

O/531/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3391623  
BY MOHAMED IBTHIGAR MOHAMED ISACC

TO REGISTER:

**UNITED KINGDOM THOWHEED JAMATH**

AS A TRADE MARK IN CLASS 45

AND

IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 417942 BY  
UKTJ LIMITED

## BACKGROUND AND PLEADINGS

1. Mohamed Ibthigar Mohamed Isacc (“the applicant”)<sup>1</sup> applied to register the trade mark shown on the cover page of this decision in the United Kingdom on 12 April 2019. The application was accepted and published on 5 July 2019 in respect of the following services:

### Class 45

*Religious services, including religious meetings and prayers, providing information about religion and clarifying the misconceptions about Islam; charitable services, namely providing clothing to needy persons.*

2. On 3 October 2019, the application was opposed by UKTJ Limited (“the opponent”). The opposition is based on sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”) and concerns all the services in the application.

3. Under section 5(4)(a), the opponent claims that use of the applicant’s trade mark would be contrary to the law of passing off. It claims to have used the sign **UNITED KINGDOM THOWHEED JAMATH** in South London since March 2016 for the following services:

*Education; training; sporting and cultural activities; publishing; publications (not downloadable) from databases or the Internet; arranging and conducting conferences, seminars, exhibitions, awards and competitions; consultancy, information and advisory services relating to all the aforesaid services.*

*Providing community centres for social gatherings and meetings; provision of food and drink; consultancy, information and advisory services.*

*Religious services; organisation of religious meetings; consultancy, information and advisory services to all the aforesaid services.*

---

<sup>1</sup> On his notice of defence, Mr Isacc describes himself as the Secretary of UKTJ.

4. The opponent claims that, as a result of the extensive use and promotion of this sign, it has built up substantial goodwill. Registration of the contested mark would lead to misrepresentation, thereby causing confusion amongst the public and consequent damage to the goodwill of the opponent.

5. Under section 3(6), the opponent claims that the application for the mark was made in bad faith as the applicant was aware that the opponent was the proprietor of the mark **UNITED KINGDOM THOWHEED JAMATH** and had been using it since 2016. It says that the applicant was a member of the organisation and had been its president from January 2018 to 9 January 2019. The opponent further claims that the applicant's intention was to disrupt the opponent's activities and confuse and mislead the community.

6. The applicant filed a defence and counterstatement denying the claims made. He contends that he represents the "rightful members" of United Kingdom Thowheed Jamath ("UKTJ") and the individuals who constitute the opponent have broken away from the organisation. I shall return to this point.

7. The matter came to be heard before me by videolink on 13 May 2021. Only the applicant attended and, along with Dr Ajmal Khan Kudlebbai, he represented himself. In these proceedings, the opponent is represented by Trademark Eagle Limited.

## **EVIDENCE AND FACTUAL BACKGROUND**

8. The opponent's evidence in chief comes in the form of a witness statement from Yassin Hussain, a Director of the opponent. It is dated 27 April 2020 and is accompanied by Exhibits YH1-YH28.

9. The applicant's evidence comes in the form of a witness statement from Mr Mohamed Ibthigar Mohamed Isacc (the applicant himself) and is dated 2 August 2020. It is accompanied by Exhibits MI1-MI15.

10. The opponent also filed evidence in reply in the form of a second witness statement from Mr Hussain dated 15 December 2020.

11. The following facts are not in dispute:

- UKTJ was founded in March 2016 in Croydon to support Muslims from the Tamil-speaking community in the practice of their faith and to undertake activities with social benefits, such as the organisation of blood donation sessions;
- The organisation is funded through the donations of its members;
- Between March 2016 and April 2019, there was contact between UKTJ and Tamil Nadu Thowheed Jamath (TNTJ), based in Chennai, India. The poster advertising UKTJ's inauguration event promised a speech from P. Jainullabudeen from TNTJ entitled "Why Should We Support TNTJ – Are They The Only One Who Propagates Thowheed...?". This event is described as "TNTJ's London branch UKTJ's inauguration";<sup>2</sup>
- The applicant was appointed President of UKTJ in January 2018;
- UKTJ opened a Community bank account in June 2018;
- On 9 January 2019, the applicant resigned as President, citing personal reasons;
- The applicant retained access to one of UKTJ's official email accounts and its Facebook and YouTube accounts;
- UKTJ Limited and United Kingdom Thowheed Jamath were registered as private limited companies at Companies House on 1 and 2 April 2019 respectively. The minutes of a meeting held on 18 March 2019 state that this was done for the purposes of reserving the names and in the belief that this was a necessary step before starting the process of registering as a charity;<sup>3</sup>
- On 11 April 2019, the opponent emailed TNTJ to inform it that UKTJ was dissociating from the Indian organisation;<sup>4</sup>
- The applicant filed his trade mark application on 12 April 2019;
- The opponent applied for the trade mark UKTJ in Classes 41, 43 and 45 on 17 April 2019 and it was registered on 12 July 2019;

---

<sup>2</sup> See the opponent's Exhibit YH5 and the applicant's Exhibit M11.

<sup>3</sup> Exhibit YH18A.

<sup>4</sup> Exhibit YH22.

- The opponent also applied for the trade mark UNITED KINGDOM THOWHEED JAMATH in Classes 41, 43 and 45 on 15 January 2020. It was registered on 7 August 2020.

## **DECISION**

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

### **The rights to the name United Kingdom Thowheed Jamath**

13. The fundamental issue in these proceedings is that both parties claim that they have the right to use the name United Kingdom Thowheed Jamath and function as the entity that was founded in 2016. Article 2 of the Trade Marks (Relative Grounds) Order 2007 (SI 2007 No. 1976) states that an objection under section 5(4)(a) may only be raised by the proprietor of the earlier right. I must first therefore determine whether the opponent has the right to oppose the contested mark under this ground.

14. Before I do so, though, I wish to emphasise that my remit here is limited to the matters that are relevant for the registration of trade marks, and I keep in mind the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *John Williams and Barbara Williams v Canaries Seaschool SLU (CLUB SAIL SEA SCHOOL Trade Mark)*, BL O-074-10:

“... it must be remembered that the purpose of Registry proceedings is not to punish or deter, but to deal with issues arising in relation to the registration of trade marks. Such proceedings are civil proceedings. And in civil

proceedings the standard of proof with regard to things which are alleged to have been said and done is proof on the balance of probabilities.”<sup>5</sup>

15. The events leading up to the dissociation are disputed. I have considered all the evidence that has been submitted by both parties, including allegations made about the behaviour of various individuals. Many of these allegations are uncorroborated by documentary evidence and, for reasons I shall explain, their exact nature has no bearing on the trade mark issues that I must decide here.

16. I also note that neither party requested cross-examination of the other’s witnesses and, indeed, the opponent did not attend the hearing, a choice it was, of course, entitled to make. I must strive to make a decision on the basis of the evidence before me, the written submissions of the opponent and the oral submissions made by the applicant at the hearing. Earlier in *CLUB SAIL*, Mr Hobbs said:

“I think it is necessary to begin by emphasising that a decision taker should not resort to the burden of proof for the purpose of determining the rights of the parties in civil proceedings unless he or she cannot reasonably make a finding in relation to the disputed issue or issues on the basis of the available evidence, notwithstanding that he or she has striven to do so: *Stephens v Cannon* [2005] EWCA Civ. 222 (14 March 2005).”<sup>6</sup>

17. For the opponent, Mr Hussain states that, following the applicant’s resignation as president, an acting president was appointed and it was intended that the matter be formally dealt with at a general meeting.<sup>7</sup> He alleges that the applicant and another individual spread rumours and “fake news” about the organisation and its members and says that, after attempts to resolve the issue were unsuccessful, Mr Isacc’s membership was terminated and his subscriptions returned. Mr Hussain also says that Mr Isacc and his associates had taken the organisation’s Facebook, YouTube and Gmail passwords without permission and continued to operate them without consent, causing confusion among members.

---

<sup>5</sup> Paragraph 34.

<sup>6</sup> Paragraph 21.

<sup>7</sup> Exhibit YH15.

18. Mr Isacc's claim that he and his associates are in fact UKTJ, and the opponents are a splinter group, is based on the alleged relationship between UKTJ and TNTJ. In his witness statement, Mr Isacc says that TNTJ has thousands of branches in India and "formal and informal branches" elsewhere in the world, including Australia, Malaysia, Brunei, the Middle East and France.<sup>8</sup> He states that when the opponent decided to dissociate from TNTJ, it formed another organisation called Tamil Muslim Dawah Centre with its own management committee. In his witness statement, Mohamed Thoufique Ziyavudeen states that he attended the meeting at which the decision was taken.<sup>9</sup> Mr Isacc states that it was also decided at this meeting that the opponent would give up access to the community bank account and that this message was given to him by telephone on 10 March 2019 by one of the individuals in what he terms the splinter group.<sup>10</sup> However, in his witness statement Mr Ziyavudeen does not refer to any discussion of the bank account. Mr Isacc also states that he and his group continued to function as UKTJ and formed a management committee in March 2019.

19. The opponent does not deny a connection with TNTJ. However, it states that UKTJ had always been a self-governing organisation and had only ever sought religious guidance from TNTJ. In its email of 11 April 2019 to TNTJ, it said that at the launch in March 2016 it had been made clear that, in the event of any issues, United Kingdom Thowheed Jamath "would not follow any individual or organisation".<sup>11</sup> As both parties agree that there was some association, I shall now consider the nature of that association and whether it has a bearing on the trade mark issues I must decide here.

20. Mr Isacc refers to an email that he says states that TNTJ has three branches in the UK, of which UKTJ is one. However, only the names of the three groups are shown in English. Even if he is correct and there was a more formal relationship between UKTJ and TNTJ, the exact nature of that relationship is not evidenced. A letter from the current president of TNTJ states that:

---

<sup>8</sup> Paragraph 5.

<sup>9</sup> Exhibit MI12.

<sup>10</sup> Mr Isacc's counter-statement for Exhibit YH12, paragraph 5.

<sup>11</sup> Exhibit YH22.

“UKTJ was unofficially functioning with elected bodies with the support of parent organization TNTJ ... It is neither the policy nor in the history of TNTJ that its office bearers preside over or support any organization outside TNTJ network. This is standard operating procedure of our organization’s by-laws.”<sup>12</sup>

21. This letter was provided for the purposes of these proceedings and is not in the form of a witness statement. Furthermore, neither party has adduced in evidence any documents setting out the constitution of either TNTJ or UKTJ. I cannot therefore give much weight to this letter as evidence of a formal relationship between TNTJ and UKTJ. While there is no dispute that a group of UKTJ members dissociated from TNTJ, there is no documentary evidence as to the legal effects, if any, of such an action.

22. It appears to me that prior to the events of 2019 UKTJ was an unincorporated association. In *CLUB SAIL*, Mr Hobbs discusses in some detail the law relating to claims to proprietorship of goodwill acquired as a result of economic activities carried out collectively.<sup>13</sup> In paragraph 27, he sets out the following principles:

- a) The goodwill accrued and accruing to the members of an alliance formed in pursuit of shared interests and objectives is collectively owned by the members for the time being, subject to the terms of any contractual arrangements between them;
- b) When members cease to be members of an ongoing alliance, they cease to have any interest in the collectively owned goodwill, subject to the terms of any contractual arrangements between them;
- c) This allows the collectively owned goodwill to devolve by succession upon continuing members of the alliance down to the point at which the membership falls below two, when the “last person standing” becomes solely entitled to it in default of any other entitlement in remainder.

---

<sup>12</sup> Exhibit MI9.

<sup>13</sup> See paragraphs 26-31.



23. The opponent states that the applicant was expelled from UKTJ and his membership subscriptions refunded. Exhibit YH19 is an email to the applicant dated 8 April 2019 informing him that his membership of UKTJ has been terminated with immediate effect. Exhibit YH20 shows that a payment was made from the community bank account to the applicant on 15 April 2019.

24. The applicant claims that it was the opponent that ceased to be members of the alliance by deciding to start a separate organisation, the Tamil Muslim Dawah Centre. Apart from the witness statement of Mr Ziyavudeen, to which I have already referred, the evidence to support this claim is a screenshot of a Whatsapp group created on 10 March 2019 and which had five members.<sup>14</sup> Counter-Exhibit MI15 is the undated Constitution of Tamil Muslim Dawah Centre Croydon, but there is nothing in this document to associate it with the opponent. In his second witness statement, Mr Hussain for the opponent submits that this evidence does not prove what the applicant is claiming. I agree. It is entirely possible that a group of people might wish to set up separate, or connected, organisations for specific purposes.

25. Furthermore, although Mr Isacc states that he and other members continued to function as UKTJ with their own management committee, he has provided no evidence of activities undertaken by his organisation or given any further details of meetings held. In *CLUB SAIL*, Mr Hobbs said:

“... when assessing the evidence in the witness statements it is appropriate to do so from the perspective identified by Lord Bingham of Cornhill in Fairchild v. Glenhaven Funeral Services Ltd [2002] UKHL 22; [2003] 1 AC 32 (HL) at paragraph [13]:

‘... And I think it is salutary to bear in mind Lord Mansfield’s aphorism in *Blatch v. Archer* (1774) 1 Cowp 63 at 65, 98 ER 969 at 970 quoted with approval by the Supreme Court of Canada in *Snell v. Farrell*:

---

<sup>14</sup> Counter-Exhibit MTZ 2.

“It is certainly a maxim that all evidence is to be weighed according to the proof which it was in the power of one side to have produced, and in the power of the other to have contradicted.”<sup>15</sup>

It should have been within the power of the applicant to have produced evidence of the activities of this management committee.

26. The standard of proof required is proof on the balance of probabilities. On the basis of the evidence before me, I find it probable that the opponent represents the organisation that was founded in March 2016 by Mohamed Ali, Jawahar Ali and Ansari, at least two of whom were active members at the time the contested application was made. There is no evidence that indicates that there were any conditions that prevented them from using the name, and this is ultimately why the precise nature of the allegations made by both parties about the conduct of individuals involved with either UKTJ or TNTJ has had no bearing on my decision.

27. The opponent is therefore entitled to bring an opposition action under section 5(4)(a).

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

28. Section 5(4)(a) of the Act states 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 –

(a) by virtue of any rule or 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 4(A) is met

...”

---

<sup>15</sup> Paragraph 39.

29. Subsection 4(A) is as follows:

“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.”

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

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”<sup>16</sup>

### **Goodwill**

31. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217:

---

<sup>16</sup> Page 406.

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

32. While passing off claims usually involve businesses, charitable or other not-for-profit organisations may also seek to protect their goodwill to maximise their support. In *British Diabetic Association v Diabetic Society Ltd* [1996] FSR 1 (1995), Walker J concluded at [10] that:

“... the scope of a passing off action is wide enough to include deception of the public by one fund-raising charity in a way that tends to appropriate and so damage another fund-raising charity’s goodwill – that is, the other charity’s ‘attractive force’ (see Lord Macnaghten in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217, 233] in obtaining financial support from the public.”

33. The opponent claims to have used the sign **UNITED KINGDOM THOWHEED JAMATH** for a long list of services (see paragraph 3 above). I shall begin by setting out the use that is shown in the evidence.

34. Mr Hussain states that UKTJ was launched on 6 March 2016 and that invitation emails were sent to “the community and the members”.<sup>17</sup> It is not clear how many people received them. A draft of the email can be found in Exhibit YH5.

35. Mr Hussain also states that UKTJ has conducted weekly Friday prayers, provided monthly religious lessons for men, women and children, run blood donation sessions

---

<sup>17</sup> First witness statement, paragraph 8.

and lectures, and organised events during the month of Ramadan and to celebrate Eid.<sup>18</sup> He does not say how many people attended and, while he states that the organisation currently has 50 members, there is no information on how large the membership was at or before the date of application for the contested mark.

36. He does give details of the income generated from members' subscriptions: £280 in 2016, £1790 in 2017, £2140 in 2018, £1035 in 2019 (although £665 was refunded to former members) and £170 from 1 January to 27 April 2020. However, it appears from the statement of the community bank account in Exhibit YH12 that these are not the only funds raised. As of November 2018, the balance was considerably higher (over £8000). Some payments to the account bear the reference "Community Fund". The email in Exhibit YH21 confirms that

"The Community Centre's Fund will be refunded fully if the fund will not be utilised for the core purpose within the set date/time frame."

No further information is given.

37. The evidence suggests that the organisation used social media to publicise its activities. In a witness statement, Mr Mohamed Sadiq Sarbudeen, a member since February 2017, says that he joined the organisation after seeing information on Facebook and Whatsapp about Friday prayers.<sup>19</sup> Mr Rafeeq Ahmed Sulaiman also refers to Whatsapp activity in his witness statement.<sup>20</sup> Very few examples have been provided but Exhibit YH23 contains a post from Facebook dated 19 April 2017 on the first blood donation event.

38. Booking forms in the name of Mr Hussain indicate that Eid prayer events were arranged to take place in Wandle Park, Croydon, in June 2018 and June 2019. Both forms give expected attendance figures of 100.<sup>21</sup> However, there is no evidence showing how many people were in fact present.

---

<sup>18</sup> First witness statement, paragraphs 7 and 10.

<sup>19</sup> Exhibit YH4-B.

<sup>20</sup> Exhibit YH4-A.

<sup>21</sup> Exhibits YH7 and YH8.

39. Goodwill does not have to be large to be protected, but it must be more than trivial. In *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*, BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman and Erven Warnink B.V. v J. Townend & Sons (Hull) Ltd* [1980] RPC 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”<sup>22</sup>

40. The extent and reach of UKTJ's activities are unclear from the evidence before me. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J stated:

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

---

<sup>22</sup> Paragraph 34.

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

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

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent’s reputation extends to the goods comprised in the application in the applicant’s specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”<sup>23</sup>

42. There is no evidence at all of the following services: sporting and cultural activities; publishing; publications (not downloadable) from databases or the Internet; arranging and conducting conferences, seminars, exhibitions, awards and competitions; consultancy, information and advisory services relating to all the aforesaid services; providing community centres for social gatherings and meetings; consultancy, information and advisory services relating to the aforesaid services; consultancy, information and advisory services relating to religious services and the organisation of religious meetings. I cannot therefore find protectable goodwill in relation to these services.

---

<sup>23</sup> Paragraph 8.

43. The remaining services for which the opponent claims to have been using the sign are *Education, training, religious services and organisation of religious meetings*. Although Mr Hussain and Mr Sarbudeen mention religious education in their witness statements, as does Mr Abuthahir Sahul,<sup>24</sup> they give no information on how many people used the services or whether they were delivered through the whole of the period from March 2016 to the date of application for the contested mark. The evidence is insufficient for me to find that the organisation had a protectable goodwill for education or training at the date of application for the contested mark.

44. There are similar shortcomings with regard to the evidence for religious services and the organisation of religious meetings. I can accept that some religious meetings and activities were organised. For example, the witness statements refer to Friday prayers, which by definition will have taken place weekly, and the applicant has not challenged this aspect of the opponent's evidence. Nevertheless, it is not stated how many people attended these meetings, nor the size of the Tamil-speaking Muslim community around Croydon, which the organisation was founded to support. I find the evidence insufficient to establish that the organisation had a protectable goodwill for religious services and the organisation of religious meetings at the date of application for the contested mark.

45. The section 5(4)(a) ground fails.

### **Section 3(6)**

46. Section 3(6) of the Act is as follows:

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

47. 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 specific context of trade: see *Sky plc & Ors v Skykick UK Limited & Anor*, Case

---

<sup>24</sup> Exhibit YH28.



C-371/18, paragraph 74. Trade marks serve to distinguish one undertaking's goods or services from others which have a different origin.

48. In *Gromax Plasticulture Limited v Don and Low Nonwovens Ltd* [1999] RPC 367, Lindsay J said that "bad faith"

"... includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined."

49. It is important to note that an allegation of bad faith is a serious allegation that must be distinctly proved. It is not enough to prove facts that are as consistent with good faith as bad: see *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), paragraph 133.

50. The correct approach to the assessment of bad faith claims is to determine, first, in concrete terms, the objective that the applicant has been accused of pursuing; second, whether that was an objective for the purposes of which the contested application could not properly be filed; and third, whether the contested application was filed in pursuit of that objective: see *Alexander Trade Mark*, BL O/036/18.

51. The applicant's intention 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: see *Chocoladefabriken Lindt & Sprüngli v Franz Hauswirth GmbH*, Case C-529/07.

52. The matter must be judged at the relevant date, which is the date of the application for registration: see *Lindt*. It is necessary to ascertain what the applicant knew at the relevant date: see *Red Bull GmbH*. The relevant date here is 12 April 2019. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2009] RPC 9 (approved by the Court of Appeal [2010] RPC 16).

53. The opponent submits that the applicant knew that the opponent was the legitimate user of the mark and that he intended to obstruct the opponent's use of the name. In *Saxon Trade Mark* [2003] EWHC 295 (Ch), Laddie J. held that:

“38. As indicated above, I disagree with Mr Foley's conclusion that Mr Oliver and Mr Dawson had a right to claim to be the owners of the mark. Furthermore, inherent in the statement that Mr Oliver “got there first”, is the recognition that ownership of the mark gave the proprietors the right to interfere with the use of the same mark by others in relation to the same goods and services. That Mr Oliver and Mr Dawson could use it to interfere, not just with other former partners in the original band, but also with the current band. As a result of the March 2001 letter referred to above, it can be seen that the ability to interfere is not a hypothetical possibility.

39. As Lindsay J. said, each case must be decided on its own facts. Here the proprietors have obtained registration of SAXON simpliciter even though they have no existing title to it and have done so for the purpose of interfering with the rights of others who do and have consistently used the mark....In my view this is bad faith within the meaning of the section.”

54. It is not in dispute that, at the time of his resignation, the name UNITED KINGDOM THOWHEED JAMATH was being used by the organisation of which he had been president. The applicant could not have been unaware of this fact.

55. The mere fact that the applicant knew that another party used the mark in the UK does not in itself establish bad faith: see *Lindt, Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ v EUIPO*, Case C-104/18 P (paragraph 55). An applicant may have reasonably believed that it was entitled to apply to register the mark: see *Hotel Cipriani*, paragraph 189.

56. Earlier in my decision, I found that, on the balance of probabilities, the opponent was entitled to use the name UNITED KINGDOM THOWHEED JAMATH. I have seen no document that supports the position that this name can only be used with the permission of TNTJ. The applicant resigned from his office as president and an acting president was appointed. It appears probable to me that the applicant was intending

to prevent the opponents from using the name: indeed, as I discuss in more detail below, he refers to himself and his associates as the “rightful owners” of the name. In my view, an application to register a trade mark by a former office holder of an organisation with the intention of interfering with that organisation’s own use of the name would *prima facie* constitute bad faith within the meaning of section 3(6) of the Act.

57. Once the opponent has established a *prima facie* case, it is for the applicant to persuade me that the facts are as consistent with good faith as bad. Again, I make the point that my assessment must be in the context of trade marks.

58. Throughout the hearing, the applicant maintained his position that he represented the rightful owners of the name. I have already found, on the balance of probabilities, that the opponent is the original UKTJ and there is no evidence to support the view that any organisation using the name United Kingdom Thowheed Jamath must have a connection with TNTJ. Given that lack of evidence, I find that the account of the reasons for the dissociation are not relevant to my consideration of whether the application for the trade mark was made in bad faith.

59. I have considered Mr Isacc’s submissions at the hearing that the use of United Kingdom Thowheed Jamath by the opponent was liable to mislead the community into thinking that there was a connection with TNTJ. These submissions may have had more force if there had been evidence that the applicant was also using the name or that TNTJ had any proprietary rights over the words “Thowheed Jamath”. Even then, I would have needed to weigh all the evidence in the balance to come to my decision.

60. The evidence filed by the applicant does not, in my view, rebut the opponent’s *prima facie* case. Consequently, I find that the aim of the application was to interfere with the activities of the opponent. The filing of an application for a trade mark with the intention of stopping others from using a name that they had been using, even if not to the extent to create protectable goodwill, is, in my view, an action that falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced people in the particular area.

61. The section 3(6) claim succeeds.

## **OUTCOME**

62. The opposition has been successful and the application will be refused.

## **COSTS**

63. The opponent has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice (TPN) 2/2016. In the circumstances, I award the opponent the sum of £1600 as a contribution towards the cost of the proceedings. The award reflects the fact that the opponent neither attended the hearing nor filed any submissions after the evidence round. The sum is calculated as follows:

*Preparing a statement and considering the other side's statement: £400*

*Preparing evidence and considering the other side's evidence: £1000*

*Official fee: £200*

***TOTAL: £1600***

64. I therefore order Mohamed Ibthigar Mohamed Isacc to pay UKTJ Limited the sum of £1600, which 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 13<sup>th</sup> day of July 2021**

**Clare Boucher**

**For the Registrar,**

**Comptroller-General**