

o/815/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003507862

BY RL MEDIA LIMITED

TO REGISTER THE TRADE MARK:



IN CLASSES 35, 38 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 421917

BY TOTAL FAN TV LIMITED

BACKGROUND AND PLEADINGS

1. On 3 July 2020, RL MEDIA LIMITED (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 31 July 2020.

2. The applicant seeks registration for the following services:

Class 35: Advertising and marketing; Advertising and marketing services; Advertising and marketing services provided by means of blogging; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotional services; Advertising services provided over the internet; Advertising services provided via the internet; Advertising; Advertising, marketing and promotion services; Marketing; Marketing, advertising and promotion services; Marketing, advertising, and promotional services; Promotion [advertising] of business; Promotion of goods and services for others; Promotion of sports competitions and events; Promotion services; Promotion, advertising and marketing of on-line websites.

Class 38: Broadcasting of programmes via the internet; Satellite broadcasting services relating to sporting events; Audio and video broadcasting services provided via the Internet; Audio, video and multimedia broadcasting via the Internet and other communications networks; Broadcasting of video and audio programming over the Internet; Streaming audio and video material on the Internet; Streaming of video material on the internet; Broadcasting of audiovisual and multimedia content via the Internet; Internet based telecommunication services; Internet broadcasting services; Transmission of multimedia content via the Internet; Transmission of user-generated content via the Internet; Transmission of video by means of the Internet; Transmission of videos,

movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet.

Class 41: Entertainment agency services; Entertainment by IP-TV; Entertainment by film; Entertainment by means of radio; Entertainment by means of telephone; Entertainment by means of wireless television broadcasts; Entertainment in the form of television programmes (Services providing -); Entertainment in the nature of mobile phone television; Entertainment in the nature of soccer games; Entertainment services; Entertainment services for sharing audio and video recordings; Entertainment services in the form of television programmes; Entertainment services in the nature of interactive television programmes; Entertainment services in the nature of sporting events; Administration [organisation] of entertainment services; Arranging of entertainment shows; Conducting of entertainment activities; Education, entertainment and sport services; Education, entertainment and sports; Fan club services (entertainment); Film production for entertainment purposes; Information about entertainment and entertainment events provided via online networks and the Internet; Information relating to entertainment, provided on-line from a computer database or the internet; Interactive entertainment; Interviewing of contemporary figures for entertainment purposes; On-line entertainment; Online interactive entertainment; Organising of entertainment; Preparation of entertainment programmes for broadcasting; Providing entertainment information via a website; Providing video entertainment via a website; Provision of entertainment information; Provision of entertainment information via television, broadband, wireless and on-line services; Provision of entertainment information via the Internet; Provision of entertainment via podcast; Provision of information relating to entertainment online from a computer database of the Internet; Provision of on-line entertainment; Entertainment; Entertainment services provided by on-line streams; Entertainment services provided by television; Services for the production of entertainment in the form of video; Television and radio entertainment; Television entertainment; Tv entertainment services;

Video entertainment services; Entertainment in the nature of football games; Video recordings [not downloadable] provided from the internet; Providing online videos, not downloadable; Entertainment provided via the internet; Entertainment services provided on-line from a computer database or the internet; Sporting results services; Sports and fitness; Sports entertainment services; Sports information services; Entertainment services relating to sport; Entertainment services relating to sporting events; Organisation of sports events in the field of football; Providing information about sporting activities; Providing information relating to sports; Providing sports entertainment via a website; Providing sports information; Providing sports news; Provision of information relating to sporting events; Provision of information relating to sports; Provision of information relating to sports persons; Provision of news relating to sport; Organising of football events; Provision of entertainment information via the Internet.

3. The application was opposed by Total Fan TV Limited (“the opponent”) on 2 November 2020. The opposition is based upon sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”).

4. For the purposes of its opposition based upon section 5(4)(a) of the Act, the opponent relies upon the word only sign **AFTV** (“the First Earlier Sign”) as well as the following sign:



(“the Second Earlier Sign”)

5. The opponent claims to have used these signs throughout the UK since 2018 in relation to the following goods and services:

Goods: clothing and hats

Services: advertising and marketing services; broadcasting services, including podcasting services, internet broadcasting services, transmission of videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the internet; entertainment services, including entertainment services for sharing audio and video recordings, providing video entertainment via a website, entertainment services provided by on-line streams, sports entertainment services.

6. Under section 3(6), the opponent claims that the application was made in bad faith because the applicant's Mr Robin Lyle and Mr Tao Weitzer were directors and employees of the opponent company when it had changed its name from ArsenalFanTV, to AFTV and created its AFTV logo. The applicant therefore knows the opponent owns the AFTV mark and "the application has been filed as part of the improper attempts to take away the "AFTV" business from the opponent".

7. The applicant filed a counterstatement denying the claims made.

8. The opponent is unrepresented, and the applicant is represented by Stobbs. Only the opponent filed evidence in chief. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

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

EVIDENCE AND SUBMISSIONS

10. The opponent filed evidence in chief in the form of the witness statement of Mrs Simone Davids-Lyle, which is dated 11 May 2021. Mrs Davids-Lyle is the sole director and shareholder of the opponent. Mrs Davids-Lyle's statement was accompanied by 1 exhibit (SDL1). I note that the opponent also filed written submissions.

11. Whilst I do not propose to summarise those here, I have taken them into consideration and will refer to them below where necessary.

DECISION

Section 5(4)(a)

12. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

13. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.”

14. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

15. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then

to assess whether the position would have been any different at the later date when the application was made.”

16. As the applicant has filed no evidence of use, I have only the prima facie relevant date to consider i.e. 3 July 2020.

Goodwill

17. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“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 customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

18. 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 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

19. 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.”

20. Goodwill arises as a result of trading activities. It is clear from the evidence and narrative provided by Mrs Davids-Lyle that the opponent has been trading under the ArsenalFanTV sign since 2012, specifically in regard to their YouTube channel. In 2017, Arsenal Football Club objected to the use of their sign in ArsenalFanTV. Pursuant to a settlement, the opponent agreed to change their name and trade under the sign AFTV. Consequently, their YouTube channel and other social media accounts all changed their name from ArsenalFanTV to AFTV (the First Earlier Sign). The new AFTV logo, the Second Earlier Sign, was first featured on the YouTube Channel on the 31 July 2018, as demonstrated in exhibit SDL1.¹

21. I note the following subscriber figures for the ArsenalFanTV/AFTV channel:²

¹ Page 2

² Figures were provided in Mrs Davids-Lyle's witness statement and supported with screenshots in SDL1

11 April 2013	8,884
18 January 2014	68,356
11 January 2015	135,038
21 February 2016	199,184
26 October 2016	279,759
2 September 2017	534,134
16 August 2018	824,262
6 September 2018	837,210
30 August 2019	1,039,852

22. The YouTube channel screenshots dated from 16 August 2018 onwards use the First Earlier Sign as the name of the channel and the Second Earlier Sign at the beginning of the opponent's videos, and on the AFTV's YouTube Channel's banner and profile picture.³

23. Exhibit SDL1 contains a screenshot of a video called "SHOWDOWN: GARY NEVILLE Meets ArsenalFanTV (Ft DT, Troopz, Claude & Moh)" dated 17 February 2017.⁴ I note that by 20 February 2017, just three days after it was uploaded, the video had already gained 918,952 views. Mrs Davids-Lyle gives evidence that due to this video, the total views for the AFTV YouTube channel increased to approximately 20 million, with its YouTube revenue increasing significantly and AFTV obtaining a much higher profile.

23. Mrs Davids-Lyle gives evidence that the total revenue earned from AFTV's YouTube channel is "in excess of £1.9 million" since it was established in 2012. Exhibit SDL1 contains an email which breaks down AFTV's earnings, by year, from November 2012 to December 2016.⁵ Although the total earnings from YouTube only amounted to £118,096.00 during this period, this is in line with Mrs Davids-Lyle's above evidence, that its Gary Neville video increased the opponent's YouTube revenue significantly from 2017 onwards. It is important to note that the AFTV sign was also used from 2018 onwards. The email also contains a breakdown from the AFTV merchandise store

³ Pages 117 and 118

⁴ Page 134

⁵ Pages 91-92

earnings for the period of January 2015 to December 2016 which amounted to £39,625.94. It is noted within the email that these figures did not include sponsored advertising earnings.

24. Mrs Davids-Lyle highlights that as a result of the above Gary Neville 2017 video, AFTV obtained more lucrative sponsorship, endorsement and advertising opportunities. I note that only one agreed endorsement is exhibited in SDL1 which postdates the 2017 video; however, it does demonstrate a significant increase in payment from its previous agreements. The following are exhibited in SDL1:

- Page 12 in an invoice issued by the opponent to EveryFan Operations Ltd for an advert for EveryFan dated 21 November 2016 for the sum of £2,000.
- Page 11 is an invoice issued by the opponent to Calibre30 for the 888sport Gary Neville interview sponsorship dated 22 February 2017 for the sum of £4,000.
- Pages 53 and 54 show an endorsement deal between the opponent and United Football Fans of Africa (UFF). This content agreement shows that UFF agreed to pay £500 for its content per month for the first six months of the agreement. It is dated 30 March 2017. However, I note that it is unsigned, and that Mrs Davids-Lyle has not confirmed whether this agreement was officially entered.
- Page 99 is an invoice issued by the opponent to Ball street for monthly frees due in respect of Ladbrokes advertising on the AFTV channel dated 30 June 2017 for the sum of £15,000.00.

25. In exhibit SDL1, Mrs Davids-Lyle also highlights that AFTV has won the following Football Blogging awards:

- ArsenalFanTV picked up the Snack Media Award for Best Overall Football Content Creator 2018. I note that Niall Coen, CEO of SnackMedia, who organised the event said that “no one can deny the impact that they have had on football over the last 18 months. Congratulations to Robbie & The ArsenalFanTV team for a much-deserved victory”.

- At the Football Blogging Awards 2019, AFTV was one of the biggest winners of the night picking up 5 awards for their channels including Best Overall Content Creator with Snack Media, Best Young Content Creator with Mitre and Best Podcast. I note that they refer to the opponent using the First Earlier Sign.

26. Lastly, in exhibit SDL1, Mrs Davids-Lyle provides multiple examples of where ArsenalFanTV and AFTV (The First Earlier Sign) have been reported in the media, especially in regard to its name change. It is important to highlight that the articles provided in exhibit SDL1 give background facts and figures for the ArsenalFanTV YouTube channel. I note the following from The Sun (13 August 2018), The Independent (14 August 2018) and The Mail Online (14 August 2018) articles:

- ArsenalFanTV was set up in October 2012.⁶
- The 2018 articles report that ArsenalFanTV has just over 820,000 subscribers.⁷
- The 2018 articles report that ArsenalFanTV has a total number of views of 487,500,000 across its 9,129 uploaded videos.⁸
- The Independent 2018 article notes that ArsenalFanTV's Twitter has 285,000 followers.⁹

27. I note that all of the articles report that ArsenalFanTV has rebranded itself to AFTV (the First Earlier Sign), changing their Twitter and Instagram handles.

28. Although, I am not provided with market share figures, the opponent provides in exhibit SDL1 a Prolific London article dated 3 January 2020. It reports that "Arsenal Fan TV (AFTV)" is ranked the UK's highest-earning fan sports channel on YouTube with 1.1 million subscribers, and "earns \$357,039 a month".¹⁰

29. I note that there is very little evidence in relation to the goods (clothing and hats). Although I am provided the above figure of £39,625.94 relating to the sale of

⁶ Pages 162, 169 and 178.

⁷ Pages 162 and 169.

⁸ Pages 162 and 169.

⁹ Page 173.

¹⁰ Pages 184-185.

merchandise for the period of January 2015 to December 2016, this is not broken down into specific goods and there are only two screenshots in exhibit SDL1 of the aftvstore website showing the clothing that they sell, both of which are undated.¹¹ The Sun article dated 16 July 2020 highlights that “AFTV even flogs its own merch, selling hoodies for £34.99 and trucker hats for £24.99”. However, I am not provided with any sales figures for these goods. I also note that there is minimal evidence in relation to the advertising and marketing services, such as the above invoices for EveryFan and Ladbrokes. There is also minimal evidence in relation to broadcasting services, including podcasting services, internet broadcasting services, transmission of videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the internet. A broadcast is defined as “a programme, performance, or speech on the radio or the television”.¹² Even if YouTube itself is a broadcasting service, the opponent is only creating the content which is then uploaded onto YouTube. YouTube is then the platform which broadcasts the video. Consequently, I do not consider that the opponent is providing the broadcasting services. However, I note that the opponent has provided evidence of an award won by AFTV for Best Podcast at the Football Blogging Awards 2019 in regard to its podcasting services. Therefore, taking the above into account, due to the lack of evidence, I do not consider that the opponent has demonstrated goodwill for the above goods and services at the prima facie relevant date.

30. It is important to note that the applicant claims that the rights and ownership of the AFTV name and logo belong to them. However, the applicant has filed no evidence to explain why any goodwill would have accrued to it (rather than the opponent), or indeed, why it might have accrued to Mr Lyle and/or Mr Weitzer personally. Based upon the opponent’s unchallenged evidence, as demonstrated above, it is the opponent who has used the AFTV signs and operated the AFTV YouTube channel. Consequently, I find that any goodwill would have accrued to the opponent.

31. Taking the evidence as a whole into account, I am satisfied that the opponent has demonstrated a reasonably strong degree of goodwill prior to the relevant date in

¹¹ Page 95 and 199.

¹² <https://www.collinsdictionary.com/dictionary/english/broadcast>

relation to entertainment services, including entertainment services for sharing audio and video recordings, providing video entertainment via a website, entertainment services provided by on-line streams, sports entertainment services. Examples have been provided of the signs being used in relation to their YouTube channel which is the UK's highest-earning fan sports channel, with over a million subscribers. In light of this, I am also satisfied that both the First and Second Earlier Signs were distinctive of the opponent's goodwill at the relevant date.

Misrepresentation and damage

32. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite

of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

33. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

34. The Second Earlier Sign is identical to the applicant’s mark. The First Earlier Sign consists of the letters AFTV. These letters all appear identically in the applicant’s mark. The difference is that in the applicant’s mark, the letters AFTV are slightly slanted, in a white font, against a red circular background. A circle device with a red triangle also appears over the bottom of the letter V in the applicant’s mark. The differences in colour and stylisation do not, to my mind, create a point of significant difference taking into account notional and fair use. I also consider that the red triangle device, which is likely to be recognised as a play button device, does not create a significant point of difference because it reinforces the “TV” element in AFTV. Consequently, I consider the First Earlier Sign to be highly similar to the applicant’s mark.

35. I have found that at the relevant date, the opponent had a reasonably strong degree of goodwill in relation to entertainment services, including entertainment services for sharing audio and video recordings, providing video entertainment via a website, entertainment services provided by on-line streams, sports entertainment services, and that the signs relied upon were distinctive of that goodwill. The applicant’s mark also covers a range of entertainment services in class 41. I consider that all of these services are likely to fall within the same field of activity.

36. The applicant’s mark also covers a range of broadcasting and transmission of multimedia/video services in class 38. I consider it likely that the same business could

provide both the class 38 services and the services for which the opponent has demonstrated goodwill. For example, many TV channels such as the BBC provides both its broadcasting services in conjunction with its entertainment services. I, therefore, consider that there will be some overlap in fields of activity.

37. Lastly, the applicant's mark also covers a range of advertising and marketing services in class 35. I consider it likely that the same business could provide both the class 35 services and the services for which the opponent has demonstrated goodwill. For example, many TV channels offer both entertainment services and advertising services to allow companies to advertise their goods and services within the ad breaks. I also note that, those who provide entertainment services via YouTube, such as channels and content creators, commonly offer advertising services to allow other businesses to advertise during their videos. Consequently, I consider that there will be some overlap in fields of activity.

38. In its Form TM8, the applicant highlights that Mr Robin Lyle is the owner of the applicant company. In its witness statement, Mrs Davids-Lyle gives evidence that the applicant was incorporated by Mr Robin Lyle and Mr Tao Weitzer on 11 September 2018. This evidence is unchallenged. It is clear from the evidence provided that Mr Lyle and Mr Weitzer had a relationship with the opponent. The following are exhibited in SDL1:

- Director meeting minutes dated 29 November 2013 naming Mrs Davids-Lyle, Mr Lyle and Mr Weitzer all as directors.
- A draft Share Purchase Deed for the sale of the opponent to Ball Street. Mrs Davids-Lyle, Mr Lyle and Mr Weitzer are all named as sellers.
- An email regarding Mr Lyle and Mr Weitzer's responsibilities as directors and Mrs Davids-Lyle being a shareholder of TFT, which I consider is the abbreviation of the opponent, dated 23 June 2017.
- Barclays business current account statement for the opponent dated 21 October to 21 November 2017. I note from this evidence, three payments of £1,000 were made to "On-Line Banking Bill payment to Robin Lyle" on 25 October, 30 October and 6 November.

- A letter from Level Law to Arsenal Football Club dated 17 November 2017. The opening paragraph reads as follows; “We act for Total Fan TV Limited. Please note that despite your initial correspondence being addressed to Mr Robin Lyle (for whom we also act) the ArsenalFanTV service and business is in fact owned and operated by Total Fan TV Ltd.”
- An email from Mr Lyle to Mrs Davids-Lyle and Mr Weitzer, with the subject heading “TotalFanTV Directors meeting” dated 16 July 2018. This includes the discussion of “the rebranding of AFTV following the Arsenal court case”.
- Mr Lyle is named in all of the online newspaper articles contained in exhibit SDL1 as the creator of the ArsenalFanTV/AFTV YouTube Channel (all dated August 2018).
- Mr Lyle’s P45 dated 30 November 2018 leaving the employment of the opponent.
- Mr Weitzer’s P45 dated 30 November 2018 leaving the employment of the opponent.
- Barclays business current account statement for the opponent dated 22 November to 21 December 2018. I note from this evidence, a payment of £200 on 7 December, and a payment of £1,300.00 on the 11 December were made to “On-Line Banking Bill payment to Robin Lyle”.
- An invoice from El Seven for the total of £1,600, dated 29 December 2018, addressed to TotalFanTV and “Robb e Ly e”, which I consider is a misprint of Robbie Lyle.
- The Football Blogging Awards name Robbie Lyle and quote him as he received the 2018 award for ArsenalFanTV.
- The Opponent’s Annual report and unaudited financial statements for the period ended 31 March 2019, whereby Mr Lyle and Mr Weitzer are named Directors.
- A printout from the Companies House website dated 5 June 2021. This shows that Mrs Davids-Lyle, Mr Lyle and Mr Weitzer were all Directors of the opponent. I note that Mrs Davids-Lyle was appointed on 6 November 2012 and is still an active director. Mr Lyle was appointed on 2 February 2017, and Mr Weitzer was appointed on 29 November 2012. However, both Mr Lyle’s and Mr Weitzer’s roles are resigned.

39. Taking the above into account, the evidence overwhelmingly demonstrates that Mr Lyle and Mr Weitzer were directors and employees of the opponent at the time that ArsenalFanTV changed to AFTV and created the AFTV logo. From the evidence provided in exhibit SDL1, it is clear that the AFTV logo was being used as early as the 31 July 2018 whereby the AFTV logo is displayed on the t-shirt of the presenter in the video.¹³ I also note that evidence has also been provided of its use at the beginning of a video dated 14 August 2018¹⁴ and use on the AFTV YouTube banner from the 16 August 2018.¹⁵ Consequently, Mr Lyle would have known of the opponent's goodwill and use of the signs in the UK. I, therefore, consider that the applicant (by virtue of Mr Lyle's knowledge) must have recognised that trading in, at the very least, the services that were within the same field of activity had potential to cause members of the relevant public to be misled. I consider it likely that by registering the identical AFTV mark, the applicant had an intention to deceive the relevant public. In any event, even without this intention, taking into account the identity, and similarity, between the signs and the mark in issue, I consider that there is a likelihood that a substantial number of members of the relevant public would be deceived by the use of the applicant's mark in relation to those services that are within the same field of activity, or have some overlap in field of activity. I consider that a substantial number of members of the relevant public would be misled into purchasing the applicant's services in the mistaken belief that they are the services of the opponent. Damage through diversion of revenue is easily foreseeable.

40. The opposition based upon section 5(4)(a) succeeds in its entirety.

Section 3(6)

41. 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.”

¹³ Page 2

¹⁴ Page 117

¹⁵ Page 118

42. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].
2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].
3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].
4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other

sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].
6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].
7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].
8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].
9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].
10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].
11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].
12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the

applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]”.

43. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith 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 could not be properly filed? And
- (c) Was it established that the contested application was filed in pursuit of that objective?

44. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *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).

45. The relevant date in this case is 3 July 2020.

46. In its Form TM7, the opponent states:

“The opponent was incorporated on 6 November 2012 for the purpose of owning and operating what was then known as “Arsenal Fan TV”. For the period from its incorporation until November 2018, revenue from “Arsenal Fan TV” was

accounted for via the opponent. The opponent's position is that at all material times it owned (and still owns) "Arsenal Fan TV" (now called "AFTV").

Robin Lyle (RL) was a director of the opponent between 2 February 2017-25 November 2020. Tao Weitzer (TW) was a director of the opponent between 15 November 2013-5 February 2021. During the year 2018 (until 30 November 2018), RL and TW were also employed by the opponent.

In the summer of 2018, "Arsenal Fan TV" changed its name to "AFTV" and created a new logo that is subject of the opposed trade mark application. The new logo was first used in a video posted on YouTube on 11 August 2018.

On 11 September 2018, RL and TW incorporated the applicant. From November 2018, despite "AFTV" being owned by the opponent, RL and TW have taken steps to divert all revenue earned by "AFTV" to the applicant.

On 3 July 2020, the applicant filed the opposed trade mark application for the "AFTV" logo that was created in August 2018 whilst RL and TW were directors and employees of the opponent.

The applicant (via the knowledge of its directors, RL and TW) knows that the opponent owns the "AFTV" business, including the "AFTV" logo that is the subject of the opposed application. The application has been filed as part of improper attempts to take the "AFTV" business from the opponent.

As a result, the opposed application is made in bad faith. The applicant is seeking to lay its hands on the trade mark of another and its conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people."

47. In summary, the opponent claims that the applicant had prior knowledge of its trade mark as a result of its prior business relationship with Mr Robin Lyle and Mr Tao Weitzer and that registering an identical mark falls below the standards of acceptable

commercial behaviour. The opponent also claims that this is part of a pattern of behaviour of the applicant attempting to divert revenue from the opponent.

48. As highlighted above, in the evidence that Mrs Davids-Lyle provides in exhibit SDL1, a previous relationship is established between the opponent, Mr Robin Lyle and Mr Tao Weitzer. It is also established that that Mr Robin Lyle was a director and was employed by the opponent before the relevant date. I note that this is contrary to the applicant's pleaded case in their Form TM8 that "at NO point in time was Robin Lyle (owner of the applicant company) an employee of the opponent company". However, based on the evidence outlined above, particularly the P45, I am satisfied that he was.

49. Professor Ruth Annand, sitting as the Appointed Person, held in *Joseph Yu v Liaoning Light Industrial Products Import and Export Corporation* (BL O/013/15) that:

"22. [A] claim of bad faith is not avoided by making an application in the name of an entity that is owned or otherwise controlled by the person behind the application."

50. Consequently, I consider that any knowledge attributed to Mr Lyle and Mr Weitzer can also be attributed to the applicant by virtue of their roles as directors.

51. I accept that prior knowledge of a trade mark may amount to bad faith in some circumstances. The case law is clear that the mere fact that the applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton*. However, in this instance it is clear that Mr Robin Lyle and Mr Tao Weitzer were directors of and employed by the opponent. They were involved in the opponent's business during the time that ArsenalFanTV changed to AFTV, created and started using the AFTV logo, which was as early as the 31 July 2018. On 11 September 2018, the applicant was incorporated by Mr Robin Lyle and Mr Tao Weitzer, and on the 30 November 2018 they filed their P45's. I consider that this prior business relationship supports the opponent's prima facie case of bad faith, and points towards the fact that the application has been made with the intent of blocking another business' legitimate interest in the UK.

52. In her witness statement, Mrs Davids-Lyle further stated:

“9. Since around November 2018, RL and TW have diverted all revenue from ArsenalFanTV/AFTV to the Applicant (or other related companies that they have set up). On 3 July 2020, the Applicant made their current Application. This Application is part of RL and TW’s attempts (via their new corporate vehicles) to unlawfully take ArsenalFanTV/AFTV from TFTL. It is for this reason that TFTL alleges that this application has been made in “bad faith”.”

53. I note that this evidence is unchallenged by the applicant.

54. Taking all of the above into account, I consider that to apply to register a trade mark that you know is being used by a party which you had a previous relationship with, having been involved in the development of an identical sign for that business, falls below the ordinary standards of honest people. I am satisfied that the only motivation for the application was an illegitimate one. The applicant has filed no evidence to rebut the opponent’s prima facie case, either that there was an intention to block the opponent’s legitimate business by applying for an identical/highly similar mark or to divert business away from the opponent. Consequently, I consider that the applicant’s mark was filed in bad faith.

55. The opposition based upon section 3(6) succeeds in its entirety.

CONCLUSION

56. The opposition has been successful and the application is refused.

57. Awards of costs in these proceedings are based upon the scale published in Tribunal Practice Notice 2/2016. The opponent has been successful and would normally be entitled to a contribution towards its costs.

58. However, as the opponent is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the opponent and invited it to indicate whether it intended to make a request for an award of costs. The opponent was informed that, if so, it

should complete a Pro Forma, providing details of its actual costs and accurate estimates of the amount of time spent on various activities in the opposition. It was informed that “if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded”.

59. The opponent did not file a completed Pro Forma. That being the case I award the opponent the sum of £200 in respect of the official fee only.

60. I therefore order RL MEDIA LIMITED to pay Total Fan TV Limited the sum of **£200**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 3rd day of November 2021

L FAYTER

For the Registrar