

O-448-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3016941
IN THE NAME OF HUANG NING JUAN
FOR THE TRADE MARK



AND

IN THE MATTER OF APPLICATION NO 3013047
IN THE NAME OF
HUANG NING JUAN, PETER BAXENDALE AND PARAMOUNT EUROPE LTD
FOR THE TRADE MARK

TRIINKS

AND

OPPOSITIONS THERETO UNDER NO 401138 AND 401139
BY GARETH ROBERTS

Background

1: Application 3016941 was filed on 6 August 2013, stands in the name of Huang Ning Juan and seeks registration of the following trade mark:



2: Application No 3013047 was filed on 8 July 2013, stands in the name of Huang Ning Juan, Peter Baxendale and Paramount Europe Ltd. It seeks registration of the trade mark TRIINKS.

3. In each case, registration is sought in respect of the following goods:

Ink jet cartridges [filled]; Ink jet printer ink; Iridescent ink; Metallic ink; Ink [toners] for photocopiers; Solid ink cartridges [filled] for ink-jet printers; Ink (Printing -); Engraving ink; Ink [toner] for photocopiers; all included in Class 2.

4. Following publication of the applications in *Trade Marks Journal* 2013/036 on 6 September 2013, notices of opposition were filed by Gareth Roberts (“the opponent”). In each case the oppositions are based on a single ground under section 3(6) of the Trade Marks Act 1994 (“the Act”) as well as a ground under section 5(4)(a) of the Act based on two earlier rights: the word Triinks and a composite mark consisting of the word Triinks to the left of which is what I shall refer to as a splatter device (see Annex A to this decision).

5. In each case, counterstatements were filed denying the grounds of opposition. The forms included a request that the opponent should prove use of his marks. As the form indicates, however, such a requirement is only applicable where the opposition is based on grounds under either section 5(1), 5(2) or 5(3) of the Act. Such grounds are not relied upon in these proceedings.

6. The proceedings were consolidated. Only the opponent filed evidence. This takes the form of a witness statement of Gareth Roberts with exhibits. I do not intend to summarise the evidence here but will refer to it as necessary later in this decision. No other written material was filed and no request for a hearing was made. I therefore give this decision on the basis of the written material before me.

The objection under section 3(6) of the Act

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

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

8. The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

9. In his notice of opposition against 3016941, the opponent puts his objection in the following terms:

"We have corresponded with P.E.L. on many occasions regarding them passing off the Triinks brand to which we have had no resolution. In a recent telephone call with the Director she advised they would be applying for this TM to, I quote, "ruin your company" + reputation". This is understood to be an

act of bad faith. Triinks have a 15,800 amazon positive feedback review for previous transactions, this is good reputation PEL are gaining sales off the back of”.

10. Whilst PEL is one of the co-owners of 3013047, this particular application is, as noted above, made in the name of an individual and, in his counterstatement, he submits:

“The Opponent makes no separate allegations under Section 3(6) beyond an allegation that the use by the Applicant would be passing off. The opposition under Section 3(6) should therefore be struck out. An allegation under Section 3(6) is a separate allegation and should be made out in detail and where not made out (as in this case) any award of costs should be increased. The Applicant had used the mark a number of years before the Opponent alleges it began use of the mark.

The Opponent does not identify any details of the vague assertion of what was said to the Opponent and the Applicant denies that this was ever said.”

11. Whilst not identically worded, the opponent’s objection under section 3(6) in respect of application 3013047 is identical in all material particulars. He claims that the applicant filed the application in bad faith and bases this on an alleged telephone conversation. The counterstatement filed in response in this case is identically worded to that filed in 3016941.

12. In respect of both applications, Mr Roberts’ evidence is silent as to the alleged call, however, he does make reference to bad faith. He states:

“It is my view that the applicants are acting in bad faith and are hoping to gain further orders off the back of our good reputation should their applications be registered. I am further lead (sic) to believe this as the applicants wrote to the IPO and I to confirm they would be abandoning both applications to which I am told they withdrew once I had spoken to you. I am lead (sic) to believe that this was also an act of bad faith and that as a result they would be awarded the TM’s”.

13. I will deal with the abandonment matter first. Exhibited at GR14 and GR15 to Mr Roberts’ witness statement are copies of emails sent to the registrar in respect of each application and which were copied to the opponent. The emails were sent by the respective applicants on 23 May 2014 and notify the registrar that “we would like to abandon” the applications. The emails were received and are part of the official record, however, it is clear that the applications were not recorded as abandoned. This is because in further emails dated 4 June 2014, and received before any official action to abandon the applications had been taken, the registrar was notified in clear terms that the respective applicants did *not* wish to abandon the applications. In light of this, the applications were not recorded as abandoned. It may be that the abandonment and the retraction of abandonment is indicative of e.g. an error or of the applicants being in some disarray but this cannot be relied on to support a finding that the applications themselves, filed around a year earlier, were made in bad faith.

14. As to the claims made in the notice of opposition, whilst it could be said that the opponent's claim also implies that the applications were filed to thwart the opponent's business, an allegation of bad faith is a serious allegation that requires an opponent clearly to set out his claim and the reasons for it. That claim must be distinctly proved. Whilst the opponent has made reference to part of a telephone conversation, no specific details of that call (such as timing or who made/answered the call or what, specifically, was discussed or said) are given and, in the counterstatements, the applicants deny such a conversation took place. The opponent has not "distinctly proved" anything and his claim goes nowhere near showing the applications were made in bad faith. The oppositions against the applications based on section 3(6) of the Act are dismissed accordingly.

The objections under section 5(4)(a) of the Act

15. Section 5(4)(a) of the Act states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) 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, or

(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."

16. In the counterstatements, the applicants state:

"The Opposition insofar as it relates to Section 5(4)(a) appears to be based on two marks...

In relation to the "first" opposition under Section 5(4)(a), the Opponent does not identify the trade mark relied upon. The Registry is invited to strike out this Opposition for lack of detail.

Further, the Opponent does not identify the goods on which the mark has been used, and the Registry is invited to strike out the Opposition on the basis that this information is not provided.

...

In relation to the "second" opposition under Section 5(4)(a), the Opponent has not identified the goods of the Application against which opposition is made. As such, the Opposition should be struck out."

17. I decline to strike out the oppositions under this ground. The form which constitutes a notice of opposition requires an opponent to complete a separate sheet for each earlier mark relied upon. Each sheet contains a box wherein he should provide a representation of the earlier unregistered mark on which he relies. In each

of his notices of opposition, the opponent has completed two separate sheets. Again, whilst the wording he uses in each notice of opposition is not identical, the two do not differ in their material particulars. For convenience, I quote from the notice of opposition against 3016941 where the first relevant box has been completed by the opponent thus:

“My company has traded as triinks since the incorporation in 2012. From December 2012 Paramount Europe Ltd (P.E.L 07032046) and its Directors Huang Ning Juan and Huagian (David) Xie have been attempting to pass off the Triinks brand. The company is misleading British consumers selling inferior inks as what the public assume are triinks. The majority of our sales are generated through the Amazon website where P.E.L are blantly (sic) confusing customers by intruding on all of our sales channels. We have built up a very good reputation of the brand and have been showing good growth year on year.”

18. The second relevant box contains the words “PLEASE SEE ATTACHMENT AS DISCUSSED”. Attached is a copy of the Triinks and splatter mark on which the opponent relies.

19. The opponent has not had the benefit of professional representation. Whilst this does not absolve him of the responsibilities incumbent on parties in proceedings such as these, and noting that he has not completed the forms in the usual way, I consider it is clear from the above, and would have been clear to the applicant, that the first objection under this ground is based on his claimed use of the mark Triinks. This is the only mark referred to in the text and it is mentioned more than once (albeit sometimes without the capital letter). Furthermore, at question 4 of the same form, he states:

“My company is widely known as Triinks...[the applicants] are applying for this trademark (sic) in attempt(sic) to take over all the Triinks listings...”

20. The applicant also asks for the opposition to be struck out on the basis that Mr Roberts has not identified the goods on which he claims to have used his mark. As set out above, the opposition is based on two earlier rights. In relation to the first of those earlier rights, and on the relevant part of the forms, Mr Roberts has written “Class 2”. In relation to the second of the earlier rights, he has written *Ink jet cartridges, ink jet printer ink, iridescent ink, ink [toners] for photocopiers, solid ink cartridges [filled] for ink-jet printers, ink [printing], ink[toner] for photocopiers*. Given that the goods for which the applicant seeks registration are, broadly, inks and ink cartridges, goods which are classified in Class 2, coupled with the fact that the opponent refers to his own sales of such goods, I consider it is equally clear, and would have been to the applicant, that he relies on his use of the mark Triinks in respect of ink and ink cartridges.

21. In respect of the second mark relied upon, Mr Roberts has included a representation of the mark (on a separate attachment) and has set out the goods on which he relies in identical terms to that set out above. What he has not done, is tick the relevant box on the form to set out whether he opposes all of the applicant’s goods or only some of them. Given that each of the goods for which registration is

applied is an ink or an ink cartridge, it is clear, and would have been clear to the applicant, that the opposition is directed at each of the applicants' goods in each case.

22. I proceed on the above basis.

23. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

24. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 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 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 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.”

25. The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP).

The relevant dates

26. In each of the counterstatements, the applicants submit:

“The Applicant first used the mark of the Application in respect of the goods of the Application in May 2006 in China, in 2007 in Spain and in the UK in 2013. Whilst the date of the Application is usually the Relevant Date for the purposes of considering whether the rights relied upon exist, in the case of a “passing-off” right where the date of first use of the mark of the Application is earlier than the date of filing of the Application, it is this earlier date which is the “Relevant Date” for considering the rights of the Opponent.”

27. Despite the claim to have used the mark in the UK and elsewhere, the applicants have not filed any evidence of such use. Even if such evidence had been filed to show use of the mark in the UK as claimed in 2013, this is a later claimed date of first use than that claimed by the opponent. In all the circumstances, the relevant dates at which matters must be judged are the filing dates of the applications. The

two applications, as shown above, have different application dates and therefore the relevant date is 6 August 2013 in respect of application no 3016941 and 8 July 2013 in respect of application no 3013047.

28. The meaning of goodwill was set out in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“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.”

29. 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.”

30. 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.”

31. With this in mind, I go on to consider whether the opponent has shown he has the necessary goodwill. The opponent's evidence takes the form of a witness statement of Gareth Roberts. Mr Roberts states that he is the owner and Director of Triangle MMA Ltd trading as Triinks, a business which he himself set up. He states that through this company he has sold printer cartridges and inks since 4 January 2011. At GR1 he exhibits a copy of an extract from the Companies House website confirming the incorporation of his company.

32. Mr Roberts states that he registered the domain name triinks.co.uk on 12 April 2011 and, at GR2, exhibits a copy of an extract from the Nominet registry confirming this. Mr Roberts states that the domain name is registered in his personal name but has always been used for the benefit of his company.

33. Mr Roberts states that his company sells its products under the mark Triinks both through its website and via the Amazon website. Mr Roberts estimates that approximately £1.5m worth of printer cartridges and inks have been sold under the mark since January 2011. At GR12 he exhibits a copy of a "Sales Dashboard" taken from the relevant pages of the Amazon sellers' website. It gives details of, inter alia, sales and traffic details. Mr Roberts states that such data remains available only for a two-year period. The document lists daily sales of inks and ink cartridges in August and September 2012. It also indicates total sales from 29 August 2012 to 28 August 2014 (i.e covering a period approximately a year before to a year after the relevant dates) of over £935,000.

34. Mr Roberts states that between £1500 and £2000 has been spent on marketing since 2011. He states the marks are used on his company's own website and on the Amazon website as well as on electronic marketing, leaflets, correspondence and letterheads, all in connection with printer cartridges and inks. At GR4 to GR6, he exhibits examples which he states show such use. The documents at GR4 and GR5 show they were downloaded from the Amazon website in August 2014. GR6 consists of an invoice on headed paper.

35. Exhibited at GR8 to GR11 are various pages downloaded from the Amazon website. Whilst they all bear a download date of August 2014, they each show customer reviews for the opponent's business which were uploaded onto the site on various dates in 2011 and 2012 (the earliest I can see is dated 6 February 2011). There are multiple references to the opponent's inks and cartridges and references to the mark Triinks.

36. The opponent relies on two earlier rights: the mark Triinks and the composite mark consisting of the word Triinks and splatter device. The only evidence he provides showing use of the composite word and splatter device mark is at GR6. As set out earlier, this is an invoice on headed paper. The composite mark is shown as its heading. The invoice is dated April 2014 which is well after the relevant dates. Whilst the applicant has not challenged the evidence, I do not consider this one exhibit is sufficient to show the opponent to have had goodwill under the composite mark at the relevant dates. Absent proof of goodwill, the oppositions under section 5(4)(a) of the Act based on this earlier mark fail.

37. That leaves the oppositions based on the word-only mark Triinks to consider further. Whilst the opponent's evidence is not directed specifically to the relevant dates and most, if not all, of it was obtained at a later date, the content of much of it refers to a period which clearly straddles the relevant dates. Evidence of significant sales before the relevant dates is given by way of the Amazon dashboard (exhibits GR12 and GR13) and is supported by the customer reviews (exhibits GR8 to GR11). Furthermore, the evidence shows that trade to have been continuous and ongoing. Those sales are shown to have been made under the mark Triinks in connection with inks and ink cartridges. I am satisfied that it shows the opponent to have goodwill in the mark Triinks at the relevant dates in relation to such goods.

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

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

Morritt L.J. stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill.”

39. Application 3016941 consists of a composite mark made up of the device of a sunflower to the right of which is the word Trilnks. The word Trilnks forms by far the

largest element of the mark and is the dominant element of it. Whilst the mark is presented in colour, for the reasons given in *Specsavers International Healthcare Ltd & Ors v Asda Stores Ltd* [2012] EWCA Civ 24, nothing rests on this. Whilst the device element will not be overlooked, the mark will be referred to and identified by the word Triinks. Application no 3013047 is for the mark TRIINKS in plain block capitals. Both marks will clearly be seen and referred to as “Triinks” marks.

40. The earlier mark relied on by the opponent consists of the word Triinks. It has been shown to have been used in relation to ink and ink cartridges which are identical goods to those for which the applicant seeks registration. These are goods used by the general public on a fairly regular basis at relatively low cost and with no more than an average degree of care. Taking all matters into account, I consider that in respect of each of the applicants’ marks there would be misrepresentation.

41. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff’s business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff.”

42. I have no doubt that on encountering the applicant’s mark, a substantial number of the opponent’s customers or potential customers would be deceived and that damage would follow. Whilst not determinative, I note that Mr Roberts has filed evidence at GR13 which shows that his Amazon sales reduced around the time the applicants claim to have begun trading in the UK.

43. The oppositions against both applications under section 5(4)(a) founded on use of the earlier mark Triinks succeeds.

Summary

44. The oppositions to each of the applications fail on grounds under section 3(6) of the Act and fail under section 5(4)(a) of the Act insofar as they rely on the earlier “Triinks and splatter” mark. The oppositions to each of the applications succeed under section 5(4)(a) of the Act insofar as they rely on the earlier mark Triinks. Subject to any successful appeal against my decision, the applications will be refused.

Costs

45. The opponent has been successful and is entitled to an award of costs in his favour. The evidence filed by the opponent is not particularly well directed to each of the earlier marks relied on nor to the relevant dates. It is not extensive, consisting, in the main, of pages downloaded from the internet which would not have taken very much effort or cost to collect though it would have taken some time to prepare and file. The counterstatements filed by the applicants are identically worded. The applicants did not file evidence and, in fact, took no part in proceedings other than

filing those counterstatements. The decision has been reached from the papers without a hearing and no written submissions in lieu of attendance at a hearing have been filed. I do not consider it necessary or proportionate to make further enquiries as to the costs to which the opponent has been put. In all the circumstances, I consider the sum of £600 to be a reasonable award to reflect the time, effort and fees involved in opposing the applications.

46. I order Huang Ning Juan, Peter Baxendale and Paramount Europe Ltd to pay Gareth Roberts the sum of £600 as a contribution to his costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of September 2015

**Ann Corbett
For the Registrar
The Comptroller-General**

SHINJI