

O-114-21

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO000001437003
IN THE NAME OF GUANGZHOU NOME BRAND MANAGEMENT CO., LTD. IN
RESPECT OF THE TRADE MARK**



NOME

IN CLASSES 3, 9, 18, 20, 21, 24, 25, 29, 30, 32 AND 35

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 415723 BY
GUANGZHOU RENREN MANAGEMENT CONSULTING CO., LTD**

Background and pleadings

1. Guangzhou Nome Brand Management Co., Ltd. (“the holder”) is the holder of an International Trade Mark designated the UK no. WO000001437003 (“the IR”). It’s International registration date and the date of designating the UK is 22 May 2018. The IR is in respect of the following mark:

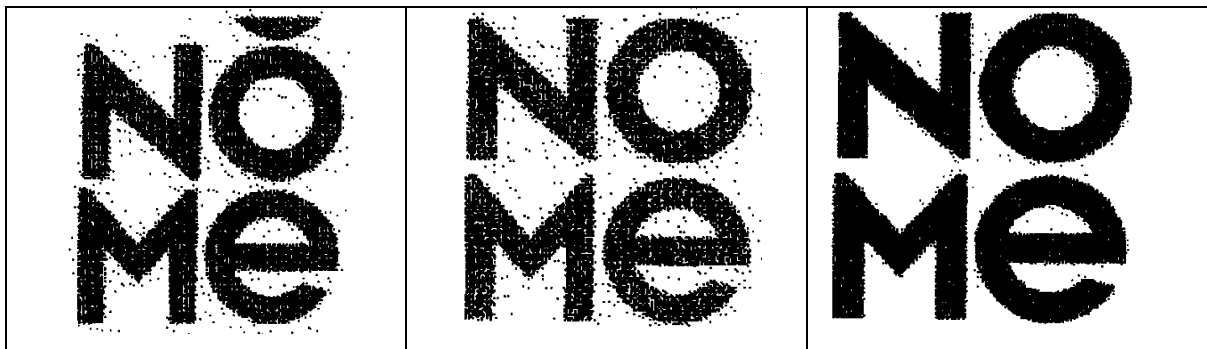


2. It was accepted and published in the Trade Marks Journal on 7 December 2018 in respect of a list of goods and services in Classes 3, 9, 18, 20, 21, 24, 25, 29, 30, 32 and 35.

3. Guangzhou Renren Management Consulting Co., Ltd (“the opponent”) opposes the IR on the basis of section 3(6) and section 5(4)(b) of the Trade Marks Act 1994 (“the Act”). The ground under section 5(4)(b) is on the basis that it is the alleged owner of the copyright in the holder’s mark. It asserts that it was established in 2016 and is one of a group of companies that created the “Miniso” brand, well known in China and having 3,500 stores in 79 countries and 30,000 employees. The opponent has conceived the plan for a NOME life and home collection brand. These products are sold via the opponent’s website <http://nome.com.cn/> and its Miniso stores and other stores in China. It uses various branding on the front of its stores and on its products including the following:

**NO
ME**

4. It asserts that it owns the copyright directly, indirectly, by virtue of associates assignments and/or licences thereof, in the following by virtue of Chinese copyright registrations 2018-F-00515700 (where it relies upon the “date the work was finished”, namely, 8 December 2015) and 2018-F-00510217 (dated 23 May 2018):



5. It points out that the Berne Convention extends protection of such copyright to the UK (and associated assignments and/or licences therefor).

6. In respect of the claim under section 3(6), the opponent points out that the holder’s mark differs to its own copyright protected mark by the addition of semicircle above the letter “O”. I note, however, that the images relied upon (see paragraph 4, above) include an image that includes the semicircle. It further asserts that the holder has been opening stores in China and other countries with similar get-up and bearing its virtually identical and similarly positioned mark. It has been promoting these stores including via its websites <http://www.nome.com> and www.nome.cn both of which are accessible from the UK. It is using identical and similar business concepts including use of the opponent’s slogan “Explore A New Life”. It asserts that, as a consequence, the IR designation was made in bad faith.

7. The holder filed a counterstatement asserting that it is not clear that the opponent is a licensed user or the owner of the copyright claimed in the opponent's work. It puts the opponent to strict proof to demonstrate how it owns or has permission to use the claimed work. It also puts the opponent to strict proof that its work qualifies as an artistic work in which copyright subsists in the UK. The holder claims that the actual registration date of the copyright relied upon by the opponent is 10 April 2018 and it relies upon a Chinese copyright registration (no. 2017-F-00404795) standing in the name of its affiliate Guangdong Puss Investment Co., Ltd. ("GPI") in respect of the holder's mark and with a registration date of 2 November 2017. The registration date of this copyright is earlier than that of the registration relied upon by the opponent. The holder also denies the factual matrix relied upon by the opponent illustrates that the holder is acting in bad faith.

8. The parties both filed evidence. This will be summarised and referred to to the extent that it is considered necessary. The parties did not request a hearing and I make my decision after careful consideration of the papers.

9. The holder is represented by Appleyard Lees IP LLP. The opponent was previously represented by London IP and is currently represented by Bayer & Norton Business Consultant Ltd.

Evidence

10. The opponent's evidence takes the form of the witness statement of Francesca Ifechukwunyem Maria Nwaegbe, Head of Trade Marks at London IP, the opponent's previous representative in these proceedings. Ms Nwaegbe provides evidence regarding the opponent's use of its mark around the world and the copyright protection relied upon.

11. The holder's evidence is in the form of the witness statement of Chen Hao CEO of Guangdong Puss Investment Co., Ltd., a company affiliated with the holder. This was provided with the holder's counterstatement.

DECISION

Section 5(4)(b)

12. Section 5(4)(b) 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) [...]

(b) by virtue of an earlier right other than those referred to in subsections(1) to (3) or paragraph (a) or (aa) above, in particular by virtue of the law of copyright, or the law relating to industrial property rights.

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.”

13. To recap, the relevant date in these proceedings is the date the contested IR designated the UK, namely, 22 May 2018. The earlier right relied upon is copyright. The opponent must have been in a position to prevent use of the holder’s mark under the law of copyright at this date.

14. Section 1 and Section 4(1) of the Copyright, Designs and Patents Act 1988 (“the Copyright Act”) state:

“(1) Copyright is a property right which subsists in accordance with this Part in the following descriptions of work –

- (a) original literary, dramatic, musical or artistic works,
- (b) sound recordings, films [or broadcasts], and
- (c) the typographical arrangement of published editions.”

and

“4. Artistic works.

(1) In this Part “artistic work” means-

(a) A graphic work, photograph, sculpture or collage, irrespective of artistic quality,

(b) ...

(c) A work of artistic craftsmanship”

15. As referred to by the opponent, a helpful summary of the main principles of copyright law and artistic works was given by District Judge Clark in *Suzy Taylor v Alison Maguire* [2013] EWHC 3804 (IPEC):

“6. I will set out the law in greater detail than usual to assist the unrepresented Defendant, who did not attend the hearing, in understanding it. Section 1 of the CDPA provides for copyright to subsist in original artistic works. An "original artistic work" is a work in which the author/artist has made an original contribution in creating it – for example by applying intellectual effort in its creation.

7. Artistic works are listed in s.4(1) CDPA and include "a graphic work... irrespective of its artistic quality". Graphic work is defined in 4(2) as including "(a) any painting, drawing, diagram map, chart or plan and (b) any engraving, etching, lithograph, woodcut or similar work...".

8. For an artistic work to be original it must have been produced as the result of independent skill and labour by the artist. The greater the level of originality in the work the higher the effective level of protection is, because it is the originality which is the subject of copyright protection. If the work includes elements which are not original to the artist then copying only those elements will not breach that artist's copyright in the work. It is only where there is copying of the originality of the artist that there can be infringement.

...

11. If something is an exact copy of the whole or a substantial part of an artistic work protected by copyright, it will be an infringement if there is no defence provided by one of the exceptions contained in the CDPA. If something is an inexact copy, for example if it merely resembles an artistic work protected by copyright, it may or may not be infringing. The issue is whether it is a mere idea which has been copied or whether it is the work itself – ie the expression of the author's idea – which has been copied. There is no copyright in an idea per se because a mere idea is not a "work" in which copyright can subsist.

12. The issue was considered by Lord Hoffman in *Designers Guild Ltd v Russell Williams (Textile) Ltd* [2001] FSR11 HL who said:

"Plainly there can be no copyright in an idea which is merely in the head, which has not been expressed in copyrightable form, as a literary, dramatic, musical or artistic work, but the distinction between ideas and expression cannot mean anything so trivial as that. On the other hand, every element in the expression of an artistic work (unless it got there by accident or compulsion) is the expression of an idea on the part of the author. It represents her choice to paint stripes rather than polka dots, flowers rather than tadpoles, use one colour and brush technique rather than another, and so on. The expression of these ideas is protected, both as a cumulative whole and also to the extent to which they form a "substantial part" of the work...

Ladbroke (Football) Ltd v William Hill (Football) Ltd establishes that substantiality depends on quality rather than quantity... and there are numerous authorities which show that the "part" which is regarded as substantial can be a feature or combinations of features of the work, abstracted from it rather than forming a discrete part. That is what the judge found to be copied in this case...

Generally speaking, in cases of artistic copyright, the more abstract and simple the copied idea, the less likely it is to constitute a substantial part. Originality, in the sense of the contribution of the author's skill and labour, tends to lie in the detail with which the basic idea is presented."

13. Lord Hoffman went on to set out the correct approach for a court concerned with determining an action for infringement of artistic copyright, which is the approach I shall follow:

"The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges to have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are too commonplace, unoriginal or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying... Once the judge has found that the defendant's design incorporates features taken from the copyright work, the question is whether what has been taken constitutes all or a substantial part of the copyright work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It depends upon its importance to the defendant's work... The pirated part is considered on its own... and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose."

16. Therefore, an “artistic work” is one where “the author/artist has made an original contribution in creating it”. The opponent’s evidence in support of its claim includes the following:

- Extracts¹ from a publication entitled “Chinese Intellectual Property: A Practitioner’s Guide”². In the first extract, entitled “Establishing copyright ownership”, Ms Nwaegbe highlights that “Copyright arises automatically, but it may not be easy to prove ownership in China”³;
- The second extract is under the heading “Summary of copyright recordal requirements” for China where there is a list of filing requirements⁴. Included in these requirements is the need to provide “Relevant information about the author and the work, such as (a) the author’s name; (b) date and place for completion of his work; and (c) the publication information, including the date and place of first publication. Notarisation or legislation is not required”;
- A copyright registration certificate⁵ that records that the “date the work finished” was 8 December 2015. The certificate and accompanying images is reproduced below:

¹ At Exhibit FIMN3

² (2012) by Jian Hu and Gordon Harris

³ Ms Nwaegbe’s witness statement, page 3

⁴ See Exhibit FIMN3

⁵ At Exhibit FIMN4a



- The following translation of the certificate is provided:

Registration No.: Chinese copyright registration certificate No.-2018-F-00515700

Name of the Work: NOME **Type of the Work:** Work of art

Author: Hu Yao **Owner of the Copyright:** Hu Yao

Date of the Work Finished: December 08, 2015 **Date of the First Publication:**
December 08, 2015

In accordance with the regulations of *Voluntary Registration of Works Trial Measures* and upon the audit of the China Copyright Protection Center, the above mentioned matters, applied by Hu Yao, is approved.

Registration Date: April 10, 2018

Registry Department:

National Copyright Administration of the People's Republic of China

Special Seal for Voluntary Registration of Works (Sealed)

- The Author is identified as “Hu Yao”, a member of staff in one of the companies owned by Ye Guofu⁶. Mr Ye is, himself, the majority shareholder of the opponent⁷. A second certificate (No. 2018-F-00510217) records the assignment of the copyright by Hu Yao to Mr Ye on 12 April 2018 and officially recorded on 23 May 2018⁸. Ms Nwaegbe states that “to the best of her knowledge” the opponent’s copyright was created by Hu Yao alone⁹;
- A Power of Attorney between Mr Ye (as trustor and “legal owner of copyright of NOME”) and the opponent (as trustee) authorises use of “NOME as a trademark worldwide” and also permits the opponent to authorise third party use and to conduct infringement proceedings globally to safeguard the rights

⁶ Ms Nwaegbe’s witness statement, page 4

⁷ Ditto, page 2

⁸ See Exhibit FIMN4b

⁹ Ms Nwaegbe’s witness statement, page 5

and interests in the identified works¹⁰. This document includes the statement: “This Power of Attorney takes effect from the date of signature“ and the date of signature is shown as “May 24, 2018”;

- A copy of the UK Statutory Instrument entitled “Copyright and Performance (Application to Other Countries) Order 2013” is provided. This lists China as a country in which such protection is granted in respect of artistic works¹¹.

17. The opponent submits that its protected work is a graphic work capable of qualifying for protection as an artistic work by virtue of section 1(1) and section 4(1) of the Copyright Act. To support this, Ms Nwaegbe draws attention to the supplementary decision BL O-483-16 of George Salthouse, a Registry hearing officer, who referred to his following earlier comment in decision BL O-395-16:

“21) I accept that a single word may qualify as an “artistic work” if it is visually embellished in some way such as in its form of stylisation or additional matter.
...”

18. Mr Chen, on behalf of the holder, provides evidence on the basis that the opponent’s copyright rests only in the following work¹²:

The image shows a stylized logo consisting of the words "NO" and "ME" stacked vertically. The letters are bold, black, and blocky, with a slightly irregular, hand-drawn appearance. The "O" in "NO" and the "E" in "ME" are particularly prominent.

19. As I have previously observed, the copyright registration certificate appears to include a variation of this representation that exactly matches the contested mark. Therefore, on the face of it, it appears that Mr Chen is incorrect in identifying only the above representation. Even if this is wrong and the opponent’s copyright claim is in respect only of the above representation, this does not impact upon its chances of success because the NO ME part of the work is reproduced exactly in the works relied upon by both parties indicating that one has clearly been copied from the other.

¹⁰ See Exhibit FIMN4c

¹¹ At Exhibit FIMN5

¹² See para 4 of Mr Chen’s witness statement

20. Mr Chen states that the holder has traded under its mark since its formation in 2017¹³ and that the applicant's mark was developed independently by himself between March – April 2017 and it has been used extensively by the holder since August 2017¹⁴. He also states that the holder applied to register the copyright in its mark in China on 2 April 2017 and that it is now registered under registration no. 2017-F-00404795¹⁵. An image of the work registered and the translation of the certificate are shown below:

No.00404795

Registration No.: 国作登字-2017-F-00404795

Name of Work: NOME

Type of Work: Work of Art

Author:

Copyright Holder:

Guangdong Puss Investment Co.,Ltd.

Guangdong Puss Investment Co.,Ltd.

Date of Completion: April 10, 2017

1st Publish: August 20, 2017

The above work and information was applied by GIANNI FERRARI S.R.L.. After examination by the Copyright Protection Center of China (CPCC), this work is approved of registration in accordance with Tentative Measures for Voluntary Registration of Works.

Date of Issuance: December 21, 2017

(Seal of National Copyright Administration of the People's Republic of China)



¹³ Ditto, para 7

¹⁴ Ditto, para 8

¹⁵ Ditto, para 9 and the registration certificate is provided at Exhibit 1

21. Following the holder's application to register its copyright, on 2 November 2017 it applied to register trade marks in China and the UK.

22. The holder puts the opponent to proof that the works it relies upon qualifies as an artistic work. There is some uncertainty regarding the scope of the earlier right relied upon by the opponent because the images provided in the representation of the work accompanying the copyright registration certificate no. 2018-F-00515700 includes an image with the semi-circle element present above the letter "O" (shown in paragraph 4, and third bullet point of paragraph 18). However, as discussed at paragraph 21 above, the holder's submissions are presented upon the assumption that the semi-circle is a difference between its mark and the opponent's work. The presence of this semi-circle adds further to the artistic contribution but I am firmly of the view that the other images relied upon possess the requisite originality to qualify as an artistic work. This is because the placing of the word NO above the word ME creates a work that is roughly equal in length and height making it square-like in appearance with a visual impact over and above the words alone. This, combined with the apparent randomness of the combination of the two words, is sufficient to illustrate that the author made an original contribution to its creation and that the work has been created as a result of the author's independent skill. Whilst the level of artistic skill required to produce the work is not high, I have little hesitation in concluding that the opponent's claimed earlier right qualifies as an artistic work.

23. The holder claims that opponent's reliance upon the copyright registration no. 2018-F-00515700 is flawed. The holder asserts that the relevant date is its registration date (of 10 April 2018) rather than the date of first publication some three years earlier because this latter date is unsubstantiated. The holder asserts that its own copyright registration pre-dates the registration date of no. 2018-F-00515700. This is factually correct and I agree with the holder that the opponent cannot rely upon a claimed date of first publication because, firstly, the opponent's own evidence (see paragraph 18, second bullet point) illustrates that substantiating the date of first publication is not a requirement for registration and, secondly, the claim remains unsubstantiated here because no evidence has been adduced to support the claim despite the holder making the criticism. Consequently, the date of registration is the only clear evidence of the date from which copyright existed.

24. A finding in favour of the opponent requires there to have been copying of its work. I have found that its claim to copyright protection extends from 10 April 2018. The holder has provided evidence of a further copyright certificate (no. 2017-F-00404795) in the name of a company affiliated to the holder. This has a “date of issuance” (as the holder’s translation has described it) of the certificate of 21 December 2017. This pre-dates the registration date of the copyright registration relied upon by the opponent and undermines the opponent’s claim that its work was copied.

25. The respective works represented by both these registrations are either identical (if the opponent’s work includes a representation with the semicircle above the letter “O”) or similar in that the NO ME part of the work is reproduced identically in both registrations. It is inconceivable that these works were both developed independently without knowledge of the other and there has been a clear case of copying. However, based upon the registration dates on the respective copyright registration certificates, the *prima facie* position is that it was the opponent who copied the holder’s work rather than the other way around as asserted by the opponent.

26. This position finds some support in the evidence provided by the holder where two published articles discuss the phenomenon of brand appropriation in China¹⁶. The first article cites that another company of Mr Ye called Miniso, “even went on copying Nome...The original NOME made extensive PR efforts to accuse Miniso for its asshole behaviour but Miniso succeeded in taking advantage of loopholes in the system”. The second article discusses how Mr Ye:

“spread the fake news that MINISO has acquired NOME. March 19, 2018, he let 27,000 MINISO employees repost this rumor on their WeChat Moments. A copy website was born as well.

¹⁶ At Exhibit 6 are two articles, the first obtained from www.linkedin.com and the second www.hitouch.com



Ye ignored the truth that NOME has registered the brand in 2017, he took a risk of infringement and tried hard to let NOME suppliers, franchisee believe that the brand value of NOME now has been transferred to MINISO”

27. These two articles are opinion pieces and are not verified or accompanied by a statement of truth from the authors. Nevertheless, their content is consistent with my finding that the opponent has copied the applicant’s copyright work rather than the other way around.

28. The opponent relies upon a second copyright registration but as the holder has pointed out this appears to be no more than a registration of the assignment of the work relied upon by the opponent rather than a registration of a different work. However, even if this is wrong, its registration date is even later than the opponent’s first registration and cannot, therefore, improve its position.

29. Taking all of the above into account, I find that the opponent has failed in demonstrating that its work was copied by the holder. Rather, on the information before me, it appears that the opponent copied the holders work.

30. Even if I am wrong, the opponent’s case also falls on a technical shortcoming. The evidence relied upon by the opponent includes the Power of Attorney by which the opponent is claimed to have acquired the necessary rights to the copyright registration in order to rely upon it as an earlier right under section 5(4)(b). A copy of the Power of Attorney records that Mr Ye authorised the opponent to use the copyright work relied upon by the opponent. This document took effect from the date

of signature, namely, 24 May 2018. This is after the relevant date in these proceedings (22 May 2018). As a consequence, the opponent was neither the owner, licensee nor authorised user of the works relied upon at the date the holder designated the UK.

31. The Trade Marks (Relative Grounds) Order 2007 (Statutory Instrument 2007 No. 1976) stated as follows:

“2. The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.”

32. This created a requirement that an opponent must be the proprietor of the earlier right relied upon. Even if “proprietor” is construed as including other persons who have the authority to use the earlier right, it is clear from the date that the Power of Attorney was signed that the opponent could not rely upon the work at the relevant date.

33. In the circumstances, the opponent cannot rely upon the work as an “earlier right” as required by section 5(4)(b) of the Act.

34. In summary, the opponent has failed to demonstrate that it was the proprietor of the earlier right relied upon at the relevant date or that the holder copied its copyright registered work. For these reasons, the grounds based upon section 5(4)(b) fails in its entirety.

Section 3(6)

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

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

36. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why the following relevant case-law covering trade mark applications made in bad faith includes the case law of the EU courts. The relevant cases are: *Chocoladefabriken Lindt & Sprüngli*, CJEU, Case C-529/07, *Malaysia Dairy Industries*, CJEU, Case C-320/12, *Koton*, CJEU, Case C104/18P, *Sky v Skykick*, CJEU, Case C-371/18, *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16), *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch), *Copernicus-Trademarks v EUIPO*, General Court of the EU, Case T-82/14, *Daawat Trade Mark, The Appointed Person*, [2003] RPC 11, *Saxon Trade Mark*, [2003] EWHC 295 (Ch), *Mouldpro ApS v EUIPO*, General Court of the EU, Case T-796/17, *Alexander Trade Mark, The Appointed Person*, BL O/036/18, *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and *Sky v Skykick* [2020] EWHC, 990 (Ch).

37. The law relevant to this case appears to be as follows:

(a) While in everyday language the concept of 'bad faith' involves a dishonest state of mind or intention, the concept of bad faith in trade mark law must be understood in the context of trade: *Sky* CJEU.

(b) Although it may be a relevant factor, the mere fact that the applicant knew that another party was using the trade mark in another territory does not establish bad faith: *Malaysia Dairy Industries*.

(c) Similarly, the mere fact that the applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55). 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: *Hotel Cipriani*.

(d) However, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat*, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited*.

(e) An application may also have been filed in bad faith where the applicant acted in breach of a general duty of trust as regards the interests of another party, including his or her own (ex) company or (ex) partners, or a party with whom there is, or had recently been, a contractual or pre-contractual relationship, such as a licensor, prospective licensor or overseas principal: *Saxon*, *Mouldpro*; or where a legal agreement prohibits such a filing.

38. The correct approach to the assessment of bad faith claims is as follows. According to *Alexander Trade Mark*, the key questions for determination in such a case are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application/registration could not be properly filed? and

(c) Was it established that the contested application/registration was filed in pursuit of that objective?

39. The applicant's intention (i.e. objective) is a subjective factor which must be determined objectively by the competent authority. An overall assessment is required, which must take account of all the factual circumstances relevant to the particular case: *Lindt*.

40. The matter must be judged at the relevant date, which is the date of the

application for registration: *Lindt*.

41. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull*. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani*.

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

43. The opponent's evidence focuses upon its claimed copyright and does not state that it is provided in support of its bad faith claim but I note that:

- Mr Ye is the majority shareholder of the opponent and he is also co-founder of the Chinese low-cost retailer "Miniso" that has 3,500 stores in 79 "countries and regions"¹⁷. The Wikipedia entry for the brand records that it was founded in 2011. Mr Ye is credited as being its founder and in 2016 its sales revenue reached \$1.5 billion, almost double the year before¹⁸. It also states that the majority of its stores operate in China but that it also has stores in many parts of the world. In Europe it has stores in Spain, Germany and Italy and several other countries but the UK is not mentioned;
- Since the establishment of the NOME brand in 2016, the opponent "began to conceive and plan a NOME branded life and home collection. The figurative mark identical to the opponent's claimed copyright (i.e. without the semi-circle above the letter "O") is shown appearing on shop frontage and some product packaging. These are undated but the store is identified as being in Shanghai¹⁹.

¹⁷ Ms Nwaegbe's witness statement, paras 1 and 2

¹⁸ Exhibit FIMN1

¹⁹ Exhibit FIMN2

44. The holder was founded in 2017 and since its formation has run a retail business in various cities in China bearing the NOME mark²⁰. In the 12 months ending on 12 April 2019, its annual revenue was in excess of £1,136 million²¹.

45. There is a well-publicised “feud” between the parties and the holder has provided English language articles where this is discussed. These take the view that the holder was the original NOME brand but the opponent, being a competitor of the holder, copied its brand²².

46. I adopt the approach identified by the Appointed Person in *Alexander Trade Mark*.

What is the objective that the holder has been accused of pursuing?

47. The opponent asserts that the holder’s mark differs to its copyright work only by the addition of a semicircle above the letter “O”. It further asserts that the holder has been opening stores in China and other countries and has been using a similar get-up and bearing the virtually identical and similarly positioned mark and that these have been promoted via two websites that are both accessible from the UK. It claims that, as a consequence, the filing of its IR designation was made in bad faith.

Is this an objective for the purposes of which the contested designation could not be properly filed?

48. The opponent relies upon the claim to copyright infringement and to a pattern of behaviour, in China, by the holder after the date that the opponent had become established in China. If these claims are made good they may point towards a finding of bad faith.

²⁰ Mr Chen’s witness statement, paras 13 - 14

²¹ Ditto, para 16

²² Exhibit 6 being three articles, one from a personal LinkedIn.com account, a second from hitouch.com and a third from nbdpress.com all dated in March or April 2018

Is it established that the contested designation was filed in pursuit of that objective?

49. The opponent's complaint appears to be that the filing of the designation amounts to an extension of the holder's claimed illegitimate activities in China. I note that there is conflicting evidence from the parties regarding these activities and that the onus is upon the opponent to establish a prima facie case of bad faith. In this respect, it is not possible to substantiate the opponent's claim that it created the NOME brand in 2016. The holder provides photographs of its own store fronts and a variety of goods all bearing its mark²³ but these are undated. It is clear from this evidence that both sides appear to use their marks in respect of retail services and goods. Whilst not determinative, this has some support in the third party articles provided by the holder that make reference to the feud between the parties and indications that it was an affiliate company to the opponent that was actually undertaking activities of copying the holder's brand, copyright and trading style. In contrast, the opponent's evidence is provided by Ms Nwaegbe in her capacity as the representative of the opponent and, therefore, was reliant upon the opponent for this information regarding its claim to first use being 2016 in China. In the absence of this claim being corroborated in the evidence, Ms Nwaegbe's statement carries little weight.

50. In light of the fact that the opponent has not demonstrated that it has senior rights to the copyright, it cannot rely on that as the basis for claim based upon bad faith. Neither has it presented any evidence to show prior use of its mark in China. Therefore, the evidence falls short of demonstrating that the filing of the holder's designation was an extension of a pattern of behaviour of exploiting the opponent's brand and, as a consequence, it also fails to demonstrate that the holder's making of its UK designation falls short of the standards of acceptable commercial behaviour.

51. In addition, as I have observed, there is a territorial nature to the trade mark regime. There is an absence of any evidence that the holder had knowledge that the opponent undertakes activity under its sign in the UK or that the holder was attempting to benefit from or pre-empt any plans the opponent had to enter the UK

²³ See Exhibit 3 to Mr Chen's witness statement

market. Therefore, the claim of bad faith is not made out for this reason also. The opponent does submit that its websites can be accessed from the UK, but there is nothing to suggest that they are targeted at the UK. This does not, therefore, illustrate that the opponent has any interest in trading in the UK.

52. In light of the holder's *prima facie* senior claim to the copyright and the third party articles referring to the opponent's activities in attempting to appropriate the identity of the holder's business, this would also provide the holder with a legitimate reason to protect its mark in the UK, namely, as an attempt to arm itself with a right upon which to base a defence to any UK activity by the opponent, even in the absence of knowledge that such activity was planned.

53. I conclude that there is no evidence upon which I can make a finding that the holder's designation was filed as an extension of an alleged pattern of behaviour in China and I find that the ground based upon bad faith fails for these reasons. Further, the circumstances apparent before me indicate that there was a positive and legitimate reason for the holder to make its UK designation. Its behaviour is, therefore, consistent with good faith.

54. The ground based upon a claim of bad faith is dismissed.

Summary

55. The grounds based upon section 5(4)(b) and section 3(6) both fail and the UK designation of the IR is accepted.

COSTS

56. The holder has successfully defended itself against the opposition and is entitled to a contribution towards its costs. I take into account that both parties filed evidence but that no hearing took place before me. I award the following sum as a contribution towards the costs of the proceedings, in accordance with TPN 2/2016:

Preparing statements in both cases and considering the opponent's statements	£700
Preparing and considering evidence	£1000
TOTAL	£1700

57. I, therefore, order Guangzhou Renren Management Consulting Co., Ltd to pay Guangzhou Nome Brand Management Co.' Ltd. the sum of £1700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 22nd day of February 2021

Mark Bryant
For the Registrar
The Comptroller-General