has the support of its trustees. In support of the opponent’s primary position, Ms Collett provided extracts from Wadlow on the Law of Passing Off [6th Edn], including those as set out below:²⁶

“3-114 In contrast to trade and professional associations, charities do not necessarily or typically provide their members, subscribers or supporters with tangible benefits so as to be said to enjoy any goodwill in the provision of services to their members for value. However, charities and other non-profit or non-trading organisations such as churches, political parties and interest groups, do depend on the financial contributions of their members and the

²⁶ Footnotes have been removed

general public. To that extent, they may be said to have something corresponding sufficiently closely to the goodwill of trading organisations in so far as they are able to attract money (or money's worth) which would otherwise have been kept, spent or bestowed elsewhere. It is settled law that even a non-trading charity may maintain a passing-off action against another similar charity and a fortiori any such charity would expect to be protected against exploitation of its reputation by a non-charitable commercial organisation, or an outright fraudster. Although the claimant in the Diabetic Association case was principally a self-help charity (analogous in some ways to a members' club or even a motoring organisation), the implications of the decision extend to every kind of charity, regardless of the extent to which selflessness is combined with self-interest. What is true for charities may be applied with suitable caution to other non-trading organisations dependant on public financial support.

3-115 ... There is no doubt that in its capacity as a trading concern a charity, whether incorporated or not, has as much locus standi in a passing-off action as any other business.”

30. Later on in the hearing, Ms Collett changed her secondary position on this matter, stating that it remained the opponent's primary position that it holds the locus standi to bring the claim, but if they are found not to hold this, they request the following alternatives:

- (1) The opponent requests to make an amendment to the opposition to bring the claim on behalf of the trustees of the opponent on the basis that this is a procedural point; or alternatively
- (2) If the opposition fails of this basis, there should be nothing (particularly there should be no estoppel) preventing the opponent from filing an application for the invalidation of this mark once it becomes registered.

31. As stated, the opposition has been filed in the name of UNITED SIKHS, and the statement of grounds filed with the opposition clarifies the opponent is UNITED SIKHS (UK) with registered charity number 1112055. At MK10 of its evidence, the opponent

filed a copy of the opponent's current constitution, entitled "GD3 - Model Constitution for a Charitable Unincorporated Association". The document states that it contains amendments dating from 29 August 2020, and that it was originally adopted in October 2005. The original 2005 constitution is provided by the applicant at Exhibit HS5. There is no suggestion from the opponent that it was not an unincorporated association at the time the opposition was filed.

32. With consideration to the authorities provided by both parties, it is my view that there is no doubt that a charity is in principle capable of accruing and owning goodwill under a sign. This is clearly explained in the passages provided from *Wadlow [6th Edn]* above, particularly at paragraphs 3-114 of the same. However, it is true that not all charities are unincorporated associations, and not all unincorporated associations are charities. So whilst it is the case that a charity, through its endeavours, is capable of acquiring goodwill, this does not mean it is also the case that a charity that happens to also be an unincorporated association may hold property in the name of that association. Indeed, I find *Artistic Upholstery* tells us that any goodwill (which, as identified, is capable of being acquired through charitable endeavours), will be held jointly by the members of the unincorporated association. Further, I note that should the constitution of a charity vest the legal ownership of its property to the trustees of the charity, it will be the trustees that are the correct legal owners of the goodwill in the mark.

33. I note the changes made to the constitution of the opponent on 23 August 2020 as provided at MK10 states as follows:

7 Membership.

(1) The Trustees may appoint any person to be a member provided that person has also agreed to be a Trustee. Membership of the Charity cannot be transferred to anyone else.

(2) Any member and Trustee who ceases to be a Trustee automatically ceases to be a member of the Charity.

(3) The Trustees must keep a register of names and addresses of the members which must be made available to any member upon request.

34. From the above, it is shown to be the case that the Board of Trustees of the opponent were, at the date the opposition was filed and at the date the application was filed, also the sole members of the opponent as an unincorporated association. Whilst it is the case that they may not have been the sole members of the opponent at the priority date of the application or earlier, as Mr Hardyal Singh submits, it is my view that this does not prevent them from bringing the opposition at the date it was filed, as the remaining members and trustees of the opponent when the opposition was brought.

35. However, it remains the case that the opponent is listed as 'UNITED SIKHS' on the Form TM7. It is clear the use of UNITED SIKHS by the opponent was intended to represent the registered charity number 1112055 'UNITED SIKHS', with the details of the charity number and address being identified within the opponent's statement of grounds. This is and was at the relevant dates and the date the opposition was filed an unincorporated charitable association,²⁷ and as such, in my view it cannot legally hold the goodwill on which the section 5(4)(a) claim has been brought in its own name.

36. As I have found the opponent has no standing to hold property including goodwill in the name UNITED SIKHS, I consider Ms Collett's request on behalf of the opponent to make an amendment to the party bringing these proceedings. I note that whilst the opponent submitted this was purely a procedural point, Ms Hart for the applicant submitted this is a substantive point, it is too late to request this amendment, and that the opposition should instead be struck out.

37. As stated above, the Board of Trustees of the opponent were and are the sole members of this charity according to its current constitution, and it was the Board of Trustees who will hold the goodwill accrued by its activities (if it is found that this resides with the same). It is the Board of Trustees who will be responsible for and liable for the proper administration of the charity on behalf of its beneficiaries.

²⁷ I note the reference to the opponent setting up a limited company to hold its property on the 3 September 2020. However, I have no evidence that there has been a transfer of any property between the members of the unincorporated association and this entity and I find no reason to believe that this entity held any goodwill as of 3 September 2020.

38. In this instance, I am in agreement with the opponent that the use of 'UNITED SIKHS' on the initial form equates at most to what is essentially a procedural error, that may be easily and simply regularised by amendment to the opponent to 'The Board of Trustees of UNITED SIKHS, a UK Charity number 1112055' as at the date of filing the opposition. It is my view that had the matter of the opponent not being able to hold property been picked up by the Registry when examining the admissibility of the Form TM7, or had it been raised by the applicant in its initial counterstatement (which it was not), the opponent would have or at least should have been provided with an opportunity to make amendments to the same. The applicant's defence within its counterstatement was not based on the argument that the opponent has no legal personality and therefore could not hold property, and it is my view that no prejudice will be caused by the substitution of the opponent 'UNITED SIKHS' with the opponent 'The Board of Trustees of UNITED SIKHS, a UK Charity number 1112055' in this instance. I therefore direct that the opponent in these proceedings be amended to 'The Board of Trustees of UNITED SIKHS, a UK Charity number 1112055' accordingly.

39. Having established the trustees of the charity are capable of collectively holding goodwill in the UK, there is one additional point I find it prudent to address before continuing with the substantive issues, and that is the consequence of the opponent's removal of trustees Hardayal Singh and Harpreet Singh in 2019, and the removal of these individuals (and any other non-trustees) as members in 2020. Within its written submissions, the applicant states:

"Hardayal Singh was closely involved with the activities in the UK from the initial stage onwards. He attended the event Ms. Kaur describes as an AGM in November 2002. He and Harpreet Singh (also from the United States) were members and registered as trustees for over a decade with the Charity Commission from 2005 until about 2019, when they ceased, without their knowledge, to be listed as trustees. Currently key projects in the UK, including the helpline, are today being supported and funded by the Applicant, due to lack of support from Ms. Kaur."

40. At the hearing, Ms Hart for the applicant stated:

“I must mention the removal of Hardayal and Harpreet Singh as trustees from the UK charity in 2019. First, we say that their trusteeship originally before they were removed is again supportive of this collaboration and involvement of the applicant in the UK activities as representative. But as to their removal without their knowledge, we must challenge the submission in my learned friend's skeleton that this was by legitimate means. I am afraid there is no basis on which to say that. My learned friend relies upon the fact that no challenge has formally been made to the Charity Commission, and that again is not in evidence and again we do not see how that assists in this case. That does not suddenly mean the unchallenged evidence they were removed without their consent can somehow be disregarded.

There is also the issue of the amendments made to the constitution in 2020 precluding those two individuals from being members at all. That is not addressed by Mejjindarpal in her reply evidence either. We say this is not a prejudicial point and we do not intend to make it as such. This is a relevant point and relevant evidence because, first, the opponent cannot rely upon the fact that those two individuals are no longer trustees of the UK chapter as somehow suggesting the applicant is detached from the UK chapter. I do not think that submission has been made, but we say the submission that their removal was not with their consent could not be made. Secondly, this is another example of an uncollaborative and disruptive approach to the running of the UK chapter. This all fits in with the objective circumstances that need to be considered when we come to the issue of bad faith and the steps the applicant is now taking to formalise the structure and file trade mark protection in the local chapter countries.”

41. On this point, I consider the passage below from *Artistic Upholstery* which deals with the matter of a perceived ‘wrongful expulsion’ of a member of the Guild as follows:

“49. The claimant accepts that summary judgement is not appropriate if the validity of Art Forma’s expulsion is a relevant issue. In my judgement, it is not relevant. Both sides contend that Art Forma is no longer a member of the Guild. The claimant relies on the expulsion of Art Forma from the Guild as terminating

its membership. Art Forma claims that the expulsion was a wrongful repudiation of the contracts between the members (including Art Forma), and that it has accepted the repudiation as terminating the contracts; and consequently the Guild has ceased to exist (“deemed to be dissolved and/or wound up”, in the words of the defence, para. 37), and the claimant has no standing to sue as a representative of the members, and the members have no goodwill left to protect. But, as Brightman J. said (*Re Recher’s Will Trusts* [1972] Ch. At 539) the contracts of members are multi-partite, and the members can by unanimous agreement (or by majority vote if the rules so prescribe) terminate their multi-partite contract. It would fly in the face of practicality and common sense that one member could, even if invalidly excluded, bring to an end all the relations *inter se* between the members by accepting the exclusion as a repudiation of the entirety of the contractual relations between the members: otherwise a sports club with hundreds or thousands of members could be effectively dissolved by the actions of a single aggrieved member. It does not seem ever to have been suggested that wrongful expulsion has this consequence, which would make no sense in practice or in theory. The appropriate remedy is a declaration that the expulsion is wrongful and (perhaps) damages: see cases cited at *Halsbury’s Laws of England* (4th ed.) Vol. 6, para. 237, to which I was referred by counsel after the hearing.”

42. I have considered the impact that the claimed wrongful removal of Hardayal Singh and Harpreet Singh as Trustees and members may have on this matter. After consideration of the case law in addition to the facts of this case, it is my view that the removal of Trustees and members in 2019 and 2020 will not have dissolved the association, such as the case may be with other unincorporated parties such as partnerships, which are of course governed under their own provisions in the Partnership Act 1890. Further, in *John Williams and Barbara Williams v Canaries Seaschool SLU* (“Club Sail”), BL O/074/10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, discussed the ownership of the goodwill generated by the business activities of the sign CLUB SAIL SEA SCHOOL, and explained what happens to the collectively owned goodwill when membership of one or more members of an alliance ceases. Mr Hobbs KC stated as follows:

“26. This opens up the appeal to the extent that I am now required to determine the competing claims of the parties to proprietorship of the goodwill of the business appertaining to the signs in issue. Before doing so, I make the general observation that goodwill can be and frequently is built up and acquired by means of economic activities carried out collectively. By using the word ‘collectively’ I am intending to refer to all of the various ways in which alliances may be formed between and among individuals or corporate bodies in pursuit of shared interests and objectives [..]

[...]

27. I consider that the starting point for the purposes of analysis in the present case is the general proposition that the goodwill accrued and accruing to the members of an alliance such as I have described is collectively owned by the members for the time being, subject to the terms of any contractual arrangements between them: *Artistic Upholstery Ltd v. Art Forma (Furniture) Ltd* [2000] FSR 311 at paragraphs 31 to 40 (Mr. Lawrence Collins Q.C. sitting as a Deputy High Court Judge). When members cease to be members of an ongoing alliance they cease to have any interest in the collectively owned goodwill, again subject to the terms of any contractual arrangements between them; see, for example, *Byford v. Oliver (SAXON Trade Mark)* [2003] EWHC 295 (Ch); [2003] FSR 39 (Laddie J.); *Mary Wilson Enterprises Inc’s Trade Mark Application (THE SUPREMES Trade Mark)* BL O-478-02 (20 November 2002); [2003] EMLR 14 (Appointed Person); *Dawnay Day & Co Ltd v. Cantor Fitzgerald International* [2000] RPC 669 (CA); and note also the observations of Lord Nicholls of Birkenhead in *Scandecor Development AB v. Scandecor Marketing AB* [2001] UKHL 21; [2002] FSR 7 (HL) at paragraphs [42] to [44]. This allows the collectively owned goodwill to devolve by succession upon continuing members of the alliance down to the point at which the membership falls below two, when ‘the last man standing’ becomes solely entitled to it in default of any other entitlement in remainder: see, for example, *VIPER Trade Mark* (BL O-130-09; 13 May 2009) (Appointed Person, Professor Ruth Annand).

43. It is my view that the goodwill accumulated by the actions of unincorporated association operating under UNITED SIKHS in the UK will, subject to a finding that it is not the property of the opponent, therefore continue to be held by the current iteration of The Board of Trustees of UNITED SIKHS, a UK Charity number 1112055, and upon their removal as trustees and as members, Hardayal Singh and Harpreet Singh will no longer have an interest in this goodwill. The removal of Hardayal Singh and Harpreet Singh from the opponent's Board of Trustees and as members is therefore separate issue to that of who owns the goodwill in this instance, and not one that is to be considered within the scope of this opposition. I note for completeness, that I have considered Ms Hart's submissions that the removal of these individuals as trustees and members should be considered in the context of the section 3(6) ground as evidence of the opponent's uncooperative behaviour, and whilst I will consider these submissions in that context, I am of the view that this will be of little relevance to whether the applicant itself has filed the application in bad faith in this instance.

With whom does the goodwill reside?

44. I therefore move on to consider, with whom does the goodwill accumulated over the years of trading under the sign United Sikhs in the UK reside.

45. I note firstly that the constitution of opponent makes no mention of the applicant, nor does it mention goodwill accumulated under the sign. Further, I am not aware of any written contract or assignment in place, and so it is only the informal arrangements of the parties and the perception of the relevant UK public that I am to consider in this instance.

46. The only party in this instance located in and running operations from the UK at least up until 2019 was the opponent. The applicant itself is based in the US and has been working collaboratively with the opponent (and vice versa) primarily in relation to international projects. However, this does not necessarily mean the applicant is prevented from owning the goodwill accrued in the UK. In Wadlow 6th Edition, it is explained:

“3-319 A foreign business may have a goodwill in the jurisdiction even though it may not trade here in its own right. As the Court of Appeal acknowledged in *Scandecor v Scandecor*:²⁸

“We accept that, in an appropriate case, it is legally and factually possible for a business based overseas to acquire a goodwill in this country by the supply of its products or services through a subsidiary, agent or licensee. Whether or not that occurs must depend on the facts of the particular case.”

3-320 It is sufficient that customers for its goods are to be found here, whether or not the foreign business is in direct contractual relations with them. In particular, if the foreign business is represented by a legally distinct person of whatever capacity then the goodwill will in general belong to the foreign business rather than its local representative *provided* that the foreign business is recognised as the ultimate source of the goods. It is not necessary, or common, for the relationship to be one of agency in the strict legal sense.”

47. When there is a question of ownership of goodwill in the context of an international manufacturer and a UK distributor of goods, Wadlow (6th Edition) sets out the factors to consider as follows:

“3-295 To expand, the following questions are relevant as to who owns the goodwill in respect of a particular line of goods, or, *mutatis mutandis*, a business for the provision of services: (1) Are the goods bought on the strength of the reputation of an identifiable trader? (2) Who does the public perceive as responsible for the character or quality of the goods? Who would be blamed if they were unsatisfactory? (3) Who is most responsible in fact for the character or quality of the goods? (4) What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill? For example, goodwill is more likely to belong to the manufacturer if the goods are distributed through

²⁸ [1999] F.S.R. 26 CA.

more than one dealer, either at once or in succession. If more than one manufacturer supplies goods to a dealer and they are indistinguishable, the dealer is more likely to own the goodwill.”

48. Whilst it is true these considerations are framed in respect of the relationship between an international manufacturer and a UK distributor of goods, I find the same questions, may still act as a helpful guide where reframed for the current situation as follows:

- (1) Are the donations made on the strength of the reputation of an identifiable trader?
- (2) Who does the public perceive as responsible for the charitable operations undertaken?
- (3) Who is in fact most responsible for the charitable operations carried out?; and
- (4) What circumstances support or contradict the claim of the opponent or the applicant as being the owner of the goodwill?

Who is in fact most responsible for the charitable operations carried out?

49. I begin at question (3) above. It is agreed that prior to the establishment of the UK Chapter, that being the opponent, there existed a US organisation under the name *United Sikhs in Service of America*. It is also agreed that this now runs as UNITED SIKHS (that being the applicant), and there are a number of other chapters around the world also making use of this name. Further, it is agreed by both parties that the opponent has been run with the informal cooperation of the applicant. There are some shared resources, including a shared website and social media, and the funding for these resources is provided by the applicant.

50. The applicant, particularly Hardayal Singh, claims to have assisted the opponent in setting up or promoting the activities of the UK chapter. This is denied by the opponent. Whilst it appears likely from the evidence that Mr Singh was around and involved in some way with the UK chapter of the charity from the outset, indeed it appears he was on the Board of Trustees for the applicant between 2005 and 2019, I do not consider his involvement to be decisive, even though he also had involvement

with the applicant also. However, I do accept that the UK chapter was set up following the suggestion from and with the support of the applicant in 2002.

51. Since this date, both parties agree that there has, to some extent, been financial collaboration between the parties, particularly but not solely where they have worked together on joint endeavours, such as the Right to Turban campaign which was focused on change in France. The level of the applicant's financial support both in this campaign and in home grown action over the years is disputed by the parties, and within her witness statement, Ms Mejindarpal Kaur for the opponent states:

“18. United Sikhs UK's operations are financially independent of other charitable organisations and have been self-funded since the charity's establishment. United Sikhs UK's accounts, attached as Exhibit MK11, show that the Applicant did not provide funding to aid the establishment or running of United Sikhs UK.”

52. The accounts provided at MK11 are from 2005 – 2019. Some, but not all of the years, show a portion of the funds raised being attributable to transfers from the applicant, in addition to the Canadian chapter. However, many, although not all of the transfers are shown to be in the form of restricted funds directed at specific international projects. A useful summary of the accounts is provided by the opponent at Exhibit MK12 detailing that the total 'Transfers from USA and Canada' amount to 8% of income between 2005 – 2019, at approximately £70,117 of the total £830,260.

53. I also note that in his witness statement, Mr Hardayal Singh for the applicant states the chapters, including the UK chapter operate for the most part independently of the applicant, stating:

“56. For logistical reasons, and because financial rules differ across countries, the local boards of the various Chapters raise funds for the work their specific chapter's conduct in their respective regions. I believe they do so predominantly on the website and social media provided by the Applicant, at the Applicant's cost and with its permission. The local boards are responsible to raise funds for their regions and safeguard the chapters' resources and assets.

57. The more developed chapters, like the USA and the Canada-based chapter, assist other chapters, including the UK chapter, who cannot manage to implement the organization's mission on their own. The Applicant has spent close to \$76,146.00 on staff salaries and running expenses for the UK Chapter alone in the last two years and an additional \$12,000 for goods distributed for humanitarian aid work in the UK. This amount does not include \$465,401.00, which is the approximate expense of maintaining the social media and website internet presence for the years 2015 to 2021 (see above).

58. All funds received for the UK chapter on the website and through crowdfunding on the UNITED SIKHS Facebook page or social media, regardless of the source, are handled by or for Ms. Kaur as director of the UK chapter. While some donors via the website may be UK based, the site allows donors from around the world to donate to the UK chapter. It appears that, especially in recent years, the bulk of the funds received by the UK chapter have been being used to fund international activities rather than grassroots supports for the Sikh community in the UK.”

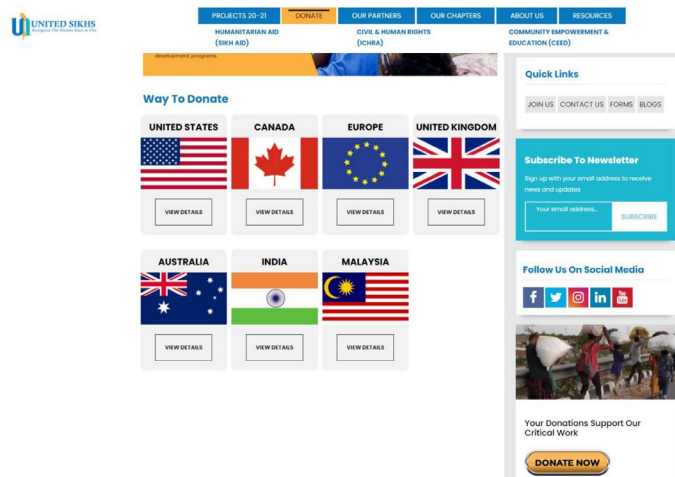
54. Mr Hardayal Singh's statement is dated 21 November 2021, and so based on his statement above it appears that the portion of funds transferred since November 2019 may have been higher than the 8% up until 2019, although it is not entirely clear if the money spent on 'staff salaries' as referred to are in relation to the running of the 'parallel operations' during this time.

55. Earlier in his statement, Mr Hardayal Singh states:

“54. Ms. Kaur claims that the Opponent is financially independent. The UK chapter raises donor funds and solicits volunteers through the UNITED SIKHS website, where each chapter has a fundraising page. This website is run and funded by the Applicant, as are other social media presences through which crowdfunding campaigns are run. Exhibit HS11 is the landing page for donations and the UK donations page on the unitedsikhs.org website.

55....Even if donations are made directly to the UK chapter by means other than the unitedsikhs.org website or social media presences, I would expect potential donors to have consulted the website in the process of deciding to donate.”

56. HS11 provides the page below:



57. The above page is undated. Within the opponent’s evidence in reply, Ms Mejindarpal Kaur for the opponent states:

“73. Further, we have not used the unitedsikhs.org website to raise funds for running our chapter or for events in the UK. Most donations via PayPal by UNITED SIKHS UK via the unitedsikhs.org website were received during a global humanitarian relief campaign run by all chapters. On average, the UNITED SIKHS UK PayPal facility on unitedsikhs.org website has received about £6000 a year. Likewise, JustGiving is a UK fundraising portal to fundraise for specific projects e.g. the Farmer protest relief campaign and the COVID-19 relief campaign in India. Both of these campaigns have taken place since 2019, after UNITED SIKHS UK lost access to the UNITED SIKHS website and social media platforms. Since 2019, we have publicized our fundraising campaigns through WhatsApp broadcasts by our team. My personal WhatsApp broadcast message reaches about 2500 people.

74. The UNITED SIKHS UK chapter has not relied on the unitesikhs.org website or UNITED SIKHS social media accounts for our 'financial independence'."

58. Ms Kaur's original statement provides further comment on how funds are raised by the opponent, stating as follows:

"19. Approximately 92% of the income was raised directly by United Sikhs UK from individuals, third parties and grant providers. Evidence of United Sikhs UK receiving grants from the National Lottery and TSB is attached at Exhibit MK13 and Exhibit MK14 respectively."

59. Exhibit MK13 shows two funding grants in 2010 and 2014 awarded to the opponent under its UK registered charity number, both in the region of £10,000. Exhibit MK14 shows screenshots of videos stating United Sikhs were awarded £300 in the TSB Bank Pride of Britain awards. The videos are posted on the United Sikh's Facebook and dated in 2018.

60. Within the witness statement of Hardayal Singh for the applicant, Mr Singh indicates that the local chapters not only hold a level of autonomy in their own regions but also a level of authority, stating:

"43. Whenever a chapter wanted to create programs or advocate in a different region from their own, they first consulted the leaders in the specific region about the project. There was and continues to be a spirit of mutual respect and collaboration between the different UNITED SIKHS Chapters worldwide. The boards have intermixed board members and the leadership communicates regularly."

61. Whilst this statement is made in the context of stating that Mejjindarpal Kaur was in breach of this understanding through her 'uncollaborative' activities in India, it nonetheless indicates that if another chapter, presumably including the US chapter, wishes to create a program or advocate in the UK, the understanding between the chapters is that the UK chapter would first be consulted.

62. Considering the comments from both parties provided in the evidence, it appears that in respect of the international work carried out, there is considerable collaboration between the various international chapters on the larger projects conducted overseas. It is also clear that where the opponent is conducting of operations outside of the UK without the consent of the local chapters or cooperation of the applicant, it is not, in the applicant's view, permissible. Further, the opponent appears to have received some funding from the applicant in respect of the international projects run over the years, and to have made use of the shared website and other online resources funded by the applicant.

63. However, when considering the UK work carried out within the local communities, it is clear that it is the opponent that is primarily responsible for the same, and that this is essentially agreed by both the opponent and the applicant. It appears from the evidence that in respect of the local projects, the opponent received the vast majority of the funds directly and allocated these and conducted local community projects without the oversight or involvement of the applicant, and without reliance on the shared resources. When it comes to answering the question as to who is most responsible for the charitable operations carried out in the UK the question is undoubtedly the opponent, but with regards to the operation of the collaborative international projects, the responsibility is at least for the most part shared, and often if not always may be weighted in favour of the applicant considering its running of the shared resources through which these operations appear to be funded.

Are the donations made on the strength of the reputation of an identifiable trader?

64. As discussed above, the opponent's donations are received in a number of ways. These are in the form of grants, for example the lottery grants mentioned, in addition to the donations from members of the public. In respect of the small portion of funding that is transferred from the applicant (and from the Canadian chapter) to the opponent, it is clear that this money will have initially been raised on the strength of the reputation of the applicant or the reputation of the other chapters such as the Canadian chapter, rather than on the strength of the opponent's reputation. However, I find it unlikely that

a large percentage of these funds (if any) were originally donated from the UK public, and the question in this instance is whose reputation is responsible for the donations from the relevant public, that being the UK 'customer'.

65. I note that a portion of the donations made to the UK chapter have been made via the website owned, funded and at least partially run by the applicant. Whilst it is true that a portion of these donations may have been received due to the reputation of the opponent, with individuals simply seeking a place to make online donations to the same, I find it reasonable to assume that at least a portion of these donations may also have been made based on the strength of the applicant's or other chapters reputation, with potential donors reviewing the website and choosing the UK based chapter to donate to due to their own location.

66. However, the opponent has stated that the donations received through the website only make up a small portion of the total donations received. I also note that the local UK projects are funded by donations made via other means, and whilst I do not have a huge amount of detail about how exactly all of the remaining donations are made, I do note the reference to the receipt of lottery grants to the UK Charity, in addition to the funding received from the TSB Bank Pride of Britain awards. I also note Hardayal Singh's reference that the local chapters raise funds for the work their specific chapter conducts in their respective regions. I note the number of projects operated by the UK chapter over the years, and whilst I note these projects are publicised on the shared website, this does not mean it will not result in recognition for the work undertaken locally by the opponent. It is my view that grants such as those given to the UK chapter by the national lottery, in addition to Pride of Britain funding, and a large number of donations and fund raising towards local projects will be as a result of the successful projects that have been controlled and run by the UK chapter, and the strength of the reputation held by the UK charity.

67. The evidence from both parties references the award presented at the Sikhs in Charity 2010 awards. The opponent claims this award was presented to the UK chapter. The applicant, on the other hand, states this award was presented in the UK, and so the UK chapter collected the same, but award was presented in recognition of the collaborative international work in which the applicant was involved. I consider the

evidence regarding this point, and I note particularly Exhibit HS13 provided by the applicant, which provides a press release summarising the awards ceremony on the applicant's website. This states:

"The panel of 5 esteemed judges, comprising Sir Mota Singh QC, Mrs Harminder Kaur, Mr. Peter Singh, Dr. Surinder Kaur and Mr. Ranjit Singh, selected the winners from nominees who have made a significant contribution to British society in the fields of business, sport, entertainment, charity, the media, service and education."

68. It is my view that in light of how the awards were reported within the press release issued by the applicant, this was likely awarded to the UK Chapter in recognition of the work carried out in the UK. The awards are reported to have been attended by "...above 600 Sikhs and leaders of other communities from the UK and abroad ..." ²⁹ This award is likely to have contributed to the reputation of the UK chapter and to the donations to the same.

69. It is my view that the donations and funding received by the opponent will likely be partially on the strength of the reputation accumulated by virtue of the collaborative international work, and is at least partly attributable to the applicant, but also that a significant part of the UK funding and donations will have been received on the basis of the body of work carried out in the UK and reputation of the opponent.

What circumstances support or contradict the claim of the opponent or the applicant as being the owner of the goodwill?

70. I move now to question 4 above. I note firstly that it is agreed by both parties the applicant was established before the additional international chapters, although it is also agreed this was set up under the name UNITED SIKHS IN SERVICE OF AMERICA. It is also not disputed that the UK entity was set up to work collaboratively with this chapter, with full knowledge of the same. The fact that the opponent acknowledges and refers to itself as the UK Chapter is not decisive, but it does indicate

²⁹ Exhibit HS13

an acknowledgement that it is at least to an extent connected informally with an international organisation.

71. In *British Legion v British Legion Club (Street)* (1931) 48 R.P.C. 555 the plaintiffs were a charity for ex-servicemen. There were a number of legally independent British Legion clubs operating, most of which were in the UK, which still acknowledged the plaintiff's ultimate authority. The British Legion required these clubs to submit to periodical inspections and in return the clubs were authorised to use the words 'British Legion' as part of their names. The goodwill generated by these clubs inured to the plaintiff. The defendant was operating as a social club for ex-servicemen without the authority of the plaintiff. When granting an injunction, Farwell J, held that the defendants would be taken as connected with the plaintiffs and that as such, damage would result.

72. Whilst the above case tells us that it is possible the goodwill in the mark will have inured to the benefit of the applicant, I note the fact that the opponent operates at least to a large extent independently, raising funds and operating on local projects without input or oversight from the applicant (and without any 'periodical inspections' or any such requirements) for over 15 years, does suggest that the opponent holds a better position than the clubs discussed in *British Legion* when it comes to owning its own goodwill in the mark.

73. It is also a point of dispute between the parties whether the other chapters operating around the world under the name United Sikhs ultimately recognise the authority of the applicant, as was the case in *British Legion*. Hardayal Singh for the applicant states in his witness statement:

"50. As I mention above, the Applicant, in conjunction with local chapters, is also discussing a restructuring to create an over-arching UNITED SIKHS international organisation in which each chapter can be formally represented. As of today, Ms. Kaur amongst those approached is the only representative of a local chapter who is not supportive of setting up this new international structure. I and others have attempted through various routes to bring her on board to the concept. From the Applicant's perspective, which I believe is

shared with by other UNITED SIKHS chapters, this UK trade mark opposition is an attempt to prevent this more formal structure being put in place, so that she may continue to operate without proper liaison with other chapters with the title of UNITED SIKHS International Legal Director.”

74. At the hearing, Ms Collett for the opponent argued that it has not been shown that all other chapters support the applicant’s new structure, and highlights that some chapters have filed evidence in support of the opponent, including, for example, the President of UNITED SIKHS Malaysia. Whilst I note this is the case, I find the witness statement provided by this statement does not address the question of whether the UNITED SIKHS Malaysia (or indeed the other UNITED SIKHS chapters) support or oppose the applicant’s new structure. I also find the applicant’s evidence to be inconclusive on this point, with phrases such as “amongst those approached” meaning I cannot conclusively find all other international chapters are in support of the applicant’s proposal. However, I do find that there are other chapters, such as the Canadian chapter, which do support the applicant’s plans to formalise its structure and who are seemingly supportive of the applicant’s position of authority across the chapters³⁰ and the evidence, namely the witness statements provided by the applicant suggest that UNITED SIKHS France, India and Australia all support the applicant within these proceedings.³¹ The recognition of authority from other international chapters is not conclusive, as this decision concerns the particular relationship and context of the running of the UK chapter, but it is a factor that supports the applicant’s position that it is viewed as the ‘headquarters’ and of the chapters, a point that is denied by the opponent.

75. However, I note that the discussion and the disagreement on which chapters support the applicant in its intention to “create an over-arching UNITED SIKHS international organisation”, does not address the fact that, as the applicant indicates by making this statement, that there was no such overarching international organisation or structure in place at the relevant date. This supports the opponent’s

³⁰ See paragraph 12 of the witness statement of Sukhwinder Singh, President of UNITED SIKHS Canadian chapter.

³¹ See witness statements from Shingara Singh Mann, Jasmeet Singh and Gurvinder Singh Madaan respectively.

position that the various national chapters were independent entities which co-operated on international projects at the relevant date.

76. I have already discussed the existence of the shared website, and I note here that it does reaffirm the position of collaboration between the parties, which I also note is not in dispute. It is also not in dispute that the website is funded by the applicant, although Ms Mejjindarpal Kaur for the opponent states that all chapters contribute to the websites content, and that she was a key contributor up until 2018.³² It is also agreed that up until fairly recently the majority of the social media was collaborative, and whilst Ms Mejjindarpal Kaur states this was set up by the opponent, it seems to be agreed that the running and funding of the same is undertaken by the applicant. Again, these are points that help the applicant to show a link between the entities, supporting an argument that some of the goodwill accrued in the UK may have inured to the benefit of the applicant.

Who does the public perceive as responsible for the charitable operations undertaken?

77. I now address the final question above. I have left this question until last as I believe it draws on factors from the previous questions set out, and it is also a major point of dispute between the parties.

78. The applicant has filed witness statements in its evidence from individuals that are heavily involved in Sikh activism, including Dabinjderjit Singh³³ and Sukhvinder Singh³⁴. These individuals attest to the fact that to their knowledge, the UNITED SIKHS is an international organisation either headquartered in or started in the USA respectively. These individuals are likely of course to have a deeper knowledge of the workings of Sikh charities than the majority of the relevant public, those being (generally) members of the Sikh population in the UK.

³² See paragraph 49 of Mejjindarpal Kaur's second witness statement.

³³ "...an internationally known Sikh activist for the last two decades" (witness statement of Dabinjderjit Singh)

³⁴ "...currently on the Leadership Panel of the Sikh Federation UK, which is a non-governmental organisation that works with the main UK political parties to promote relevant Sikh issues" (witness statement of Sukhvinder Singh).

79. The applicant also provides a witness statement from Ravjeet Singh. Mr Singh explains that he became aware of and used the services of the opponent as follows:

“5. I first became aware of the UNITED SIKHS in 2000 when I was a student and started following the UNITED SIKHS legal cases. These were civil and human rights cases in various countries having to do with the Sikh right to wear a turban, particularly in France.

6. A few years later, I contacted UNITED SIKHS on behalf of my family because my brother was a minor and he was being excluded and segregated from other students in his school due to the fact that he wears a Sikh Article of faith, Kirpan. It was my understanding at the time that UNITED SIKHS was one international organisation with various Chapters, and I believe I contacted them by filing out a form through the website www.unitedsikhs.org, which I later came to know is administered by the USA Chapter.”

80. Mr Ravjeet Singh explains he later became involved as a volunteer and then as a director for the UK chapter, but that he left in 2012 “predominately because [he] had professional differences with Mejjindarpal Kaur”. Mr Singh’s statement does not specifically state that he was aware or under the impression that the applicant itself was responsible for the charitable operations, however, Mr Singh confirms he believed an international organisation to be responsible for the UNITED SIKHS, rather than the UK chapter alone.

81. At the hearing, Ms Hart submitted:

“We say Ravjeet Singh's evidence is important because he speaks from the perspective first of a member of the relevant public. A criticism was made by my learned friend that we do not have helpful evidence from members of the public. We say Ravjeet Singh was exactly that. He explains his perception of the organisation as a user of the services of the organisation (that was paragraph 6) when he first sought their services for assistance with his brother's case. He used the central website for this purpose and that was his

understanding at the time of how the organisation was structured.”

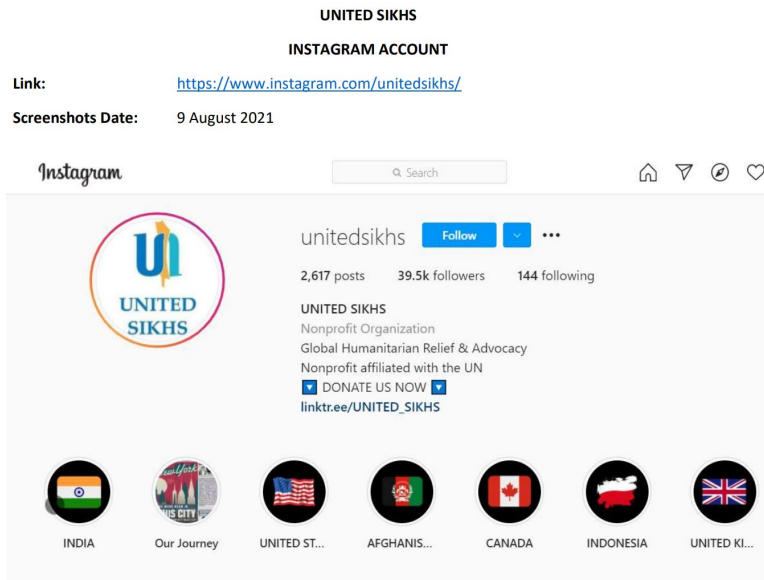
82. Whilst I note Ms Hart’s arguments that Mr Singh initially came across the opponent as a member of the public, it is also the case that Ravjeet Singh had been following their international campaigns as a student, and then subsequently sought their assistance within the UK. Further, he states he only later become aware of aspects such as the website being “administered” by the applicant after using the same, and again I note there is no express statement confirming he believed, particularly when he first came into contact with them, that the USA Chapter were in charge. He also states he was in regular contact with the USA and Canadian directors before he left his post due to professional differences with Ms Kaur of the opponent in 2012, and so his knowledge at that time and when writing the statement will be far beyond a typical member of the relevant public. Notwithstanding this, it is also true that the evidence in the form of a witness statement from one or even several individuals adduced for the purposes of the proceedings only goes so far to show who the relevant public would believe were responsible for the running of the same, and although this evidence is not discounted, it must be considered as part of the picture the evidence creates as a whole.

83. As previously mentioned, up until around 2020 the parties shared social media sites in addition to the website, although Mejindarpal Kaur states in her evidence that funding received through these has also been only part of that received and was primarily in respect of the international projects. Nonetheless, it is clear that on viewing the website or social media site, the relevant public would understand the UK chapter to be part of a larger organisation. Ms Kaur states herself:

“The general United Sikhs Facebook page was established on 21 February 2010. Originally, the account was set up by volunteers of United Sikhs UK on behalf of all entities of the United Sikhs charity. This Facebook account was intended to serve different global entities of the United Sikhs operation, as evidenced by the posts on the account which include references to different branches of United Sikhs (see Exhibit MK4).”

84. The posts shown at MK4 as referenced above refer both to the UK and to Australia

and are dated '4 days ago'. I also note the Instagram account, which although I note is dated after the relevant date, clearly shows UNITED SIKHS as part of a broader international organisation, as below:



85. Mejjindarpal Kaur describes this in her witness statement as follows:

31.

...

(b) Please see Exhibit MK47 which shows that the United Sikhs Instagram account was used to post about the work done by United Sikhs UK in the United Kingdom prior to access being revoked, including extracts from the "United Kingdom" story wheel.

86. Further, I note that promotional material filed in evidence by the opponent makes reference to the shared website, such as the below poster promoting the UK helpdesk which was set up in 2010, provided at Exhibit MK78:



**UNITED SIKHS
HELP DESK**

ਯੂਨਾਈਟਿਡ ਸਿੱਖਸ
ਹੈਲਪ ਡੈਸਕ

Every Tuesday 10am - 1pm
at Gurdwara Sri Guru Singh Sabha,
Park Avenue, Southall
Venue: Meeting Room

ਹਰ ਮੰਗਲਵਾਰ ਗੁਰਦੁਆਰਾ ਸਿੰਘ ਸਭਾ,
ਪਾਰਕ ਐਵਿਨਿਊ, ਸਾਊਥਾਲ

ਇਸ ਬਾਰੇ ਹੋਰ ਜਾਣਕਾਰੀ ਲੈਣ ਲਈ:
Tel: +44 (0) 8701993328
Email: helpdesk-uk@unitedsikhs.org
www.unitedsikhs.org

UNITED SIKHS
Recognize the Human Race as One

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87. It is noted however, that a UK address and a UK directed email address have been used.

88. It is apparent that a large number of the relevant public in the UK, when coming into contact with the UK chapter, will have been directed to the shared website and social media pages. Mejjindarpal Kaur has provided at Exhibit MK7 a copy of the website 'about' page dated by the WayBack Machine as being from 19 September 2020, after the relevant dates for consideration. The about page reads as follows:

UNITED SIKHS is a U.N. affiliated, international non-profit, non-governmental, humanitarian relief, human development and advocacy organization, aimed at empowering those in need, especially disadvantaged and minority communities across the world. UNITED SIKHS is registered: as a non-profit tax exempt organization pursuant to Section 501(c)(3) of the Internal Revenue Code in the USA; as a Registered Charity in England and Wales under the Charities Act 1993, Charity Number 111 2055; registered in Australia as a not for profit charity (ABN 24 317 847 103); and is a registered NGO in Belgium; as a non-profit organization in Canada; under the Societies Registration Act 1860 in Panjab and as a tax exempt organisation under section 80G of the Income Tax Act 1961; under the French Association Law 1901; under the Societies Registration Act 1860 in Khyber Pakhtoonkhwa, Pakistan; as a registered society under the Registrar of Societies in Malaysia (registered as UNITED SIKHS Malaysia Humanitarian Aid Organisation- Regn No: PPM-015-14-06042015); and an NGO pending registration in the Rep of Ireland.

Our History

UNITED SIKHS began in 1999 when a group of Sikhs from the New York metropolitan area banded together to assist in the socio-economic development of immigrant communities in Queens, New York. Today, UNITED SIKHS is a grass-roots organisation with chapters in America, Asia and Europe that pursue projects for the spiritual, social and economic empowerment of underprivileged and minority communities.

89. Mejjindarpal Kaur has also provided this page from a later date of 9 August 2021 at Exhibit MK6. This page shows that the reference to United Sikhs being 'headquartered' in New York.

90. Considering the website itself, I note that whilst (around the time of the filing of the application) it made it clear to those viewing the same that there were many chapters around the world, it does not make it particularly apparent that the applicant is in charge of the other chapters or responsible for the same, although I note the reference to the charity originating in New York. Having also considered the Instagram account used prior to the creation of the opponent's separate account, I also note this does not give any indication of one particular chapter being ultimately responsible for the others.

91. Further, I note the letterhead used on correspondence shown in the evidence, such as that provided by the opponent from 2009 and 2010 at Exhibit MK55 showing letters to volunteers. This is displayed as follows:

141, Gali No. 6, Sant Avenue, GT Road, Amritsar
143001, Panjab, India
Tel: +919779957973

PO Box 43799, London, W14 8SS, United Kingdom
Tel: +44 (0)870 1993328

20, Allee des Geais, 95200 Sarcelles, France
Tel: +33616176205

JAF, POB 7203, New York, NY 10116, USA
Tel: +16466883525

P.O.BOX 1021 Code 00606 Nairobi Westlands, Kenya
Tel: +254 0 720402727

2980 Drew Rd. Unit# 223B Mississauga,
ON L4T 0A7, Canada.
Tel: +1905672-2245

www.unitedsikhs.org
contact@unitedsikhs.org

4 Castlegateway, Adamstown Castle Adamstown,
Lucan, Co Dublin
Tel: +353(0)85 729 4425

Office No.176-A, UG Deans Trade Centre F.C Chowk,
Peshawar, Khyber Pakhtoonkhwa, Pakistan.
Tel: +923339113230

Halmaal Dorp 20, 3800 Sint-Truiden, Belgium
Tel: 0032 485825492

PO BOX 3747, Success, WA 6964, , Australia
Tel: +61430301272



Recognise The Human Race as One

*To transform underprivileged and minority communities
and individuals into informed and vibrant members of
society through civic, educational and personal
development programmes.*

92. A very similar letterhead is used on a letter dated 8 April 2020, as provided by the applicant at HS10. Hardayal Singh describes the letterhead featured at Exhibit HS10 as “global letterhead”. Again, this does little to indicate the US entity has particular authority over the other chapters. I note, of course, that it is less likely the relevant public will be exposed to the letterheads than they will the website and social media.

93. Further, I note that the UK chapter, when conducting UK activities is left largely to its own devices. It is a UK registered charity in its own right, with its own independent Board of Trustees. The charity raises funds in various ways, including some via the shared website and social media as mentioned above, but also by way of grants awarded to the UK chapter, such as the national lottery grants and the Pride of Britain funds were donated directly to the UK registered charity. It appears that the authority to carry out local projects in the UK under the mark has traditionally rested with the opponent, and undoubtedly it is the opponent that has been dealing with the public, including those donating and benefitting from the local projects on the ground, for the majority of the running of the UK chapter. In my view, the award received in 2010 appears to have been presented to the UK chapter for its UK work.

94. With consideration to the large body of evidence, it is my view that whilst there will undoubtedly be members of the relevant public who think of the United Sikhs as an international organisation with its roots in the US, this does not mean the relevant public will be led to believe that the US Chapter or the applicant is ultimately

responsible for the work carried out by the UK chapter, particularly those projects taking place in the UK. There is very little evidence to show that the US chapter has made a significant effort to be viewed as the entity responsible by the UK public, even where resources are shared by all of the chapters. The relevant public will not be privy to information about how the webpages and social media pages are funded. There appears to be no reference to an overarching entity, rather the chapters all appear to be given equal weight and independence. It would not be logical, without sufficient steer, for the relevant public to consider that UNITED SIKHS is international and has several independent chapters, and that as such it must be the applicant, that being the US chapter, that is ultimately in responsible for the activities carried out in the UK. Instead, it is my view that the UK chapter will appear the most likely candidate. I also believe there may be a significant number of members of the relevant public who have come across and even donated to the UK charity only, who will not have visited the website and may be unaware of its links to a wider international movement. It is my view on balance that should a local UK project not be properly carried out or should a member of the public feel its donations have been put to improper use in this respect, they would most likely seek to hold the opponent responsible for these actions.

95. In *Scandecor Development AB v. Scandecor Marketing AB*³⁵ the Court of Appeal observed:

“It may happen, as observed by Oliver LJ in *Habib Bank Ltd v Habib Bank AG Zurich* [1982] RPC 1 at 20 and 30, that the goodwill in a mark is "shared" in the sense that an internationally known business based abroad, which establishes a branch in this country as part of that international organisation, does not cease to be entitled to its existing goodwill because there is also a goodwill in the local branch. In that situation it would be correct to assert that the international organisation retains its existing "international" goodwill and that the newly created branch or subsidiary company has a local goodwill in the business carried on by it in this country, at the very least for the purpose of protecting it against injury by third parties.”

³⁵ 1999 FSR 26CA

96. Considering all of the factors above, it is my view that the opponent as the UK chapter is at least:

- Responsible for the independent running of the charitable services in relation to the UK funding and administration of projects
- Considered by at least a significant portion of the relevant UK public as responsible for the above; and
- The holder of the reputation upon which at least a significant portion of the funding for UK projects carried out will be received.

97. It is my view on this basis that there will be significant goodwill in the sign UNITED SIKHS that will have inured to the opponent in respect of the running of its UK projects over a period of over fifteen years prior to the applicant's parallel operations and both the priority and the filing date of the application. I acknowledge that that the accumulation of goodwill by the opponent in relation to some of the work carried out on the international projects may have inured to the benefit of the applicant or even the other chapters operating on the same, by virtue of the collaboration and the shared resources and funding between the chapters. However, it is sufficient for me at this stage to find that the opponent is the holder of at least a significant share of the goodwill in the UK as distinguished by the sign in respect of the services as previously determined.

Misrepresentation

98. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

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

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

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

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

"... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

99. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

"64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

100. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons

would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

The applicant's denial of the opponent's 5(4)(a) ground rests on the fact that the applicant and not the opponent is the owner of the goodwill under the mark. It is clear that the applicant's intention to "formalise the arrangements between UNITED SIKHS and the chapters internationally" as identified within its TM8 means that the intention of filing the UK trade mark application was to take control of the operation of the sign in the UK. The intention of the applicant is not to distinguish between the entities in the UK but have the relevant public view them as one and the same under the ultimate control of the applicant. Having found that the opponent does in fact own goodwill as distinguished by the sign UNITED SIKHS as defined above, it is my view that there is no doubt that the applicant's use of the sign in respect of the services applied for in the UK would misrepresent to a substantial number of the opponent's donators and service users that the actions carried out by the applicant are being carried out by or with the endorsement of the opponent.

Damage

101. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

"In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if

he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

102. In this instance, the damage caused to the opponent will undoubtedly manifest in the redirection of donations, in addition to the possible damage to the goodwill caused by any dissatisfaction in respect of the services carried out by the applicant.

103. I note at this stage for completeness that I have found that both entities will likely hold goodwill in some capacity as distinguished by the sign UNITED SIKHS in the UK. However, I have found that in the past, both entities have respected the autonomy of the other chapters to conduct projects within their own area and respected the authority of the chapter based in a particular area (including the UK) when it comes to conducting local projects in the same. I note that there may already be some confusion amongst the relevant public as to the relationship between the applicant and the opponent, however, it is my view that the continuation of the functioning of the chapters as they had been (particularly prior to 2019), with the opponent being responsible for the local UK projects, and both the applicant and the opponent both seeking donations from the UK public and collaborating on the international projects is unlikely to leave either party with the ability to take action against each other, or sue one another for passing off within the UK. The parties have clearly coexisted in this manner for a number of years and this is the established status quo between the same. However, a change to the status quo, such as the applicant seeking to take control of the local UK projects from the opponent, or running conflicting local activities under the sign, as would be possible should the applicant gain a valid registration for the sign, would mark a significant change in the status quo and would significantly increase the likelihood of confusion or deception in respect of the relevant public.

104. In *Sir Robert McAlpine Limited v Alfred McAlpine Plc* [2004] RPC 36 (HC), Mann J. considered the position where one of the users of a name in which both shared goodwill (McAlpine) dropped part of the name (Alfred) which distinguished it from the other user (Robert McAlpine) and asked himself whether that caused damage to the other user’s goodwill:

“50. Is this sort of loss made out here? It seems to me that it certainly is. Before the rebranding, the co-owners of the goodwill co-existed and exploited the name, and benefited from it, in whatever manner they could. But at all times their activities in that respect were as a matter of fact constrained by the fact that an identifier was added to make it clear which party was speaking or being referred to. That identifier was available not only to the parties, but was also available to third parties such as the press and the construction industry generally. The exploitation was carried out without misrepresentation, and without either party taking steps to suggest that it was the sole owner of the name. That has now changed. Alfred has taken steps which suggest that it is the sole owner of the name, and to do that is to affect the value of the name to Robert because it starts to elbow it out—it deprives Robert of some of the value of the name to itself, and it blurs or diminishes Robert's rights. So to hold is not to let the metaphor govern the principle; it is to acknowledge the principle and to acknowledge the usefulness of the metaphor in expounding it. It is no answer to say that Robert could also call itself McAlpine (as was suggested in the trial). The fact is that Alfred has sought to do so, and it cannot escape the consequences by saying that Robert could do that as well if it wanted.

51 Another way of looking at this point is to consider the “punching above its weight” point. This phenomenon, identified by Fishburn or some of its interlocutors, gives each company the benefit of an impression that it might be bigger than it actually is. To do so is to some extent to live off the goodwill of the other. While each company takes steps to hold itself out as separate from the other by means of an appropriate identifier, neither can complain if the other has this benefit. It has become a necessary consequence of the shared goodwill, and something to which each has effectively consented. However, once one of them goes further, and actively looks to increase this effect by adopting the jointly owned name as its principal identifier, then it is likely to increase the effect. That is damaging to the co-owner because it does in a genuine way deprive him of part of the value of the goodwill; and it achieves it by a misrepresentation, which makes it passing off. In this case I find that it is likely that that effect will be increased, and that that is damage for the purposes of passing off. It is no answer to say that this is a mutually beneficial effect. It is

no answer for a defendant to say that its goods are of a higher quality than the claimant's; so it is no answer for Alfred to say that Robert too can punch above its weight as a result of Alfred's positive passing-off activities”.

105. Whilst this case discusses the impact of changes made to a sign used where there was previously concurrent goodwill, and the passing off that may result from this change where it increase the likelihood of misrepresentation, it is analogous with this case in the sense that where there has been coexistence for a number of years, with both parties holding goodwill distinguished under a sign, and a change in behaviour occurs that increases a likelihood of misrepresentation (in this case a change to the trading activity and the manner in which the parties operate in the UK), this will inevitably result in damage and a successful passing off claim.

106. As the application for registration of the sign by the applicant will clearly result in a significant shift in the status quo between the two parties, resulting in an increased likelihood of misrepresentation and damage for the reasons given, the opposition based on section 5(4)(a) of the Act has succeeded in its entirety.

Section 3(6)

107. Although I have already found the opposition to be successful on section 5(4)(a), at the hearing both Ms Collett and Mr Hart requested that all grounds³⁶ of the opposition be decided, as this will assist the parties moving forward. I now move on to consider the opposition filed under section 3(6) at this stage.

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

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

109. 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*

³⁶ Excluding section 5(6) of the Act which has been dropped.

Franz Hauswirth GmbH, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. 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]".

110. 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?

111. 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).

112. In respect of absolute grounds including section 3(6) of the Act, the relevant date is the date the application was filed. That is 3 September 2020.

113. In this instance, the opponent has set out the bad faith claim in the following terms:

“2.12 As at the date the Application was filed, the Opponent was the Chapter responsible for the UK and had been the sole operating Chapter in the UK since 2002. The Applicant’s sudden filing of the Application without notice to the Opponent marked a radical change in practice, and given the Opponent’s intentions for the UNITED SIKHS brand and the opposed Application was filed as a blocking mechanism.

2.13 The filing of an identical trade mark used by the Opponent is indicative of behaviour that falls short of the standards of acceptable commercial behaviour, in the context of charitable services where brand integrity is especially important. Therefore, the Application should be refused registration pursuant to Section 3(6) of the TMA.”

114. Within its counterstatement, the applicant responded as follows:

“UNITED SIKHS denies that it filed the Applicant's mark in bad faith. In so far as there is an "over-arching UNITED SIKHS charity" as referred to in 2.10 of the Statement of Grounds, that has to date been UNITED SIKHS, as the originator of the international charitable organisation and founder of the various international chapters. UNITED SIKHS' aims in filing were not to enable it to seek donations in the United Kingdom, but to ensure that operations under the UNITED SIKHS name and logo were carried out to an appropriate extent and in an internationally coordinated way, with transparency and accountability, especially as regards fundraising and donations. The Opponent is well aware that it would be licensed to use the marks, under the oversight of their owner, for so long as it remains the UK chapter.”

115. Within his witness statement, Mr Hardayal Singh states as follows:

“42. In the last few years, there have been growing concerns about the UK chapter and Ms. Kaur's activities.

....

49. Ms. Kaur's uncoordinated activities in countries where there are local UNITED SIKHS chapters were one of the reasons why the Applicant decided to start a program of registering trade marks around the world as a means to protect the goodwill of the global UNITED SIKHS operations and promote appropriate global cooperation between local chapters. Another reason was that other organisations were emerging with somewhat similar names, in countries where we had established chapters and we wanted to be able to avoid confusion.

50. As I mention above, the Applicant, in conjunction with local chapters, is also discussing a restructuring to create an over-arching UNITED SIKHS international organisation in which each chapter can be formally represented. As of today, Ms. Kaur amongst those approached is the only representative of a local chapter who is not supportive of setting up this new international structure. I and others have attempted through various routes to bring her on

board to the concept. From the Applicant's perspective, which I believe is shared with by other UNITED SIKHS chapters, this UK trade mark opposition is an attempt to prevent this more formal structure being put in place, so that she may continue to operate without proper liaison with other chapters with the title of UNITED SIKHS International Legal Director.

....

68. Ms. Kaur refers at para.36 to it being "catastrophic" if the Opponent were to "lose the right to use the name UNITED SIKHS". She is well aware that the UK Chapter will not use [sic] the right to use the name UNITED SIKHS or the related logo if the opposed mark is registered. So long as it operates, like other chapters, in accordance with the shared principles and mission of UNITED SIKHS internationally, in co-ordination with the other chapters, its rights to use the name will be clearer than ever."

116. Later on the applicant has stated in its submissions as follows:

"29. As explained by Hardayal Singh, Jasmeet Singh, Sukhwinder Singh, and Gurvinder Singh, the Applicant and other UNITED SIKHS chapters attempted to work collaboratively with Ms. Kaur but from about 2018 she increasingly refused to accept "interference" in what she wished to do, under her title as International Legal Director or as a member of boards of other local chapters. Hardayal Singh, Dabinderjit Singh, Sukhvinder Singh, Ravjeet Singh, Gurpal Singh, and Narpinderjit Mann give evidence that she has been rarely in the UK in recent years and that many activities have been run by volunteers and employees funded by the Applicant, with little or no involvement from her.

30. Witnesses from other local chapters confirm that they support the Applicant's move to create a more formal international structure and, as part of that, for the Applicant to register the UNITED SIKHS word mark and logo internationally."

117. The objective that the applicant has been accused of pursuing is the filing the application for the purpose of blocking the opponent from making use of the same. I have found that the opponent has goodwill in its business in the UK as distinguished

by the sign. I find the objective of filing the application to register the mark for the purpose of blocking the opponent from making further use of the same without the applicant's consent, is an objective for the purposes of which the contested application could not be properly filed.

118. At the hearing, Ms Hart for the applicant responded to the claim the application is a blocking mechanism in the following terms:

“The second point we would emphasis is the applicant is clear the opponent will be licensed to use the trade mark in the UK in furtherance of that shared mission. We say that is what it always has been doing anyway. There is no blocking mechanism as suggested in the opposition. Quite the opposite. We say this is essentially the continuation of the status quo and of course the applicant has the right to do that.”

119. The applicant itself has acknowledged that the application has been filed for the purpose of preventing the opponent, or more specifically Ms Kaur, a member and trustee of the opponent, from continuing on with her “uncoordinated activities”. They have confirmed that after registration, the opponent may continue with use of the mark, so long as it does so “like other chapters, in accordance with the shared principles and mission of UNITED SIKHS internationally, in co-ordination with the other chapters”. This appears to be contrary to how the chapters have previously operated, in accordance with Mr Hardayal Singh's statement, the passage from which I have previously set out in this decision, which confirms that when a chapter wishes to create programs or advocate in a different region from their own, they first consulted the leaders in the specific region about the project. It is clear from this that the “status quo” prior to the filing of the application would be that the opponent would be the first entity consulted about new projects taking place in the UK and would have autonomy to carry out UK projects under the sign as it pleases. If the applicant gains a registration for the mark, as the registered right holder in the UK they would undoubtedly become the first party to be consulted on new projects taking place in the UK – and indeed they have stated this control over the operations is the reason for the application. I do not accept that by gaining registration and offering a licence to the opponent with conditions, that the applicant will maintain the status quo as stated.

120. In my view, the applicant has acknowledged that the application has been filed as a way of preventing the opponent from continuing on with the unrestricted use of the sign, which it has been using largely independently for UK projects and has acquired UK rights for over more than 15 years, without the permission and/or oversight of the applicant. It does not appear that the intention is to specifically block *any* of the opponent's future use of the sign, but rather it appears the intention is to gain the ultimate control over the sign and to block the opponent's independent use of the sign, due to a dislike and/or a distrust of a member of the Board of Trustees of the opponent and the operations carried out over recent years. It does not appear from what has been said that the applicant intends to continue to run separate side by side operations to the opponent in the UK, with the witness statement of Mr Hardayal Singh in addition to the applicant's submissions stating its intention is not to seek UK donations, but instead is to formalise the structure, prevent third parties with similar names from using the mark, to ensure operations are carried out in an internationally coordinated way and to offer a license to the opponent on this basis. Having discussed this plan with the opponent and having been told the opponent was not in agreement with this approach, the applicant nonetheless moved forward with the application to register the mark in its own name.

121. I note at this stage the submissions made at the hearing by Ms Collett on behalf of the opponent as follows:

“When I first read through the witness evidence and when I first read through the way in which this case had been presented, an initial read of the evidence was that there was a personal dislike of someone running an international chapter, and that dislike meant that they were trying to take back control of that chapter by force and all of this was presented as an essentially a smear campaign. The more I have read into this and the more I have read the evidence, and of course considered the position, I do not think it is quite as simple as that. I just think the applicant has understood the law and misunderstood the position based on the fact there were no formal structures put in place at the time of the establishment of the opponent...”

122. Ms Collett's submissions above were made on the basis of the 5(4)(a) ground of this opposition. When discussing the bad faith ground of the opposition, Ms Collett went on to submit:

"We say we all want lots of things but that does not mean that one has a right to do so something. Plainly, [the applicant] knew they did not have the rights in the United Kingdom. The reason they knew that is because they had been aware of the opponent since its establishment. They are aware that Mejindarpal is a trustee of the UK organisation. They are aware that the opponent operates as a charity and has its own way of dealing with things. All of the evidence makes clear they have just decided that she is not doing it well enough. That is not for them to decide. I can think that Barclay's Bank is not running something well enough. I cannot walk in there and suddenly take over as CEO. Essentially, that is what has happened. That is an absolutely classic position of bad faith."

123. I consider that the submissions made at the hearing by Ms Collett under the 5(4)(a) ground, if I understand them correctly, slightly contradict those made in respect of the 3(6) ground. On the one hand, it appears to be accepted that the application was filed based on the applicant's fundamental misunderstanding of its position. On the other, it is stated that the applicant plainly knew it did not have rights in the UK and they knew of the opponent's position. It is my view however, despite the slight contradiction in the submissions made, that it is clear from the 3(6) arguments put forward that the opponent wishes to maintain the latter argument under this ground. I find this argument to be supported by the evidence, and it is my view that on balance, the objective of the applicant to restrict the opponent's freedom to use the mark in the UK which it has been using for its UK operations for over 15 years and in which it holds earlier rights, based on the applicant's dislike of the opponent's current operations, does falls short of the standards of honest commercial behaviour. The opposition based on section 3(6) of the Act therefore succeeds.

Final remarks

124. The opposition has been successful, and subject to any successful appeal the application will be refused in its entirety.

COSTS

125. The opponent has been successful and is entitled to a contribution towards its costs. Within its skeleton arguments, the opponent requested a total of £900 in costs as follows:

£200 for the opposition fees;

£200 for preparation of the Statement of Case; and

£500 for attendance at the hearing on 19 March 2021.

126. At the hearing, the Ms Hart for the applicant raised that both parties were represented on a pro bono basis and stated they would be requesting no costs on this basis. Ms Collett for the opponent explained the opponent's current legal team are operating entirely on a pro bono basis. However, while the initial work was done on a pro bono basis by those instructing the opponent's representative's predecessors, there was also a substantial amount of work was done on a non pro bono basis, and it is those figures that are sought. Ms Collett explained there is nothing untoward about the costs being sought, and that none of those costs sought are in respect of the pro bono work that has been done by herself or those instructing her, who she believes have acted at all times on a pro bono basis.

127. I accept Ms Collett's submission that where the opponent has not been represented on a pro bono basis, the issuance of a cost award will be reasonable. The £200 request for the official fees and for the preparation of a statement of case will be awarded accordingly. In respect of the £500 requested for the hearing that took place before me on 19 March 2021, I note this concerned the filing of the opponent's initial Form TM7 and statement of grounds. The documents were emailed by the opponent at 11.59pm and were originally considered by the Tribunal as late having been received by the Tribunal after midnight. Following the filing of a witness statement, the

Tribunal issued a preliminary view that the TM7 should be accepted into proceedings. The applicant challenged this preliminary view, and a joint hearing took place. I accept the decision of the joint hearing went in favour of the opponent, and the TM7 was allowed into proceedings. However, I also note that there would have been no need for any hearing had the filings not been left to the very last minute by the opponent. Further, in any case, I consider the request for a £500 contribution to costs on this matter to be unduly high, and I consider a £250 contribution to be appropriate in the circumstances.

128. I therefore award the opponent the sum of £650 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£200
Preparing and filing the TM7 and statement of grounds:	£200
Attending the joint hearing concerning the TM7:	£250

129. I therefore order United Sikhs (USA) to pay The Board of Trustees of UNITED SIKHS, a UK Charity number 1112055 the sum of £650. The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of October 2022

Rosie Le Breton
For the Registrar

Annex A

Class 35: Charitable services, namely, promoting public awareness about charitable, philanthropic, volunteer, public and community service and humanitarian activities; charitable services, namely, coordinating the procurement and distribution of in-kind donations of goods and services; charitable networking services, namely, coordinating volunteers and organisations to facilitate collaboration on social, cultural or spiritual projects; compilation and systemisation of census data into computer databases; promoting the interests of discriminated persons, children, and victims of discrimination by means of public advocacy; arranging promotion of charitable fundraising events; information and advisory services in relation to all the aforesaid.

Class 36: Charitable fundraising; arranging of financing for humanitarian, natural disaster relief and victim support projects; providing emergency financial assistance for individuals and families; information and advisory services in relation to all the aforesaid.

Class 41: Education, tutoring, mentoring and training; cultural activities; organising community cultural events; charitable services, namely, providing resource library services to those in need; information and advisory services in relation to all the aforesaid.

Class 42: Conducting of social and political research and analysis; research and analysis relating to demographics; information and advisory services in relation to all the aforesaid.

Class 43: Provision of food and drink; provision of soup kitchens; providing emergency shelter services in the nature of temporary housing; providing community centres for social gatherings and meetings; information and advisory services in relation to all the aforesaid.

Class 44: Emergency assistance services in the medical field; paramedical services; charitable services, namely, providing medical equipment and services to under-served communities; information and advisory services in relation to all the aforesaid.

Class 45: Legal aid services; legal advocacy services relating to civil and human rights; providing information on issues concerning civil and human rights; information and advisory services in relation to all the aforesaid.