

**O/0268/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO. 3677498**

**IN THE NAME OF JERMARL DOUGLIN-KIRTON**

**AND**

**OPPOSITION THERETO UNDER NO. 429249**

**BY SHINESTY, INC.**

## **Background and pleadings**

1. On 5 August 2021, Jermarl Douglin-Kirton (“the applicant”) applied under number 3677498 for a series of two trade marks, namely “SHIESTY LONDON” and “Shiesty London”. The application was published in respect of the following goods in class 25:

Class 25: T-shirts; Printed t-shirts; Short-sleeved T-shirts; Shirts; Golf shirts; Casual shirts; Sport shirts; Tennis shirts; Camouflage shirts; Under shirts; Pique shirts; Yokes (Shirt -); Sports shirts; Football shirts; Knit shirts; Fishing shirts; Turtleneck shirts; Rugby shirts; Polo shirts; Shirt yokes; Tee-shirts; Dress shirts; Shirt fronts; Ramie shirts; Hunting shirts; Woven shirts; Sweat shirts; Collared shirts; Soccer shirts; Aloha shirts; Yoga shirts; Shirt-jacs; Corduroy shirts; Button down shirts; Shirts and slips; Mock turtleneck shirts; Shirts for suits; Short-sleeve shirts; Short-sleeved shirts; Open-necked shirts; Hooded sweat shirts; Long-sleeved shirts; Button-front aloha shirts; Moisture-wicking sports shirts; Sports shirts with short sleeves; Snap crotch shirts for infants and toddlers; Balaclavas; Ski balaclavas; Headwear; Peaked headwear; Children's headwear; Caps [headwear]; Visors [headwear]; Bonnets [headwear]; Leather headwear; Fishing headwear; Caps being headwear; Visors being headwear; Sun visors [headwear]; American football shirts; Footwear; Footwear [excluding orthopedic footwear]; Infants' footwear; Children's footwear; Rubbers [footwear]; Casual footwear; Ladies' footwear; Beach footwear; Footwear for women; Footwear for men; Inner socks for footwear; Footwear not for sports; Footwear for men and women; Flip-flops for use as footwear; Parts of clothing, footwear and headgear.

2. The application is opposed in its entirety by Shinesty, Inc (“the opponent”) under s. 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent says that it has used the word sign “SHINESTY” and the figurative representation of that word shown below in the UK since November 2014:

The logo for Shinesty, Inc. is written in a red, cursive, script font. The word "Shinesty" is written in a fluid, handwritten style with a slight shadow or outline effect.

3. The opponent says that it has sold the following goods under the signs:

Clothing, footwear, headgear, blazers, boxers, suits, suit trousers, suit shorts, sleeveless blazers, ties, swimming briefs, sunglasses, socks, dresses, pajamas [sic], headbands, ski suits, thongs, knitwear, hats, beanies, all in one suits, shirts, coats, underwear, trunks, kimonos, flight suits, masks, onesies, sweaters, pajamaralls [sic], jumpsuits, base layers, fleeces, bow ties, ski trousers, bar-lets, bikinis, vests, tops, t-shirts, pet accessories, novelty gifts and bags.

4. The opponent asserts that it has a protectable goodwill and that use of the contested trade marks would result in misrepresentation and damage. It says that the trade mark application should therefore be refused under s. 5(4)(a).

5. The applicant filed a counterstatement denying the claim.

6. The opponent filed evidence. The applicant also filed some documentation but despite repeated invitations to refile this material as a properly constituted witness statement and exhibits, the applicant chose not to avail himself of this opportunity. I have read this material and will give it the weight it deserves.

7. Neither party requested a hearing. The opponent filed written submissions in lieu. This decision is taken following a careful reading of all of the papers.

8. The applicant represented himself. The opponent is represented by Stobbs.

### **Evidence**

9. The opponent's evidence is provided by Laura Sanchez, the Chief Operating Officer of the opponent. Ms Sanchez gives some background information about the company, along with evidence about the use made of the signs in the UK and resulting sales.

10. Ms Sanchez was not cross-examined. I have read all of her evidence and will return to it as appropriate in the course of this decision.

## Decision

11. The relevant parts of s. 5(4) read:

“5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

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

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.

(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.”

12. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341 HL, Lord Oliver of Aylmerton described at [406] the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

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

defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff".

13. The prima facie relevant date under s. 5(4)(a) is the filing date but use before the filing date may be relevant.<sup>1</sup> However, there is no evidence of any use by the applicant in this case. Consequently, the relevant date is 5 August 2021.

## **Goodwill**

14. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described as follows:

"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".

15. The opponent claims in its submissions in lieu that the applicant has accepted that the opponent has goodwill. This is because, in his counterstatement, the applicant said, "I am not trying to destroy or damage the goodwill of the Opponent". He also said that the opponent is "a predominantly US-based funky, crazy and hideous partywear, underwear and Skiwear brand, that has expanded to the UK market". However, the applicant is not professionally represented and I am not satisfied that the comments in the counterstatement amount to a clear concession that the opponent has goodwill in the UK to the required legal standard.

16. Goodwill which is protectable under the law of passing off must be more than trivial. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was)

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<sup>1</sup> *Maier & Anor v Asos & Anor* [2015] EWCA Civ 220 at [165]. See also *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11.

concluded at [62] that references in earlier cases to a “significant reputation” meant that “one is looking for more than a minimal reputation”.

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

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

18. In *Smart Planet Technologies*, Mr Mitcheson decided that ten invoices showing sales to two customers, totalling €3,230 for around 40,000 paper cups, did not show the required significant or substantial reputation. In that case, the sign at issue was, at best, weakly distinctive and Mr Mitcheson found that this supported his conclusion.

19. The case law also shows that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant’s goods. The claimant had been selling “LUMOS” anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant’s sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, “very limited”, the claimant’s goodwill was found to be sufficient to entitle it to restrain the

defendant's trade under "LUMOS". In *Stannard v Reay* [1967] F.S.R. 140, a mobile fish and chip van had been trading for three weeks, generating around £130 per week, which was held to be sufficient for an interlocutory injunction to prevent the defendants using the same sign ("MR CHIPPY"). The facts were unusual because of the very localised nature of the case.

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

"27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

21. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered

of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

22. The opponent is a fashion retail brand based in the US. It was launched in the UK in November 2014 and sells its goods through its own website, [www.shinesty.com](http://www.shinesty.com). The evidence shows that the brand's own website bore the figurative sign prominently both in the form relied upon and in white on red between January 2016 and July 2021.<sup>2</sup> I do not consider the colour inversion significant as the colour plays a far weaker role in the sign than the word. The website has categories for “Men”, “Women” (in earlier versions “guys” and “gals”) and “underwear”; specific items of clothing are shown, mainly boxers but also suits, dresses, ties and ski suits. In addition, there are seventeen articles dated between 2016 and 2020 which refer to the “Shinesty” brand in relation to various items of clothing, including sunglasses, suits, swimwear, pyjamas, underwear and dresses.<sup>3</sup>

23. There are six invoices which show that a blazer, dress, suit jacket, sunglasses and suits “by Opposuits” were sold to different UK customers between 2015 and 2020. Other clothing items which appear on the invoices appear to have been provided at zero cost.<sup>4</sup> Two of the invoices indicate that the order was fulfilled from Denver, Colorado. They are all in USD. Four of the invoices (2017 to 2020) show the figurative “Shinesty” sign; the other two bear the word “Shinesty”.

24. In my view, it is quite clear from the evidence that the opponent operates a clothing business in relation to which it had used by the relevant date both of the signs relied upon. The evidence does not show each type of clothing pleaded but there is a sufficient range of items for the business to be described as a clothing business rather than, for example, as an underwear manufacturer. Although a more limited range of goods has been

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<sup>2</sup> Exhibit LS21.

<sup>3</sup> LS4, LS9. See also LS5, which includes a duplicate of one article on a UK-based website.

<sup>4</sup> LS2.



provided to UK customers, the sales appear to have been effected through the opponent's website, which offers the full range of goods. I also bear in mind that there are references in an article from [www.popsugar.co.uk](http://www.popsugar.co.uk) (November 2019) to a two-person jumper, overalls, onesies and pyjamas and in an article from [www.huffingtonpost.co.uk](http://www.huffingtonpost.co.uk) (November 2020) to a jumpsuit and a dress, all from Shinesty. I accept that sunglasses were sold under the signs, though there is limited evidence in that regard. There is no evidence that the opponent has sold bags or pet accessories. I also find that the opponent has not sold novelty gifts. Notwithstanding that clothing may be purchased by some consumers as a gift, the clothing and gift sectors would normally be understood as distinct from the gift market, novelty or otherwise, by the relevant public.

25. As regards the level of business in the UK, turnover and order numbers are given as follows:<sup>5</sup>

<b>Year</b>	<b>Turnover</b>	<b>Orders</b>
2015	USD 585.98	6
2016	USD 4,948.26	35
2017	USD 17,628.60	149
2018	USD 16,116.55	104
2019	USD 22,229.90	204
2020	USD 10,862.48	95
2021	USD 12,226.95	105
<b>Total</b>	<b>USD 41,435.88</b>	<b>698</b>

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<sup>5</sup> Sanchez, §§5, 9, 10; LS1.

26. It appears that these totals are the “total sales” figures shown in the exhibit. These include delivery costs of around USD 23,500. The goodwill of a business relates to its provision of goods and services. Delivery charges are not, in my view, to be taken into account in this assessment. The turnover figures less the delivery charges show sales of around USD18,000. It is not particularly helpful that the figures are in US dollars. Exchange rates vary. At today’s rate, £1 is worth about USD 1.18. That would make the opponent’s sales worth around £15,200 over a seven-year period. It is of course possible that the opponent’s sales were higher (or lower) than this but the opponent has chosen to give its evidence in the currency of another country.

27. In 2020, there were 10,202 UK users of the opponent’s website, rising to 40,230 in 2021, of whom 39,738 were new users.<sup>6</sup> This represents about 0.4% of visitors to the site.

28. The majority of the seventeen articles in evidence, from sites such as [www.buzzfeed.com](http://www.buzzfeed.com), [www.cnbc.com](http://www.cnbc.com), Fox News and Vogue, are clearly directed towards a US consumer, giving prices in dollars, using US spellings and making reference to US culture (e.g. cornhole games, the Kentucky Derby). There are six articles which clearly appeared in UK publications, including three major newspapers. Four of these are dated May 2019 and relate to denim-effect swimwear launched by Shinesty. The other UK articles are the [www.popsugar.co.uk](http://www.popsugar.co.uk) and [www.huffingtonpost.co.uk](http://www.huffingtonpost.co.uk) pieces I have already described. It is not obvious whether the press attention in May 2019 came about because the opponent actively promoted its unusual swimwear to these publications or whether an article which appeared in one prompted similar articles from the rest. In either case, whilst these publications have national reach, the articles were concentrated in a very short space of time and do not indicate a serious attempt to raise the profile of the brand in the UK.

29. The opponent has provided evidence that the remaining publications which featured articles about the opponent and its products have international reach, and that some have

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<sup>6</sup> Sanchez, §13; LS3. The 2020 figures in the exhibit do not correspond to the figures Ms Sanchez gives and are in fact identical to the 2021 figures.

specific UK-facing websites and social media.<sup>7</sup> I accept this. However, the fact that these entities may have UK-facing sites does not demonstrate that US-centric content appeared on the UK sites or the extent to which, if at all, it came to the attention of the UK public. Whilst the opponent asserts that these articles could have appeared on the UK sites and could have been seen by the UK user, there is no evidence that this happened. There is one article printed from www.espn.co.uk which also appears in the evidence taken from www.espn.com. The latter website is visible at the beginning of the piece. I accept that this evidence was accessible by users in the UK. I am, however, doubtful about whether it was published for the UK user to read on the UK website or whether the opponent has accessed the UK site, searched for the piece from that site and this result has been returned. It is not an archive print showing that the article appeared on a UK-facing site at a given point in time. Further, Ms Sanchez says in her statement that the BuzzFeed UK website can be searched and that the article presented elsewhere in the evidence can be viewed from there.<sup>8</sup> It therefore appears that Ms Sanchez has conducted this type of search to seek out articles about the opponent from UK sites in preparing her evidence.

30. None of the remaining evidence is specific to the UK. Therefore, while advertising figures are significant, it is impossible to know how much of this was used to attract the UK public to the opponent's business.<sup>9</sup> Similarly, social media evidence shows follower numbers, "views" and reviews but it is impossible to know how many of these were from individuals in the UK.<sup>10</sup> Information that Shinely "went viral" is not of any further assistance, because (i) the programme which began that was a US show, (ii) it is possible for something to go viral in one country and not another and (iii) there is no evidence that its fame extended to the UK.<sup>11</sup>

31. The opponent's website does not appear to be in any way aimed at customers in the UK. There is no evidence of, for example, UK shipping being promoted or any attempt to price products in pounds to make it easier for the UK customer. Although there have been

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<sup>7</sup> LS5-LS8, LS10-LS13.

<sup>8</sup> Sanchez, §19.

<sup>9</sup> Sanchez, §29, LS22-LS23

<sup>10</sup> LS15-LS20.

<sup>11</sup> LS14.

some UK visitors to the site, it is clear that UK visitors are only a very small proportion of users. There is no detail about these UK users. In particular, while figures for 2021 are provided which show a significant increase, what is not clear is how many of these users visited the site before the relevant date. The evidence does not specify whether these are unique users. There is also nothing to indicate whether these users reached the site on purpose, for example by searching for it, or whether they clicked into the site via another means and promptly left. It is apparent from the order numbers that the vast majority of visits to the site by users in the UK did not result in sales.

32. While the opponent has sold some goods to customers in the UK, the sales figures themselves are very limited. Even assuming that each order was sent to a different customer, the order numbers are modest. I accept that the sales have occurred over a period of years but that is set against a backdrop of sparse press attention and no evidence of a real effort to promote the goods to UK consumers. Taking all of this into account, my conclusion is that the opponent's activities in the UK have not generated a substantial goodwill protectable under the law of passing off.

33. The opposition based on s. 5(4)(a) fails accordingly.

### **Costs**

34. The applicant has been successful and would ordinarily be entitled to an award of costs. However, as the applicant is not professionally represented, the tribunal wrote to him asking him to complete a costs pro forma outlining his costs and warning that if the pro forma was not returned, costs other than official fees may not be awarded. The applicant did not file a costs pro forma. Consequently, I direct that the parties bear their own costs.

**Dated this 13<sup>th</sup> day of March 2023**

**Heather Harrison**

**For the Registrar**

**The Comptroller-General**