

O-882-22

**TRADE MARKS ACT 1994
(AS AMENDED)**

IN THE MATTER OF:

UK TRADE MARK REGISTRATION NO. 3524029:



FOR SERVICES IN CLASS 41

IN THE NAME OF MICHAEL JEYASEGARAN ARNOLD

AND

CANCELLATION APPLICATION No. CA503730

BY FRIENDS OF MANIPAY HOSPITAL

FOR A DECLARATION OF INVALIDITY OF THE ABOVE

BACKGROUND AND PLEADINGS

1. Michael Jeyasegaran Arnold (“**MJA**”) is the registered proprietor of the following UK trade mark registration (“**the Contested Registration**”):



Class 41: *Services for the organisation of sports events; Sporting event organization; Sports activities; Cultural and sporting activities.*

Filing date: 18th August 2020

Registration date: 11th December 2020

2. On 19 March 2021, the UK registered charity known as Friends of Manipay Hospital (“**FOMH**”) filed an application under the provisions of section 47 of the Trade Marks Act 1994 (“**the Act**”) requesting that the Contested Registration be declared invalid. The cancellation application is based on the following three grounds under the Act:
 - (i) **Section 5(4)(a)** - FOMH claims an earlier right founded on goodwill resulting from its use throughout the UK since 2018 of an identical sign in relation to charity events for the benefit of Green Memorial Hospital in Manipay, Sri Lanka. FOMH claims that use of the Contested Registration would amount to passing off.
 - (ii) **Section 5(6)** - FOMH claims that when MJA applied for the Contested Registration in his own name, he was an agent or representative of the proprietor of a trade mark who did not consent to that action, and which has no justification.

(iii) **Section 3(6)** - FOMH claims that MJA was acting in bad faith in applying for the Contested Registration.

3. FOMH claims to own a previously registered trade mark in Sri Lanka for the same sign, which in recent years has been used in raising money through cycling events in Sri Lanka. The section 5(6) and 3(6) claims involve allegations around whether MJA, having worked alongside the charity, acted objectionably in applying for the mark in the UK in his own name, without the knowledge or consent of FOMH, knowing the identical sign was in active use by the charity, to which, as a committee member, he owed a duty of care. It is also claimed that MJA planned to use the trade mark as part of a commercial travel and tourism package rather than for charitable purposes.
4. Further details of the claims are set out later in this decision and considered alongside the parties' evidence and submissions as to the differing versions of events preceding MJA's filing for the Contested Registration.

Defence and counterstatement

5. MJA defends the Contested Registration and filed a 20-page counterstatement that denies each of the grounds claimed and which sets out his version of events as to why the Contested Registration is valid. In summary, MJA states that he applied for the Contested Registration because it was he who came up with the idea of Ride 4 Ceylon and that he has always been its sole owner and required no consent for his application. MJA claims that he has never been a trustee of FOMH and that FOMH is just one of the projects that benefits from Ride 4 Ceylon. He denies that he had a fiduciary duty to FOMH. He also states that FOMH does not own the Sri Lankan trade mark, nor is it registered in the name of FOMH (or any of its trustees). MJA claims that he has legal rights in respect of that registration. MJA states that FOMH (along with a mutual friend, namely, David Rasiah) are abusing the goodwill under the sign that belongs to MJA.

Papers filed and representation

6. Legal & Commercial Consultants are the attorneys acting for MJA; Silk Route Legal are the attorneys for FOMH. Neither party requested an oral hearing. Both parties filed extensive evidence and submissions, as I outline below. I have read all of the papers filed and I refer to their content as warranted for the purposes of determining the claims in these proceedings.

Submissions and evidence in chief on behalf of FOMH (the cancellation applicant)¹

Written submissions (as minorly amended during evidence rounds). The exhibit numbers (1 – 14) below as those as referenced in the submissions in chief.

Witness statements of:

- (i) Sritharan Karunanithy (24 August 2021) (Exhibit 1)
- (ii) Shini Mahendran (24 August 2021) (Exhibit 2)
- (iii) Frank Veddamanikkam (25 August 2021) (Exhibit 3)
- (iv) Nishantha Abeywardena (“**NA**”) (25 August 2021) (Exhibit 4)
- (v) Manjula Anjali Rasiah (“**MR**”) (24 August 2021) (Exhibit 5)
- (vi) Jayantha Arnold (“**JA**”) with Exhibits JA1 – JA6 (23 September 2021) (Exhibit 6)
- (vii) Sharvanandan Arnold (“**SA**”) with Exhibits SA1 – SA44 (23 September 2021) (Exhibit 7)
- (viii) Raj David (“**RD**”) (25 August 2021) (Exhibit 8)
- (ix) David Suresh Rasiah (“**DR**”) with Exhibit DR1 (23 September 2021) (Exhibit 9)
- (x) Pradeep Kumar (24 August 2021) (Exhibit 10)
- (xi) Reza Ghiasudeen (25 August 2021) (Exhibit 12)
- (xii) Stanmore Anandarajah (25 August 2021) (Exhibit 13)
- (xiii) Sharmila Meadows (25 August 2021) (Exhibit 14)

Evidence and submissions in chief on behalf of MJA (the proprietor)

- (i) Witness statement of Michael Arnold (“**MJA**”) (the Proprietor), (1st November 2021) with Exhibits MA1 – 30, responding to the submissions and evidence in chief, and including contributions from the following:
- (ii) Gerald Simon (“**GS**”) (Exhibit 1) with Exhibits GS-01 – GS-10 (1st November 2021)
- (iii) Walter De Kretser (“**WDK**”) (1st October 2021) (Exhibit 2)
- (iv) Indaka Nanayakkara (not a formal witness statement) (Exhibit 5)
- (v) Dr Lily Easterine Devaranjini Mills-Clarke (23 October 2021) (Exhibit 8)
- (vi) Nishan Wickramaratna (“**NW**”) (Exhibit 14) (statement by email to MJA 13 October 2021)
- (vii) Rev. Fr Roshan Mahesan (6 January 2022) (Exhibit 26)

1 An amended bundle was filed on 21 October 2021.

(viii) Mahesh Mannapperuma (6 January 2022) (Exhibit 29)

(ix) Chevy Green (letter dated February 2021) (Exhibit 30)

Evidence in reply on behalf of the Cancellation Applicant

(i) Witness statement Sharvanandan Arnold (20th May 2022), with Exhibits SHA1 – SHA7.

Submissions in lieu of a hearing filed on behalf of the proprietor

These submissions were cast in the form of a witness statement by MJA (6 July 2022)

My approach in this decision

7. At various points in the statements and submissions from MJA, it is stated that it is not for MJA to prove his entitlement as registered proprietor. I note in this regard that section 72 of the Act makes clear that “the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration”.
8. The onus of course lies with FOMH, as the cancellation applicant, to satisfy this tribunal that there is a basis in law to invalidate the Contested Registration that stands in the name of MJA. It is for FOMH to present evidence of facts that support the necessary components of the three grounds relied on. While the onus is on FOMH to make out its prima facie case, this will necessarily entail considering, where appropriate, the strength of any contradictory evidence of the account and position put forward by MJA in his denial of the claims.
9. The three grounds under sections 5(4)(a), 5(6) and 3(6) of the Act are formally different and require distinct consideration of their particular components and relevant caselaw principles. However, there is also a strong degree of overlap in the factual framework against which the grounds claimed in these proceedings are to be decided. I therefore consider it useful to begin with an account of salient points from the hundreds of pages of evidence filed. I will then deal with each of the grounds in light of the applicable legislative provisions and caselaw principles and in view of the evidential points noted.

EVIDENCE NARRATIVE

10. The evidence in these proceedings features numerous individuals who in varying degrees have played a role in a cycle ride first held in 2017, then repeated in 2018 and with subsequent rides in 2019 and 2020. (The restrictions arising from the coronavirus pandemic meant the planned July 2021 ride was unable to proceed.) The cycle ride involves limited numbers of riders cycling a distance of over 400 km over several days, travelling from the capital city Colombo to the city of Jaffna at the Northern tip of Sri Lanka. The event has each year raised charitable donations in aid of the non-profit hospital Green Memorial Hospital in the town of Manipay (near Jaffna).

The idea for the ride and its initial name

11. There seems no dispute that it was MJA who, in 2016, put forward the idea of fundraising through a bike ride in Sri Lanka, which he worked up with two of his friends, namely Gerald Simon (“**GS**”) and Walter De Kretser (“**WDK**”). All three live in the UK, and are former classmates from school days in Sri Lanka. The first ride (in early 2017) coincided with a school reunion and 50th birthdays.
12. MJA told GS and WDK about his cousins - Sharvanandan Arnold (“**SA**”)² and his brother Jayantha Arnold (“**JA**”)³, both also based in the UK and who are trustees of FOMH, which has been registered as a UK charity since 27 March 2006.⁴ Professor JA is a consultant gastroenterologist at Ealing Hospital. He states that Ealing Hospital has longstanding links with FOMH (including in the form of charitable provision of services by consultants). He also states that FOMH has raised over £200k for the benefit of Green Memorial Hospital in Manipay, Sri Lanka through various fundraising events, including dinner dances in London (though these are not claimed to be under the contested sign Ride for Ceylon).
13. Though GS and WDK were previously unaware of the work of FOMH, all agreed it to be a good cause for the charity ride. It was MJA, GS and WDK who were named on the Virgin Money giving site as ‘fundraisers’ for the 2017 ride, and they were the principal

2 Sometimes SA is referred to in the evidence in shortened version as Anandan.

3 See for instance witness statements of Gerald Simon and Walter de Kretser.

4 See page 1 of Reply Witness Statement of Sharvanandan Arnold

three riders.⁵ MJA, GS and WDK took various organisational and promotional roles in the ride. The claim in the statement of grounds that the 2017 ride was additionally organised “*under the governance of*” FOMH is disputed. What can be said with certainty is that ahead of the 2017 ride there was some significant involvement on the part of SA and JA. GS gives evidence that “*he dealt with SA and his wife Meera but that JA, though aware of the project was not directly involved at the outset*” and that GS only met JA in person around June/July 2017.

14. It is worth emphasising at this juncture that in 2017, the fundraising ride by the four or so participating cyclists styled itself simply “Riders for Charity”. At various points of the evidence there are references (by witnesses on both sides) to “R4C”. On its surface this may serve equally as an abbreviation for “Riders for Charity” or for “Ride for Ceylon”; often the intended significance of the R4C reference is made clear by the evidence, but sometimes there is an ambiguity and a blurring of the distinction between those names. For the purposes of this decision, use of the sign “Riders for Charity” (or occasionally “Ride for Charity”) has no direct relevance, since it is clearly not the contested sign. I mention the use of the “Riders for Charity” sign in this narrative account only as part of the genesis of the charitable activity that features centrally in the evidence.
15. There is good evidence that the 2017 cycle ride was to raise funds for FOMH. **Exhibit JA1** shows an email from GS, dated 17 January 2017, which is shared with MJA, SA and JA, and which includes the following promotional content, drafted by GS, clearly connecting the ride with FOMH:

Sponsorship - Team RideForCharity

On the 1st of March 2017, in celebration of their fiftieth year, a group of 4 ex-classmates are getting on their bikes and riding 400 kilometres from Colombo to Jaffna to raise money for a small rural not-for-profit hospital on the Jaffna peninsula in Sri Lanka.

Calling themselves - Team RideForCharity - they are raising funds for the ‘Friends of Manipay’ -- a [UK registered charity](#) for the refurbishment and restoration of the Green Memorial Hospital in Manipay.

5 GS states that SA joined the 2017 ride at its final stage.

16. Likewise, **Exhibit SA1**, of the cancellation applicant's evidence shows promotional information for the 2017 ride and emphasises that "*every penny of your donations will go directly to*" the UK registered charity Friends of Manipay Hospital, and includes the UK bank account details for bank transfers as an alternative to the Virgin Giving route.⁶ **Exhibit SA2** shows sponsorship solicitation material that again emphasises the purpose of the 2018 bike ride, which states that "*it is through FoMH that we – Riders for Charity – directly support the hospital*". Contact details for Riders for Charity are given, including an address in Chandos Avenue, London, and a website www.ridersforcharity.com. (I note that the address corresponds with the address for MJA exhibited on the Sri Lankan trade mark Sri Lankan trade mark at **Exhibit SA18**, indicating that MJA was a point of contact for the initial rides.)
17. **Exhibit SA3** is a letter dated 6 February 2018, from Sriomal de Silva (SDS), on behalf of Riders for Charity, to Ceylon Biscuits Ltd at an address in Sri Lanka. That letter from SDS explains that "*the cycle ride is in its 2nd year and the project is being organised and administered by Friends of Manipay Hospital, a UK registered charity.*" That letter again refers to the Fundraising page and gives bank account details for the Institute of Medical Sciences Trust (**IMS**) in Sri Lanka. IMS is another not-for-profit vehicle in which JA is closely involved and which serves the needs of Green Memorial Hospital.⁷ It is also clear that as early as 16 January 2017, JA was a point of liaison with a journalist at London BBC TV news, where the subject of the exchanged emails was "Manipay Hospital Sri Lanka – charity". SA is part of that correspondence, which includes a focus on the RideforCharity as the charity's "*main campaign in 2017.*"⁸ The same exhibit shows GS, drafting a reply to the same journalist, copied to WDK, MJA and SA, where GS refers to "*the good works we do at Friends of Manipay Charity*" (my underlining).
18. WDK states that "the main sponsors" of 2017 ride were his sister who owns a small hotel in Sri Lanka, his ex-wife and one of his business clients, totalling £2k.⁹ Both SA and JA state that they personally sponsored some of the travel costs and helped to obtain commercial sponsorship for ancillary support. (JA states the offer of £400 towards the

6 at page 42.

7 See paragraph 47 of the Witness Statement of MJA and its Exhibit 13. See too page 18 of Exhibit SHA6.

8 Exhibit SHA3 to the further evidence of fact filed in reply on 20 May 2022.

9 At paragraph 14.

airfare of MJA was made in the presence of family witnesses.) **Exhibits SHA1 and SHA2** to the further evidence of fact filed in reply on 20 May 2022 show HSBC payments made on 27 February 2017, from account name “FOMH”, with the reference “Bicycle Challenge”, where the beneficiaries are GS (£375) and WDK (£975).

19. SA states that funds raised by the sponsorship were placed directly into the UK HSBC bank account of FOMH.¹⁰ MJA states that FOMH acted in a supporting role and raised funds through personal friends and contacts and were not involved in the public fund-raising under the Riders for Charity name.¹¹
20. In view of the success of the 2017 ride (which is said to have raised around £12,500), it was repeated in early March 2018, raising a further £43k for Manipay Hospital. GS acknowledges that on 25 January 2018, SA transferred £875 of sponsorship funds from BBK, the accountancy firm for whom SA works.
21. After the 2018 ride (the second ride), which GS and WDK considered to have been “hijacked” by SA, there was a parting of ways, where GS and WDK decided that “Riders for Charity” should have no further association with the FOMH charity.

Renaming of the ride

22. Among the 20 or so riders who participated in the 2018 ride (when the ride was under the name “Riders for Charity”) were two other of MJA’s friends from schooldays: David Rasiah (DR) and Indaka Nanayakkara. DR is a banker who lives in the UK. His young daughter passed away in July 2017 and MJA invited DR to join the 2018 charity ride. Following the split with GS and WDK (and “Riders for Charity”), MJA asked DR to join him to continue the work for the Green Memorial Hospital and the trustees agreed to the renovation of one of its blocks in memory of DR’s daughter, Gabriella.
23. Manjula Rasiah (“MR”) is the wife of DR. In her witness statement she expresses her sincere appreciation of the kindness shown by MJA following her bereavement. She states MJA informed her that his family were involved in a project called FOMH which charity’s aim was to redevelop the Green Memorial Hospital, with funds to be raised

10 At paragraph 9 of his witness statement.

11 At paragraph 7 of his witness statement.

through an annual bike ride. When FOMH needed a name for the cycling element of the fundraising branch, it was MR who “suggested *RIDE FOR CEYLON*, since the aim was to renovate and regenerate the hospital for the benefit of the whole island.” MR states that “the brand name was never Michael’s creation and though, I came up with the idea, it was solely for the purpose and benefit of this particular cause and charity which accepted the same and set up the brand.”

24. MJA in his evidence in chief makes no denial of MR’s claim to have put forward the name “Ride for Ceylon”. At no stage does MJA distinctly claim that it was he who recast the name as Ride for Ceylon. Instead, at the point of final submissions (after closure of the evidence rounds), MJA states (in his submissions, which are framed as a witness statement) that “the name *Ride4Ceylon* came into being through consultation by the committee and all involved. It was not one person that came up with the name or logo. Manjula Rasiah, who is DR’s wife, was never involved and she will need to be consulted under oath to prove their claim.”¹² I note of course that MR provided her evidence in the form of a witness statement, signed and dated and a statement of her belief that the facts stated in her witness statement are true and understanding that proceedings for contempt of court may be brought against anyone who makes, or causes to be made, a false statement in a document verified by a statement of truth without an honest belief in its truth. MJA made no application to cross-examine MR.

The logo for the new name

25. FOMH claims in its statement of grounds that DR, having been one of the few riders in the 2018 cycle riding event, took a lead role in designing a logo for this brand, “Ride 4 Ceylon”. The task of designing by the logo was achieved through the input of DR’s friend Raj David (“RD”) and his son Dillon. RD, who lives in Sri Lanka, states in his witness statement that in 2018 he was asked “by ‘Ride for Ceylon’ to help them design a logo for the charity.” RD states that “we offered our services free of charge because we knew that ‘Ride for Ceylon’ was an arm of the charity ‘Friends of Manipay Hospital’” and that “during the process we were in frequent contact with the committee members of the charity so as to finalise the logo. It was the Charity and us working together that led to the conceptualisation of the logo in 2018”.

¹² At paragraph 22. See too paragraph 20 where MJA states that he “commissioned the logo for the volunteer group of which DR was a member of the committee.”

26. In his counterstatement, MJA “strongly denies” the cancellation applicant’s claim in its statement of grounds that it “*came up with "Ride 4 Ceylon" as a new brand for the continuation of the annual cycle challenge following the split with Riders for Charity.*” MJA states that “*the original logo design was obtained through an online search by MA and DR, who then created a brief of the changes they wanted*” and characterises the involvement of RD/RD’s son as adapting the logo design to a brief issued by MA and DR. Paragraph 5 of the submissions in chief from FOMH challenged MJA “*to prove his claim that the brand name was his brainchild and the logo was found from an online search with his assistance.*” MJA responds to that challenge at paragraph 25 of his witness statement by saying it is for the cancellation applicant to prove their claim, and that it is wrong for the cancellation applicant to ask MJA to prove what he claims in his counterstatement.
27. I note that **Exhibit SA9** shows JA, SA, DR and MR in email discussion dated 28 June 2018 about banners to be used at the hospital. One of those emails from DR to JA is shown to have been copied at that time to MJA (as well as to MR and SA) and reads: “*My wife has done a banner for the interim ward. However, we have a budding professional young artist lined up to do the proper one for the Sellamuttu ward. This young man has designed the ride4ceylon logo as well.*” **Exhibits SA10** and **SA11** show emails dated June 2018 with the subject “R4C LOGO” from Dillon David to DR.

The website for the new name

28. DR states that after the second ride he took a significant interest on the organisational side, partly as distraction after his daughter’s death. The name Ride for Ceylon is shown to have been agreed by 22 March 2018, since Exhibit JA2 shows email correspondence of that date between DR and the trustees JA and SA (though MJA is not part of that correspondence). That correspondence shows the planning for the third cycle ride that began in 2019 and where the two trustees and DR agree that the ride should continue annually and be for the exclusive benefit of the hospital under the ride4ceylon banner. DR offered in his March 2018 email to register the ride4ceylon domain and JA agrees that DR should register the domain “*as it would secure it for the Hospital.*” JA adds that “*FOMH will pay for all fundraising expenses, with documentation for Charity Commission inspection if ever needed.*” **Exhibit SHA5** is an email dated 27th April 2018 from DR to

JA, SA and MJA confirming that *“the “ride4ceylon” domain has been registered and we are set to go.”*

29. **Exhibit SA13** shows a receipt dated 27 April 2018 from the Internet domain registrar and web hosting company GoDaddy, which is addressed to DR and shows payment for the two-year registration of the ride4ceylon.com domain. The evidence on behalf of FOMH includes the witness statement of Pradeep Kumar, who is based in the UK and who states that he developed and maintained the website for the 2019 – 2021 annual rides.¹³ He states that he took no payment for this work as it was his contribution to the FOMH charity, which administers the Ride for Ceylon. He states *“I agreed to develop the site on the basis that the ride was backed by a registered charity, thereby guaranteeing accountability as it was important to me that all donated funds were administered with integrity. Therefore, it was the charity that was associated with the logo from the very beginning.”*

Ride for Ceylon Committee

30. **Exhibit SA10** includes email exchanges from 22 March 2018 between DR and JA, including reference to DR's additional WhatsApp discussion with SA that day. That exhibit shows the close involvement of those two trustees of FOMH in organising and taking forward the cycle ride under new branding, directly after the second ride. I note that among the 15 or so organisational points raised in DR's email of 22 March 2018, is the suggestion for an organising committee to comprise of 3 members from the UK and 2 from Sri Lanka.
31. In his counterstatement MJA claims that he *“was the only person till early 2018 involved with R4C and had asked DR to join for the purpose of communications and IT handling as MA's proficiency in these domains was very basic. Later, a committee was formed which included initially MJA, DR, Nishan Wickramaratna [NW] and [SDS]. Another member Kalyana Kumar joined after the 2019 ride event.”*
32. Also in his counterstatement MJA states that his *“only relation .. with FomH apart from the fact that SA and JA are his cousins was with the formation of a subcommittee.”* In his witness statement evidence he then takes issue with the word “subcommittee” (the word

13 Exhibit 10

he had used in his counterstatement) and states (at paragraph 43) that “*Ride4Ceylon only ever had a committee and never any sub-committee ... which functioned/communicated via a WhatsApp group.*” MJA states that “*DR took it upon himself to add both SA and JA to the committee group*”. A further member of the committee is Nishantha Abeywardena (NA). NA states that he was assigned by the committee (comprising MJA, DR, NW and SDS) to be the 'Chief Organiser' of the 2019 ride.”¹⁴ MJA submits in his witness statement that NA was “*not assigned by the committee but rather by DR, and that he was not ‘Chief Organiser’ as claimed but rather ‘Ride Coordinator’ as is evidenced in Exhibit-12.*” Exhibit 12, filed by MJA, appears to be a screenshot extract from the Ride for Ceylon website (showing a copyright date of 2019, attributed to DR) where NA is pictured as part of the R4C Committee. The screenshot includes the contested logo and the words RIDE FOR CEYLON - IN AID OF GREEN MEMORIAL HOSPITAL, MANIPAY, JAFFNA. The extracted page focuses on the Committee, and states “*R4C would not be possible with the great work of committed individuals, organisations and volunteers.*”

33. I also note that **Exhibit SA44** is a letter to Silk Route Legal (attorneys for FOMH) sent by email on 8 February 2021 by MJA. At Point 7 of that letter MJA appears to acknowledge that he is a committee member of FOMH, but denies any fiduciary duty.

Role of FOMH and use of the contested sign in the rides in 2019 and 2020

34. The 2019 and 2020 rides, under the name Ride 4 Ceylon and contested logo, were increasingly successful as fundraising events for FOMH. The cancellation applicant’s statement of grounds states that 25 riders took part in the 2019 event, raising £65k and in 2020 where 50 riders took part to raise £102k for the hospital. This is not denied by MJA.
35. It is clear that JA and MA (trustees of FOMH) played important roles in those 2019 and 2020 rides. JA states that not only did he personally participate in the 2020 ride, but gave the welcome speech when riders reached Green Memorial Hospital, completing their ride.¹⁵ At paragraph 23 of his witness statement JA states that he also gave the main speech at the pre-ride launch event in Colombo and press conference attended by

14 In his witness statement at Exhibit 4.

15 At paragraph 20 of witness statement.

several Sri Lankan journalists. He states that the contested logo was on the screen and materials that were distributed to the riders and that his speech specifically mentioned that the FOMH trustees were particularly grateful to the leading to volunteers, MJA and DR, who had been the dynamos in the R4C committee and were generating considerable funds and awareness of FOMH.

36. **Exhibit SA5** is a letter dated 2nd May 2018, from DR, on behalf of ride4ceylon, to another business at an address in Sri Lanka, seeking donations. That letter highlights the cycle ride upcoming in February 2019 in which DR is to participate, and as with the earlier letter from SDS, states that *“the project is being organised and administered by Friends of Manipay Hospital, a UK registered charity.”* The letter contains the footer “Friends of Manipay Hospital” with an address in the UK and its charity and company numbers.
37. The statement by NW is not presented as a witness statement, merely as an email to MJA. None of the committee members state that the contested brand was owned by MJA individually, notwithstanding that he was instrumental in the genesis of the ride. NW acknowledges the involvement of the trustees “of Green Memorial Hospital” in the committee from around 2018. He states that he joined the committee in support of Green Memorial Hospital as a good cause. **Exhibit SHA4** shows a communication from DR to NW dated 14 September 2018, which SA states (at paragraph 45 of his further evidence in reply) is a sample letterhead for committee members to use. The letter lists the Ride for Ceylon Committee as: NW, SDS, MJA and DR; features the ride4ceylon name and website at the top right; its footer reads “Friend of Manipay Hospital” and gives its charity and company name contact details. This aligns with the content of Exhibit SA5 and again expressly states that *“the project is being organised and administered by Friends of Manipay Hospital, a UK registered charity.”*
38. I will come on later in this decision to give particular consideration to the role of DR in promoting the mark and what he says in his evidence in contrast to his role and status attributed to him in the statements of MJA.

Registration of the identical sign as a TM in Sri Lanka

39. **Exhibit SA18** shows an application on 12th February 2019 to the Sri Lankan trade mark registry for the identical *Contested Sign to be registered for services in Class 41:*

Education, providing of training; entertainment; sporting and cultural activities. The trade mark is applied for and stands registered in the names of DR and MJA. The registration was achieved through the services of a lawyer, Mohamed Adamaly. **Exhibit 20** to MJA's witness statement shows an email sent on 14 December 2018 "From" "Manipay Hospital <ride4ceylon@gmail.com>" to Mohamed Adamaly from DR. DR reminds Mr Adamaly that they had "*spoken about registering Ride for Ceylon as a trade mark and you kindly agreed to look into it. Can you please let me know what you need from us to proceed in the cost so that I can forward the cash. I have attached the logo as requested.*" In a later email reply (7 January 2019) to the attorney handling the matter, again where the email is "From" "Manipay Hospital <ride4ceylon@gmail.com>", I note that there is a Bcc to MJA. It also appears unchallenged that the attorney in Sri Lanka offered his services on a pro bono basis in view of the charitable purpose.

40. In his counterstatement, MJA claims that "*when the lawyer sent a questionnaire to DR, he had forwarded it to both FoMH trustees (SA and JA) and MA. DR spotted that the trustees had signed their names on the questionnaire as the owners of the logo and called MA to inform him about this. Both MA and DR had objected to this because the logo did not belong to FoMH, so questioned why the trustees signed it in their names. Therefore, DR removed their names and replaced it with his own and MA's names and sent it on to the lawyer.*" He states that he has evidence to this claim. I shall address this point later in this decision.

UK correspondence - Oman Air and Waterloo Foundation

41. **Exhibit SA23** is a letter dated 15 January 2020 written in the name of MJA and addressed to the Country Manager for Oman Air (London) seeking a waiver of charges for 3 of those carrying bikes to SL, where the letter again states that the project is being organised and administered by Friends of Manipay Hospital, a UK registered charity (details given). MJA's letter requests the Country Manager "support for a charity project that we are involved in to benefit the Green Memorial Hospital, in Jaffna, Sri Lanka." The letter lists eight committee members at that date. The same exhibit includes the email that sent the letter to the named Oman Air contact. That email is shown as "From" "Manipay Hospital <ride4ceylon@gmail.com>", with Cc to MJA's personal email address.

42. **Exhibit SA24** shows a letter from DR, dated 22 February 2019, addressed to the Trustee Fund Manager, at The Waterloo Foundation in Cardiff. The letter thanks The Waterloo Foundation for its payment of £2k as a donation towards the Green Memorial Hospital GMH. It features the ride4ceylon name, logo and website at the top right; its footer reads “Friends of Manipay Hospital” and gives its charity and company name contact details. It lists the Ride for Ceylon Committee as: NW, SDS, MJA, NA and DR. A fuller letter of thanks followed on 19th March 2019, again from DR. That letter too carries the Contested name, logo, and web address. It lists the Ride for Ceylon Committee as in the earlier letter, with the addition of Upekshi Perera. It also lists Dr JA and SA as FOMH Trustees.
43. MJA raised no objection to the draft annual report on the work of FOMH and Ride for Ceylon, from Sharmila Meadows (**Exhibit SA27**) which precedes his application and which was shared with him for comment. The content of Ms Meadows report aligns with the claims of FOMH. MJA states that the evidence of Sharmila Meadows is not relevant and notes that she is DR’s sister-in-law.¹⁶ SA responds that Ms Meadows was interviewed via Zoom for a role to help write documents on behalf of FOMH and Ride for Ceylon. Ms Meadow was interviewed not only by the trustees, but also MJA and DR and MJA approved her appointment.

Exclusive use for benefit of FOMH?

44. There is some (very limited) evidence of use of the sign, or reference to “Ride for Ceylon”, in relation to areas that stray beyond the pure focus on the Green Memorial Hospital; these other activities are in the cricketing field, where MJA appears well connected, and noting that his brother is a former Sri Lankan international test cricketer. However, the evidence is overwhelmingly focused on Green Memorial Hospital. For instance, **Exhibit SA30** shows an article from March 2019 in *Ceylon Today*, which shows a banner reading “A Big Thank You to the Lord’s Taverners for their kind donation” and on which banner the contested sign is also visible. The article is headlined “*Ride for Ceylon Campaign – Pedalling to revive Manipai Green Hospital – sports goods for 11 underprivileged schools*”. It reads “*The Ride for Ceylon Campaign, aimed at raising funds for the Manipai Green Hospital, concluded on Saturday week with the donating all free sports material and equipment to underprivileged schools*” ... “*a group of 43 pedal cyclists from the*

16 Paragraph 92 of MJA’s witness statement of 2nd December 2021.

United Kingdom, Australia, Canada, Romania and Sri Lanka hit the streets on a countrywide tour to raise funds and awareness on the Green Memorial Hospital Manipai. It refers to the “*Ride for Ceylon and Friends of Manipai Hospital*” launching the ride on 27 February and lasting four days. It identifies MJA as “*Co-Organiser of the campaign*” and David Rasiah as “*Co-Chief Organiser of the ride*”.

45. Another article shown in the exhibit, under the headline “*Ride 4 Ceylon Campaign – Raising funds for Green Memorial Hospital.*” That article makes no mention of MJA, but refers to the speech at the launch event by the Manipay Hospital trustees SA and JA and “*the untiring efforts of DR*”. There are other articles in similar vein. For instance, an article from The Sunday Times (a Sri Lankan publication) from March 2019 includes words from DR, who tells the paper “*Ride for Ceylon is the face of the charity “Friends of Manipay Hospital.”* It refers to the roots from GS, MJA and to “*the committee comprising NW, MJA, SDS and DR, supported by Dr JA and SA.*”

August 2020 discord within the R4C committee

46. **Exhibit SA 20** are minutes of a meeting called by SA at his home on 15th August 2020. Among those present at that meeting were SA, his wife Meera (who took notes of the meeting) and MJA (and his wife). The minutes are very thinly expressed and their significance of the points itemised is not easily discernible. Nonetheless, I note it contains the following references: “*FOMH trustees must not interfere with R4C*” and “*All communication between R4C and FOMH must go through MJA by email.*” The meeting appears to have convened in order to discuss the working relationship between the trustees and the committee, noting comments to the effect that MJA felt somewhat side-lined in the decision making of the committee.

CONSIDERATION OF THE GROUNDS

The section 5(4)(a) claim

47. Section 47 of the Act deals with invalidity. Section 47(2)(b) provides that registration of a trade mark may be declared invalid on the ground that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied.

48. Section 5(4)(a) of the Act provides that: “... a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented 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.
(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”
49. Section 5(4) also states that “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’.”
50. 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,¹⁷ namely (i) goodwill or reputation; (ii) misrepresentation leading to deception or a likelihood of deception; and (iii) damage resulting from the misrepresentation. In relation to deception, it must be determined whether “a substantial number” of a claimant’s customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived.¹⁸
51. The **essential elements** of a claim in passing off are set out in the speeches of Lord Diplock and Lord Fraser in *Erven Warnink B.V. v. J. Townend Sons (Hull) Ltd.* [1979] A.C. 731 (the *Advocaat* case) at 742 and 755. Lord Diplock required to be found:
“(1) a misrepresentation; (2) made by a trader in the course of trade; (3) to prospective customers of his or ultimate consumers of goods or services supplied by him; (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a *quia timet* action) will probably do so.”
52. These essentials were expressed slightly differently by Lord Fraser as follows:
“*It is essential for the plaintiff in a passing off action to show at least the following facts: (1) that his business consists of, or includes, selling in England a class of goods to which the particular trade name applies; (2) that the class of goods is clearly defined, and that*

17 Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, 11 [1990] RPC 341, HL

18 (*Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)

in the minds of the public, or a section of the public, in England, the trade name distinguishes that class from other similar goods: (3) that because of the reputation of the goods, there is goodwill attached to the name; (4) that he, the plaintiff, as a member of the class of those who sell the goods, is the owner of goodwill in England which is of substantial value; (5) that he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached.”

53. The above two statements of principle complement one another, Lord Diplock emphasising what has been done by the defendant to give rise to the complaint, and Lord Fraser what the plaintiff has to show as a prerequisite of complaining.
54. The **relevant date** for the purposes of determining whether or not a registered trade mark is validly registered is the date when the application was filed. In the present case the relevant date is **18th August 2020**.
55. However, where an applicant for a trade mark has used the mark before the date of the trade mark 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 trade mark application was made.¹⁹ In *Croom’s Trade Mark Application* [2005] RPC 2, Geoffrey Hobbs QC sitting as the Appointed Person set out the position as follows (references omitted):

“45. I understand the correct approach to be as follows. When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

- (a) the senior user prevails over the junior user;
- (b) the junior user cannot deny the senior user's rights;
- (c) the senior user can challenge the junior user unless and until it is inequitable for him to do so.

46. ... The principles themselves are, in my view, deducible from:

¹⁹ *SWORDERS TM* (O-212-06), per Allan James

- (a) the right to protection conferred upon senior users at common law ...;
- (b) the common law rule that the legitimacy of the junior user's use of the mark in issue must normally be determined as of the date of its inception ...; and
- (c) the potential for co-existence to be permitted in accordance with equitable principles ...

56. I shall return to consider the applicability of the above in relation to use of the Contested Registration before the relevant date. First though I shall consider the position of the claim based on passing off as at the relevant date.
57. It is clear that the Contested sign is identical to the ride4ceylon and logo sign on which FOMH relies for its section 5(4)(a) claim. It is also clear that there is at least a high degree of similarity between the services registered in Class 41 under the Contested Registration and the sporting event organisation associated with the charity rides in evidence. In those circumstances, the second element of the 'classical trinity' for passing off – misrepresentation is – are readily established. Likewise, the third element also follows since there is an obvious risk to the FOMH through substitution.
58. The challenges for FOMH in this case are around the first component of the trinity: whether FOMH has established that at the relevant date it had actionable goodwill in the UK, based on the sign relied on by FOMH. This raises at least the following two issues: (i) **Sufficiency of goodwill in the UK** – i.e. whether the sign had been used in such a way that it had given rise to goodwill associated with it to a sufficient degree that it would have been possible for a claimant to have brought an action in the UK in passing off to prevent a third party from using the sign in respect of the sports activities registered in Class 41; and (ii) **Ownership of any such goodwill** – it must be noted that Art. 5 of SI 2007/1976 provides that only “the proprietor of the earlier right” may make an application for a declaration of invalidity on the grounds in section 47(2) of the Act. Although I have highlighted those two issues separately, I nonetheless consider it convenient to deal with the issue of goodwill in the round, in light of what may be gleaned from the following case law principles.

59. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*²⁰ Lord Macnaghten observed as follows:

"What is goodwill? *It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name; reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."*

60. In *Hart v Relentless Records*,²¹ Jacob J. (as he then was) stated that: "*In my view the law of passing off does not protect a goodwill of trivial extent. one is looking for more than a minimal reputation.*" However, case law such as *Stannard v Reay*,²² and *Stacey v 2020 Communications Plc*²³ shows that even a modest goodwill may support an action for passing off. Just how modest such goodwill can be was tested in *Lumos Skincare Ltd v Sweet Squared Ltd*.²⁴ Lumos Skincare's share of the huge market for women's skincare products averaged about £2000 per quarter from the beginning of 2008 until September 2009, and then gradually rose to about £10,000 per quarter in September 2010. The claimant was selling about 100 bottles of its product a quarter, mainly to the trade, and the judge at first instance described it as "very modest use" and "very small in absolute terms" and "as a proportion of the skincare industry." Even so, the Court of Appeal was prepared to protect the goodwill in that business under the law of passing off.

61. The Starbucks case²⁵ was the first time the UK's highest court directly addressed the position of foreign claimants having limited or no business activity in the UK (though I note that this is not quite the position in the present case). Lord Neuberger (with whom the rest of the Supreme Court agreed) stated (at paragraph 47 of the judgment):

"I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill **in this jurisdiction**, and that such goodwill involves **the presence of clients or customers in the jurisdiction for the products or**

20 [1901] AC 217

21 [2002] EWHC 1984 (Ch) at paragraph 62 of that judgment.

22 [1967] RPC 589

23 [1991] FSR 49

24 *Lumos Skincare Ltd v Sweet Squared Ltd, Famous Names LLC and Sweet Squared (UK) LLP* [2013] EWCA Civ 590

25 *In Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31

services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad." (my emphasis)

62. At paragraph 52, Lord Neuberger continued:

"As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough ... The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant." (again my own emphasis).

63. The nature of a charity and its services are different from a conventional business; those who donate or participate in support of a charity and those who benefit from its cause differ from 'customers' in a conventional business model. However, there is no doubt that charitable organisations may bring proceedings for passing off.²⁶

64. The evidence is that the sign first came into use in 2018, after the second ride and in preparation for the 2019 ride. 25 riders are said to have taken part in the 2019 event, raising £65k for the Green Memorial Hospital in Manipay and in 2020 50 riders took part to raise £102k. The evidence indicates that the participants came not only from the United Kingdom but also from Australia, Canada, Romania and Sri Lanka. It is not clear how many riders were from the UK, or how much of the raised funds came from donations in the UK. However, the ride has its 2017 roots from an initiative conceived and driven from

²⁶ British Legion v. British Legion Club (Street) Ltd (1931) 48 RPC 555 (Farwell J); British Diabetic Association v. Diabetic Society [1996] FSR 1 (Robert Walker J)

riders based in UK and it is reasonable to ascribe a relevant portion of the sums raised to donations from the UK or to donations driven by participants from the UK. The sums are relatively small in absolute terms and of course tiny as a proportion of the charity field, or sporting or even cycling industry. However, the services offered under the sign are more or less inherently small in scale. Participants will be few in number, limited by road safety considerations and by the cost and commitment of travel to Sri Lanka.

65. The purpose of the rides has been centrally focussed on raising funds for the benefit of the Green Memorial Hospital in Manipay, Sri Lanka and the funds raised – from the UK at least – pass through FOMH as the dedicated charity responsible for furthering the work of the hospital. While undoubtedly a worthwhile cause, it is a charity that has no prospect of attracting funds on a scale anything like comparable to more mainstream UK charities such as Cancer Research UK, Barnardo's, or Greenpeace. Its cause is geographically remote and the fundraising is on a relatively modest scale. These are factors that in my view should temper the expectations of this tribunal in determining the sufficiency of the goodwill in evidence. With that in mind, I find that tens of thousands of pounds raised in successive years tends to indicate a valuable goodwill, which though modest, is not trivial.
66. The Sri Lankan connection is inherent by virtue of location of the beneficiary hospital and the family roots of key individuals involved in the rides. However, while the rides take place in Sri Lanka, FOMH is both a UK-registered company and a UK registered charity. There is also evidence of donations from people and organisations in the UK and/or of UK entities being approached for contributions and exposed to the Ride4Ceylon sign. This includes BBK (the accountancy firm for whom SA works), the UK country manager for Oman Air, and the Trustee Fund Manager, at The Waterloo Foundation in Cardiff. There is evidence too of JA's medical colleagues in the UK being aware of the work of FOMH and of at least one wearing a top featuring the logo. I also note that the domain name, present in the Contested sign, is a .com URL, and is at least accessible to UK users. The domain is registered to DR, based in the UK and the website is maintained by Pradeep Kumar, again based in the UK. That said, there is nothing in the evidence to establish the extent to which UK consumers have accessed the website and gained exposure to the sign that way.
67. The sign in respect of which goodwill is claimed has been in use only since 2018 and in relation only to the rides of 2019 and 2020. This is a relatively short period of time, but in

my opinion, not so short as to prevent the accrual of goodwill. On balance, given the nature of the activity under the sign, which is based on the arrangement of an annual cycle ride in Sri Lanka for charitable ends, I find the evidence sufficient to have established goodwill in the UK. The next question to determine is who may be considered to own such goodwill and in particular, whether it be said that FOMH is the proprietor of that goodwill.

68. In considering that matter, I bear in mind firstly, the nature and description of goodwill cited earlier, that it is the attractive force that brings in custom; and secondly, I note the guiding questions posed in *Wadlow*²⁷ as follows:
- a. Are the services bought on the strength of the reputation of an identifiable trader?
 - b. Who does the public perceive as responsible for the character or quality of the services? Who would be blamed if they were unsatisfactory?
 - c. Who is most responsible in fact for the character or quality of the services?
 - d. What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill?
69. The evidence shows that it was MJA, with GS and WDK who came up with and took forward the idea of a charity bike ride in Sri Lanka, promoting the ride and participating in rides of 2017 and 2018. Those rides, it must be remembered, were conducted under the name "Ride for Charity". Although it is stated on behalf of MJA that the ride was never to have been limited to benefit of one charitable cause, the evidence is that the first rides were in fact exclusively in aid of Green Memorial Hospital, through FOMH. Even in the initial two rides, JA and SA, as trustees of FOMH, played significant supporting roles – such as in JA's liaison with the BBC London journalist. Following the name change in early 2018, after the second ride and the split from GS and WDK and Riders for Charity, the connection of the annual event with FOMH came increasingly to the fore. This included, for instance, JA making welcoming speeches, including as part of a press conference, where the Contested logo is also used. The connection to the UK charity is highlighted in newspaper articles in Sri Lanka in March 2019, where DR states "*Ride for Ceylon is the face of the charity "Friends of Manipay Hospital."* Correspondence sent in the name of various committee members (DR, SDS, MJA) features in its header / footer,

²⁷ See Chapter 3 of *Wadlow* at 3-139 – 3-141.

the Contested logo and the name of FOMH and its content expressly states “*the project is being organised and administered by Friends of Manipay Hospital, a UK registered charity.*”

70. I find that the attractive force that brought in participants and supporters was the desire to support the work of the hospital through FOMH and it is the registered status of that entity that would have provided an assurance of legitimacy and propriety. This perception is expressly supported by the witness statement of Sritharan Karunanithy, from the UK, who says as follows: “*For 3 years I joined Ride for Ceylon and raised funds to renovate the Green Memorial Hospital as the ride was backed by the UK registered Charity 'Friends of Manipay'. The ride was never owned or organised by an individual. The ride was organised by the R4C committee which consists of a number of volunteers from UK, Sri Lanka and US. Michael Arnold [MJA] has been part of the R4C committee and helped organizing the ride but it was never owned by him. I and many other riders would not have taken part in a ride if it was not backed by a charity and owned by an individual. Therefore, I believe that the true and prior proprietors of the trademark in question is the charity and not Michael.*”
71. The prima facie onus is of course on FOMH to show that it was the proprietor of the earlier right (owned actionable goodwill in the UK). However, it is necessary to consider the counter position maintained by MJA that he alone may claim to own the goodwill under the Contested sign. In my view, MJA’s position in that regard is untenable, not least because the weight of the evidence is that it was not he who came up with the name “Ride for Ceylon” nor with the logo. Those steps are attributable to MR (wife of DR) and to Dillon David (via DR). MJA is not the owner of the web domain that is an important part of the logo, nor is there evidence that he even contributed to the content it hosts.
72. MJA is one of the members of the Ride for Ceylon committee. No other member of the committee states that MJA is the owner of the goodwill. There are some supportive comments from other quarters: I note that GS gives his own “solid view” that MJA “*is the sole founder and rightful owner of Ride for Ceylon (R4C) and whatever trademarks that bare the R4C name*”.²⁸ I note too that WDK expresses his similar opinion.²⁹ **Exhibit 5** to

28 Paragraph 9 WS GS – MJA’s Exhibit 1

29 Paragraph 22

the WS of MJA is a “to whom it may concern letter”, dated 21 September 2021 (not a formal witness statement) from Indaka Nanayakkara. He says that MJA was the key reason that he joined the rides (seemingly both in 2017 and 2018) and that he has always felt MJA to be the true originator of the ride to raise money for the hospital. However, those comments fall long short of establishing that in the perception of the UK public, the goodwill under the Contested sign belonged to MJA.

73. I also note that MJA has claimed that FOMH is just one of the projects that benefits from Ride 4 Ceylon. This claim may tend to suggest a dispersal of the association of the sign away from one beneficiary, diminishing FOMH’s claim laid to the goodwill. However, the evidence does not establish MJA’s claims as to use of the Contested sign in relation to a range of projects ahead of the relevant date. I note the following points from MJA’s evidence: **MJA’s Exhibit 30** is a letter (not a witness statement), from Chevy Green, Director of Programmes for a charity affiliated to Surrey County Cricket Club. He states his letter is “*in support of Ride for Ceylon Multi-Faith Cricket Festival and Charity Bike Ride in support for Friends of Manipay.*” This letter is dated February 2021 and does not assist MJA. **MJA’s Exhibit 28** is a to whom it may concern letter (with no statement of truth) from Natpiddimunai Cricket club, which reads: “*We started our hard ball cricket with the only help from Mr Michael Arnold, Ride for Ceylon. He helped us giving complete sets of cricket equipments by hand in his visit to our school.*” This Exhibit is of no assistance, not least since it is not possible to determine when MJA provided help – noting that the letter is dated 25 October 2021 – long after the relevant date - or the extent to which the Contested Sign played any part.
74. **MJA’s Exhibit 4** is a to whom it may concern letter dated 22 October 2021 from the secretary Manipay Parish Sport Club (UK) (based in Surrey). The letter states that MJA has been a member of that cricket club since 2015/16 and that MPSC (UK) “*donated cricket equipment every year to Michael’s ‘ride4ceylon’ which in turn to be donated to the needy cricket clubs back in Sri Lanka’s war-hit north-east.*” The letter also reads “*In May 2020, on Michael’s initiative, the ‘ride4ceylon’ organised a Northern Masters Cricket team in Sri Lanka.*” While these actions do predate the relevant date, the evidence is insufficiently detailed to undermine the weight of the evidence focussed fully on the association of the sign with FOMH and the cause of the Green Memorial Hospital.

75. I note that MJA claims that any use made of the sign by FOMH has been only with his consent (based on an oral understanding between the parties). I again find this an untenable position not least because MJA did not create the logo, or the name - which were created by other volunteers who understood their acts to be on behalf of FOMH. Simply because MJA came up with a way to fundraise for FOMH through organising a cycle ride in Sri Lanka, and played an important role in the team of volunteers helping to plan and run the events, does not give him exclusive rights. MJA emphasised the content of **Exhibit JA4**, which is an e-mail dated 31st of August 2020 from JA to MJA where JA states: *“we all agree that R4C is your excellent idea and we appreciate your dedication commitment to the development of Green Memorial Hospital and all your valuable contribution towards R4C. However, we must all realise that R4C has moved on and very many others have also committed their time and effort and worked tirelessly for R4C ... and we cannot disregard this.”* The idea of the ride (under a different name) is not enough. FOMH and its supporters were free to recast the brand and to develop goodwill accordingly.
76. I have no doubt that a substantial number of FOMH’s potential customers or ultimate consumers may be deceived by use of the Contested sign by MJA in a private capacity. Finally, returning to the position with regard to use of the sign during a period earlier than the relevant date, I conclude that the position would have been no different at the later date when the trade mark application was made, since the goodwill was never owned by MJA individually.
77. **Outcome:** The claim based on section 5(4)(a) succeeds.

The section 5(6) claim

78. Section 47(2ZA) provides that registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6). Section 5(6) of the Act reads as follows: “Where an agent or representative (“R”) of the proprietor of a trade mark applies, without the proprietor’s consent, for the registration of the trade mark in R’s own name, the application is to be refused unless R justifies that action.”
79. In *Mouldpro ApS v EUIPO*, Case T-796/17, the General Court summarised the case law about when a party may be regarded as ‘agent’ or ‘representative’ of an opponent or

application for invalidation. The court (referencing the article of the European legislation that mirrors the provision of section 5(6) of the Act) stated that:

“21. It is apparent from the wording of Article 60(1)(b) of Regulation 2017/1001 that, for an opposition to succeed on that basis, it is necessary, first, for the opposing party to be the proprietor of the earlier mark; second, for the applicant for the mark to be or to have been the agent or representative of the proprietor of the mark; third, for the application to have been filed in the name of the agent or representative without the proprietor’s consent and without there being legitimate reasons to justify the agent’s or representative’s action; and, fourth, for the application to relate in essence to identical or similar signs and goods. Those conditions are cumulative (judgment of 13 April 2011, *Safariland v OHIM — DEF-TEC Defense Technology (FIRST DEFENSE AEROSOL PEPPER PROJECTOR)*, T-262/09, EU:T:2011:171, paragraph 61).

The European Courts have also given the following guidance:

(a) The terms ‘agent’ and ‘representative’ must be interpreted broadly, covering all kinds of relationships based on a contractual agreement where one party represents the interests of the other. It is sufficient that the agreement or commercial cooperation between the parties gives rise to a fiduciary relationship by imposing on the applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the proprietor of the earlier mark (*EUIPO v John Mills Ltd & Jerome Alexander Consulting Corp.*, Case C-809/18 P, EU: C:2020:902, paragraph 85);³⁰

(b) It does not matter how the contractual relationship between the proprietor or principal, on the one hand, and the applicant for the EU trade mark, on the other, is categorised (*FIRST DEFENSE AEROSOL PEPPER PROJECTOR*, T-262/09, EU:T:2011:171, paragraph 64, and *Moonich Produktkonzepte & Realisierung v OHIM — Thermofilm Australia (HEATSTRIP)*, T-184/12, not published, EU:T:2014:621, paragraph 58);

(c) Nevertheless, some kind of agreement must exist between the parties. A mere purchaser or client of the proprietor cannot be regarded as an ‘agent’ or as a ‘representative’ (*FIRST DEFENSE*, paragraph 64);

30 My underlining.

(d) The misuse of the mark may occur both where the earlier mark and the mark applied for by the agent or representative are identical, and where the marks at issue are similar (*EUIPO v John Mills Ltd*, paragraphs 70-73);

(e) The protection also extends to cases where the goods and services are only similar and not identical (*EUIPO v John Mills Ltd*, paragraphs 98-99);

(f) The specific protection afforded by Article 8(3) is not to be assessed on the basis of whether the similarity between the marks results in a likelihood of confusion (*EUIPO v John Mills Ltd*, paragraph 92);

(g) The assessment of similarity between the goods and services should take all relevant factors into account, including, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*EUIPO v John Mills Ltd*, paragraph 100 and *The Tea Board v EUIPO*, C-673/15 P to C-676/15 P, EU:C:2017:702, paragraph 48).

80. For the application for invalidity to succeed under section 5(6), FOMH must first establish that it is the owner of an identical or similar prior trade mark right. The Contested sign is identical, and the services are at least highly similar. The first real point of consideration is therefore whether FOMH owns a prior trade mark right. It must be noted that FOMH is not the registered proprietor of the Sri Lankan trade mark registration. Nor are its trustees the registered proprietors. Sri Lankan trade mark registration No. 238854 - registered in respect of the following services in Class 41: *education; providing of training; entertainment; sporting and cultural activities* – stands in the name of DR and MJA. I note too that **Exhibit SA18** shows that DR and MJA are also named as the proprietors of trade mark registration 238855, for the same logo, but in respect of the following services in Class 45: *Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals*.

81. DR states in his evidence that both he and MJA “*in consultation with Friends of Manipay Hospital trustees completed the paperwork to register the R4C logo in Sri Lanka. The required paperwork was handed over to lawyer Mohamed Adamaly and it was submitted on 12th February 2019 with signatures of [DR and MJA].*” DR states that he “*also requested trustee Prof. Jayantha Arnold to complete questions asked by the lawyers and copied all parties involved, in the email (in case of objection).*”

82. MJA states that there is no mention of FOMH in the email correspondence with the trade mark attorney, and that the trustees are not copied in to the emails with the trade mark attorney.³¹

Manipay Hospital <ride4ceylon@gmail.com>

83. It is MJA's position that "R4C was always his idea" and under his "sole ownership" and that he "appointed" DR as "committee secretary" in view of DR's stronger IT, drafting and administrative skills. While public-facing correspondence consistently co-brands the Contested Logo with FOMH, and expressly states that "*the project is being organised and administered by Friends of Manipay Hospital, a UK registered charity*", MJA maintains that he overlooked those references. Yet in any event there is nothing really to support MJA's belief of his personal entitlement to the benefit and goodwill of the sign – the idea of the ride is not enough. I again note that I have found that he did not create the logo, come up with the name, or register the domain. No correspondence or public-facing documentation differentiates or singles out MJA. The overwhelming association of the Ride for Ceylon is with the Green Memorial Hospital as overseen by the FOMH. There is no clear evidence of MJA having a particular place of primacy in the ride for Ceylon

31 MJA's Exhibit 20

committee of volunteers, and certainly no evidence of his personally appointing other members of the committee, or that other committee members considered themselves to be acting at the behest of MJA or for his individual benefit.

84. The next question to determine is whether MJA, when he applied for the Contested Registration, may be considered to have been an agent or representative of FOMH. I note the case law (set out in my paragraph 79 above) requires a broad interpretation of terms 'agent' and 'representative'. In the present case, I have rejected MJA's claim that FOMH used the Contested sign only with MJA's consent (based on an undocumented agreement between cousins). However, since MJA was a committee member for Ride for Ceylon and since, from the content of correspondence and newspaper articles, MJA would be perceived as an important volunteer behind Ride for Ceylon and the support for FOMH and its fundraising activities, I find that there arises an implicit general duty of trust and loyalty as regards the interests of the proprietor of the earlier mark.
85. The next requirements are clearly made out, that MJA applied for the Contested Registration in his own name and that he did so without the consent of FOMH. The final question is therefore whether MJA, whom I have found to have been acting as an agent or representative for FOMH, is able to justify his action. MJA's position in that regard again returns to the same essential point that he considered himself entitled to register exclusive trade mark rights, because he initiated the idea of the ride and he considered all trade mark rights that followed to be his alone. For the reasons I have set out already, I do not accept that that perception was correct or reasonable and it does not justify the trade mark application by MJA in his own name. The rightful owner is FOMH.
86. **Outcome:** The claim based on section 5(6) succeeds.

The section 3(6) ground

87. I turn now to consider the claim under section 3(6) of the Act that when MJA applied for the Contested Registration, he did so in bad faith.
88. Section 47(1) of the Act, provides that "*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).*"

Section 3(6) of the Act provides: “A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

89. There is no definition of “bad faith” in the legislation, rather the criteria for assessing “bad faith” have been set out in judgments of the Court of Justice of the European Union (CJEU) and UK Courts. The Court of Appeal in *Sky Limited (formerly Sky plc) v. SkyKick, UK Limited* [2021] EWCA Civ 1121 Sir Christopher Floyd (with whom Nugee and Newey LJ agreed) summarised the approach as follows (case references added in footnotes):

“67. 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].³²

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].³³

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].³⁴

32 Case C-320/12 *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* EU:C:2013:435

33 Case C-104/18 P *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ* EU:C:2019:724

34 Case T-663/19 *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening* ECLI:EU:2021:211.

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].³⁵*

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].³⁶*

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]".*

90. Although it may be a relevant factor, the mere fact that an applicant knew that another party was using the trade mark in another territory does not establish bad faith.³⁷ Given the territorial nature of IP rights, the mere appropriation of a name registered/used abroad

35 Case T-136/11 pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening EU:T:2012:689)

36 Case C-529/07 Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH EU:C:2009:361; [2010] Bus LR 443

37 Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker Case C-320/12. See also Wright v Dell Enterprises Inc. (HOGS AND HEFFERS), BL O/580/16

is not enough under UK law: there must be something else involved before this can justify a finding of bad faith. Similarly, the mere fact that an applicant knew that another party used the trade mark in the UK does not establish bad faith.³⁸ The applicant may have reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks.³⁹

91. It is necessary to ascertain what MJA knew at the relevant date (when he applied for the Contested Registration).⁴⁰ Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date.⁴¹
92. It is clear that MJA knew about the use of the Contested sign by FOMH (both in the UK and Sri Lanka) and that in various public-facing communications (press articles and correspondence) FOMH had consistently been inextricably linked with the trade mark. While it is not clear that the report drafted by Ms Meadows (Exhibit SA27) had been shared publicly by the relevant date, it is clear that it had been shared with MJA and that he made no objection nor sought any amendment to that report.⁴² Yet the report could hardly be clearer on the connection of FOMH with Ride4Ceylon. The cover page of the Annual Report shows the name “Friends of Manipay Hospital” and the Contested logo. The opening line of its Foreword reads “*Welcome to the Annual Report of Friends of Manipay Hospital, including its operating brand for fund raising through the annual cycle ride – rideforceylon...*”. A footnote on the first page of the report reiterates: “*Ride4Ceylon is one of the brand names for the UK Registered Charity Friends of Manipay Hospital (charity number: 1113439)*”.
93. In line with earlier analysis, MJA would have been aware of the valuable goodwill associated with the Contested sign, and I have found that he had no legitimate basis on which to consider himself the individual beneficial proprietor of that goodwill. Case law suggests that this could in and of itself be sufficient basis to establish that an application was made in bad faith.⁴³ In the present case, the claim for bad faith is strengthened by

38 Lindt, Koton (paragraph 55)

39 *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] R.P.C. 9 (approved by the Court of Appeal in England and Wales: [2010] R.P.C. 16)

40 *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)

41 *Hotel Cipriani*

42 See **Exhibit SA21** and the email there from Ms Meadows on 10 August 2021 to SA, JA, DR and MJA.

43 see *Jules Rimet Cup Ltd. v The Football Association Ltd* [2007] EWHC 2376 (Ch).

my finding that the evidence establishes a fiduciary relationship on the basis that MJA was a member of the ride4ceylon committee. I also note that MJA filed the application just a few days after the meeting where he had aired his issues relating to the communications and operation of the committee. The application was also filed just a few weeks before the incorporation of a UK company Ride4Ceylon Ltd,⁴⁴ of which MJA's son is the director and sole shareholder. MJA used the Contested Registration as the basis for cease and desist correspondence to prevent the continued use by FOMH of the website domain or trade mark. In my view, having regard to all the relevant circumstances, an ordinary person adopting proper standards would consider MJA's conduct to depart from accepted standards of ethical behaviour or honest commercial and business practices. On this basis, I find that the application was made in bad faith. That MJA may hold the view that he was not doing anything wrong is not relevant since my finding in this regard is determined by reference to the objective circumstances of the case.

94. I note that FOMH raised as one element of its section 3(6) claim that the intention behind the application was to use the trade mark as part of a commercial package. In that regard, while the evidence shows that MJA has a role at a travel company (Calypso tours), MJA denies that he has ever had any intention of using the mark for personal gain, rather that he had merely raised as a possibility a package deal for riders whereby a specified portion of the package fee would serve as a charitable contribution to the hospital. He also states that no such proposal was ever taken forward. I should make it clear that my finding of bad faith is not premised on that element of the allegations.
95. **Outcome:** The claim based on section 3(6) succeeds.
96. **Overall outcome:** Cancellation Application No. CA503730 succeeds. UK trade mark registration 3524029 is invalid and is deemed never to have been made.

COSTS

97. The application to invalidate the Contested Registration has succeeded on all of its claimed grounds and FOMH is entitled to a contribution towards its costs. Costs are payable in line with the scale set out in Tribunal Practice Notice 2/2016.

44 **Exhibit SA43** – Companies House records showing incorporation on 9 September 2020.

Official fee for filing the application for invalidity:	£200
Preparing statement of grounds and reviewing the counterstatement:	£600
Preparing evidence and considering and commenting on the other side's evidence:	£1900
Preparing submissions in lieu of a hearing:	£500
Total	£3200

- (i) I order Michael Jeyasegaran Arnold to pay Friends of Manipay Hospital the sum of £3200 (three thousand two hundred pounds). This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 11th day of October 2022

Matthew Williams

For the Registrar
