

O/0473/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK NO. UK00003529661

IN THE NAME OF COMPASS COMMS LIMITED

FOR THE FOLLOWING TRADE MARK:

Social Work News

IN CLASSES 16, 35, 38 & 41

AND

**THE APPLICATION FOR A DECLARATION
OF INVALIDITY THERETO UNDER NO 504087
BY SANCTUARY PERSONNEL LIMITED**

BACKGROUND AND PLEADINGS

1. Compass Comms Limited (“the proprietor”) is the registered proprietor of the UK trade mark shown on the cover of this decision (“the contested mark”). The contested mark was filed on 3 September 2020 with registration subsequently granted on 25 December 2020. It stands registered for goods and services in classes 16, 35, 38 and 41, a complete list of which is shown in the **Annex** of this decision.
2. On 23 August 2021, Sanctuary Personnel Limited (“the applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is brought under sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”) and is aimed against all goods and services for which the contested mark is registered.

3. Under its 5(4)(a) ground, the applicant relies on the following unregistered signs:

‘SANCTUARY SOCIAL WORK NEWS’
 (“the applicant’s first sign”)

‘SOCIAL WORK NEWS MAGAZINE’
 (“the applicant’s second sign”)

‘SOCIAL WORK NEWS’
 (“the applicant’s third sign”)

‘SWN MAGAZINE’
 (“the applicant’s fourth sign”)

‘MY SOCIAL WORK NEWS / MYSOCIALWORKNEWS’
 (“the applicant’s fifth sign”)

4. In respect of its first, second and third signs, the applicant claims to have used them throughout the UK since 2013. As for its fourth and fifth signs, the applicant

claims to have used them throughout the UK since 2019 and 2017, respectively. The applicant claims to have used all of the signs relied upon for the following goods and services:

“Downloadable publications (class 9); teaching and instructional material (classes 9 and 16) printed matter, printed publications (class 16); recruitment services (class 35); advertising and PR services (class 35); communication by online blogs; providing online forums (class 38); Publishing, reporting and writing of texts (class 41); Educational, training and instructional services (class 41); publication services (class 41); Organising awards (class 41); Hosting of digital content, namely, online publications and blogs (class 42); Providing forums for communication in the field of social work (class 9, 16 and 38, 42)”

5. The applicant claims that it owns a significant level of goodwill in its signs due to the continuous use made of them throughout the UK since 2013, 2017 or 2019. Given the existence of this goodwill, the applicant claims that use by the proprietor of the identical (in the case of its third sign only) or similar contested mark on identical or similar goods and services would constitute a misrepresentation. The applicant argues that this would lead consumers to believe that the proprietor's goods and services originate from the applicant, thereby causing damage to its goodwill and resulting in a loss of custom.

6. I note that the applicant has brought forward a separate claim under the 3(6) ground in relation to each sign relied upon under its 5(4)(a) grounds. Aside from the pleadings' reference to the applicant's different signs, the claims are the same. Firstly, the applicant claims that the proprietor was fully aware of the applicant's use of its signs prior to submitting its application. Secondly, the applicant claims that seeking and obtaining a registration for an identical (in the case of its third sign only) or similar mark to the applicant's signs for identical or similar goods and services has been interpreted as a way of blocking the continued use by the applicant of its earlier signs. The applicant claims that this is evidenced by the proprietor's subsequent demand that the applicant ceases to use its signs with an allegation of trade mark infringement.

7. The applicant filed a counterstatement denying the claims made.
8. The applicant is represented by Birketts LLP and the proprietor is unrepresented. Both parties filed evidence in chief with the applicant also filing evidence in reply. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
9. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

10. The applicant's evidence in chief came in the form of two witness statements. The first being the statement of Joe Taffurelli dated 21 July 2022. Mr Taffurelli is the Head of Group Operations at Liquid Friday Limited ("Liquid"), a seemingly unconnected entity to the applicant but one that Mr Taffurelli claims has a working relationship with it. Mr Taffurelli's statement is not accompanied by any exhibits.
11. The second statement is that of James Rook dated 25 July 2022. Mr Rook is the Chief Executive Officer of the applicant. He has worked for the applicant since 2006, previously holding the role of Managing Director. Mr Rook's statement is accompanied by 26 exhibits, being those labelled JR1 to JR26.
12. The proprietor's evidence in chief also came in the form of two witness statements. The first being the statement of Kelly Doubtfire dated 26 September 2022. Ms Doubtfire is the Publishing and Events Director of both the proprietor and Compass Career Opportunities Ltd ('CCO'), being positions she has held since 2001. Ms Doubtfire's statement is accompanied by six exhibits, being those labelled KD1 to KD6. The proprietor's second statement is that of Mark Pearson, also dated 26

September 2022. Mr Pearson is the Director of the proprietor and the Managing Director of CCO, a role that he has held since 2001.

13. In its evidence in reply, the applicant filed a further two witness statements. The first being the second witness statement of Mr Rook dated 28 November 2022. Mr Rook's second statement is accompanied by a further six exhibits, being those labelled JR2.1 to JR2.6. The second statement is that of Mr Adam Farah, also dated 28 November 2022. Mr Farah is employed by the applicant as its Technology Consultant for Social Work News, being a role he has held since early 2020 which he claims coincides with the inception of the Social Work News online platform.

14. I will refer to points from the evidence or submissions where necessary.

PRELIMINARY ISSUES

Honest concurrent use

15. Under invalidation claims reliant upon 5(4)(a), an owner of a mark may rely on the defence of honest concurrent use in order to avoid a passing off claim. In its counterstatement, the proprietor argued that it intended to use the contested mark from as early as 2006 and that it has a long strategic history with the title 'Social Work News'. It seems to me that such a statement by the proprietor may be deemed as giving rise to an argued defence of there being honest concurrent use. That being said, such an argument in the present case was not furthered by the proprietor throughout the remainder of these proceedings. Also, a defence of honest concurrent use requires evidence of use by the proprietor from the date mentioned or, at least, at some other earlier date that fell before the filing date of the contested mark. As I will come to discuss in greater detail throughout this decision, no satisfactory evidence showing any earlier use by the proprietor has been provided. So while it may have been alluded to in its counterstatement, no such defence has been validly brought and I will say no more about it.

The five year 'grace period'.

16. In the proprietor's evidence, I note that Ms Doubtfire states the following:

"We launched in October 2020 and began developing both brands, developing our website and other elements of the project. **We were aware that a trademark has to be developed within 5 years of its being registered.**"
(emphasis added)

17. It is true that when a trade mark is registered, the owner of that mark has a five year 'grace period' from the date of registration within which it is not necessary for it to demonstrate use of the mark in order to rely on that mark in opposition/invalidation proceedings. After the expiration of that five year period, should the owner of that mark wish to rely on it in the course of an opposition, for example, the other party may request that the owner provide proof that it has genuinely used the mark. If it does not, the owner will not be entitled to rely on the mark. In addition, a mark may not be revoked for non-use under section 46(1) of the Act during the five year grace period. Neither of these factors are at play under the present proceedings so the fact that the proprietor was still within this five year grace period when the application was brought is not relevant to my decision.

Submissions of the proprietor

18. As set out above, the proprietor filed written submissions in lieu of a hearing. The applicant took issue with the nature of these submissions on the basis that they were filed in the form of a witness statement and contained evidence of fact. I note that there was some correspondence between the Tribunal and the parties during this time. While it is not my intention to reproduce the entirety of that correspondence here, I will summarise it briefly. Upon receipt of the issues raised by the applicant, the proprietor (who is unrepresented) wrote to the Tribunal on 1 March 2023 wherein it accepted that it was not aware of the intricacies of the process. However, it stated that the evidence filed deserved to be heard in "the interests of truth". As such, the proprietor made a request to file additional evidence. This request was refused by way of a preliminary view of the Tribunal

dated 2 March 2023. The preliminary view set out that while the evidence would not be admitted into these proceedings, the document would remain before the Tribunal insofar as it contained written submissions. Further, the preliminary view confirmed that the Hearing Officer ultimately responsible for this decision would not give the submissions any evidential weight and any weight given to the submissions (which may be none) will be determined by that same Hearing Officer. As with all preliminary views issued by the Tribunal, this was open to challenge by the proprietor. No challenge to this preliminary view was brought by the proprietor (I note a challenge was brought by the applicant but subsequently withdrawn) and the preliminary view was subsequently confirmed.

19. Having reviewed the submissions filed, I appreciate that they contain a range of responses to the claims made against the proprietor that I accept as being submissions. However, the proprietor made several statements that I deem to be evidence of fact. Due to the number of statements that are evidential in nature, I do not intend to go over each and every example. However, as an illustration, I note that there is reference to a conversation with an unnamed Director of Children's Services regarding that person's lack of knowledge regarding the applicant's magazine. The submissions make reference to the fact that this person was "willing to go on record in support of this fact". Clearly this is an attempt at filing evidence of fact, namely evidence pointing to the understanding of individuals in the industry. Further, accompanying the submissions is a statement from an individual within the International Federation of Social Workers. I will not discuss its content but this is clearly meant to be taken as evidence of fact. For the avoidance of doubt, the above statements and anything else that is deemed to be evidence of fact in the submissions is to be considered as such. Given the Tribunal's decision to refuse the filing of additional evidence, anything that I deem to be evidence is to be disregarded.

DECISION

20. Both sections 5(4)(a) and 3(6) of the Act have application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

“47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.

Section 5(4)(a)

21. Section 5(4)(a) of the Act reads as follows:

“(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.”

22. 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.”

23. 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).”

24. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant Date

25. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C., 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.’ ”

26. The contested mark does not have a priority date. There is reference in the proprietor’s counterstatement to its intent to utilise the contested mark as a brand as early as 2006. This includes evidence that Ms Doubtfire purchased the domain name *socialworknews.com* on 2 August 2006. While this is noted, there is no evidence of actual use of the website prior to the filing date of the contested mark. The mere existence of the website as a registered domain name is not outward use that is capable of being the start of the behavior complained about. As for the proprietor’s intention to use the contested mark, this is also not the same as actual outward use and, as was the case above, it is not capable of being deemed the start of the behaviour complained about. This means that the broad claim of having an intention to use the mark can only be supported if evidence of actual use is provided. Having reviewed the evidence, I note that there is nothing before me setting out any actual earlier use of the contested mark by the proprietor. The only evidence pointing to the proprietor’s use of its mark is the following passage taken from Ms Doubtfire’s witness statement:

“We launched in October 2020 and began developing both brands, developing our website and other elements of the project. We were aware that a trademark has to be developed within 5 years of its being registered.

The Registrant has been using Social Work News continuously within the Social Work Today brand with a view to future development as its own product.

- It is an integral part of the brand with its own section on the Social Work Today website
- Social Work Today emails are in the form of a newsletter and news is sent to the circulation list at 10am every day. Therefore, Social Work News identifies the service we provide
- There is a specific section called Social Work News on the e-newsletters sent out every morning at 10am
- The domain names www.socialworknews.com and www.socialworknews.co.uk link through to the Social Work Today website

Please see exhibit KD 3.”

27. By the proprietor’s own admission, its use did not begin until at least October 2020 and, given that the application date for the contested mark was 3 September 2020, this does not constitute earlier use. In any event, I note that the example of use referred to, being Exhibit KD3, only shows undated examples of the proprietor’s purported use of the mark on its website.

28. In light of the above, there is nothing before me to suggest the existence of any earlier date on which the behaviour complained about began. Therefore, as the case law set out above confirms, the relevant date for the present case is that of the date on which the contested mark was filed, being 3 September 2020.

Goodwill

29. The first hurdle for the applicant is that it needs to show that, at the relevant date, it had the necessary goodwill in its business and that the signs relied upon were distinctive and/or associated with that goodwill. Goodwill was described in *Inland*

Revenue Commissioners v Muller & Co's Margarine Ltd [1901] AC 217 (HOL), in the following terms:

“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.”

30. 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.”

31. 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.”

32. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

33. Goodwill arises as a result of trading activities. As I have set out above, the applicant claims to have used the signs ‘SANCTUARY SOCIAL WORK NEWS’, ‘SOCIAL WORK NEWS MAGAZINE’, ‘SOCIAL WORK NEWS’, ‘SWN MAGAZINE’

and 'MY SOCIAL WORK NEWS / MYSOCIALWORKNEWS' on the below goods and services since either 2013, 2017 or 2019.

"Downloadable publications (class 9); teaching and instructional material (classes 9 and 16) printed matter, printed publications (class 16); recruitment services (class 35); advertising and PR services (class 35); communication by online blogs; providing online forums (class 38); Publishing, reporting and writing of texts (class 41); Educational, training and instructional services (class 41); publication services (class 41); Organising awards (class 41); Hosting of digital content, namely, online publications and blogs (class 42); Providing forums for communication in the field of social work (class 9, 16 and 38, 42)"

34. As discussed above, both parties' evidence in chief consisted of two sets of witness evidence and, further, the applicant filed two additional witness statement in reply. In the present circumstances, I do not consider it necessary (or particularly helpful) to summarise the entirety of the evidence. Instead, I will only summarise it to the point that I consider it necessary.

Evidence of trading activities

35. The applicant's evidence shows that, since 2013, it has published a quarterly news magazine that covers the social work sector. Included in the evidence is a number of images showing the cover page of the applicant's publication between 2013 and 2017.¹ I note that the images provided show the wording 'SANCTUARY SOCIAL WORK NEWS' as the title of the applicant's publication. The applicant claims that use of the words 'SOCIAL WORK NEWS' on a separate line on these front pages are such that they are capable of gaining a secondary meaning.²

36. From the Winter 2017 edition onwards (or at least, until the relevant date), the front cover of the magazine was changed. Copies of these updated front covers are provided and I note that they show the words 'SOCIAL WORK' at the top of the

¹ JR1

² JR2

page in large writing.³ The applicant also draws attention to the fact that, above these words in smaller typeface are the words 'Social Work News Magazine' and a reference to the applicant's website, being 'mysocialnews.co.uk'. In respect of this wording, the applicant also confirms that they have also been used in the header and footer sections of its inner pages since 2017, at the latest. An example of this is provided in the evidence⁴ which includes a comment from the magazine's editor confirming the change of the name to 'Social Work News'. Additional covers from 2021 onwards have been provided but are after the relevant date so are not relevant to my present assessment. The applicant claims that this publication has always been known by its readers as 'SOCIAL WORK NEWS', a point that I will discuss in my conclusion.

37. The evidence then goes on to discuss the applicant's websites, being 'mysocialworknews.com' and 'mysocialworknews.co.uk'. The applicant claims that these were purchased in 2017 with the expectation that they would go live soon after. However, it appears from the evidence that these websites did not go live until November 2020,⁵ being after the relevant date.

38. The distribution of the applicant's magazine is then discussed. On this point, I note that the proprietor makes several contentions that the applicant has admitted that its magazine is only circulated internally amongst agency-registered staff. This is expressly denied at paragraph 12 of Mr Rook's witness statement. He accepts that free copies have previously been given to all Directors of Adult Services and Children's Services of all English authorities, however, the magazine has never been an internal publication. The applicant confirms that it is an outward facing physical and digital publication (with a digital version only being available from 2015 onwards) aimed at social workers, employers and the health sector in general. The applicant confirms that the magazine is published quarterly at a price of £3.25.⁶

³ JR3

⁴ JR5

⁵ JR6

⁶ Evidence is specifically adduced to support this at JR7 but I note that each front cover of the magazine provided shows its pricing.

39. The evidence sets out that each issue is distributed to around 1,500 to 2,000 social workers per quarter. A yearly breakdown of magazine issues that have been printed and mailed to the applicant's subscribers have been provided. The evidence shows figures for 2014 to 2021 and, save for the 2021 figures (which are after the relevant date), this information is as follows:

Year	Magazines issued	Total figure inc. digital reads
2014	8,000	11,625
2015	11,500	18,691
2016	18,500	11,177
2017	8,000	13,835
2018	4,000	28,082
2019	8,000	19,258
2020	4,500	22,610
Total:	62,500	125,278

40. A document provided by the applicant's printer company verifying the printed publication numbers is provided,⁷ so too is an invoice from the printer that identifies the magazine as 'SOCIAL WORK NEWS'. While the latter point is noted, the assessment I must make is based on the perception of the relevant public, not the printer contracted to print the publications.⁸

41. Information and analytics regarding the applicant's website are provided but these are dated after the relevant date so are of no assistance to the present assessment.⁹

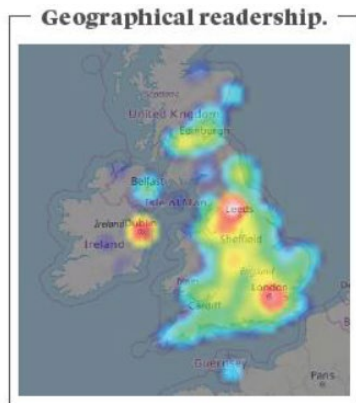
42. I note in its evidence regarding the provision of advertising services, the applicant has provided evidence of the geographical spread of its readership for both its October to December 2018 and January to March 2019 issues.¹⁰ This is not in the form of any tangible figures but in a heat map showing a readership that spreads across the UK. These are images are shown below.

⁷ JR9

⁸ JR10

⁹ JR11

¹⁰ JR12



(October to December 2018)



(January to March 2019)

While only covering two issues, I consider it reasonable to conclude that this general geographical spread also applies to all other issues of the magazine.

43. As demonstrated in the above graph, there is a cluster of readers in the Republic of Ireland. There is no legend indicating the meaning behind the colours shown but given that it is a heat map, I consider it reasonable to conclude that the red areas represent the highest concentration of users. As a result, the cluster for Ireland represents a significant amount of readers. While noted, my assessment is focused on UK consumers so the readership in Ireland is of no relevance. However, it is an issue for the applicant as it demonstrates that not all use in the evidence is within the relevant territory.

44. In respect of advertising, I note that with the heat map evidence referenced above, the applicant has provided a print-out showing its advertising rates for 2019. While noted, there is no evidence suggesting the level of services provided off the back of these print-outs. The only evidence that points to the actual procurement of services is the inclusion of an 'advertising services agreement' dated 24 November 2016 that shows the sale of one full page advert within one issue of the applicant's publication for the sum of £1,250 plus VAT and the witness statement of Mr Taffurelli. The evidence from Mr Taffurelli confirms that, in the six years prior to the date of his statement, Liquid has promoted its services via adverts in the applicant's magazine. I note that the statement is dated over two years after the relevant date and, as a result, the confirmation from Mr Taffurelli means that, for approximately four years prior to the relevant date, Liquid was acquiring advertising services from

the applicant. In total, the evidence shows two customers obtaining advertising services from the applicant, one being a seemingly one off purchase but the other indicating repeat custom for a period of four years.

45. The applicant operates a Twitter account under the handle '@myswnews' with the account name 'Social Work News'. This account was registered on 4 February 2019.¹¹ A number of tweets and exchanges are shown in evidence and while these are all dated prior to the relevant date,¹² the engagement with each post (by way of likes and retweets) is either very limited or non-existent. I note that there are a number of replies and retweets to the applicant's posts but, again, this is limited. The applicant states that this clearly shows significant reach but, given the limited interactions, this is not the case. The applicant claims that this evidence shows use of 'SOCIAL WORK NEWS' and 'MYSOCIALWORKNEWS' on services in class 38, but does not specify which ones, or why.

46. Since 2013, the applicant confirms that it has been regularly attending events wherein it has offered and advertised the 'SOCIAL WORK NEWS' magazine for purchase and/or subscription. A photograph of the applicant's attendance at the National Children and Adult Services Conference (NCASC) in 2018 is provided.¹³ I note that the photo shows a copy of the magazine titled 'SOCIAL WORK' (while the magazine is not shown in full, it is a copy of the October to December 2018, the cover of which was provided earlier in evidence at page 5 of JR3). While the applicant's stand at this event is not shown, the background of the photograph show that some form conference is taking place. The evidence sets out that the NCASC event is aimed at local and central government, voluntary organisations and private sector bodies with an interest in health, social care and education. Mr Rook states this event has considerable reach in the community. While noted, there are no figures in support of this. Another event is then discussed, being the Community Care Live event in 2016. Mr Rook states that this is the UK's largest free-to-attend social work event offering seminars, training, exhibit stands and networking opportunities. Again, there is no supporting evidence showing the

¹¹ JR14

¹² JR15

¹³ JR16

actual reach of this event. A photograph of the applicant's stand at this show is included in evidence.¹⁴ This shows a copy of the SANCTUARY SOCIAL WORK NEWS magazine on display. I also note that the stand is labelled as 'Sanctuary Social Care' and includes a logo wherein the word 'SANCTUARY' is the dominant element as well as a reference to a website called 'sanctuarysocialcare.com'.

47. In response to the applicant's evidence, the proprietor filed its own evidence wherein it sought to raise issues with the evidence filed. For example, I note that Ms Doubtfire claims that the applicant's publication is an internal one which is used as a promotional tool. While noted, the applicant has confirmed that this is not the case. Ms Doubtfire also points out that the applicant's magazine has a limited circulation in comparison to a sector with 105,000 qualified social workers and social care stakeholders of three million. Ms Doubtfire also goes through and comments on a number of the exhibits filed by Mr Rook in his evidence. I do not intend to reproduce those comments here but confirm that they have been considered. The same point applies to the comments of Mr Pearson in his narrative evidence.

48. I note that the proprietor sought to raise additional points in its written submissions such as a claim that many organisations within the sector have been producing materials that include the title 'Social Work News' (including the International Federation of Social Workers). Therefore, the proprietor submits that any claim that the applicant owns unregistered rights in the sign is "rather far-fetched". While this is noted (and the distinctiveness of the sign being relied upon is part of the assessment which I must carry out under the present ground), there is nothing before me in evidence showing any other use in the industry of the sign.

49. As set out above, the applicant filed evidence in reply. The majority of this evidence attempts to raise issues with the proprietor's claimed ongoing use of the contested mark. I do not intend to reproduce this evidence here as I have discussed the issues with the proprietor's allusion to earlier use at paragraphs 26 to 28 above. The evidence in reply sets out that the applicant uses its magazine as a marketing tool when seeking to propose its social care services to clients. This is

¹⁴ JR17

demonstrated via the winning of two contracts on 15 May and 14 July 2020 (there are additional contracts but those are from after the relevant period) and is supported by images showing use of the magazines in the pitches.¹⁵ In addition, the applicant has provided additional figures from October 2022 that it claims to demonstrate how well received its publications are. The applicant acknowledges that these figures are from after the relevant date but sets out that such figures do not occur overnight, seemingly supporting a claim that, as at the relevant date, some significant figures would have been present. The October 2022 figures are as follows:

“We published **100 articles**, had **214,000 visitors** to the site, and had **235,000** page views, that we're able to track.

Across our social media platforms, **5.4 million people** saw our posts online, and **723,000 people engaged** with our posts (liked, commented, shared).

Throughout this month-long period, our content was read by people in **164 countries**.

We now have **83,000 followers** across our social media channels.” (original emphasis included)

50. While I appreciate that numbers like this do not simply appear overnight, the above figures relate to October 2022, being approximately two years after the relevant date. This is a significant period of time and it is not automatically the case that a significant level of figures must have existed as at the relevant date just because they existed two years later. In looking at the evidence on the point of social media, I remind myself that the Twitter account was only created in February 2019 (being some 19/20 months prior to the relevant date) and the evidence in respect of the posts from that account show very limited engagement. I accept that there may have been considerable growth in the applicant's social media accounts after the relevant date, however, I am not satisfied that the evidence is sufficient enough for

¹⁵ JR 2.6

me to infer that a significant level of engagement would have existed as at the relevant date simply because it did two years later. In addition, I note this evidence makes reference to readers from 164 countries which makes it difficult to determine how this evidence relates to the UK which, as above, is the relevant territory for this assessment.

Conclusion on the existence of goodwill

51. Before proceeding to the bulk of my assessment, it is necessary to discuss the applicant's reliance upon its fourth and fifth signs, being 'SWNMAGAZINE' and 'MY SOCIAL WORK NEWS'/'MYSOCIALWORKNEWS', respectively. There is no use of the fourth sign whatsoever and, therefore, the applicant's reliance upon this fails. As for the fifth sign, I note the presence of 'mysocialworknews.co.uk' on the top right of the cover page of the applicant's magazine (from September 2017 onwards). Even if this website reference is noticed, the average consumer will see it only for what it is, which is a website domain and not a distinctive sign that is capable of being used as an indicator of the applicant's business. Consequently, it is my view that if any goodwill is associated with the use of the applicant's business resulting from the use of its magazines, the website reference will not be distinctive of or associated with that goodwill. As a result, the applicant's reliance upon this sign also fails.

52. In making my assessment of whether there exists a protectable level of goodwill, I wish to discuss the range of goods and services that the applicant has sought to rely on. Having reviewed the evidence, the majority of it relates to the provision of "downloadable publications", "printed publications" and "advertising and PR services". I will address these in detail below but, first, I will consider the services in class 38 and 41. This is because the applicant makes various claims that its evidence shows use of services in class 38 and 41. Having reviewed the evidence, I am not convinced. My reasons are set out below.

53. In its evidence regarding its Twitter account, the applicant claims that it demonstrates use of class 38 services, which includes "communication by online blogs" and "providing online forums". My primary position in respect of the former

service is that posting tweets on Twitter is not the provision of a service. If it were, any active twitter user could argue that it provided such a service. This cannot be the case. Alternatively, the engagement of this account shown in the evidence is extremely limited so would not justify the accrual of any goodwill in any event. As for the latter services, an online forum is an online space dedicated to conversation or questions/answers between registered users. There is nothing in evidence showing any use of this service being provided to customers. The applicant's class 41 services are "publishing, reporting and writing of texts", "educational, training and instructional services", "publication services" and "organising awards". It does not seem to me that the provision of a publication (whether printed or electronic) automatically means that the provider of the publication offers publishing, report and writing of text services or publication services. No such evidence has been provided in support of any of these services and while I appreciate that the applicant may publish, report and write in relation to its own publication, there is nothing to suggest that it provides these as actual services to customers. The applicant's reliance on these services, therefore, fails.

54. As for the remaining terms covered in the applicant's claim, I also consider that no evidence has been filed in relation to these. For example, in respect of "hosting of digital content, namely, online publications and blogs", I note that the evidence points to the applicant's digital content being provided by a third party, being 'issuu.com'.¹⁶ There is nothing to suggest the offering of a service whereby the applicant hosts the digital content of its customers. For the avoidance of doubt, the applicant's reliance upon all remaining goods and services fails.

55. I turn now to the substantial issue of whether the evidence is sufficient to demonstrate that the applicant owns a protectable level of goodwill in "downloadable publications", "printed publications" and "advertising and PR services". I believe I can deal with the latter service relatively swiftly so will address that first.

¹⁶ See paragraph 16 of Mr Rook's second Witness Statement

56. I remind myself that goodwill stems from trading activities so the fact that the applicant has a print-out that shows its advertising prices is of no assistance to this determination without evidence of trade. The totality of the applicant's evidence regarding advertising is, therefore, the provision of one advert in one issue of its 'SANCTUARY SOCIAL WORK NEWS' magazine in November 2016 and ongoing advertising sought by Liquid for approximately four years prior to the relevant date. Being a quarterly magazine, this equates to advertising across approximately 16 issues. While repeat custom is often a factor in favour of the existence of goodwill, evidence of just one repeat customer is not compelling. Further, the existence of just one other customer prior to the relevant period is another factor weighing against the applicant.

57. In addition to the above, the applicant claims that its attendance at events and using its magazine in pitch meeting are sufficient to cover the provision of an advertising service. This is not the case. Advertising services are those provided as an actual service to customers. This is not the same as a company undertaking its own advertising efforts. If it were, any undertaking that sought to advertise its own goods or services would be duly protected for advertising in class 35. On this point, I remind myself of the case of *BLINK*¹⁷ wherein Mr Phillip Johnson, sitting as the Appointed Person, set out that advertising alone does not generate goodwill. Taking this into account together with the fact that the totality of the evidence shows only two customers (albeit one repeat) prior to the relevant date, I am not satisfied that the applicant has shown enough evidence to support a claim that it owns goodwill in relation to this service. The reliance on this service, therefore, fails.

58. Turning now to consider "downloadable publications" and "printed publications", I can deal with these together. Before considering the level of trading activities undertaken by the applicant, I wish to first discuss the signs that are covered by the applicant's magazine. As I have discussed above, the applicant began issuing a magazine in 2013 under the name 'SANCTUARY SOCIAL WORK NEWS'. This changed to 'SOCIAL WORK' for the October to December 2017 issue and this was the name of the magazine as at the relevant date. The applicant makes repeated

¹⁷ Case BL O/606/18

reference to the fact that the sign 'SOCIAL WORK NEWS' has always been associated with the magazine. While this claim is noted, I am not convinced that the evidence demonstrates this for the period when the magazine was referred to as 'SANCTUARY SOCIAL WORK NEWS'. When the magazine was published under this name, it was displayed on the cover page as follows:



59. The applicant argues that 'SOCIAL WORK NEWS' appearing on its own line supports its claim that it would have been referred to as 'SOCIAL WORK NEWS'. I do not agree. Given that 'SOCIAL WORK NEWS' is descriptive of the goods being offered, namely that it is a news magazine regarding social work, the word 'SANCTUARY' will clearly be considered the dominant element. While the whole phrase would have been noticed, I see no reason why the average consumer would simply refer to the magazine as 'SOCIAL WORK NEWS'. If anything, in the event that the consumer did seek to shorten the title, I consider that they would refer to it as 'SANCTUARY'. As a result of the above, the applicant's argument that the magazine was referred to as 'SOCIAL WORK NEWS' and, therefore, obtained a secondary meaning¹⁸ is dismissed.

60. Despite dismissing the argument in respect of the pre-September 2017 magazine, I consider that this argument holds more weight in respect of the re-branded 'SOCIAL WORK' magazine. The cover of the magazine from September 2017 to the relevant date showed the following title:



¹⁸ As per Mr Rook's argument at paragraph 7 of his first witness statement

While presented a lot smaller than the words 'SOCIAL WORK', the words 'SOCIAL WORK NEWS MAGAZINE' are clearly present on the cover page. Further, I note that the words 'SOCIAL WORK NEWS' is displayed in the header and footer of each page of the magazine, with the footer also indicating the page number.¹⁹ Taking this into account, I am satisfied that, during this time, the magazine would have been referred to as 'SOCIAL WORK', 'SOCIAL WORK NEWS' or 'SOCIAL WORK NEWS MAGAZINE'.

61. While no turnover figures in respect of magazine sales have been provided, I remind myself that between 2014 and 2020, the applicant had a total of 62,500 printed publications issued and, inclusive of digital reads, its readership figure stood at 125,278. While it may have been possible to calculate the applicant's turnover on the basis that the price of the publication is shown as £3.25, I do not consider this appropriate in the present case for two reasons. Firstly, there is no indication that there is any cost associated with the online publication and, secondly, the narrative evidence of Mr Rook sets out that the applicant did issue free copies to all Directors of Adult Services and Children's Services of all English authorities. I have nothing before me to suggest how many directors of adult and children services there are in each authority and neither is there anything to suggest how many authorities there are in England. Another point I wish to discuss in respect of the readership base of the applicant's magazine is the fact that the geographical spread map shows a significant cluster of readers in the Republic of Ireland. On this point, there is no indication that the figures mentioned above are UK only figures so I have no alternative but to treat them as covering all jurisdictions, which the evidence confirms as including Ireland. While the cluster on the heat map is significant, there is nothing showing exact figures for that region and while this is an issue that I must bear in mind going forward, I remind myself that the majority of the spread shown in the heat maps does cover the UK.

62. From the switch to the name 'SOCIAL WORK' in September 2017, the evidence shows 10 publications as being issued between then and 'Autumn 2020'. In 2020, the issues were renamed from months to seasons but, in line with the published

¹⁹ JR5

dates of previous issues, I consider it reasonable to consider that the Autumn 2020 issue covered September to December of that year. While the last issue may have been issued just prior to the relevant date, I consider that a number of sales and reads of this issue may have fallen after the relevant date. This is another point that I must bear in mind going forward.

63. In respect of advertising, I note that no advertising or marketing expenditure has been provided in the evidence. That being said, the evidence confirms that the applicant attended two exhibitions (in 2017 and another in 2018) wherein it sought to promote its magazine. While no specific figures have been provided as to the attendance at these events and the subsequent reach of the magazine at those events, I note the narrative evidence of Mr Rook that confirms that one event has considerable reach in the community while the other was the UK's largest free-to-attend social work event. There are no figures supporting these claims but I have no reason to doubt the statements made. In addition, I note that the applicant confirms that when it pitches its social services to potential clients, it uses its magazine as a marketing tool. On this point, I note the evidence shows that, using this method, the applicant won two contracts on 15 May 2020 and 14 July 2020 (the former being referred to as 'Innovate CYPs Blackpool' and the latter being a 'Sanctuary Social Care Perm proposal')²⁰.

64. The above referenced evidence clearly does not represent widespread use, a point raised by the proprietor in its own evidence. Further, this is something that the applicant has admitted to by way of Mr Rook's evidence in reply wherein he stated that "a large print circulation has never been the goal."²¹ All that being said, I remind myself that while goodwill must be more than trivial in extent,²² 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.²³ So while the limited nature of the evidence is an issue for the applicant, it is not necessarily fatal to its claim for the existence of goodwill.

²⁰ As confirmed at paragraph 12 of the second witness statement of Mr Rook

²¹ Paragraph 17 of the second witness statement of Mr Rook

²² *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

²³ See *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 wherein the judge at first instance defined the relevant customer base as 'very limited', it was still sufficient to support of claim for passing off.

65. In making the present assessment, I remind myself that the applicant only used its first sign between 2013 and September 2017 and that it only used its second and third signs from September 2017 until the relevant date. Therefore, for any claim reliant upon the applicant's first sign to proceed, any goodwill that existed as at 2017 will need to have remained at a protectable level as at the relevant date. Additionally, any claim reliant upon its second and third signs will need to show that, between September 2017 and the relevant date, a level of goodwill accrued in the applicant's business and that those signs were distinctive of and/or associated with the same. I will deal with these issues in turn.

The applicant's first sign

66. The applicant claims to have used its first sign since 2013 but has only provided readership figures for 2014 onwards. From the figures provided, there were a total number of 46,000 magazines issued with a total readership of 55,328 (inclusive of digital reads) over a four year period. While the 2017 figures are included in this total, some of this will include readership for the first 'SOCIAL WORK' magazine, a point I will bear in mind. During this time, the applicant attended one exhibition. This is, in my view, very low use and while the applicant may have customers across the majority of the UK, the use is not particularly longstanding. Further, I remind myself that some readership was from Irish customers. As I have already discussed above, this is not fatal to the applicant's claim and I conclude that, as at September 2017, the applicant had acquired a low (but protectable) level of goodwill in its business (being the provision of "downloadable publications" and "printed publications") and that its first sign was distinctive of or associated with that goodwill. However, given that the cessation of use was three years prior to the relevant date, I must consider the position in respect of residual goodwill.

67. It is settled case law that when a trade ceases to carry on its business, for a period of time it may retain the goodwill attached to that business and, by extension, the ability to enforce its rights.²⁴ The point at which the goodwill no longer exists is a matter of fact and degree. In the present case, I will consider the three stage test

²⁴ *Ad-Lib Club Limited v Granville* [1971] FSR 1 (HC)

set out in paragraph 15 of *Minimax* (cited above). This test requires an assessment of (1) the size of the reputation when use stopped, (2) how lasting in the public eye are the goods for which the sign is applied and (3) how, if at all, the applicant has acted in order to keep its reputation in the public eye. As set out in *Minimax*, the greater each of these elements, the longer it will take for any goodwill to dissipate. Firstly, I have found that the applicant enjoyed a low (but protectable) level of goodwill in its first sign in September 2017. Secondly, I do not consider that magazines (whether printed or digital) are goods that can be said to last in the eye of the public. Lastly, the applicant has provided no evidence of how, if at all, it has asserted its rights in its first sign for the goods at issue, particularly given that the magazine changed its name. Taking all of this into account and bearing in mind that three years passed between September 2017 and the relevant date, I am of the view that the low level of goodwill will have dissipated to a below a trivial (and, therefore, not protectable) level as at the relevant date. As a result, the reliance upon the applicant's first sign fails in its entirety.

68. In the event that I am wrong to conclude that there was no protectable level of goodwill in the first sign at the relevant date, I do not consider that this will get the applicant over the line. This is because the dominant element of the applicant's first sign will be seen as 'SANCTUARY'. I accept that the words 'SOCIAL WORK NEWS' will not be overlooked entirely and that they are identical to those in the contested mark, however, they are of a low (or no) distinctive character due to their descriptive nature i.e. they describe (or at least heavily allude to) goods and services that cover news relating to the social work sector. On this point, I bear in mind the case of *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39 wherein Lord Simonds found that the differences between *Office Cleaning Services* and *Office Cleaning Association* were sufficient to preclude a finding of misrepresentation between those signs. In that case, the differences were 'Services' and 'Association', which themselves are not particularly distinctive elements. In the present case, the point of difference between the sign and the mark is the word 'SANCTUARY' which I consider to be significantly more distinctive than the differentials in discussed in *Office Cleaning*. As a result, I see no reason why a similar finding does not apply here in that there will be no misrepresentation. To conclude, even if I found there to be a protectable

level of goodwill as at the relevant date, there would be no misrepresentation and, consequently, the applicant's reliance upon its first sign fails.

The applicant's second and third signs

69. Moving to the second and third signs, I remind myself that the first issue of the applicant's magazine that used these signs was in September 2020. As a quarterly magazine, this means that between then and the relevant date, the applicant issued just ten issues. The applicant's figures for the distribution of the printed magazine during this period would have been approximately 16,500 magazines. Accounting for an average of 1,500 to 2,000 magazines issued, I consider it reasonable to find that this figure rises to approximately 18,500 with the inclusion of the September 2017 issue. Inclusive of digital reads, the total readership for the magazine during this time was approximately 72,450 (admittedly, I am unable to determine the digital viewership for the September 2017 issue). During this time, the applicant attended one exhibition and used its magazine in support of two successful bids for contracts. While the evidence for this period is slightly greater than the evidence in respect of the applicant's first sign, it is still, in my view, very low. As was the case above, I appreciate that the applicant may have had customers across the majority of the UK but note that the use is not particularly longstanding, stemming from just three years of use and the issuance of just ten issues of a magazine. Further, I remind myself that some readership was from Irish customers. The advertising attempts during this time were marginally greater than those discussed above but I consider the impact of this to be minimal.

70. At paragraph 66 above, I found that a slightly lesser level of use was sufficient to warrant a minimal (but still protectable) level of goodwill in the applicant's business. While that may have been the case, I was satisfied above that the applicant's first sign was distinctive of and/or associated with that goodwill. In considering the applicant's second and third signs, I do not consider the same finding applies. This is on the basis that the signs relied upon, being 'SOCIAL WORK NEWS MAGAZINE' and 'SOCIAL WORK NEWS' are relatively descriptive and, in my view, describe (or at least heavily allude) to the nature of the goods at issue (being social work news magazines) rather than being distinctive indicators pointing to the

applicant. On this point, I refer to the case of *McCain International Limited v Country Fair Foods Limited and Another* [1981] R.P.C. 69 (COA) wherein the Court of Appeal found that while a descriptive term may acquire a secondary meaning (as a reference to the source or maker of goods or services and, therefore, distinctive of the provider of those goods or services), any evidence in support of such must be extensive. In that case, the plaintiff's use of the descriptive term 'OVEN CHIPS' was considered to be extensive national use; however, the period of use was far too short (18 months) for a secondary meaning to have been acquired. In the present case, the level of use over this time was clearly far from extensive national use and was, on the contrary, very low. Three years of such a low level of use is, in my view, far from sufficient to demonstrate extensive use that would give rise to a finding that 'SOCIAL WORK NEWS MAGAZINE' or 'SOCIAL WORK NEWS' obtained a secondary meaning as a reference to the source or maker of the goods. In light of the above, I find that the applicant's reliance upon its second and third signs fails.

71. Given my findings above, the applicant's 5(4)(a) claim fails in its entirety.

Section 3(6)

72. 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”

73. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 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]”.

74. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

75. Having considered the evidence of both parties, it appears to me that the timeline of events relevant to the bad faith claim is as follows:

- a. On 2 August 2006, Ms Doubtfire purchased the website 'socialworknews.com'.²⁵ Both before and after this date, Ms Doubtfire purchased a wide range of websites seemingly related to the topic of 'social work'. As rightly claimed by Mr Rook, this is not trade mark use. A lot is made of these websites in the applicant's evidence to the point that a witness statement was specifically introduced to deal with it, being that from Mr Farah. As above, Mr Farah is a Technology Consultant at the applicant who has discussed the nature of these websites and their lack of use. I will not discuss this evidence here but will assess it to the extent I deem necessary below.
- b. The applicant began using 'SANTUARY SOCIAL WORK NEWS' as the title of its quarterly magazine in 2013. The applicant operates in the same industry as the proprietor.
- c. Mr Rook has crossed paths with both Mr Pearson and Ms Doubtfire on many occasions. The applicant claims that Mr Pearson and Ms Doubtfire have both visited the applicant's stands at events such as NCASC (being the 2018 event referred to under the 5(4)(a) grounds above). Their relationship during this time appears to have been amicable.
- d. The applicant attended the proprietor's jobs fair as an exhibitor in 2016. An order form confirming this is provided²⁶ but there are no images showing the nature of the applicant's attendance and whether 'SANCTUARY SOCIAL WORK NEWS' or the 'SOCIAL WORK NEWS' range of signs were used.
- e. In 2017, employees of the applicant and the proprietor engaged in a number of email exchanges wherein the applicant's attendance at the proprietor's 2017

²⁵ JR24

²⁶ JR19

job's fair was discussed.²⁷ In an email dated 8 February 2017, the employee of the applicant attached an employer profile to use for the proprietor's job's fair. I note that this references the 'SANCTUARY SOCIAL WORK NEWS' magazine. In the last email dated 8 November 2017, a representative for the applicant made reference to the SOCIAL WORK NEWS magazine and the website mysocialworknews.com.

- f. In September 2017, the applicant's magazine was re-branded to 'SOCIAL WORK' and, on the front cover and in the headers and footers of that magazine, it used the wording 'SOCIAL WORK NEWS'
- g. On 3 September 2020, the proprietor applied for the contested mark which was accepted and registered on 25 December 2020.
- h. In October 2020, Ms Doubtfire claims that the proprietor began developing its branding, its website and other elements of the project. Ms Doubtfire sets out that the proprietor has been using the contested mark continuously with its Social Work Today brand and has provided undated copies of its logo used on its website, the back of its business card, a full page advertisement and an exhibition stand panel are included in evidence and all show the contested mark.²⁸
- i. As of 27 January 2021, there was no reference to the contested mark on the proprietor's website.²⁹
- j. On 12 March 2021, Ms Doubtfire rang Mr Rook to discuss the applicant's branding. During this call, Mr Rook claims that Ms Doubtfire mentioned the proprietor's registration (being the contested mark) and the rights in that name that went back over 15 years. There is no mention of Ms Doubtfire demanding that the applicant cease using the mark. Mr Rook states that this was when he first became aware of the existence of the contested mark.
- k. Ms Doubtfire followed this call up with an email to Mr Rook dated 15 March 2021.³⁰ In this email, Ms Doubtfire discussed the fact that the applicant's intention to re-brand its product would be restricted if it included 'Social Work News'. Further, Ms Doubtfire mentioned the possibility of the trademark being licenced in full or in part. Reference is also made to a discussion regarding a

²⁷ JR20 and JR21

²⁸ KD3

²⁹ JR22

³⁰ JR18

potential name change. Mr Rook confirms that, at this point, he felt that the registration was filed in an underhand manner.

- i. Upon discovering the existence of the contested mark, Mr Rook purchased the domain and trade mark registrations (although he does not specifically state which ones). After doing so, he had a number of discussions with Mr Pearson wherein he offered £5,000 (presumably to buy or licence the mark but this is not confirmed) and, when that was rejected, negotiated up to £15,000 but, at this point, he decided to explore the applicant's legal position. There is some contention surrounding this issue as Mr Pearson's evidence states that there was no negotiation and that Mr Rook simply rang to buy the rights. Further, in his evidence in reply, Mr Rook claims that a call from Mr Pearson followed Ms Doubtfire's email (at a date that Mr Rook is unable to confirm) wherein Mr Pearson presented a sales pitch regarding how much the name was worth.
- m. On 19 April 2021, the contested mark appears on the proprietor's website.³¹ Following on from point i. above, this means that at some point between 27 January and 19 April 2021, the proprietor began using the contested mark on its website.

76. On balance, I am willing to accept that the proprietor's organisation was aware of the existence of the applicant's magazine, be that when it was titled 'SANCTUARY SOCIAL WORK NEWS' or when it was simply 'SOCIAL WORK'.³² While it is not expressly admitted by either of the proprietor's witnesses that they were aware of the use of 'SOCIAL WORK NEWS', there is an implication that at least Ms Doubtfire was aware of the title 'Social Work'³³ and that Mr Pearson was aware of the fact that the applicant had used several titles over the years.³⁴ While that may be the case, I refer to paragraph 40 of *Lindt* (cited above) which sets out that:

“the fact that an applicant knows or must know that a third party has long been using [...] an identical or similar sign for an identical or similar product capable

³¹ JR23

³² While the proprietor has not sought to avoid the bad faith claim on the basis that the evidence relates to individuals only (being directors of the proprietor), it is settled case law that see the case of *Joseph Yu v Liaoning Light Industrial Products Import and Export Corporation*, BL O/013/05 wherein it was found that a claim of bad faith is not avoided by making an application in the name of an entity that is owned or otherwise controlled by the person behind the application.

³³ See paragraph 4 of the Witness Statement of Ms Doubtfire

³⁴ See paragraph 3 of the Witness Statement of Mr Pearson

of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the applicant was acting in bad faith.”

77. It is not enough to simply suggest that as the proprietor was aware of the applicant’s use, it was acting in bad faith in filing its mark. Instead, there needs to be something more such as an intention to extract payment/consideration from a third party, e.g. to lever a UK licence from an overseas trader³⁵ or to gain an unfair advantage by exploiting the reputation of a well-known name.³⁶ I note that the applicant’s evidence argues that the proprietor sought monetary payment from the applicant in March 2021, however, this is not in line with its pleaded case, namely that the proprietor has sought to block the applicant’s use. While the pleaded case does mention that the proprietor’s demand to cease using its signs is evidence of the attempt to block, nothing is mentioned in relation to any attempt to extort. It would not ordinarily be necessary to consider this issue given that it is not in line with pleaded claim, however, having considered the evidence, I do not consider that it supports such a claim. Therefore, even if it was pleaded, it would be of no assistance to the proprietor. Briefly, I do not consider that the mention of a potential licence to use the sign is an indicator of a serious attempt by the proprietor to extract money from the applicant. This is on the basis that licence agreements regarding trade marks are relatively common. Further, I note the claim of Mr Rook that Mr Pearson tried to negotiate a fee with the applicant relating to the applicant’s use of the mark. Such a claim has been expressly rebutted by Mr Pearson in that he claims that it was Mr Rook who rang him and proposed a price to pay for the trade mark. As I have alluded to above, this was, in turn, disputed by Mr Rook in that he claims that he made the offer following a ‘sales pitch’ by Mr Pearson. There is clearly some disagreement on this issue and, essentially, it is Mr Rook’s word against Mr Pearson’s. On this point, I remind myself that claims under 3(6) grounds are serious allegations that must be distinctly proven and I am not satisfied that Mr Rook has provided sufficient evidence in order to overcome Mr Pearson’s express rebuttal of this point.

³⁵ *Daawat Trade Mark*, [2003] RPC 11

³⁶ *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch).

78. In respect of the pleaded claim, I remind myself of the case of *Copernicus-Trademarks v EUIPO (LUCEO)* Case T-82/14, wherein the General Court found that the filing of EU trade marks for the purposes of blocking applications by third parties, and without an intention to use the mark, was an act of bad faith. In order for the pleaded case to succeed, it is necessary for the applicant to show that the proprietor sought to block its use of its signs and that the proprietor had no intention to use the contested mark. It is not enough to simply demonstrate a 'blocking' attempt as, in ordinary circumstances, an owner of trade mark has a right to block third parties from using its mark (or similar marks, for that matter). On this point, I note that Mr Rook places emphasis on the call with Ms Doubtfire in March 2021 but I see no reason why it should be considered bad faith for a representative of the proprietor to seek to protect its trade mark rights by highlighting potential infringement to the applicant. After the successful registration of its mark, this is something that the proprietor was entitled to do and to support the applicant's claim, more evidence would be required to speak to the actual intention of the proprietor in filing its mark.

79. Speaking to the proprietor's intention to use the contested mark, I note that Ms Doubtfire has owned a domain name for 'socialworknews.com' since 2006. This supports Ms Doubtfire's position that the proprietor has had the intention to use the contested mark for a substantial period of time. While the website has not been used and I note the applicant's issues with this, the proprietor's lack of use does not necessarily contradict Ms Doubtfire's statement regarding the proprietor's intention to develop the brand. In addition, Ms Doubtfire confirms in her narrative evidence that the proprietor began working to develop its branding in October 2020, being just after it filed the application at issue. While the evidence on this point is not overwhelming, I have no reason to doubt Ms Doubtfire's narrative evidence, particularly given that it is accompanied by a statement of truth. Further, I note that Ms Doubtfire also confirms that the proprietor has been using the mark at issue on the documents shown in KD3 of her evidence and, in the applicant's own evidence, it shows use of the contested mark on the proprietor's website in April 2021. While evidence in bad faith claims should be targeted at the relevant date, evidence regarding subsequent events may be of assistance if it can be said

to cast light backwards as to the position at that time.³⁷ On this point, it is not controversial to suggest that, upon the registration of a trade mark, it is reasonable for the owner of that mark to take some time to actually develop and launch its branding and, therefore, put its mark to use. In this case, the period of approximately five months between registration and use of the mark on a website is not unreasonable, particularly given Ms Doubtfire's confirmation that work in doing so actually began in October 2020. On balance, I am satisfied that the evidence demonstrates an intention on behalf of the proprietor to use its sign.

80. Taking all of the above into account, I am not satisfied that the applicant has given rise to the existence of an intention of bad faith on the part of the proprietor in applying for the contested mark. As such, the applicant's claim under the 3(6) ground has not been made out and therefore fails.

CONCLUSION

81. The application has failed in its entirety and the contested mark may remain registered.

COSTS

82. The proprietor has been successful and, in the ordinary course of these proceedings, would be entitled to a contribution towards its costs. However, the proprietor is unrepresented meaning that, in order to claim its costs, it is required to file a completed costs pro-forma. It did not do so. I note that a blank costs pro-forma was provided to the applicant under the cover of a letter from the Tribunal dated 11 January 2023. I also note that this letter set out that:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

³⁷ *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)

83. As no costs pro-forma was filed and the proprietor incurred no official fees arising from this action, I make no order as to costs. Both parties are hereby ordered to bear their own costs of these proceedings.

Dated this 23rd day of May 2023

**A COOPER
For the Registrar**

ANNEX

Class 16

Books; Printed books; Printed educational materials; Printed matter; Printed news releases; Printed newsletters; Printed periodicals; Printed promotional material; Printed publications.

Class 35

Advertising analysis; Advertising and advertisement services; Advertising and marketing; Advertising and marketing consultancy; Advertising and marketing services; Advertising and marketing services provided by means of blogging; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotion services and related consulting; Advertising and promotional services; Advertising and publicity; Advertising and publicity services; Advertising in periodicals, brochures and newspapers; Advertising material (Dissemination of -); Advertising research; Advertising research services; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services relating to books; Advertising; Advertising services relating to the recruitment of personnel; Advertising services relating to the sale of goods; Advertising services to promote public awareness of social issues; Advertising space (Rental of -) on the internet; Advertising via electronic media and specifically the internet; Advertising via the Internet; Advertising, including on-line advertising on a computer network; Advertising, marketing and promotion services; Advertising, marketing and promotional consultancy, advisory and assistance services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Advertising, promotional and public relations services; Compilation of advertisements; Compilation of advertisements for use as web pages; Compilation of advertisements for use as web pages on the Internet; Compilation of advertisements for use on the internet; Conducting of trade shows; Conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes; Development of promotional campaigns; Dissemination of advertisements; Event marketing; Exhibitions (Arranging -) for advertising purposes; Exhibitions (Conducting -) for advertising purposes; Job matching services; Magazine advertising;

Marketing, advertising, and promotional services; Marketing services provided by means of digital networks; Online advertisements; Online advertising; On-line advertising and marketing services; Pay per click advertising; Preparation and presentation of audio visual displays for advertising purposes; Preparing audiovisual presentations for use in advertising; Product launch services; Product marketing; Providing advertising services; Providing advertising space; Providing advertising space in periodicals, newspapers and magazines; Providing and rental of advertising space on the internet; Providing recruitment information via a global computer network; Provision and rental of advertising space; Provision of advertising space; Provision of space on websites for advertising goods and services; Recruitment advertising; Recruitment of personnel; Retail services in relation to downloadable electronic publications; Texts (Publication of publicity -).

Class 38

Audio and video broadcasting services provided via the Internet; Chat room services for social networking; Collection and delivery of messages by electronic mail; Communication services for video conferencing purposes; Electronic file transfer; Electronic forwarding of messages; Electronic mail and messaging services; Electronic transmission of news; Interactive transmission of video over digital networks; Providing access to an Internet discussion website; Providing on-line chat rooms for social networking; Transmission of audio and video content via computer networks; Transmission of information on-line; Transmission of news; Transmission of podcasts; Transmission of webcasts; Transmission of written communications (Electronic -).

Class 41

Providing electronic publications; Providing on-line publications; Publication of books, magazines, almanacs and journals; Publication of documents in the field of training, science, public law and social affairs; Publication of educational and training guides; Publication of educational materials; Publication of electronic books and journals online; Publication of electronic magazines; Publication of journals; Publication of magazines; Publication of printed matter and printed publications; Publication of printed matter in electronic form; Publishing of web magazines.