

O/619/22

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 3306310
IN THE NAME OF DISHANT NAGPAL FOR THE TRADE MARK**

STORE INDYA

IN CLASSES 20 AND 21

AND

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO UNDER
NUMBER 503771 BY STORE INDYA UK LIMITED**

Background and pleadings

1. On 25 April 2018, Dishant Nagpal filed an application for the trade mark STORE INDYA in classes 20 and 21, for the following goods:

Class 20: Wood bedsteads; Wood boxes; Wood carvings; Wood crates; Wood door handles; Wood doorknobs; Wood knobs; Wood planters; Wood ribbon; Wood screws (Non-metallic -); Wood statues; Wood surrounds [furniture] for electric apparatus; Wood surrounds [furniture] for electronic apparatus; Wood window handles; Wooden barrels; Wooden beds; Wooden bedsteads; Wooden bins; Wooden blinds; Wooden boxes; Wooden boxes for storing toys; Wooden chests for the storage of toys; Wooden chests with drawers covered with decorated paper; Wooden containers [other than for household or kitchen use]; Wooden furniture; Wooden holders for signboards; Wooden ladders; Wooden picture mouldings; Wooden racks [furniture]; Wooden sculptures; Wooden sticks for holding candy or ice cream; Wooden storage boxes; Wooden tubs [not bath tubs].

Class 21: Incense burners; Incense burners [domestic]; Incense pots; Incense stick holders; Wooden chopping blocks [utensils]; Wooden chopping boards for kitchen use.

2. The application achieved registration on 27 July 2018. On 16 April 2021, Store Indya UK Limited (“the applicant”) filed an application to have the registration declared invalid, relying on section 5(4)(a) (via section 47(2)(b)) of the Trade Marks Act 1994 (“the Act”).

3. The applicant states that it first used the sign STORE INDYA throughout the UK on 26 October 2015, in relation to a list of goods corresponding exactly to the specification of the contested registration. The applicant claims that its goodwill and reputation in its business distinguished by the sign entitles it to prevent the use of the contested mark under the law of passing off. The applicant’s statement of case alleges that Mr Nagpal has been able to get the applicant’s goods de-listed from Amazon because he has the contested trade mark registration, thereby falsely taking ownership of the applicant’s listings.

4. Mr Nagpal filed a defence and counterstatement. He denies the ground and states that although his trade mark was registered on 27 July 2018, he has used the mark, in relation to the registered goods, since 2015. Mr Nagpal denies the applicant's claim to goodwill and reputation in STORE INDYA.

5. The applicant is represented by Lucria Ltd and Mr Nagpal by United Legal Experts. Both parties filed evidence. Neither party requested a hearing and neither filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers, referring to them as necessary.

Legislation

6. Section 47 of the Act states:

“47. (1)

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a)

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

...

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

...

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

7. Section 5(4)(a) states:

“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.”

8. Subsection (4A) of Section 5 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.”

9. The three elements which the opponent must show are well known. 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)."

10. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant 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 indicium which 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 two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which 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 claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (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 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”.

11. In a case where the contested mark is unused, it is the date when the application was made for the contested mark (in this case, 25 April 2018) which is the relevant date for the purposes of section 5(4)(a) of the Act. However, if the contested mark has been used prior to the date of application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about. If an applicant for registration was not passing off when it commenced use of the sign, a continuation of the same trade under the same sign is unlikely to amount to passing off at the application date.¹ In these proceedings, Mr Nagpal has filed evidence about use of his mark prior to 25 April 2018. I will make findings about the applicant’s claim to goodwill before looking at Mr Nagpal’s evidence to ascertain what bearing, if any, his evidence has on the relevant dates.

12. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 at 223:

¹ *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander QC, sitting as the Appointed Person.

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

Applicant’s evidence

13. The applicant’s evidence comes from Ashish Bhatnagar, who has been the applicant’s director since 2015. Mr Bhatnagar’s short witness statement is dated 25 October 2021, accompanied by five exhibits.

14. Mr Bhatnagar states that he bought the website storeindya.com on 8 May 2013. This was prior to the date of incorporation, 26 October 2015. Exhibit JS1 is a copy of the website purchase invoice. Mr Bhatnagar states that the applicant advertised its goods on amazon.co.uk under the brand STORE INDYA. Exhibit JS2 comprises five advertisement invoices which Mr Bhatnagar states were issued to the applicant by amazon.co.uk. I can see the supplier’s name as “Amazon Services Europe S.a.r.L.” on two of the invoices and “Amazon Online UK Limited” on the other three invoices. The “Business Name” is Store Indya UK Limited (the applicant). The five invoices are dated 31 March 2018; 31 January 2019; 31 October 2019; 31 December 2019; and 31 May 2020. Only one of these is dated prior to the relevant date (the 31 March 2018), and that precedes the relevant date by about three weeks. This particular invoice is from Amazon Services Europe S.a.r.L.. The ‘product ads fees’ listed in the invoice are dated between 3 March 2018 and 22 March 2018.

15. Mr Bhatnagar states that the applicant began importing “incense stick holders and other wooden items” into the UK on 19 May 2016 from its sister company in India, Store Indya Private Limited. Mr Bhatnagar states that the applicant sold products in “multiple classes” (which I take to be a reference to the Nice Classification system) but then states that he summarises the goods the applicant sold as “Class 20: - wooden storage boxes and other miscellaneous wooden items” and “Class 21: - Incense Stick Holder.” Exhibit JS3 comprises eleven invoices, showing Store Indya Private Limited (in India) as the exporter; the buyer as the applicant; and the consignee as

Amazon.co.uk Limited. Nine of the invoices are to Amazon.co.uk in Bedfordshire, Peterborough, Doncaster, Dunfermline and Staffordshire. The other two are to Amazon in Germany. The two 'German' invoices are both dated 23 February 2018 and appear to be duplicates. The other nine invoices are dated (in the order in which they appear in the exhibit) 19 May 2016; 13 September 2016; 16 September 2016; 29 July 2016; 29 September 2016; 31 August 2016; 29 July 2016; 28 October 2016; and 11 July 2016. The goods imported include wooden boxes, wooden furniture, candle holders, coasters, trays and clocks. The invoices are mostly for several thousand pounds each.

16. Mr Bhatnagar gives the following annual sales figures which he states were before the date of application. The date of application is 25 April 2018 which means that some of these figures relate to sales which took place after the relevant date (the date of application).

Sales			
Data	Period		Amount
	From	To	
Sales SI-UK	01-Mar-18	27-Apr-21	£ 104,549.94
Sales IE-UK	01-Dec-16	14-Mar-20	£ 28,331.06
Sales Class 20	08-Mar-18	10-Mar-21	£ 6,613.10
Sales Class 21	04-Mar-18	16-Jan-20	£ 13,931.90

17. Mr Bhatnagar gives the following figures for the amount spent on promoting goods under the brand STORE INDYA:

Data	Period		Amount
	From	To	
Advertisement	03-Mar-18	27-Dec-18	£ 16,289.00

18. Exhibit JS4 comprises undated screenshots of three product listings on amazon.co.uk:



Wooden Bookends Book Cd DVD Stand Supporter Holder with Handcrafted Animal Shaped Book Shelf for Home Decor (Elephant-3) (Design 8)

Visit the storeindya Store
★★★★☆ - 35 ratings

Currently unavailable.
We don't know when or if this item will be back in stock.

Colour Design 8
Material Wood
Brand Storeindya
Item dimensions 32.5 x 17 x 2 centimetres
L x W x H

About this item



Antique Finished Wooden Jewellery Box Organizer Multipurpose Handcrafted with Floral Carvings

Brand: STORE INDYA
★★★★☆ - 89 ratings | 4 answered questions

Currently unavailable.
We don't know when or if this item will be back in stock.

Colour Brown
Material Wood
Brand Store Indya
Item dimensions 64.5 x 38.6 x 19.3 centimetres
L x W x H
Special feature Portable, Tab_Top, Fragrance-Free, Nonstandard-Shaped, Firm

★★★★★ **Beautifully Carved**
Reviewed in the United Kingdom on 1 September 2018
Verified Purchase

I got this as a quirky way to store teabags, I have lined it with an old lunchbox as thw smell of the varnish might transfer but it wasn't advertised as food safe so don't mind doing this at all. Such a lovely carving for the price

One person found this helpful

Carole
★★★★★ **Need a Beautiful Gift?**
Reviewed in the United Kingdom on 14 July 2018
Verified Purchase

Beautifully crafted, well-made jewellery box. Cannot praise it highly enough. Will make a beautiful gift. Highly recommended. Also a lovely surprise inside the box of some pretty earrings. Thank you Store Indya.

One person found this helpful

Richard Johnson
★★★★☆ **The carving is nice, but the box seems sloppily finished**
Reviewed in the United Kingdom on 11 February 2017
Verified Purchase

The carving is nice, but the box seems sloppily finished. The inner lining wasn't cut to the right size, so there are gaps. The wood stain on the outside has been unevenly applied, so looks rather crude. It needs some work to finish it properly really.



Sale Store Indya Authentic Indian Spice Box Indian Masala Dabba Hand Carved From Rosewood Kitchen Storage Organization

Visit the storeindya Store
★★★★☆ - 18 ratings

Currently unavailable.
We don't know when or if this item will be back in stock.

Colour Brown
Material Wood
Brand Storeindya
Item dimensions 16.5 x 10.2 x 16.5 centimetres
L x W x H
Item weight 1.28 Pounds

About this item

- The dimensions of the box are length and breadth-

19. The evidence shows five UK reviews for the first item, dated 26 November 2015, 30 January 2017, 27 February 2017, 22 August 2018 and 19 August 2020. The last two are after the relevant date. There are five reviews for the second item, dated 22 December 2015, 18 May 2016, 11 February 2017, 14 July 2018 and 1 September 2018. The last two are after the relevant date. There are four reviews for the third item, dated 30 May 2014, 28 February 2016, 15 September 2016 and 28 December 2017. I note that the screenshots for the three items, respectively, show that there were 35 ratings, 89 ratings and 18 ratings; however, as already noted, some reviews are after the relevant date.² The ratings numbers are not reliably dated prior to the relevant date. The screenshots may be contemporaneous with Mr Bhatnagar's witness statement as the three items are showing as unavailable with no indication that they will become available.

20. Exhibit JS5 comprises a report from amazon.co.uk, said to show the product listings that the applicant created on amazon.co.uk, along with the number of reviews and level of rating from customers. The four pages of the exhibit have been filed in a miniscule size. Using the magnifier on my computer screen at its maximum level, I can just make out the following details:

- many of the listings post-date the relevant date;
- the earliest listings are dated 16 February 2018 for e.g. wooden coasters, bookends, book stands and spectacle stands, with no reviews;
- there are listings dated 17 February 2018 for an umbrella stand and an incense stick holder, with no reviews. This is about two months prior to the relevant date;
- there are listings in March and April 2018 for the same sort of goods as in February 2018, the vast majority with no reviews;

² The 35 ratings are described as "global".

- with the exception of a listing dated 21 February 2018 for a candle holder (3 reviews); a chopping board on 23 February 2018 (3 reviews); a jewellery box on 23 February 2018 (4 reviews); containers on 1 March 2018 and 16 April 2018 (2 reviews); a box on 1 March 2018 (2 reviews); and listings dated 3 March 2018 for a piggy bank (2 reviews), a wall hook (2 reviews), a jeweller box (47 reviews) and a wooden box (72 reviews), there are no product reviews or ratings for any items listed prior to the relevant date;
- there is a variety of different “seller SKU” codes, and not all the listing descriptions start with “Store Indya”. Many of the codes start with “UK.IE...” “IE.UK...” or “SI.UK...”.

Decision

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

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.”

22. 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.”

23. The applicant's evidence is not well put together. For instance, the German consignee invoices are irrelevant because the applicant must show goodwill generated in the UK, not in other countries.³ The relevant date, in the first instance, is the date of application of the contested mark, 25 April 2018. The earliest product listing date in the Amazon product report is 16 February 2018. This is about two months prior to the relevant period and is a very short space of time in which to demonstrate that the applicant had generated sufficient goodwill in its business distinguished by the sign STORE INDYA to mount a successful passing off action. The goods listed in February 2018 do not have reviews. Considering the short period of time, the evidence needs to be robust and cogent. It is neither. Two of the three products shown as screenshots on Amazon.co.uk have three reviews prior to the relevant date. There are only four reviews for the third product, which are all before the date. It is not possible from these parts of the evidence to gauge the level of custom achieved prior to 25 April 2018.

³ *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31.

24. The purchase of a domain name does not show evidence of sales in the UK. The sales figures do not help to build a picture, either on their own or in conjunction with the rest of the evidence. There are several reasons why the figures are unhelpful. The first is that there is no explanation as to what "Sales SI-UK" and "Sales IE-UK" might mean. I could hazard a guess that "SI-UK" is an abbreviation for "Store Indya - UK". If so, it begs the question what "IE-UK" means, which is the Seller SKU code for many items in the Amazon report. There is also no explanation as to why there are figures for "Class 20" and "Class 21" goods which are separate to the "Sales SI-UK" and "Sales IE-UK" figures. The Sales SI-UK figures span over three years from 1 March 2018 to 27 April 2021. Only the first seven weeks of this period pre-date the relevant date. There is no way of knowing what proportion of sales can be attributed to prior to the relevant date. Apart from the lack of explanation as to what the abbreviation means, the Sales IE-UK figures span a period of over three years, and approximately the last two years are after the relevant date. There is no way of knowing or surmising what proportion of sales can be attributed to prior to the relevant date, even if I knew what Sales IE-UK stood for.

25. The sales figures for Class 20 span three years, and only the first 6 weeks are relevant. The total amount for three years is small: £6,613.10. The sales figures for Class 21 span nearly two years; again, only the first six weeks are relevant. It is not possible to work out what level of sales took place prior to the relevant date. The advertising figure span some nine months from 3 March 2018 to 27 December 2018. Only the first six weeks pre-date the relevant date. The advertising figure, £16,289, appears large when viewed against the sales figures. There is no explanation about the relative figures. Only one of the Amazon advertisement invoices predates the relevant date; and that only by three weeks.

26. Although the import invoices date from 2016, there is no evidence about whether and when the imported goods were sold in the UK. There is a gap between 2016 and early 2018. Ordering products for sale and listing them on Amazon is insufficient if it cannot be demonstrated what level of sales took place prior to 25 April 2018 (and in relation to what goods).

27. This is a case in which much of the evidence post-dates the relevant date or dates from about two months or less prior to the relevant date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander QC, sitting as the Appointed Person, observed:

“20...the less extensive the evidence of use relied on, the more solid it must be. The Registrar is not obliged to accept - and in some circumstances may be obliged to reject - a conclusory assertion by a witness that it has a given goodwill at the relevant date or that the use by a third party of a similar mark would amount to misrepresentation, when the material relied upon in support does not bear that out.

21. That point was also made by Laddie J in *DIXY FRIED CHICKEN TM* [2003] EWHC 2902 (Ch) and, more recently, in *Williams and Williams v. Canaries Seaschool SLU (CLUB SAIL)* [2010] RPC 32, Geoffrey Hobbs QC, Appointed Person, said at [38]: “...it is not obligatory to regard the written evidence of any particular witness as sufficient, in the absence of cross-examination, to establish the fact or matter (s)he was seeking to establish.”

22. Overall, the adequacy of evidence falls to be assessed by reference to the Lord Mansfield’s aphorism from *Blatch v. Archer* (1774) 1 Cowp 63 at 65, cited, inter alia by Lord Bingham in *Fairchild v. Glenhaven Financial Services Ltd* [2002] UKHL 22 [2203] 1 AC 32 and in *CLUB SAIL*: “...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.””

28. Mr Alexander went on to observe:

“28. The more limited the reputation on the part of the undertaking asserting the potential claim in passing off under s.5(4)(a), the less likely that it will be able to show that a misrepresentation would be made by the use of a similar mark by a third party. Moreover, it has been repeatedly stated that passing off requires that a substantial number of members of the relevant public are likely to be deceived by the use complained of. In *Reckitt & Colman Products Ltd. v.*

Borden Inc. (Jif Lemon) [1990] RPC 341 at 407, Lord Oliver said that the question on the issue of confusion was: "...is it on the 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?"

...

30. In *Neutrogena Corporation v. Golden Ltd (Neutrogena)* [1996] RPC 473, Jacob J, describing the perspective of the first instance tribunal attempting to form a view in the absence of satisfactory evidence, said at 482: "...if the judge's own opinion is that the case is marginal, one where he cannot be sure whether there is a likelihood of sufficient deception, the case will fail in the absence of enough evidence of the likelihood of deception. But if that opinion of the judge is supplemented by such evidence then it will succeed."

31. That approach was implicitly approved by the Court of Appeal in upholding his judgment (see 496) although Morritt LJ particularly emphasised the need for a "substantial number" of members of the public, questioning Jacob J's language in the use of the terms "more than de minimis" and "above a trivial level".

29. I find that the evidence is not sufficiently cogent for me to conclude that at the date on which the contested registration was applied for, 25 April 2018, the applicant had sufficient goodwill in the sign relied upon to be able to prevent Mr Nagpal from using his trade mark. The application for a declaration of invalidity fails.

30. For completeness, and in case of appeal, I will look at Mr Nagpal's evidence to see if there is an earlier relevant date. Whilst the applicant must show that it had the necessary goodwill at the date on which Mr Nagpal's actionable use began, Mr Nagpal's evidence must be sufficiently cogent to support its claim to a date of use earlier than 25 April 2018. I note that in *Casablanca Trade Mark*, BL O/349/16, Mr Thomas Mitcheson QC, sitting as the Appointed Person, observed:

“35. I think it is clear from the remainder of §165 of the judgment of Kitchin LJ that generation of goodwill *by the applicant* is not required. This is because he goes on to explain that it is the opponent who must show that he had the necessary goodwill and reputation to render that use actionable *on the date that it* (i.e. the applicant’s use) began.

36. This is entirely consistent with the more lengthy discussion of the topic in the decision of Daniel Alexander QC in the *Multisys case (Advanced Perimeter Systems Ltd v Keycorp Ltd [2012] R.P.C. 14)*. See the passage at §§35-45 which reviews many of the authorities which were cited to me, including the earlier Croom decision of Geoffrey Hobbs QC. It is correct that, as the Opponent pointed out, §49 of Croom refers to the build up of goodwill (rather than mere use) as justifying the designation of senior user, but it does not appear that the precise point in issue in *Multisys* or the present case was in issue there, and in any event I consider that I am bound by *Assos* and I would have followed the later *Multisys* case anyway.

37. Accordingly the relevance of the activities of the applicant is limited to establishment of the date that the actionable use began. Once that date is established, the only question of goodwill arises in respect of the opponent’s activities. As the Applicant in the present case pointed out, self-evidently it would only be in very exceptional circumstances that a party would have established goodwill at the point in time at which it commenced the use complained of. The establishment of goodwill would take much longer. But the authorities recognise that it is the date that the activity commenced which is the crucial one, and so in my judgment it cannot be necessary for goodwill to have been accrued at that time.

38. That does not mean that it is irrelevant what happens after the first alleged date of commencement. Clearly if the activity ceased or changed materially between the date of commencement and the date of application for the trade mark then this must be taken into account, as it may mean that the true date of commencement of the activity complained of is later or that the activity complained of cannot properly be said to have properly commenced at all (if it

was later abandoned). This is all a matter of fact and degree and is no doubt why Kitchin LJ expressed it as “*a matter which must be taken into account*” rather than as being determinative of the issue. However it does not mean that what is required is anything more than the commencement of the activity which is carried on in such a way as to fix the date of assessment. There is no greater requirement to prove goodwill on that date.”

31. Mr Nagpal’s evidence is also poorly put together. His evidence comes from Shahzaib Malik, who works for Mr Nagpal’s representatives, United Legal Experts, although he doesn’t say what his position is with that firm.⁴

32. Exhibit SAM1 is said to show prints from a sales database from 2017 to 2020 “through Amazon seller central which is the backend administration portal of Amazon marketplace.” The prints refer to account activity for the calendar years from 1 January 2017 to 31 December 2020. At the top of the prints, it says “Display name: HIPPISTRYHUB” and “Legal name: ENN DEE INTERNATIONAL”. I cannot see STORE INDYA on the prints. Exhibit SAM2 is a print of Mr Nagpal’s trade mark registration, which does not show that the mark has been used. Exhibit SAM3 comprises copies of invoices from Amazon Services Europe for advertisements. These are dated between 28 February 2018 and 31 December 2020. The business name is ENN DEE INTERNATIONAL. I cannot see STORE INDYA.

33. Mr Malik provides the following:

8. The below table shows the overview of the sales and advertisement expenses made in the UK from 2017-2020 in the below table.

⁴ Witness statement dated 27 December 2021, amended 28 February 2022.

Year	SALES (GBP)	Marketing/Advertisements (GBP)
2017	36000	300
2018	71000	1800
2019	3,24000	24000
2020	500,000	57500

34. There is a further table showing sales and marketing figures for Germany, France, Italy, Spain and the UK for 2018 to 2021. Only the UK figures are potentially relevant. However, what Mr Nagpal is required to show is actionable use of STORE INDYA prior to the date on which he applied for his trade mark, which was 25 April 2018. This evidence does not assist.

35. There is no evidence of product listings or any evidence in relation to goods which shows the mark STORE INDYA. In fact, there is no evidence of use in relation to any specific goods. Exhibit SAM5 consists of the following, which Mr Malik states “shows the trademark Store Indya has been accepted by the amazon for the brand registry enrolment program and an approved brand on Amazon since 2018”:



DISHANT NAGPAL <enndeeintuk@gmail.com>

RE:Brand Registry request for STORE INDYA

Amazon Seller Support <merch.service05@amazon.co.uk>
 To: "ENNDDEEINTUK@GMAIL.COM" <ENNDDEEINTUK@gmail.com>

Tue, Aug 28, 2018 at 7:38 PM

Brand Name: STORE INDYA

Dear HIPPISTRY HUB,

Thank you for your interest in Amazon Brand Registry.

Congratulations! Your Brand Registry application for STORE INDYA has been approved. Your Brand Registry account will reflect this change within 1-2 hours, at which time you can access our new Brand Registry tools and features. To learn more about these new features visit <https://brandservices.amazon.com>.

If you did not apply for Amazon Brand Registry, contact us at brand-registry-service@amazon.com immediately. For any other questions, reply in the Case Log.

Thanks and Regards,
 Amazon Brand Registry Support

36. This is dated after the relevant date, so does not show what the position was prior to 25 April 2018. Mr Malik does not explain the significance of this brand registry

request to amazon.co.uk. In the absence of anything showing the mark STORE INDYA in the other evidence, which is all from Amazon, I am left to wonder if this was the beginning of Mr Nagpal's use of the mark in the UK.

37. I repeat Mr Alexander's words, set out above:

"20...the less extensive the evidence of use relied on, the more solid it must be. The Registrar is not obliged to accept - and in some circumstances may be obliged to reject - a conclusory assertion by a witness that it has a given goodwill at the relevant date or that the use by a third party of a similar mark would amount to misrepresentation, when the material relied upon in support does not bear that out."

38. Although Mr Nagpal does not have to prove goodwill at an earlier date than 25 April 2018, a conclusory assertion when the material supplied does not bear out the assertion is not sufficient. The evidence raises far more questions than gives answers. It does not support Mr Nagpal's statement in the counterstatement, nor Mr Malik's statement, that the mark was in use in 2015, nor does it show that there was actionable use of the mark in the UK prior to 25 April 2018. This means that the date of assessment remains 25 April 2018.

Outcome

39. The application for a declaration of invalidity fails.

Costs

40. Mr Nagpal has been successful and is entitled to a contribution towards his costs, based upon the published scale.⁵ I will not make an award for Mr Nagpal's evidence because it was of no assistance. I award costs in Mr Nagpal's favour, as follows:

Considering the application and

⁵ Tribunal Practice Notice 2/2016.

preparing the counterstatement	£200
Considering the applicant's evidence	£500
Total	£700

41. I order Store Indya UK Limited to pay to Dishant Nagpal the sum of £700. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of July 2022

Judi Pike
For the Registrar