

O/0481/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK NO. 3631940

BODY2BODY

**REGISTERED IN THE NAME OF JAVAID ISLAM:
IN CLASS 44**

-AND-

**THE REQUEST BY BODYPLUS (EURO) LTD
FOR INVALIDATION THEREOF
UNDER No. CA504472**

BACKGROUND AND PLEADINGS

1. Javid Islam (“**the Proprietor**”) applied on 25 April 2021 to register UK trade mark No. 3631940 for BODY2BODY (“**the Registration**”). The trade mark application was published for opposition on 25 June 2021 and subsequently registered on 3 September 2021 in respect of the following goods in Class 25:

Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing.

2. BodyPlus (Euro) Ltd, (“**the Applicant**”) has requested, pursuant to section 47(1) and (2) of the Trade Marks Act 1994 (“**the Act**”), that the Registration be declared invalid based on objections under sections 5(4)(a) and 3(6) of the Act.
3. The **section 5(4)(a) claim** is that, through years of selling on platforms such as eBay and Amazon, the Applicant had goodwill associated with the sign “Body2Body” in respect of the following goods:

Clothing; mens clothing; womens clothing; leggings; cycle clothing; joggers; shorts; baggy; bodysuit; shirt; skirt;

and of the following services: *Retail services and online retail services relating to the sale of clothing*

such that use of the Registration would constitute passing off.

4. The **section 3(6) claim** is that the filing of the Registration was made in bad faith, in

essence because the Proprietor was aware of the Applicant's business use of the same sign in respect of clothing, and applied for the trade mark with the intention of using it to block use by the Applicant on e-commerce platforms, where the Proprietor also operates, and where he filed numerous Amazon takedown requests against the Applicant on 13 September 2021, ten days after the registration date. It is claimed alternatively that the Proprietor's intention had been to divert trade from the Applicant or to take over the Applicant's unregistered trade mark rights.

5. The Proprietor filed a Form TM8 notice of defence and a counterstatement, conveying the following:
 - i. The Applicant made no objection during the opposition period, and the IPO has confirmed registration of the contested mark;
 - ii. The Proprietor claims to have applied for the Registration in good faith to safeguard his business interests, and that the allegation of bad faith is an attempt by the Applicant "to blackmail" the Proprietor;
 - iii. The Proprietor owns a small business called Little Pretty World Ltd.
 - iv. He denies being aware of the Applicant or its owner or the "alleged brand-name"
 - v. The Proprietor claims to have used the Body2Body trade mark since 2014 selling clothing and to have invested time and money in developing the trade mark and in stock printing and registration, claiming to have spent around £5000 pounds on the "trade mark registration and services and stock inventory worth £20,000."
 - vi. The Proprietor states that if the Applicant is willing to reimburse his costs and to make good any loss, he will assign the trade mark.
6. During the evidence rounds the Applicant filed evidence in support of its claims. The Proprietor filed no evidence or further submissions beyond those in its Form TM8 and counterstatement. The Applicant requested an oral hearing, which was held by video conference on 8 March 2023. The Applicant is represented in these proceedings by NLS Legal Limited; Peter Vaughan advocated on its behalf at the hearing.¹ The Proprietor is unrepresented and did not attend the hearing. A skeleton argument was filed for the

1 Matilda Kapala and Callum Scott attended as observers.

Applicant in advance of the hearing. I have read all the papers filed and refer to their contents to the extent I consider it warranted to do so.

THE SECTION 5(4)(a) CLAIM

7. 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 (4A) is met,

[...]

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 ...”

Relevant legal principles

9. The essential requirements that a claimant must establish to sustain a passing off claim are:²

- (a) a protectable goodwill in the UK owned by the claimant at the relevant date;
(b) a misrepresentation made by the defendant which is liable to deceive the public; and
(c) damage to the claimant’s goodwill caused by the misrepresentation.

10. The Applicant must show goodwill to have existed at the relevant date, which, at least in the first instance, is the filing date of the contested trade mark i.e. 25 April 2021. There can be circumstances in which a claim of passing off would have to be assessed as at a point in time earlier than the filing date of a contested trade mark. In the present case

2 The “classical trinity” per Lord Oliver in *Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341 HL, the “Jif Lemon” case.

the Proprietor claims to have used the contested mark since 2014; it might therefore have been necessary to have considered whether the Applicant had generated goodwill by the date on which the Proprietor first made use of its mark. However, the Proprietor filed no evidence at all in these proceedings, so its claim to have used the contested mark is entirely unsubstantiated. The filing date of the contested mark therefore remains the only “**relevant date**” for assessing whether its use would have been passing off.

11. The concept of goodwill has been described as “*the benefit and advantages of the good name, reputation and connection of a business*” and “*the attractive force which brings in custom.*” The same case law commented that “*it is the one thing which distinguishes an old-established business from a new business at its first start*”.³
12. The Applicant claims to have sold clothing goods by reference to the sign “Body2Body”. The evidence comes from the Witness Statement dated 20 July 2022 of Mr Kuldip Singh Bahia (“**Bahia**”), a manager at the Applicant, and accompanying **Exhibits KSB1 - KSB28**. As noted in the Opponent’s helpful skeleton argument, and as Mr Vaughan talked through at the hearing, the evidence shows the following:
 - i. The Applicant was incorporated on 22 September 2004.⁴ It is a small business operating from its factory in Smethwick, manufacturing and selling clothing.⁵ Some of its sales of clothing are under the Body2Body mark, online, direct to customers. Amazon is an important vehicle for the sale of its products and to the Applicant’s business.⁶
 - ii. The Applicant asserts a date of first use of Body2Body of 2010.⁷
 - iii. Exhibits show public-facing reviews of various clothing goods sold by the Applicant on the Amazon platform, including as far back as 2014.⁸ For instance, **Exhibit KSB6** shows a Body2Bbody “BNWT” (‘brand new with tag’) “women’s peasant gypsy top with cap sleeve and elasticated bottom”, offered in a range of sizes, where the seller is shown to be the Applicant and where the product is listed as ‘first available’ as of 20 June 2018. Among the reviews are two dating from September and October 2019

3 House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217.

4 Exhibit KSB1.

5 Bahia, Paragraph 5.

6 Bahia, Paragraphs 7, 21 and 34.

7 Bahia, Paragraph 8.

8 Page 2 and 4 of Exhibit KS14, relating to Body2Body Women’s Cycle Cotton Lycra shorts.

wherein both satisfied reviewers state their intention to repeat their purchases. **Exhibit KSB15** shows Body2Body women's shorts offered for sale on Amazon. The number of reviews received is shown to be 587 and I accept that the number of sales would likely significantly exceed the number of reviews. One such review is shown to date from May 2016 where the Applicant engages with a customer query regarding the item. **Exhibit KSB17** shows a Body2Body women's cardigan offered in a range of sizes and colours, with 325 ratings and which was first offered for sale in 2014. **Exhibit KSB18** shows Body2Body kids' fleece joggers; **Exhibit KSB19**, shows Body2Body leggings; **Exhibit KSB20** shows Body2Body harem pants.

- iv. Sales data from the Amazon platform show sales in a number of two-month periods between June 2020 and June 2021.⁹ Bahia includes the table below of further information on sales data at various periods between June 2017 and June 2022.¹⁰

Date	Number of Products Sold
June and July 2017	632
November and December 2017	690
July and August 2018	729
November and December 2018	949
March and April 2019	776
November and December 2019	457
December 2019 and January 2020	367
August and September 2020	1485
November and December 2020	904
February and March 2021	1137
April and May 2021	1326
September and October 2021	1142
December 2021	195
May and June 2022	688

- v. The Body2Body mark is shown to appear in the Amazon listing descriptions and on the labels of the clothing of the Applicant.¹¹ One of the Amazon customer reviews, dated June 2021 shows the label on clothing. **Exhibit KSB27** is a "to whom it may concern" email from a label-making firm confirming that it has supplied 'Body2Body' labels to the Applicant since June 2012. **Exhibit KSB24** is a "to whom it may concern" email, signed by Gul Khan of Reshape Direct Limited, stating that he has

9 Bahia, Paragraphs 28-31 and 33-34 refers; Exhibits KSB9, KSB10 and KSB12.

10 Bahia, Paragraph 37-38.

11 Exhibit KSB7.

purchased Body2Body clothing from the Applicant since 2013.

- vi. I also note the submission that the task facing the Applicant, to evidence its goodwill through sales of clothing on the Amazon site, is to some degree hampered by the fact that as many as 72 of its listings have, at the instigation of the Proprietor, been deleted by Amazon takedown notices such as those exhibited at **KSB2**. **Exhibit KSB3** shows an Amazon seller graph demonstrating the very significant extent to which the Applicant's sales have been negatively affected by the takedown notifications as of September 2021.
 - vii. Nonetheless, at Bahia paragraphs 28 – 30, the evidence gives good indications of sales. **Exhibit KSB8** refers to data showing Amazon sales of Body2Body-marked clothing in the two-month period June and July 2020, totalling 1487 orders covering 1572 items, generating nearly £10k in sales. **Exhibit KSB9** for November and December 2020 notes 832 orders placed, covering 952 items for a sales total of over £6k in those two months. **Exhibit KSB10** notes 1094 orders placed for 1246 items for a total of nearly £8k in sales. **Exhibit KSB12** shows sales totals of around £97k in the year 2020/21 (just beyond the relevant date), over 15,000 low-cost clothing items.
 - viii. There is also sales data evidence at **Exhibit KSB13G** that Body2Body made sales throughout England including to customers in Yorkshire, Nottinghamshire, Lancashire and Lincolnshire.
13. In *Hart v Relentless Records*, Jacob J. (as he then was) stated his view that “the law of passing off does not protect a goodwill of trivial extent. one is looking for more than a minimal reputation.”¹² This does not mean that a small business is incapable of establishing goodwill - even though its goodwill may be modest, a business can protect signs which are distinctive of that business under the law of passing off.¹⁶ Thus in *Lumos Skincare Ltd v Sweet Squared Ltd*¹⁸, the Court of Appeal upheld a claim for passing off based on the claimant's use of the mark “LUMOS” for around three years before the defendant's use of the same mark, even though sales volumes and turnover were modest. In that case, the Claimant sold skincare products under the name LUMOS and alleged passing off by the Defendants' sale of nail care products under the same name. Both

12 *Hart & Anor v Relentless Records* [2002] EWHC 1984 (Ch) [62]

parties sold their products to beauty salons whose technicians used the products on their customers. The claimant's products sold for between £40 and £100 each and between early 2008 and September 2009, the claimant had achieved a turnover of around £2,000 for quarter. From the latter date up until the relevant date in October 2010, the claimant's turnover increased to around £10k per quarter and had repeat custom from over 25 retail clients. Even so, the claimant remained a very small business with a modest number of sales, yet the court was prepared to protect the goodwill in that business under the law of passing off. It is also the case that a relatively short period of time may sometimes be sufficient to build up goodwill.¹³ Each case turns on the individual facts found in the evidence.

14. In the present case, I am satisfied that the Applicant had actionable goodwill associated with the sign Body2Body, arising from its sales of various clothing goods over a number of years – certainly since 2014. The evidence demonstrates the manner in which the Body2Body mark has been used to list the products on Amazon, year on year, achieving consistent and respectable levels of sales across England and garnering some favourable reviews suggesting repeat custom.
15. The Applicant's goodwill extends especially to clothing products sold on the Amazon platform. The Registration involves identical goods and the sign is identical, such that misrepresentation inevitably arises from the Proprietor's use of the Registration, as consumers cannot differentiate between the earlier goods of the Applicant and the later goods of the Proprietor, confusing potential and actual consumers, thereby leading to damage to the Applicant's goodwill and lost sales.

OUTCOME: The section 5(4)(a) ground succeeds.

THE SECTION 3(6) CLAIM

16. Section 3(6) of the Act states that a trade mark shall not be registered if or to the extent that the application is made in bad faith. I bear in mind the principles arising from established case law on bad faith, including:
 - i. The relevant time for determining whether there was bad faith on the part of an

13 *Stannard v Reay* [1967] F.S.R. 140, 144 may illustrate the extreme of that possibility.

applicant is the time of filing the application for registration.¹⁴

- ii. The standard of proof in relation to an allegation of bad faith is on the balance of probabilities: cogent evidence is required to the seriousness of the allegation.¹⁵

17. The relevant factors to an assessment of bad faith, were recently considered by the Court of Appeal in the Skykick case.¹⁶ . Relevantly, these include the following:

- i. 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 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;
- ii. 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;
- iii. it is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proven. However, 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; and
- iv. 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. 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.

14 Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd [2009] RPC 9 at [167]; Red Bull GMBH v Sun Mark Ltd, Sea Air & Land Forwarding Ltd [2013] ETMR 52 at [132].

15 Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd [2009] RPC 9 at [177].

16 In Sky Ltd (formerly Sky Plc) v Skykick UK Ltd [2021] EWCA Civ 1121 at [67].

18. Key questions for consideration for determination of a claim of bad faith are (1) what, in concrete terms, is the objective that the Proprietor is accused of pursuing? (2) was that an objective for the purposes of which the contested application could not properly be filed? (3) has it been established that the contested application was filed in pursuit of that objective?¹⁷
19. Whilst the relevant date on which to assess whether the Registration was filed in bad faith is that of the application date, subsequent actions of the Proprietor can be illuminating of its intentions at the time of filing.¹⁸
20. In my view the Applicant has succeeded in raising a rebuttable presumption of a lack of good faith. I make this finding based on the cumulative effect of the following factors:
- i. The Applicant puts its allegation of bad faith clearly, that the Proprietor's intention in making his application for the Registration was to disrupt the Applicant's business on Amazon, where the Proprietor also sells clothing goods;
 - ii. The Applicant has shown that it has made quite long-standing use of an identical sign for identical goods on Amazon, the very platform on which both parties operate, which tends to increase the probability that the Proprietor when applying for the Registration would have had knowledge of the Applicant's use, and ought, through due diligence to have known;¹⁹
 - iii. The Proprietor was evidently aware of the Applicant's use of the mark on Amazon shortly after applying for the Registration, since it took prompt action to initiate a multitude of takedown notices against the Applicant on Amazon;
 - iv. The Applicant's evidence at shows a photo of an item of clothing that the witness states he ordered from the Proprietor's company. Bahia states that the item of clothing (a shrug) had been advertised as 'body2body' but when Mr Bahia received it the label was in fact 'vigo', as shown in the photo.
21. There is in my view sufficient basis to support a conclusion that this is a classic case of

17 Mr Geoffrey Hobbs QC in Alexander Trade Mark BL O/036/18.

18 See Paragraphs 61-63 of T-592/20 Uniers Agro.

19 GNAT and Company Ltd & Anor v West Lake East Ltd & Anor [2022] EWHC 319 (IPEC). This discusses honest concurrent use but the factors may be considered analogous for the present claim. See in particular paragraphs 85-88 and the law cited in the paragraphs leading to this. See too, paragraph 29 of T-592/20 Uniers.

using the trade mark system to stifle competition and to undermine third party interests. A prima facie case of bad faith having been made in the evidence and statement of grounds, it is for the Respondent to rebut this; it has not done so.

22. The point made in his statement of grounds that the Applicant did not challenge the contested mark at opposition stage is not relevant; it is clearly perfectly acceptable for the Applicant to seek to invalidate the same trade mark once it became aware of the Registration.
23. The Proprietor has provided no evidence to substantiate his claim to have used the Body2Body trade mark since 2014 or his claim to have spent thousands of pounds in relation to the Body2Body trade mark. The Applicant filed evidence suggesting that the Applicant does not appear to have an existing interest in Body2Body,²⁰ and that to the extent that the Proprietor has used, at some stage, Body2Body in connection with the sale of goods, **Exhibit KSB21** suggests that this appears to have been token use not carried across to the products themselves. I also note that the Proprietor actively raises the prospect of selling the Registration to the Applicant.
24. I find that the aim of the Proprietor in filing and securing a registration for its mark was to prevent competitors from legitimately trading on Amazon, in a way that falls short of the honest practices in the sector and that amounts to an abuse of the trade mark registration system.

OUTCOME: The Applicant's claim under section 3(6) succeeds.

The Registration – trade mark number **3631940** – is declared **invalid from the date of its application – 25 April 2021** as though the trade mark application had never been made.

COSTS

25. The Applicant is entitled to a contribution towards its costs in bringing the invalidation. In line with the scale published in the annex to Tribunal Practice Notice (2/2016), I award the following costs:

²⁰ Exhibit KSB22.

Preparing a statement of grounds and considering the Applicant's counterstatement:	£500
Preparing evidence and submissions	£1500
Preparing for and attending the hearing	£1500
Official fee for Form TM26(I)	£200
Official fee for Form TM9	£100
TOTAL	£3800

26. The Applicant has received legal advice and representation from NLS Legal Limited. I order Javaid Islam to pay the sum of **£3500** (three thousand five hundred pounds) to fund other pro bono work such as that carried out by the legal advice centre at Nottingham Law School. This sum is to be paid to **The Access to Justice Foundation** (PO Box 64162, London WC1A 9AN) within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).
27. I understand that the official fee of £200 attached to the Form TM26(I) that initiated the invalidation proceedings was paid by the Applicant itself, as was the £100 required in respect of the Form TM9 requesting additional time to file the Applicant's evidence (prepared in draft by the original deadline). I therefore also order Javaid Islam to pay **BodyPlus (Euro) Ltd** the sum of **£300**. This sum is also to be paid in the same timeframe as set out above.

Dated this 24th day of May 2023

Matthew Williams

For the Registrar
