

O-172-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO 2431225  
FOR THE TRADE MARK**

**MALE ANGEL**

**IN THE NAME OF ZAHIDA UL-HAQ**

**AND**

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO 500060**

**BY  
ANGEL ARRIGO (UK) LIMITED**

## Background and pleadings

1. MALE ANGEL was applied for as a trade mark on 30 August 2006 by Anwar UI-Haq. The mark completed its registration procedure on 23 February 2007. Mr UI-Haq assigned the trade mark registration on 30 July 2012 to Zahida UI-Haq, who is the current owner of the trade mark. It stands registered in class 5 for *food supplements and pharmaceutical preparations*.

2. Angel Arrigo (UK) Limited (“the applicant”) applied to have the trade mark declared invalid on 3 June 2013. The applicant claims that the trade mark is invalid on two counts:

(i) that the trade mark was applied for in bad faith under section 3(6) of the Trade Marks Act (“the Act”), which states:

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

(ii) that use of the trade mark would be contrary to the law of passing off under section 5(4)(a) of the Act, which states:

“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”.

3. The section 3(6) claim is expressed as follows:

“The proprietor of the registered trade mark Zahida UI-Haq is the wife of Anwar UI-Haq. Mr Anwar UI-Haq was the original registered proprietor of the trade mark at the time of application and until October 2012<sup>[1]</sup>.”

Anwar UI-Haq was employed by Mr Nigel Eyre, the predecessor in business to the party bringing the invalidity action, Angel Arrigo (UK) Limited to supply orders taken by the predecessor in title as a fulfilment centre.

Mr Nigel Eyre then ceased using Mr UI-Haq to fulfil his orders and proceeded to use another party. At that time, Anwar UI-Haq it would appear registered the trade mark despite having full knowledge that the trade mark was the property of Mr Nigel Eyre, that Mr Nigel Eyre was responsible for the creation of both the trade mark and the product to which it was attached, and furthermore that Mr UI-Haq had no rights whatsoever to claim the trade mark.

The application was clearly made in bad faith by a party employed by the rightful proprietor of the trade mark.”

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<sup>1</sup> The register of trade marks records that the effective date of assignment was 30 July 2012, but that it was not ‘actioned’ until 23 October 2012.

4. The section 5(4)(a) claim is based upon the applicant's use of the sign MALE ANGEL in relation to nutritional supplements. The pleadings state that use of the sign commenced in December 2004 in the UK. The applicant claims that, by the time Anwar UI-Haq applied for the trade mark, the applicant had built up a reputation in the MALE ANGEL trade mark.

5. Zahida UI-Haq filed a counterstatement. Her counterstatement is the only document she has filed in defence of her registration. She has filed no evidence. Her counterstatement is reproduced below, in full:

"It is denied that the use of the registered owner's trade mark by the owner or her licensee would be contrary to law, in particular, the law of passing off. It is denied that the trade mark was ever the property of the predecessors in business to Angel Arrigo (UK) Limited and the Cancellation Applicant are called upon to provide evidence to support their claim in this regard.

It is admitted that the registered proprietor is the wife of Anwar UI-Haq, but neither Mr nor Mrs UI-Haq have ever been employees of Nigel Eyre. It is understood that Mr Eyre collaborated with Prima AST Computing Services Ltd for several years, but not in a way that would render he the only rightful owner of the trade mark. Mr UI-Haq was employed by Prima AST Computing Services Ltd.

Contrary to the assertion made by the Cancellation Applicant, the collaboration continued until at least 2008. The current application to register the trade mark was made in 2006 and this was known to Mr Eyre at the time and continuously since. Proof of the ongoing collaboration will be provided.

It is denied that the application to register the mark was filed in bad faith, as it was filed with the agreement (in the event that such agreement was needed) and in the knowledge of Mr Eyre."

6. Only the applicant filed evidence. The parties were given a choice as to whether they wished to be heard or for a decision to be made on the basis of the papers filed. The applicant filed written submissions in lieu of a hearing. Mrs UI-Haq did not file written submissions or ask to be heard.

## **Evidence**

7. The applicant's evidence comes from Nigel Eyre, who is the applicant's Managing Director. Prior to this position, Mr Eyre held similar positions in companies which he set up to market the MALE ANGEL product. He states that he invented the name and came up with the product. Mr Eyre states that MALE ANGEL is the property of the applicant because he transferred the rights to the name to the applicant.

8. Mr Eyre states that he was introduced to a product called Oyster Plus in July 2004 and decided to market it under the name of MALE ANGEL, which fitted in with his other brands, such as Detox Angel and Head Angel. Mr Eyre states that he started marketing MALE ANGEL on 29 September 2004. He explains that although he sources the product and handles the taking of orders, he has (until recently) used

external companies to handle order fulfilment; for example, Budelpack Limited was the first company he dealt with, providing initial packaging designs in November 2004 and order fulfilment instructed in January 2005. Mr Eyre states that exhibit NE1, which is a copy of an email dated 11 January 2005, is in relation to the said order fulfilment. This exhibit consists of five pages, three of which are completely illegible. Two pages are copies of emails from Mr Eyre to a Jean Claude Muscat, dated 11 January 2005, in respect of an Angel Series Catalogue. One of the emails mentions "maleangel.net, headangel.net, detoxangel.net and mosquitoangel.net" in addition to the Angel brochure.

9. Mr Eyre states that he set up a website in November 2004 to assist with marketing, called maleangel.net, which went live in January 2005. Exhibit NE2 is said to comprise statistics of hits for the page. It is a copy of an email from Mr Eyre to a Richard Goodyear, dated 31 January 2005, with the subject recorded as "Fw: maleangel stats", having been sent to Mr Eyre earlier that day. For the month of January 2005, a total of 556 visits to maleangel.net were recorded, with 1037 'pages' and 2559 'hits' recorded. Of these, 502 pages and 1325 hits came from the UK. A second email sent in April 2005 shows, for March 2005, a total of 181 unique visitors, 481 visits, 1110 pages and 1710 hits. UK-specific figures are not given for this month. The level of web traffic drops sharply after March 2005.

10. Mr Eyre states that he issued press releases relating to the product and attended shows such as the Vitality Show to market the product to retailers and the general public, although there are no exhibits relating to such activity.

11. Exhibit NE3 consists of a letter to Mr Eyre from the Food Standards Agency, sent in October 2004 after the Agency was contacted by Mr Eyre on 30 September 2004, in relation to food supplements and their labelling requirements. The letter from the Food Standards Agency is headed "Food Supplements – Male Angel Oyster Plus Product".

12. Mr Eyre states that, in July 2005, SSL International ("SSL"), the owner of the Durex brand, considered purchasing the MALE ANGEL product for selling alongside its condoms in vending machines. Mr Eyre explains that the possibility of extra demand caused him to start looking for other companies to assist with order fulfilment. At the time, he was trading under the name Prima Health & Wellbeing Limited. He found Anwar UI-Haq through Yellow Pages. Mr UI-Haq's company was called Prima Computing Services Limited; Mr Eyre states that he was amused by the coincidence of names and contacted Mr UI-Haq to assist him with order fulfilments. After discussions between them, Mr UI-Haq carried out the first order fulfilment in October 2005 and an agreement was reached with regard to sourcing boxes, designed by Mr Eyre, from Pakistan. Mr Eyre exhibits emails in exhibit NE4 which he says support his statement. There is a chain of emails between "theangelgroup" (from someone signed "N") and "Anwar", relating to spreadsheets and airway numbers. Other emails relate to artwork for Male Angel boxes, but are not to or from "Anwar". Emails from July 2005 are shown, which were forwarded to theangelgroup.co.uk from "Anwar", detailing exchanges Anwar had had with someone called Desmond George in relation to producing small packs with tear tape facilities. Mr Eyre exhibits an email exchange dated 26 July 2005 between Anwar and a Mark Jones at "Complete packaging", regarding pricing for cartons. An email

from Anwar to “Nigel” on 22 September 2005 asks Nigel to send artwork to a third party name. The final page in exhibit NE4 is a picture of a box, which Mr Eyre states is an example of the boxes he designed and which were sourced from Pakistan. This is shown below:



13. Mr Eyre points out that the box specifically states that the mark is used under licence from The Angel Group by [www.primaworld.co.uk](http://www.primaworld.co.uk). Mr Eyre states that Mr UI-Haq had incorporated a company called Prima Worldwide Services Limited to handle order fulfilment, on 28 May 2005. Mr Eyre says that this makes it clear that Mr UI-Haq had no claim to the trade mark. Details of the company registration are shown in exhibit NE5. I note that Mr UI-Haq is recorded as also being a director of Prima A.S.T. Computing Services Ltd. Prima Worldwide Services Limited was dissolved on 5 May 2009.

14. Mr Eyre states that the first order from SSL was made on 4 January 2006, with increased advertising for the product through both the trade and to the public in 2007. There are no exhibits in relation to this statement. Mr Eyre states that although Mr UI-Haq carried out the order fulfilment, he had no direct contact with SSL or Mr Eyre’s other clients. He explains that Mr UI-Haq wanted to develop a sales distribution channel for international trade, particularly to Pakistan, for all of Mr Eyre’s products, including Male Angel and Detox Angel. Following discussions, Mr Eyre decided not to proceed and, in fact, decided no longer to use Mr UI-Haq as he

had made errors and could not meet certain health and safety requirements and ISO standards. Mr Eyre mentions that “at this time” (it is not clear when), SSL had been purchased by Reckitt Benckiser (“RB”).

15. Mr Eyre states that he used other companies for fulfilment, including from February 2010, a company called Redrose Manufacturing Limited (“Redrose”). I note from the Trade Mark Register that a company of this name is recorded as a licensee of the contested trade mark registration. Mr Eyre states that Redrose assisted with order fulfilment to RB until May 2012. Mr Eyre states that, in March 2012, he discovered that Redrose was breaching their agreement by invoicing under its own name to RB, hiding supply information and money owed. The fulfilment agreement was terminated on 17 May 2012. Mr Eyre states that he has discovered that Redrose has continued to supply to third parties, including RB’s franchisees, since the agreement was terminated.

16. Mr Eyre states:

“15. Redrose were registered as a licensee of the registration in suit after the termination of the agreement, despite having full knowledge that the trade mark was my property.

16. Redrose subsequently threatened both myself and RB with infringement and passing off actions, based on this license.

17. At this time, Redrose included in their threats another company of which I am a director, Firstly Natural Limited. I instructed investigations into Redrose which involved a test purchase of Male Angel product. There is now produced and shown to me marked NE6 a copy of the investigation report together with a cop of the product purchased by the investigator. This product was purchased from Redrose but as can clearly be seen on the packaging shows that the producer of the product is Firstly Natural Limited, my company. It is therefore the case that Redrose have threatened to take action based upon the trade mark which is the subject of the registration, against a company whose name appears on the product, provided allegedly by Redrose under the terms of the recorded license.

...

19....The action of recording Redrose as a licensee, and then Redrose using this to attack ourselves and RB once they had also been fired by myself, suggests that this was a deliberate attempt by Anwar Ul-haq and Redrose to hijack my mark, once their services were no longer required by myself.”

17. Mr Eyre believes an error was made by Redrose when it copied the packaging which had previously been under agreement; the error was not changing any element of the packaging, including the name Firstly Natural Limited, before it threatened action.

18. The ‘investigation report’ is a series of emails from Tim Dabin of Priaux Associates, to Steve Wain, of Murgitroyd & Company, the applicant’s trade mark

attorney. The emails refer to trap orders of Male Angel and a sample is enclosed, showing the mark MALE ANGEL. The box and its contents say "Firstly Natural Ltd" and www.angelglobal.com.

## Decision

### Section 3(6)

19. The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C-529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade



mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."



20. As stated by Arnold J at paragraph 131, the position is to be judged as of the date on which the application for registration was made; that is, on 30 August 2006. The application was made by Anwar Ul-Haq. Consequently, Mr Eyre's evidence, which has not been challenged, is relevant in so far as it relates to dealings with Mr Ul-Haq, particularly prior to 30 August 2006.

21. In *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*,<sup>2</sup> Arnold J. stated that:

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

22. Zahida Ul-Haq has filed no evidence going to the bad faith claim. Consequently, if the applicant has established a *prima facie* case of bad faith, its section 3(6) ground will succeed because Mrs Ul-Haq has not answered it<sup>3</sup>. Bad faith is a serious allegation and must be pleaded fully and clearly. The applicant set out its case, which was denied in the counterstatement. The counterstatement declared an intention to file evidence to prove the collaboration, evidence which did not materialise. The applicant's evidence goes to the claims it made in its application for a declaration of invalidity. I am mindful of the fact that the applicant's evidence does not include any single 'killer' piece of evidence. There are no copies of any agreements. However, what the evidence does show is:

- Mr Eyre/the applicant's predecessor in title was in the process of preparing to market and sell MALE ANGEL supplements from 2004, as evidenced by contact with the Food Standards Agency, the brochures and the website statistics;
- The first order fulfilment was made in January 2005;

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<sup>2</sup> [2009] RPC 9 (HC) and approved by the COA in [2010] RPC 16.

<sup>3</sup> As per *Ferrero SpA's Trade Marks* [2004] RPC 29.

- The manufacturers of DUREX condoms were sufficiently interested in the product to place at least one order, fulfilled in January 2006;
- The collective picture from the emails in NE4 is that Mr UI-Haq had been commissioned by Mr Eyre to organise, at least, packaging for the product;
- The box shows the licensee and licensor names and has an expiry date of 30.11.2007. This is consistent with the dates Mr Eyre gives as showing that the business was up and running before 2007 and that his business, the Angel group, as represented in the emails as theangelgroup, was the licensor.

23. It does not strike me that this is a case of the sort envisaged in *Cipriani*. There is no evidence that the applicant, Mr UI-Haq, considered himself to have had a superior right as of 30 August 2006 to registration and use of the mark. Mr Eyre's evidence is that the collaboration between his company and Mr UI-Haq began in 2005, when the business was in its infancy and Mr UI-Haq's role was packaging and order fulfilment. The first order fulfilment involving Mr UI-Haq was carried out in October 2005. SSL/RB's first order was placed on 4 January 2006. By Mrs UI-Haq's own admission in the counterstatement, the collaboration between the applicant's predecessor/Mr Eyre did not end until 2008. The trade mark application was filed two years before this, during the collaboration. Regardless of whether trade in MALE ANGEL developed successfully or not (as to which, see my conclusion on the section 5(4)(a) ground below), the unchallenged evidence is that Mr UI-Haq had been engaged by the applicant's predecessor in title (and Mr Eyre all along) to assist with packaging and getting orders out. It was not Mr UI-Haq's business. It was Mr Eyre's. Applying for the trade mark would give Mr UI-Haq a right to prevent Mr Eyre/the applicant/the applicant's predecessors in title from using MALE ANGEL without Mr UI-Haq's/the registered proprietor's consent in the course of trade in the UK in relation to the goods at issue.

24. Approaching the matter as an overall assessment of the unchallenged evidence, I consider that the applicant has established a *prima facie* case, which Zahida UI-Haq has not answered. The application by Anwar UI-Haq to register the trade mark was unacceptable commercial behaviour, as observed by reasonable and experienced men in the field, considering what he knew about the matters in question. It was an application made in bad faith. **The ground under section 3(6) of the Act succeeds.**

#### **Section 5(4)(a)**

25. The requirements to succeed in a passing off action are well established and are summarised in *Halsbury's Laws of England* 4th Ed. as being that:

- i) the claimant's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant's goods or services are those of the claimant; and

iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant's misrepresentation.

26. The date of application for the trade mark (in this case, 30 August 2006) is the relevant date<sup>4</sup>.

27. The applicant must first prove that it has goodwill in the sign relied upon, in relation to the goods (nutritional supplements) it lists in its application for a declaration of invalidity, in the mind of the purchasing public. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margerine Ltd* [1901] AC 217 at 223:

"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."

28. Whether the applicant has the requisite goodwill has to be deduced from the evidence which it has filed. In *Reef Trade Mark* [2002] RPC 19, Pumfrey J said:

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

and

"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."

29. In *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), Floyd J, building upon Pumfrey J's observations, said:

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<sup>4</sup> See the comments of Mr Daniel Alexander QC, sitting as the Appointed Person in *MULTISYS* BL O/410/11.

“8 Those 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.”

30. As the authorities show, there is no magic evidential formula by which goodwill is established. A small amount of goodwill, as long as it is not trivial, can be evidence of an attractive force which brings in custom<sup>5</sup>. The applicant has not shown any evidence relating to turnover, promotion, invoicing, customers, and no details, apart from a couple of months of web statistics early in 2005, of any external activity relating to the sign MALE ANGEL. It is not possible to say, putting together all the items in the evidence, that a picture emerges of an attractive force which brings in custom. The applicant has not established that, at the relevant date of 30 August 2006, it had a protectable goodwill in relation to the sign upon which it relies and the goods in which it claims the sign has been used. Consequently, the ground of invalidation under section 5(4)(a) of the Act is dismissed.

### **Invalidation**

31. Section 47(1) of the Act states:

“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.

32. As per my findings earlier in this decision, the trade mark was registered in contravention of section 3(6) of the Act. Consequently, it is invalid.

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<sup>5</sup> A trivial goodwill will not accrue protection (*Hart v Relentless Records* [2002] EWHC 1984), however a small goodwill can give rise to protection (*Stannard v Reay* [1967] FSR 140 and *Teleworks v Telework Group* [2002] RPC 27).

## Outcome

33. The applicant has been successful under its section 3(6) ground. The trade mark registration is invalid. Under section 47(6)<sup>6</sup> of the Act, the registration of the trade mark is deemed never to have been made.

## Costs

34. The applicant has been successful and is entitled to a contribution towards its costs. The Registrar usually operates on the basis of a published scale of costs<sup>7</sup>. The Registrar will award costs above the scale to deal proportionately with unreasonable behaviour. The applicant has submitted that the applicant should receive costs outside of the normal scale because the application was filed in bad faith; because of the infringement threats made to Mr Eyre and the attempt to hijack his mark and his business; and because the filing of a defence but no evidence was an attempt to delay matters. The Registrar cannot award costs in relation to infringement threats and related matters. The costs regime does not differentiate between grounds as meriting awards of a greater or lesser amount, so there can be no particular award made for a successful bad faith ground simply on the basis that the trade mark was applied for in bad faith. Tribunal Practice Notice 4/2007 observes that “just because a party has lost, this in itself is not indicative of unreasonable behaviour.”

35. Scale costs are appropriate in this case, as follows:

Preparing a statement and considering the counterstatement	£300
Application fee	£200
Preparing evidence	£500
Written submissions in lieu of a hearing	£300
<b>Total</b>	<b>£1300</b>

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<sup>6</sup> “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.”

<sup>7</sup> Tribunal Practice Notice 4/2007.

36. I order Zahida UI-Haq to pay Angel Arrigo (UK) Limited the sum of £1300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16th day of April 2014**

**Judi Pike  
For the Registrar,  
the Comptroller-General**