

ESTTA Tracking number: **ESTTA1007768**

Filing date: **10/09/2019**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Transport for London
Granted to Date of previous extension	10/09/2019
Address	55 BROADWAY LONDON, SW1H0BD UNITED KINGDOM

Attorney information	CATHERINE PARRISH LAKE STOEL RIVES LLP 201 SOUTH MAIN STREET, SUITE 1100 SALT LAKE CITY, UT 84111 UNITED STATES tm-slc@stoel.com 8013283131
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Applicant Information

Application No	87005406	Publication date	06/11/2019
Opposition Filing Date	10/09/2019	Opposition Period Ends	10/09/2019
International Registration No.	NONE	International Registration Date	NONE
Applicant	CKL Holdings N.V. Leeuwenstraat 4 Antwerpen BELGIUM		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Clothing, namely, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, sleep shirts, sarongs, shoulder wraps, shorts, leggings, belts, trousers, jeans, wristbands, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, skirts, waistcoats, bathing suits, pajamas, undergarments, scarves, socks, suits, dresses, blouses, blazers, denims, jerseys, sweatshirts, tops, bottoms, windcheaters, and swimwear; Footwear; Headgear, namely, headbands, hats, caps, and visors
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Grounds for Opposition

No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)
Other	No bona fide intent to use mark in commerce for

	identified goods or services pursuant to Trade-mark Act Section 44(d) and 44(e)
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Attachments	Notice of Opposition to CKL Holdings- Final with exhibits-2.pdf(2279624 bytes)
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Signature	/Catherine Parrish Lake/
Name	CATHERINE PARRISH LAKE
Date	10/09/2019

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 87/005,406
For the Mark: ELIZABETH
Filed: April 19, 2016
Published in the Official Gazette on: June 11, 2019

Transport for London,)	
)	
Opposer,)	Opposition No. _____
)	
v.)	
)	
CKL Holdings N.V.)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Transport for London (“Opposer”) is a public utility established under the laws of the United Kingdom with an address located at 55 Broadway, London SW1H0BD, England, United Kingdom. Opposer believes that it would be damaged by the issuance of a registration for the trademark ELIZABETH (“Applicant’s Mark”) as applied for by CKL Holdings N.V. (“Applicant”) in Application Serial No. 87/005,406 (the “Application”). Accordingly, Opposer hereby opposes registration of Applicant’s Mark and requests that registration of the Application be refused.

As grounds in support of its opposition, Opposer asserts as follows:

1. Opposer is a public utility in the United Kingdom that operates the London Underground, London’s famous underground railway transit system, which uses various station names, including the mark ELIZABETH LINE and Roundel design (the “Opposer’s Mark”).

2. In February 2016, Opposer announced that its new railway line would be called the “Elizabeth Line.”

3. On July 9, 2018, Opposer filed an application with the United States Patent and Trademark Office to register Opposer’s Mark, serial number 88/030,476 (“Opposer’s Application”).

4. On October 27, 2018, the United States Patent and Trademark Office (“USPTO”) issued an office action for Opposer’s Application citing the Application as a bar to registration of Opposer’s Mark.

5. On May 14, 2019, the USPTO suspended Opposer’s Application pending the outcome of the Application.

6. On April 19, 2016, Applicant filed the Application requesting registration of Applicant’s Mark for use in connection with “Clothing, namely, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, sleep shirts, sarongs, shoulder wraps, shorts, leggings, belts, trousers, jeans, wristbands, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, skirts, waistcoats, bathing suits, pajamas, undergarments, scarves, socks, suits, dresses, blouses, blazers, denims, jerseys, sweatshirts, tops, bottoms, windcheaters, and swimwear; Footwear; Headgear, namely, headbands, hats, caps, and visors” in Class 9. The Application was assigned Ser. No. 87/005,406. A true and correct copy of a printout of Applicant’s Application from the USPTO’s TSDR system is attached hereto as Exhibit A.

7. The Application was filed based on a foreign application, Benelux Application No. 01319240, signed by Applicant’s attorney and entered the following statement regarding its

intent to use the ELIZABETH mark: “The applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the identified goods/services”

8. Upon information and belief, Applicant is not using and has no actual plans to use the ELIZABETH mark in United States commerce for any of the goods identified in the Application.

9. Upon information and belief, Applicant knew when it filed the Application that it had no bona fide intent to use the ELIZABETH mark in the United States on all of the goods identified in Class 9 in the Application.

10. Upon information and belief, Applicant knew that it had to file the declaration with regard to having a bona fide intent to use the mark on all of the goods identified in the Application to obtain a filing date for the Application and intended for the USPTO to rely on such declaration.

11. The individual behind Applicant is Michael Gleissner, who serves as Chief Executive Officer for Applicant (“Gleissner”). *See* Exhibit B, a translated listing of Applicant’s entity registration in Belgium and a Dun and Bradstreet listing for Applicant.

12. Applicant and Gleissner have a history of filing trademark applications in bad faith as evidenced by Exhibit C, copies of news articles and court decisions.

13. It is respectfully submitted that Applicant’s declaration of bona fide intent to use the mark in the United States was made with fraudulent intent.

14. On July 8, 2019, Opposer filed and was granted a request for a 90-day extension of time to oppose the Application for Applicant’s Mark until October 9, 2019.

15. Based upon the foregoing, Opposer has been and will continue to be harmed and damaged if the Application is permitted to register.

16. Upon information and belief, Applicant lacked and continues to lack a bona fide intent to use the ELIZABETH mark on the goods identified in the Application; therefore, registration of the application should be refused.

WHEREFORE, Opposer prays that the opposition be sustained, that registration to Applicant be refused, and for such other and further relief as may be deemed to be just and proper.

Dated: October 9, 2019

STOEL RIVES LLP

By: /s/ Catherine Parrish Lake/
Catherine Parrish Lake
Attorney for Opposer
Stoel Rives LLP
One Utah Center
201 South Main Street, Suite 1100
Salt Lake City, Utah 84111
(801) 328-3131

Exhibit A

Generated on: This page was generated by TSDR on 2019-10-08 18:57:32 EDT

Mark: ELIZABETH

Elizabeth

US Serial Number: 87005406

Application Filing Date: Apr. 19, 2016

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Published for Opposition

A pending trademark application has been examined by the Office and has been published in a way that provides an opportunity for the public to oppose its registration.

Status: A request for an extension of time to file an opposition has been filed with the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Jul. 08, 2019

Publication Date: Jun. 11, 2019

Mark Information

Mark Literal Elements: ELIZABETH

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Foreign Information

Priority Claimed: Yes

Foreign Application Number: 01319240

Foreign Application Filing Date: Oct. 19, 2015

Foreign Registration Number: 0983775

Foreign Registration Date: Dec. 31, 2015

Foreign Application/Registration Country: BENELUX

Foreign Expiration Date: Oct. 19, 2025

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Clothing, namely, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, sleep shirts, sarongs, shoulder wraps, shorts, leggings, belts, trousers, jeans, wristbands, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, skirts, waistcoats, bathing suits, pajamas, undergarments, scarves, socks, suits, dresses, blouses, blazers, denims, jerseys, sweatshirts, tops, bottoms, windcheaters, and swimwear; Footwear; Headgear, namely, headbands, hats, caps, and visors

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No	Currently Use: No
Filed ITU: No	Currently ITU: No
Filed 44D: Yes	Currently 44E: Yes
Filed 44E: No	Currently 66A: No
Filed 66A: No	Currently No Basis: No
Filed No Basis: No	

Current Owner(s) Information

Owner Name: CKL Holdings N.V.
Owner Address: Leeuwenstraat 4
Antwerpen BELGIUM
Legal Entity Type: naamloze vennootschap (nv) **State or Country Where Organized:** BELGIUM

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jonathan Grant Morton
Attorney Primary Email Address: jonathan@ckl.com **Attorney Email Authorized:** Yes

Correspondent

Correspondent Name/Address: JONATHAN GRANT MORTON
4TH FL
246 W BROADWAY
NEW YORK, NEW YORK UNITED STATES 10013
Phone: 212-468-5491
Correspondent e-mail: jonathan@ckl.com **Correspondent e-mail Authorized:** Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 08, 2019	EXTENSION OF TIME TO OPPOSE RECEIVED	
Jun. 11, 2019	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 11, 2019	PUBLISHED FOR OPPOSITION	
May 22, 2019	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 03, 2019	LAW OFFICE PUBLICATION REVIEW COMPLETED	76568
Apr. 29, 2019	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 18, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	
Oct. 09, 2018	LIE CHECKED SUSP - TO ATTY FOR ACTION	76568
Mar. 28, 2018	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Mar. 28, 2018	LETTER OF SUSPENSION E-MAILED	6332
Mar. 28, 2018	SUSPENSION LETTER WRITTEN	92985
Sep. 27, 2017	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	
Sep. 26, 2017	LIE CHECKED SUSP - TO ATTY FOR ACTION	76568
Mar. 22, 2017	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Mar. 22, 2017	LETTER OF SUSPENSION E-MAILED	6332
Mar. 22, 2017	SUSPENSION LETTER WRITTEN	92985
Mar. 04, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	76568
Mar. 04, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	76568
Feb. 26, 2017	ASSIGNED TO LIE	76568
Feb. 12, 2017	ASSIGNED TO LIE	77976

Jan. 30, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Aug. 05, 2016	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Aug. 05, 2016	NON-FINAL ACTION E-MAILED	6325
Aug. 05, 2016	NON-FINAL ACTION WRITTEN	92985
Jul. 28, 2016	ASSIGNED TO EXAMINER	92985
Jul. 25, 2016	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Jul. 25, 2016	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Apr. 22, 2016	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 22, 2016	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: TORRES, ELIANA ANDREA

Law Office Assigned: LAW OFFICE 110

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: May 03, 2019

Proceedings

Summary

Number of Proceedings: 2

Type of Proceeding: Extension of Time

Proceeding Number: [87005406](#)

Filing Date: Jul 08, 2019

Status: Extension of Time to Oppose Filed

Status Date: Jul 08, 2019

Interlocutory Attorney:

Defendant

Name: CKL Holdings N.V.

Correspondent Address: JONATHAN GRANT MORTON
4TH FL
246 W BROADWAY
NEW YORK NY , 10013

Correspondent e-mail: jonathan@ckl.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
ELIZABETH	Request For Extension of Time to File Opposition	87005406	

Potential Opposer(s)

Name: Transport for London

Correspondent Address: CATHERINE PARRISH LAKE
STOEL RIVES LLP
201 SOUTH MAIN STREET, SUITE 1100
SALT LAKE CITY UT UNITED STATES , 84111

Correspondent e-mail: tm-slc@stoel.com

Prosecution History

Entry Number	History Text	Date	Due Date
1	FIRST 90-DAY REQUEST TO EXT TIME TO OPPOSE	Jul 08, 2019	
2	EXT GRANTED	Jul 08, 2019	

Type of Proceeding: Opposition

Proceeding Number: [91229127](#)

Filing Date: Jul 21, 2016

Status: Terminated

Status Date: Nov 19, 2016

Interlocutory Attorney: KATIE W MCKNIGHT

Defendant

Name: White Feather Music LLC

Correspondent Address: JOSHUA M GERBEN
GERBEN LAW FIRM PLLC
1050 CONNECTICUT AVE NW, STE 500
WASHINGTON DC UNITED STATES , 20036

Correspondent e-mail: jgerben@gerbenlawfirm.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
LAUREN LIZABETH	Abandoned - No Statement Of Use Filed	86863652	

Plaintiff(s)

Name: CKL Holdings N.V.

Correspondent Address: ROMAN A POPOV
MORTON & ASSOCIATES LLLP
246 WEST BROADWAY, 4TH FLOOR
NEW YORK NY UNITED STATES , 10013

Correspondent e-mail: rp@mortonassociates.com , rp@morton.law

Associated marks

Mark	Application Status	Serial Number	Registration Number
ELIZABETH	Request For Extension of Time to File Opposition	87005406	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jul 21, 2016	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jul 25, 2016	Sep 03, 2016
3	PENDING, INSTITUTED	Jul 25, 2016	
4	ANSWER	Aug 29, 2016	
5	W/DRAW OF OPPOSITION	Nov 19, 2016	
6	BD DECISION: DISMISSED W/ PREJ	Nov 19, 2016	
7	TERMINATED	Nov 19, 2016	

Exhibit B

New search by number	New search by name	New search by activity	New search for admission	New search by address	
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Details of the registered entity

General

Enterprise number:	0870.303.004
Status:	Active
Legal status:	Normal situation Since 1 December 2004
Starting date:	December 1, 2004
Name:	CKL HOLDINGS NV Name in English, since 2 April 2015
Address of the seat:	Rue du Couvent 28-30 4700 Eupen Since March 16, 2017
Telephone number:	No information contained in KBO.
Fax number:	No information contained in KBO.
E-mail:	No information contained in KBO.
Web address:	No information contained in KBO.
Entity type:	Legal person
Legal form:	Public limited company Since November 17, 2004
Number of site units (VE):	1 Data and activities per VE

Functions

Driver	Gleissner, Michael	Since January 7, 2013
Permanent representative	Gleissner, Michael (0886.855.360)	Since September 20, 2006

Professional skills and basic knowledge of business management

Basic knowledge of business management
Since December 1, 2004

Characteristics

Company subject to registration
Since November 1, 2018

Authorizations

No information contained in KBO.

Financial details

Capital	EUR 61,500
Annual meeting	June
Financial year end date	December 31
Start date of exceptional financial year	November 17, 2004
End date of exceptional financial year	December 31, 2005

Linking between entities

No information contained in KBO.

Activities

No information contained in KBO.

external links

[Publications in the Belgian Official Journal Annual Accounts NBB](#)

[Back](#)



FPS Economy, SMEs, Self-employed and Energy.

Status in the CBE database on 07/10/2019
Version: 7.0.1-3054-16 / 07/2019

Company Information

DUNS: 76-244-1660
Name: CKL HOLDINGS
Registered Address: RUE DU COUVENT 28-30
EUPEN,
BELGIUM
Continent: EUROPE
Year Started: 2004
Operating Status: ACTIVE

Executive(s) Information

CEO Name: MICHAEL GLEISSNER
CEO Title: MANAGING DIRECTOR

Exhibit C

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“Flagrant degree of cynicism” - Michael Gleissner slammed in TRUMP TV opposition decision

United Kingdom | July 9 2018

- **Serial trademark filer Michael Gleissner sought TRUMP TV mark in October 2016**
- **Company representing the IP of Trump family prevails in opposition against mark**
- **Decision slams “well-evidenced pattern of abusive behaviour” by Gleissner**

Millionaire and serial trademark filer Michael Gleissner has lost another opposition decision at the UK Intellectual Property Office, this time for the term TRUMP TV. Of particular note is the scathing language used by the hearing officer, with the entrepreneur blasted for having “a disdainful disregard for the opposition costs of the other side” and was ordered to pay £15,000 to a company related to US President Donald Trump.

As *World Trademark Review* has reported on extensively in the last two years, German-born film director Gleissner has become notorious to trademark owners for his rampant filing activity. We reported in 2016 on over 1,000 UK company names in which Gleissner is the sole director, with those entities subsequently used as the applicant name on over 4,400 trademark applications in at least 38 jurisdictions (last year we compiled much of the data into a single searchable document, The Gleissner Files). In February, we published another investigation, The Gleissner Oppositions, looking at trademark decisions in the UK related to the millionaire (with an unprecedented 13.2% of *all* UK opposition decisions in 2018 to that date being against Gleissner marks). While his activity is entirely legal, his motivations remain mysterious and more and more brands are finding themselves impacted.

Since we published our last investigation, Gleissner has been involved in more oppositions at the UKIPO – and has been frequently unsuccessful. Those include oppositions against the marks BRIANNA, DYLAN, EASY, HELIUM, MEME, PALLADIUM, PETRUS, PURPLE and WORLD (although he did prevail in at least one opposition since February, MAGNUS). Many of these oppositions succeeded on a bad faith argument, although the decisions have been relatively mild in criticism and costs have reflected that (ranging from £100 to £1,200). However, the latest opposition decision against a Gleissner-related application stands in stark contrast.

The application for the term TRUMP TV was filed by an entity owned by Gleissner in October 2016 in class 38 (telecom services) and class 41 (production of radio and TV shows). It was subsequently opposed by DTTM Operations LLC, a New York-based entity that handles and protects the intellectual property of US President Donald Trump and his family. The opposition decision was handed down on July 4, with DTTM Operations successful based on the grounds of bad faith. Gleissner’s entity was ordered to pay off-scale costs of £15,105.70 (which includes the opposition fee, UK attorneys’ fee and US attorneys’ fees).

But what makes this opposition unique (other than the involvement of the President of the United States) is that hearing officer Matthew Williams was scathing in his criticism of Gleissner’s legal activity. In describing the applicant’s counterstatement, which denied that the TRUMP TV and TRUMP marks are similar (but did contend

that “in general, the established similarities between trademarks are retained in the average consumer's recollection, rather than the differences”), Williams wrote: “The adoption of such an indefensible position illustrates to me a flagrant degree of cynicism on the part of the Applicant, where other related companies have demonstrated a pattern of similar behaviour, including a disdainful disregard for the opposition costs of the other side.”

Considering whether off-scale costs are warranted in this particular case, Williams was similarly critical of the multi-millionaire, writing: “I particularly bear in mind the well-evidenced pattern of abusive behaviour on the part of Mr Gleissner and his related companies as shown, for example, in the Apple cases referenced above – which decisions were published well in advance of the current opposition – and in the more recent decisions in the Alexander case,” adding: “It is possible that the Applicant saw nothing wrong in its behaviour, but that changes nothing, since its behaviour must be judged against an objective standard. Looked at in that way, I have no doubt that the applicants acted unreasonably.”

Such strongly-worded criticism is rare in a UK opposition. In analysing the decision, Elkington + Fife partner [Chris McLeod](#) feels this could be a turning point. “The hearing officer’s attitude towards Gleissner is palpable,” he tells *World Trademark Review*. “The sentences in paragraphs 60 to 64 make it crystal clear. It is also interesting that he has awarded costs including those of the US attorneys who presumably instructed [UK IP law firm] Beck Greener. In essence, there is no way that the applicant could have made a valid defence, considering that the mark immediately evokes Donald Trump. In my view, the hearing officer was therefore correct to categorise the defence as he did. As such, this decision will give further support for future opponents to UK applications of this nature by Gleissner-owned companies, which can only be a positive development.”

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World Trademark Review - Tim Lince

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SpecialKats: Verónica Rodríguez Arguijo (TechieKat), Hayleigh Bosher (Book Review Editor), Tian Lu (Asia Correspondent) and Chijioke Okorie (Africa Correspondent).

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Bad faith confirmed for ALEXANDER trade mark application

Rosie Burbidge Thursday, January 25, 2018 - [abuse of process](#), [Alexander](#), [appeal](#), [Appointed Person](#), [bad faith](#), [CKL Holdings](#), [Copernicus trade marks](#), [General Court](#), [good faith](#), [Hobbs QC](#), [Michael Gleissner](#), [opposition](#), [Red Bull v Sun Mark](#), [trade marks](#), [UK IPO](#)

A recent decision of Geoffrey Hobbs QC, sitting as an Appointed Person, has rejected an appeal against the Hearing Officer's decision to refuse to register ALEXANDER as a UK trade mark for mirrors and picture frames, on the ground of bad faith, following an opposition from Paper Stacked Limited.



Will the trade marks fun fair last?

The applicant in this matter was CKL Holdings NV, a Dutch company which is owned and controlled by Mr Michael Gleissner. Mr Gleissner has previously appeared on the IPKat in connection with a range of cancellation actions which he applied for on a large scale. Indeed, it is fair to say that he has gained some notoriety in trade mark circles.

The Opponent, Paper Stacked Ltd, provided substantial evidence which included the following information:

1. Mr Gleissner is a director of over 1,200 UK companies, which include Trump International Ltd and EUPIO International Ltd
2. The applicant holds 100s of marks in the US, Benelux and elsewhere.
3. Many of the marks applied for or registered by the applicant consist of common names, such as ANNA, JESSICA, JULIA, ALAN, HOWARD, CHRISTINE, ELIZABETH, RYAN, PAUL, PETER or other words, such as the names of colours, BLUE, SAND, EBONY, EMERALD. (Mr Hobbs QC noted that 6 of the 8 applications applied for in the UK were opposed by third parties - compared with the usual 4.5% opposition rate).
4. The applicant has also registered more distinctive names, such as EUIPO and TESLA in the Benelux and holds an international registration for BAIDU.
5. Other companies controlled by Mr Gleissner are reported to have applied to register marks which are well known in the US or Europe, such as THE HOME DEPOT, ENRON, THE LEARNING CHANNEL and PAN AM.
5. The Trademarks Manager at another of Mr Gleissner's companies (who also signed the counterstatement in this case) once listed his job responsibilities on LinkedIn as including '*manipulating trademarks to reverse hijack domain names through UDRP*', although this comment was subsequently removed.



One of many famous marks
targeted by Mr Gleissner

CKL Holdings relied on the presumption of good faith in trade mark applications and submitted that the substantial evidence provided in the opposition was insufficient to rebut this presumption.

Mr Hobbs QC considered the relevant authorities including the judgment of Arnold J in *Red Bull GmbH v Sun Mark Ltd* [2012] EWHC 1929 (Ch) at [130] to [138] and the EU General Court's decision in *Copernicus Trademarks* (Case T 82/14) ECLI:EU:T:2016:396. The General Court's decision in Copernicus is under appeal to the Court of Justice of the European Union (CJEU) but Hobbs QC nevertheless considered it helpful to the issues in dispute and quoted from the court's observation that "*not only the filing strategy practiced by Mr A. is incompatible with the objectives pursued by Regulation No 207/2009, but that it is not unlike the cases of 'abuse of law'...*".

In light of the facts and the various authorities, Mr Hobbs QC had no difficulty in dismissing CKL's appeal.

The Registrar provided some further observations which helped to "reinforce" the Appointed Person's view and may be of interest to the community:

- *"(i) As at 30th November 2017, various legal entities of which Mr Michael Gleissner is a director, and which communicate from the same email address as the appellant in these proceedings, were a party to 97 live contested trade mark cases before the UK IPO. This is about 5% of all the live contested trade mark cases before the UK IPO. □*

- *(ii) The volume and proportion of cases involving Mr Gleissner's companies has reduced over recent months. At one point they accounted for 8% of all the contested UK trade mark cases. □*

- *(iii) Although the various legal entities communicating from the above email address rarely file any factual evidence before the UK IPO, an unusually high proportion proceed to a final decision. The registrar issued 42 final decisions in contested trade mark cases in November 2017. The various legal entities communicating from the appellant's email address were a party to 8 (nearly 20%) of those decisions." □*

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Never too late: if you missed the IPKat last week!

PREVIOUS

Trial sequence in SEP litigation - time for a rejig?

3 Comments:



Barbara Cookson

Thursday, 25 January 2018 at 12:33:00 GMT

A useful case.

I am curious about the opponent who brought it Paper Stacked Ltd. Its director has no less than 34 companies and I've seen some of those involved in strange oppositions. What goes on? We should be told

Reply

Anonymous

Friday, 26 January 2018 at 08:58:00 GMT

Barbara, a brief search shows that the director of Paper Stacked Ltd is an accountant and financial adviser who advises with high wealth individuals.

As set out in this decision, the first name trade marks filed by Michael Gleissner's companies have been used to interfere with businesses run by high wealth individuals e.g. fashion designers.

I may be putting two and two together and getting five, but I can certainly make a reasonable guess as to the motivation behind the so-called "strange" oppositions filed by the Opponent.

Reply

Anonymous

Sunday, 28 January 2018 at 11:39:00 GMT

It reminds me of a similar case in France years ago. For instance, when for instance rumours of merger came up, the chap rushed to file trade marks which could be used after the merger. One example was the merger between Pechiney and Ugine-Kuhlmann. The trade mark PUK was filed very swiftly. The little game went on for a while, until a French court considered this type of behaviour as being parasitic.

In the present case, and in view of the comments above, I would think that two parasites are parasiting each other!

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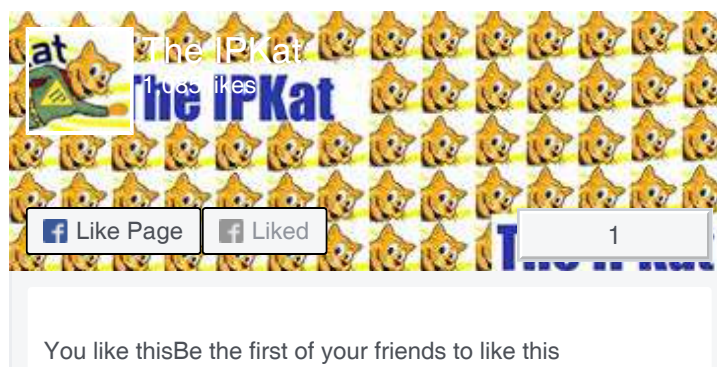
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25 Jan
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"Infamous troll" Michael Gleissner involved in 5% of all live contested trademark cases in United Kingdom

- **Entrepreneur Michael Gleissner fails attempt to register term ALEXANDER**
- **Attorney says Gleissner is missing the trademark registration system**
- **Entities related to him account for 5% of all live trademark cases in UK**

In a decision which one trademark attorney characterises as good news for brand owners, the UK Intellectual Property Office (UKIPO) has upheld an earlier decision which dismissed entrepreneur Michael Gleissner's attempt to register the common name ALEXANDER as a trademark. The decision includes the startling reveal that entities related to Gleissner account for 5% of *all* live contested trademark cases in the UK demonstrating the unprecedented volume of the millionaire's filing activity.

As we have [reported on extensively](#), German-born film director Gleissner has become notorious to trademark owners around the world for his rampant filing activity. Research conducted by *World Trademark Review* has revealed an unprecedented level of activity, including the discovery of over 1,000 UK company names in which he is the sole director. Those entities were subsequently used as the applicant name on upwards of 4,400 trademark applications in at least 38 jurisdictions. On top of that, we discovered that entities linked to Gleissner own at least 5,300 domain names. While such activity is entirely legal, his motivations remain mysterious and have been described by one expert as more sophisticated than anything seen before. We have compiled much of the data into a single searchable document, [The Gleissner Files](#).

The latest development is [an opposition decision](#) at the UKIPO. Issued yesterday, the office upheld a decision which dismissed an attempt to register the term ALEXANDER as a trademark by a Gleissner-related entity, CKL Holdings NV. The opposed mark is one of countless other common names he has filed applications for across the world, including [ASHLEY, DONALD, ELIZABETH, EMILY, HARRY, JOHN, MARIO](#) and [PETER](#) many of which have reached registration (including all those referenced). The ALEXANDER mark, on the other hand, was rejected on the basis that there was no sound business reason to use it. The decision referenced statements from the hearing officer in the initial decision, Allan James, including that there is an absence of any apparent commercial logic for the filing pattern of the applicant and/or Mr Gleissner's other companies, and that there is evidence that companies controlled by Mr Gleissner have been found to have abused legal systems.

The hearing officer also made a suggestion on how the mark could be used if accepted, which Geoffrey Hobbs QC appears to agree with: "In my judgment, the opponent has presented a *prima facie* case that the contested mark is part of a blocking strategy intended to obtain financial benefit from third parties who are likely to be already using, or who are likely in the future to wish to use, trade names including, in this case, the name ALEXANDER in order to distinguish their goods or services."

The decision ended with some shocking statistics on the scale of UK legal proceedings that Gleissner is involved in. As of November 30 2017, entities related to Gleissner were party to 97 live contested trademark cases before the UKIPO (some of which [we have written about](#)). In total, that makes up an incredible 5% of all live contested trademark cases in the UK. That's not all; that proportion of cases has actually been falling - at one point a few months earlier they accounted for 8% of all contested UK trademark cases. Reacting to these startling figures [Tania Clark](#), partner and trademark attorney at Withers & Rogers, issued a warning to brand owners: "Such litigation can disrupt the marketing strategies of businesses affected and in some instances, delay their own brand registrations."

Reiterating that point is [Barbara Cookson](#), a patent and trademark attorney at Filemot Technology Law, who [tells World Trademark Review](#) that she has personal experience in the disruption caused by Gleissner's activities. "I've only had one client affected by his actions, [and] we managed quite effectively with a much less expensive company names tribunal challenge," she explains. "Other brand owners seem to have spent a great deal more money. He clearly hasn't much love for mainstream advisers and is probably enjoying watching them spend a lot of time and money dealing with situations that possibly are not that threatening to their brands."

Reflecting on the latest decision, Clark concludes that it is ultimately "good news for brand owners", adding: "Gleissner's activities, which can only be described as 'troubling', have been frustrating trademark systems and his actions have not gone unnoticed. The decision makes it clear that the UKIPO is unwilling to tolerate 'troubling' behaviour, where individuals seek to obtain trademarks for no other reason than to extort fees or disrupt the activities of legitimate businesses. Brand owners will be hoping that the UKIPO continues its efforts to prevent Gleissner from misusing the trademark registration system." Cookson, on the other hand, is more sceptical: "I think Gleissner thinks he's had a very bad deal from the trademark system, and being rather an affluent gentleman decided to try and turn it to his advantage. However, the vast majority of his marks and companies aren't direct blocks so I do think [hearing officer] James' inference was bold."

For his part, Gleissner remains silent and all previous efforts to reach him for reaction have gone unanswered. In the UK it seems that the office is taking a critical approach to his applications once oppositions are lodged. In other countries, though, a significant percentage of his filings are reaching registration and this includes key jurisdictions such as Benelux, France, and the United States. It for that reason, then, that law firm Withers & Rogers describes Gleissner as an "infamous" troll of the trademark system in its press release following this week's decision. And while it's been over a year since we started reporting on the notorious millionaire's filing spree, this could still just be the beginning.

Tim Lince

Author □ Senior reporter

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Neutral Citation Number: [2019] EWHC 769 (Ch)

Case No: CH-2018-000205

**IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
CHANCERY DIVISION**

Royal Courts of Justice
7 Rolls Building, Fetter Lane, EC4A 1NL
29th March 2019

B e f o r e :

THE HON MR JUSTICE HENRY CARR

Between:

TRUMP INTERNATIONAL LIMITED

Appellant

- and -

DTTM OPERATIONS LLC

Respondent

**COMPTROLLER GENERAL OF PATENTS,
DESIGNS AND TRADE MARKS**

Intervener

**Denise McFarland (instructed by Appleyard Lees (Attorneys)) for the Appellant
Ian Bartlett from Beck Greener for the Respondent
Nicholas Saunders QC (instructed by The Treasury Solicitor) for the Intervener**

Hearing dates: 28 February 2019

HTML VERSION OF JUDGMENT APPROVED

MR JUSTICE HENRY CARR:**Introduction**

1. Attempts to register well-known trade marks by parties who have no connection with such marks ("third-party trade marks") are a global problem. In many jurisdictions, applications to register such marks have been rejected on the basis that they were filed in bad faith. For a recent discussion of the scale of the problem in China, including a comparative law analysis, see Jyh-An Lee, Hui Huang: *Post-Application Evidence of Bad Faith in China's Trademark Law*, Journal of Intellectual Property Law & Practice, Volume 13, Issue 5, 1 May 2018 pages 400 - 407.
2. On 30 October 2016, the Appellant ("Trump International") applied to register the words "TRUMP TV" as a UK trade mark ("the Application"). The Application was made in respect of certain services in class 38 (communication and broadcasting) and goods and services in class 41 (entertainment and education). Trump International has no connection with Mr Donald Trump, who, at the date of the Application, was standing for election as President of the United States. An opposition was brought by the Respondent ("DTTM") which holds and administers (amongst other things) trade mark registrations previously owned by Mr Trump ("the Opposition").
3. DTTM advanced four grounds of opposition, pursuant to the following provisions of the Trade Marks Act 1994:
 - i) section 3(6): DTTM alleged that the Application was filed in bad faith;
 - ii) section 5(2)(b): DTTM claimed that it owned earlier EU trade marks, namely a word mark "TRUMP" and a word and device mark "TRUMP & CREST DEVICE". It claimed that the earlier marks were similar to the Application and were registered in respect of goods and services that were identical or similar to the goods and services applied for such that there was a likelihood of confusion on the part of the relevant public as to the origin of the goods and services at issue;
 - iii) section 5(3): DTTM relied upon its ownership of the "TRUMP" word mark and claimed to have a substantial reputation in that earlier word mark in relation to certain of the goods and services covered by the Application; and
 - iv) section 5(4): DTTM claimed to have earlier unregistered rights in relation to the trade mark "TRUMP", used throughout the UK since at least 2007. It claimed that use of the Application by Trump International would constitute passing off.
4. The parties did not request an oral hearing and elected to have the Opposition determined by the Intellectual Property Office ("the IPO") on paper. By a decision dated 4 July 2018 ("the Decision"), the Hearing Officer, Mr Matthew Williams, concluded that the Application had been filed in bad faith and refused the Application in its entirety. He declined to consider the other grounds of opposition, although at [54] of the Decision he noted "patent inconsistencies in the counterstatement" and said that "I have no doubt that I would have found in [DTTM]'s favour in other aspects of its claims."
5. Trump International exercised its statutory right to appeal to the High Court from the Decision and consequent Order of the Hearing Officer. It advanced two general grounds of appeal, namely that:
 - i) the Hearing Officer had made errors of law or principle in reaching his conclusion on the evidence before him that the Application had been filed in bad faith; and
 - ii) alternatively, permission to adduce additional evidence on appeal should be granted and the additional evidence demonstrated that the Application had not been filed in bad faith.

Procedural history of the Opposition

6. The procedural history of the Opposition is relevant to the general grounds of appeal identified above. In summary:

- i) The Application was made by Trump International on 30 October 2016. Trump International was incorporated on 31 October 2016;
- ii) Following examination in the Registry, on 8 November 2016, Trump International was informed that various earlier "TRUMP" trade marks had been identified following a search and that owners of earlier UK trade marks would be notified, in accordance with Registry practice. The examiner expressed the non-binding view that the Application was similar to the earlier trade marks and their services and therefore that the public was likely to confuse the trade mark with the earlier trade marks. Trump International nevertheless pursued the Application which was published on 20 January 2017;
- iii) On 20 April 2017, DTTM filed a notice of opposition. In relation to its objection under section 3(6), DTTM alleged, amongst other things, that: Trump International was one of at least several hundred companies controlled by the same individual, a Mr Gleissner, and it was improbable that it had a *bona fide* intention to use the mark; Trump International could not fail to be aware of the international reputation of the TRUMP trade mark; the Application was intended to damage that reputation or otherwise disrupt the legitimate business interests of DTTM; and the Application was an instrument of fraud;
- iv) On 26 June 2017, Trump International filed a TM8 and counterstatement in defence of the Opposition, which was 30 pages in length. It was faxed to the IPO by Mr Matthew Bedford, a paralegal at the US law firm, Morton & Associates LLP. The counterstatement was signed by Mr Alfean Samad of the "Legal Affairs Department" of Trump International, acting on its behalf. The counterstatement contained detailed legal submissions in connection with the various prior rights relied upon and cited various decisions of the Court of Justice of the European Union ("the CJEU"). Legal submissions were also made about the bad faith ground of objection, which was denied;
- v) The IPO then set a timetable for the filing of evidence. DTTM's evidence was to be filed by 5 October 2017 with Trump International's evidence to be filed two months after receipt of DTTM's evidence;
- vi) On 5 October 2017, DTTM filed two witness statements in support of the Opposition;
- vii) On 5 December 2017, Trump International filed written submissions in reply but did not file any evidence; and
- viii) Neither party requested a hearing and on 15 February 2018 DTTM filed written submissions in lieu of a hearing. No further submissions were filed by Trump International.

The evidence before the Registrar

7. DTTM filed two witness statements in support of the Opposition. It relied upon a statement of Mr Alan Garten, the vice-president of DTTM, who stated that Trump International had no connection with the business carried out by DTTM. The statement described at [4] certain business activities carried on by Mr Trump in the UK through DTTM, including real estate and golf courses.
8. DTTM also relied upon a statement by Mr Duncan Morgan, a trade mark attorney at Beck Greener, in relation to the section 3(6) ground of objection. Among other things, Mr Morgan provided evidence that:
 - i) Trump International was incorporated the day after the filing of the Application for the "TRUMP TV" trade mark; Morgan [2];
 - ii) the sole director of Trump International is Mr Michael Gleissner. Mr Gleissner is the sole director of over 1000 UK companies almost all of which are believed not to be trading; Morgan [3];

iii) Mr Gleissner is reported to be behind a significant number of companies in other territories. In an article from World Trademark Review Mr Gleissner was identified as being behind, or linked to, a network of company name registrations, domain name registrations and trade mark applications/registrations over the last few years; Morgan [3] and exhibit DM2; and

iv) Mr Gleissner, through the companies that he controls, has been involved in numerous trade mark proceedings in the UK and elsewhere. At paragraph [4], Mr Morgan referred to a decision of Mr Allan James in *Sherlock Systems CV v Apple Inc* Decision O/015/17; [2017] FSR 30 ("the *Apple* case") which concerned 68 applications by companies under the control of Mr Gleissner to revoke trade marks for non-use which were owned by Apple. Mr James found that the proceedings had been brought for an ulterior and improper purpose and should be struck out as an abuse of process. Mr James made an order for off-scale costs in favour of Apple which he assessed at £38,085 (Decision O/118/17).

9. Mr Morgan also gave evidence at paragraphs [9] – [10] that the motivation of Mr Gleissner in registering various trade marks was not always clear but that the *Apple* case and press article suggested that Mr Gleissner's companies have attempted to register famous trade marks associated with third parties as their own. These included applications for the trade marks ITUNES, IPHONE and APPLE. Companies controlled by Mr Gleissner had also set up a deceptive version of the TMview search engine, which is a trade mark resource allowing users to search various national and intergovernmental trade mark registers and is operated by the EU Intellectual Property Office ("EUIPO").
10. Mr Morgan gave evidence at [11] that Mr Gleissner was the sole director of EUIPO International Ltd which had applied for Portuguese and Canadian trade marks for EUIPO, despite that trade mark being associated with the EUIPO.
11. At paragraphs [12] – [13], Mr Morgan provided examples of other marks applied for by companies controlled by Mr Gleissner including THE HOME DEPOT, PAN AM, TESLA, THE LEARNING CHANNEL logo and LEHMAN BROTHERS.
12. At paragraph [14], Mr Morgan stated that various of Mr Gleissner's companies had been accused of involvement in "reverse domain name hijacking" which involves filing trade mark applications in respect of well-known third-party trade marks whilst simultaneously attempting to cancel earlier registrations which could be used to oppose the application. Once registered, the new trade mark is used as the basis for a domain name complaint ("a UDRP complaint") against the domain name corresponding to the revoked trade mark. Once the domain name is transferred to the owner of the new trade mark, it can be sold at a profit or retained whilst it appreciates in value.
13. In support of this allegation, Mr Morgan referred at [15] to a UDRP complaint brought by Compania Mexicana de Aviacion, S.A. de C.V. against one of Mr Gleissner's companies, Bigfoot Ventures Ltd. The panel found that Bigfoot had registered the domain name VTP in bad faith. VTP had been the trade mark of the Mexican airline for over 75 years, and Bigfoot had used the domain to direct traffic to a website which contained links to travel offers from competitors of Compania Mexicana de Aviacion.
14. At [16], Mr Morgan said that a lawyer who worked for Bigfoot Entertainment between March 2015 and February 2017 had stated on his LinkedIn profile that his role was "to ensure creative resolution of IP disputes, including manipulation of TMs and common law marks to achieve UDRP 'reverse domain name hijacking'". Mr Morgan also gave examples in his witness statement of cases known to his firm in which entities controlled by Mr Gleissner had applied for trade marks used by his clients. Those were applications in which Mr Morgan considered that it was clear that the opposition would succeed on the basis of prior rights about which the applicant had been notified.
15. Mr Morgan concluded his evidence by stating at [21] that "it is clear the Application was filed to take advantage of the reputation of the TRUMP mark, damage it, disrupt the legitimate interests of [DTTM] in that mark, and/or to cause [DTTM] to incur unnecessary time and expense in trade mark proceedings."

16. Trump International chose not to file evidence in answer. On 5 December 2017, Trump International, by Mr Samad of its Legal Affairs Department, wrote acknowledging receipt of the evidence and making submissions in reply to the evidence of Messrs Garten and Morgan. These submissions made the following points:

- i) that the application to incorporate Trump International had been made on 30 October 2016 which was the same date as the Application for the mark (a copy of the application was enclosed with the submissions);
- ii) various points were made about the awards and accolades, photographs and advertisements referred to in Mr Garten's evidence; and
- iii) in respect of the bad faith allegations, other than the point about the date of incorporation of Trump International, Trump International's response to Mr Morgan's statement made two assertions: first, that the *Apple* case could be distinguished as it concerned the cancellation of numerous Apple registrations and abuse of process; and secondly, that Trump International should be afforded the benefit of its corporate veil.

The Decision of the Hearing Officer

17. The Hearing Officer set out the pleadings, the evidence and the parties' written submissions in detail, and it was not suggested that he had omitted any material fact. He also set out, accurately, the relevant legal principles applicable to claims that a mark has been filed in bad faith.

18. At [44] the Hearing Officer noted that, confronted with the evidential basis for the bad faith claims, Trump International had limited its response to addressing the technical objection that it was not incorporated on the date of the Application and distinguishing the circumstances of the *Apple* case from those of the current Application. In relation to the *Apple* case he recognised the factual differences but found that the numerous instances identified in the evidence remained relevant to the case at hand. He attached no significance to the fact that Mr Gleissner was joined in a personal capacity in the *Apple* case as it seemed uncontested that it was he who was the controlling interest behind the large array of companies referred to in the evidence, and he was shown to be the sole director of the Applicant in this case.

19. At [45] the Hearing Officer said:

"I note the Opponent's points as to a pattern of behaviour by companies under Mr Gleissner's control making it highly improbable that the Applicant had a bona fide intention to use the mark. Although the pattern of behaviour is well-evidenced, it cannot of itself sustain a claim of bad faith for any and all applications by Mr Gleissner or companies under his control. However, when taken in the context of this particular Application, where the Applicant's mark involves the distinctive name of an exceptionally well-known businessman and public figure (being Donald Trump Jr), and when taken with the further allegations of a motivation on the part of the Applicant to interfere with the legitimate interests of the Opponent in the TRUMP mark, then I find the combination easily overcomes the presumption of good faith and founds a prima facie basis for bad faith. Yet the Applicant offered no evidence or alternative account to counter the clear allegations, indeed nor do the Applicant's submissions of 5 December 2017 even deny them."

20. At [46] the Hearing Officer noted that there had been no request for an oral hearing to challenge any of DTTM's evidence. The Hearing Officer referred to the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person in Decision O/036/18 ("the *Alexander* case") which DTTM had submitted was highly analogous to the present case. He noted that in the *Alexander* case, Mr Hobbs referred to the judgment of the General Court in Case T-82/14 *Copernicus-Trademarks v EUIPO* [EU:T:2016:396](https://eur-lex.europa.eu/legal-content/EN/TJ/?uri=CELEX:2016:396) at paragraphs [26] – [27] which made clear that the "first-to-file" principle is qualified in the face of bad faith on the part of an applicant.

21. At [47] the Hearing Officer referred to the key questions for determination in respect of section 3(6) applications formulated by Mr Hobbs in the *Alexander* case, ("the *Alexander* questions"). Mr Hobbs set out the *Alexander* questions and their rationale at [8] of his decision:

"The key questions for determination by the Hearing Officer were: (1) what, in concrete terms, was the objective that CKL had been accused of pursuing? (2) was that an objective for the purposes of which the contested application could not properly be filed? (3) was it established that the contested application was filed in pursuit of that objective? The first question serves to ensure procedural fairness and clarity of analysis. The second question requires the decision taker to apply a moral standard which, in the absence of any direct ruling on the point from the CJEU, is taken to condemn 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 (Lindsay J). The third question requires the decision taker to give effect to the principle that innocence must be presumed in the absence of evidence sufficient to show that the applicant has acted improperly as alleged."

22. The Hearing Officer answered the *Alexander* questions in respect of the case before him at [48]. He said:

"In the context of the current case, I find that with regard to the first question, the Opponent has set out its accusations of the Applicant in very clear and concrete terms, ensuring procedural fairness and clarity of analysis. The second question, entails applying the principles of law summarised in *Red Bull GmbH v Sun Mark Ltd* and the third question involves drawing rational inferences from proven facts without allowing the assessment to degenerate into an exercise in speculation. As the Appointed Person noted in *Alexander*, the CJEU has confirmed that there must be an overall assessment which takes into account all factors relevant to the particular case. As part of that assessment, it is necessary to consider the intention of the Applicant at the time when the Application was filed, with intention being regarded as a subjective factor to be determined by reference to the objective circumstances of the particular case."

23. He then considered the Applicant's state of knowledge at the time that the Application was filed at [49]:

"I must consider what the Applicant knew about the matters in question on 30 October 2016. Although the Applicant has offered little by way of response to the bad faith allegations, I note that elsewhere in its counterstatement it exclusively attributes dictionary definitions to the word Trump. I consider it disingenuous to deny that there would be widespread public awareness of the surname significance of the word. I accept the Opponent's submission that the Applicant cannot have failed to be aware of the international reputation of the Trump trade mark..."

24. In the same paragraph, he said:

"...I am satisfied that the Application forms part of a series of abusive registrations made by Mr Gleissner under the guise of one of his companies to seek protection over [a] famous third-party marks (as indicated in the evidence from Mr Morgan). While motives are not certain, I find that it [is] unlikely that there was an intention by the Applicant to use the mark as a trade mark in trade – no such intention having been supported by evidence, notwithstanding that Mr Gleissner is known to have a professional connection to television production under other names."

25. At [50] the Hearing Officer found that it was likely that the intention was to gain some advantage deriving from the notoriety of Donald Trump. Whilst he considered that there were some shortcomings in the evidence of Mr Garten, nonetheless, the evidence showed the presence of TRUMP, as a brand, investing many tens of millions of pounds in property in the UK, particularly in the form of golf courses and luxury accommodation, at which resorts the brand was further promoted through

merchandising. He noted the Press coverage at Mr Garten's Exhibit F, which implicitly highlighted the notoriety of Mr Trump, running his name in headlines and referencing Trump Tower in New York.

26. At [51] the Hearing Officer noted that Mr Morgan also referred to Mr Trump being at the time of the Application a political candidate. The Hearing Officer considered it common knowledge and fair to observe that the Application was filed less than three months before the inauguration of Mr Trump as the President of the United States of America. He concluded that Mr Trump's exceptional notoriety and profile undoubtedly encompassed not merely services pertaining to golfing or hospitality (the focus of Mr Garten's evidence) but his wider impact as a business tycoon, reality television star and prospective US Head of State.
27. At [52] the Hearing Officer addressed the fact that DTTM was no longer linked to Mr Trump. He did not regard this as significant, since, as Mr Hobbs made clear at paragraph [19] of the *Alexander* case, pursuant to CJEU case law there is no requirement for the objector to be personally aggrieved by the filing of the application in question. It is possible for an objection to be upheld upon the basis of improper behaviour by the applicant towards persons who are not parties to the proceedings provided that their position is established with enough clarity to show that the objection is well-founded.
28. At [53] he concluded that:

"I find that the Applicant has acted below the standards of acceptable commercial behaviour judged by ordinary standards of honest people, and the Application is accordingly refused for bad faith."

Appeals from the Registrar of Trade Marks

29. In *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch) at [11] Arnold J, approved a summary of the applicable principles by Mr Daniel Alexander QC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [14] to [52]. Such principles are equally applicable in respect of appeals to the High Court. A finding that an application has been filed in bad faith is a multifactorial value judgment. Such decisions are very unlikely to be overturned on appeal in the absence of a distinct and material error of law or principle (*TT Education Ltd* At [52]):

"(iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson* and others)."

The first basis of the appeal: that the Hearing Officer made errors of law or principle in reaching his conclusion on the evidence before him

The grounds of appeal

30. Ms Denise McFarland, who presented the appeal on behalf of Trump International with considerable skill, submitted that the appeal should succeed even if the fresh evidence was not admitted. Whilst the grounds of appeal were diffuse and repetitive, Ms McFarland identified three key allegations:
31. First, that the Hearing Officer showed actual or apparent bias, rendering the hearing process and the Decision unfair and contrary to the ECHR. It was submitted that the Hearing Officer demonstrated bias in accepting and relying upon evidence or allegations concerning the history of behaviour in unrelated actions and upon allegations concerning Mr Gleissner, who was not a party to the proceedings. It was contended that this led, wrongly, to the rejection of the Application and was damaging to the personal reputation of Mr Gleissner and any companies with which he was associated or which he controlled.
32. Ms McFarland contended that, having allowed himself to be convinced that Mr Gleissner was a "bad apple", the Hearing Officer allowed prejudice and bias to permeate his thought processes. This caused him to take an impermissible short cut in what should have been a rigorous analysis of whether bad faith in relation to this Application by this Applicant had been made out.
33. Secondly, it was alleged that having decided that DTTM had established that the Application was made in bad faith, the Hearing Officer erred in law or in principle in failing to make any findings in relation to the other grounds of opposition, whilst nonetheless taking them into account when awarding costs.
34. Finally, it was submitted that this appeal should be stayed pending the determination of a reference to the CJEU in *Sky plc and Ors v Skykick UK Limited and Anor* [2018] EWHC 155. One question referred to the CJEU in *Skykick* is whether it can constitute bad faith to apply to register a trade mark without any intention to use it in relation to the specified goods or services. Ms McFarland contended that this appeal should not be determined until that reference had been concluded as it concerned an issue of direct relevance to the matters in issue in these proceedings.

Discussion

35. It is necessary to consider legal principles in respect of two areas of law, namely (i) actual or apparent bias and (ii) admissibility of similar fact evidence in civil proceedings.

Actual or apparent bias – legal principles

36. When considering judicial bias, the Court must inform itself of all the circumstances which relate to the suggestion that the decision-maker is biased. It must then ask itself whether a fair-minded and informed observer, having considered the facts, would conclude that there was a real possibility that the judge or justice was biased (*Porter v Magill* [2001] UKHL 67 at [102]-[103], endorsing (with modification) *Re Medicaments and Related Classes of Goods (No 2)* [2001] 1 WLR 700).
37. Actual bias arises where a judge or justice is a party to the proceedings or has a financial or proprietary interest in the outcome (*R v Gough* [1993] AC 646) at 661. If actual bias is established, the individual concerned must be disqualified (i.e. automatic disqualification) (*R v Gough* [1993] AC 646). Apparent bias may arise where the judge's or justice's conduct or behaviour gives rise to a suspicion that he/she is not impartial (without there being evidence to suggest that the judge or justice is a party to the proceedings and/or has a financial interest in the outcome so as to cause his/her automatic disqualification) (*R v Bow Street Metropolitan Stipendiary Magistrate, ex p Pinochet Ugarte (No 2)* [2000] 1 AC 119 at [132] – [133]).
38. The test applicable to apparent bias, regardless of whether a justice, member of an inferior tribunal or arbitrator is concerned, is whether, having regard to the relevant circumstances, there is a real possibility of bias on the part of the individual in question, in the sense that he/she might unfairly regard with favour, or disfavour, the case of a party to the issue under consideration by him/her (*R v*

Gough [1993] AC 646 at 669; *Porter v Magill* [2001] UKHL 67 at [103]). It is an objective test: i.e. the question is addressed by a fair-minded and informed observer; (*Harb v Prince Abdul Aziz* [2016] EWCA Civ 556 at [69] – [71]; *Re Medicaments and Related Classes of Goods (No 2)* [2001] 1 WLR 700).

Admissibility of similar fact evidence in civil proceedings

39. The principles on which similar fact evidence is admissible in civil cases were explained by the House of Lords in *O'Brien v Chief Constable of South Wales Police* [2005] UKHL 26. The Court of Appeal had held that similar fact evidence was only admissible in a civil suit if it was likely to be reasonably conclusive of a primary issue in the proceedings or alternatively if it had enhanced relevance so as to have substantial probative value. The House of Lords held that this test was too restrictive. There should be a two-stage enquiry where the admissibility of such evidence was challenged: first, whether the evidence was potentially probative in the proceedings; and secondly, whether the admission of such evidence would accord with the overriding objective of deciding cases justly. It is necessary to understand the reasons underlying each limb of the two stage enquiry.

40. As to probative value, Lord Bingham said at [3] – [4]:

"3. Any evidence, to be admissible, must be relevant. Contested trials last long enough as it is without spending time on evidence which is irrelevant and cannot affect the outcome. Relevance must, and can only, be judged by reference to the issue which the court (whether judge or jury) is called upon to decide. As Lord Simon of Glaisdale observed in *Director of Public Prosecutions v Kilbourne* [1973] AC 729, 756, "Evidence is relevant if it is logically probative or disprobative of some matter which requires proof... relevant (i.e. logically probative or disprobative) evidence is evidence which makes the matter which requires proof more or less probable".

4. That evidence of what happened on an earlier occasion may make the occurrence of what happened on the occasion in question more or less probable can scarcely be denied. If an accident investigator, an insurance assessor, a doctor or a consulting engineer were called in to ascertain the cause of a disputed recent event, any of them would, as a matter of course, enquire into the background history so far as it appeared to be relevant. And if those engaged in the recent event had in the past been involved in events of an apparently similar character, attention would be paid to those earlier events as perhaps throwing light on and helping to explain the event which is the subject of the current enquiry. To regard evidence of such earlier events as potentially probative is a process of thought which an entirely rational, objective and fair-minded person might, depending on the facts, follow. If such a person would, or might, attach importance to evidence such as this, it would require good reasons to deny a judicial decision-maker the opportunity to consider it..."

41. As to the second stage, Lord Bingham said at [5]:

"5. The second stage of the enquiry requires the case management judge or the trial judge to make what will often be a very difficult and sometimes a finely balanced judgment: whether evidence or some of it (and if so which parts of it), which ex hypothesi is legally admissible, should be admitted. For the party seeking admission, the argument will always be that justice requires the evidence to be admitted; if it is excluded, a wrong result may be reached. In some cases, as in the present, the argument will be fortified by reference to wider considerations: the public interest in exposing official misfeasance and protecting the integrity of the criminal trial process; vindication of reputation; the public righting of public wrongs. These are important considerations to which weight must be given. But even without them, the importance of doing justice in the particular case is a factor the judge will always respect. The strength of the argument for admitting the evidence will always depend primarily on the judge's assessment of the potential significance of the evidence, assuming it to be true, in the context of the case as a whole."

42. These principles will no doubt be familiar to intellectual property practitioners. In relation to allegations of copyright infringement, it is necessary to decide, as a matter of fact, whether copying

has occurred. As with claims of bad faith, direct evidence of copying is rarely available. In this context, it is well established that similar fact evidence may be admissible. The case law is considered in *Copinger and Skone James on Copyright*, Vol 1, 17th Edition at [21-393]:

"...where the issue in a copyright case is whether the similarity between the claimant's work and the defendant's work is due to copying or is a coincidence, it is relevant to know that the defendant has produced works which bear a close resemblance to works other than the work in question which are the subject of copyright. Whereas similarity between two works might be mere coincidence in one case, it is unlikely that there could be coincidental similarity in, say, four cases. The probative force of several resemblances together is much better than one alone."

43. This reasoning may well apply, depending on the facts, to an allegation that a third-party trade mark has been applied for in bad faith. The probative force of several instances of such applications, by the same or a connected party who has applied to register a third-party trade mark, is obvious. Such instances, if based on solid grounds, are likely to require evidence from the applicant to refute the inference of bad faith that may otherwise be drawn from them.

Application to the present case

44. The suggestion that the Hearing Officer was actually biased is obviously unsustainable and was not developed in argument by Ms. McFarland. It was not alleged that he was a party to the litigation or had a financial or other interest in its outcome. Equally, in my judgment, a fair-minded and informed observer would not conclude that the Hearing Officer's conduct or behaviour gave rise to a suspicion that he was not impartial. Having regard to the relevant circumstances, the fair-minded and informed observer would conclude that there was no real possibility of bias on the part of the Hearing Officer, in the sense that he might unfairly regard with favour, or disfavour, the case of Trump International.
45. Allegations of actual or apparent bias should not be made lightly, and they should not have been made in the present case. Even if I were to approach the appeal on the more conventional basis as an allegation that the Hearing Officer took into account irrelevant considerations, I would still consider such a ground of appeal to be obviously unsustainable.
46. The evidence was, in my judgment, both admissible and relevant. Trump International had applied to register a trade mark which was plainly associated with Mr Trump, with whom it had no connection. That, of itself, required a very clear explanation to refute an inference of bad faith. The similar fact evidence was not mere rumour or supposition. It raised some very serious matters, which required a detailed explanation and refutation, in evidence. The fact that other companies owned or controlled by Mr Gleissner had made numerous other applications to register well-known trade marks with which they had no connection (for example EUIPO) was potentially probative of the issue of bad faith. It made it less likely that the inference of bad faith could be refuted.
47. Consideration of such evidence in the Registry proceedings accorded with the overriding objective of deciding cases justly. The evidence was highly significant. Had the Hearing Officer not taken account of the evidence, he would have ignored relevant facts. He did not make that mistake, nor did he attach undue weight to the similar fact evidence. On the contrary, he expressly stated at [45] that "[a]lthough the pattern of behaviour is well-evidenced, it cannot of itself sustain a claim of bad faith for any and all applications by Mr Gleissner or companies under his control.". Further, he considered the similar fact evidence in the context of the Application before him, where, as he noted, "the Applicant's mark involves the distinctive name of an exceptionally well-known businessman and public figure" and where there were "further allegations of a motivation on the part of the Applicant to interfere with the legitimate interests of the Opponent in the TRUMP mark...".
48. He was correct, in my judgment, to find that those matters overcame the presumption of good faith and founded a *prima facie* basis for a finding of bad faith. In order to refute the allegation of bad faith, evidence was required from Trump International, to deal with the reasons why it had applied for the mark, and to refute the inference to be drawn from the similar fact evidence. No such evidence was filed, nor was any factual explanation offered by Trump International.

49. The Hearing Officer referred to the *Alexander* case, which was relied on by DTTM in its written submissions. In *Alexander*, another company of which Mr Gleissner was the sole director, namely CKL Holdings BV, had applied to register the mark ALEXANDER in relation to a range of goods. The application was opposed by Paper Stack Ltd. The Opposition succeeded, and registration was refused under section 3(6) of the Trade Marks Act 1994. As in the present case, Paper Stack filed evidence in support of its opposition, which included evidence concerning the practice of Mr Gleissner's numerous companies in filing applications for well-known trade marks owned by third parties. As in the present case, CKL filed no evidence in answer to the opponent's evidence and responded by way of written submissions.
50. Therefore, when faced with very similar evidence to the evidence filed by DTTM in the present case, the same procedure was adopted by CKL in the *Alexander* case. It chose to file no evidence in answer. Mr Hobbs stated at paragraph [7] that:

"Having chosen to file no evidence directed to the specifics of the facts and matters relied on by the opponent, CKL was, in essence, asking the Registrar to say that it had no case to answer."

51. A finding of bad faith was reached by the Hearing Officer in the *Alexander* case and affirmed on appeal by the Appointed Person. In rejecting CKL's appeal, Mr Hobbs QC agreed at paragraph [23] with the Hearing Officer's assessment that the objective which CKL had pursued in filing the mark "ALEXANDER" was an objective for which the contested application for registration could not properly be filed. In order to reach that conclusion, the Hearing Officer had relied upon the evidence of Mr Gleissner's activities, through his network of companies in filing applications for well-known third-party trade marks.
52. It can have come as no surprise to Trump International, Mr Gleissner and his advisers that in the present case, Mr Williams came to the same conclusion as in the *Alexander* case. They knew or ought to have known that evidence needed to be filed on behalf of Trump International, directed to each of the allegations relied on by DTTM, in order to refute the inference of bad faith.
53. I consider that the Hearing Officer was entirely justified in his conclusion at [48] that the Opponent had set out its allegations against the Applicant "in very clear and concrete terms, ensuring procedural fairness and clarity of analysis". I do not accept that the procedure adopted by the Hearing Officer was in any way unfair to Mr Gleissner. He is the sole director of Trump International and had plenty of notice of the allegations which were made in DTTM's evidence, and of the detail of that evidence. Yet, he chose not to answer it. I note Mr Gleissner's concern to vindicate his reputation, but he should have thought of that well before this appeal.
54. Finally, as to Mr Gleissner's concerns that the Decision may prevent him, or companies which he controls, from filing trade mark applications in the future, that depends on the nature of the mark filed. If it has no connection with a third party (for example an application to register "GLEISSNER TV") then the Decision should not prevent such an application. Absent evidence to the contrary, such an application would not be made in bad faith. However, if the application is in respect of a sign which is identical or similar to a mark owned by a third party, of which there are many examples in the evidence, then he is right to be concerned. Such applications should not be made in the future, whether by Mr Gleissner or by companies which he controls.

No findings in relation to the other grounds of objection

55. Had the Hearing Officer set out his conclusions in respect of the other grounds of opposition, this could not have improved the position of Trump International. It appears from the Decision that he considered that the other grounds of opposition were well-founded. Ms McFarland acknowledged that there was no separate appeal in relation to costs, and therefore I reject this ground of appeal.
56. Since he determined that the Application was made in bad faith, I have considerable sympathy for the Hearing Officer's position that it was unnecessary to determine the other grounds of opposition. However, I consider that it would have been sensible for him to express, briefly, his conclusion on each of those grounds. Experience in the European Patent Office shows that where only one ground of

an opposition is determined, it is frequently necessary for the board of appeal to remit the matter back to the opposition division where an appeal is successful, for determination of the other grounds. This can lead to significant delays in the determination of cases.

57. In the present case, the Hearing Officer set out in considerable detail all of the evidence which supported the other grounds of opposition. It was, in my view, obvious that each of the grounds of opposition was made out. If that was also the view of the Hearing Officer (and I believe that it was) that could, and should, have been explained in a few short paragraphs.

Application for a stay

58. This application has already been rejected by Mr Nicholas Caddick QC, sitting as a deputy High Court judge (Monday, 17 December 2018). There has been no appeal from his decision. It is not open to Trump International, in the absence of such an appeal, to renew that application.

59. In any event, I consider that Mr Caddick was right to reject the application for a stay. He did so on the basis that the Hearing Officer did not rely on any suggestion that Trump International was acting in bad faith by making a statement of intention to use, contrary to section 32(3) of the Trade Marks Act 1994. Insofar as the Hearing Officer made comments regarding the Appellant's intention to use the mark, these were not findings of bad faith on the basis of a lack of intention to use. The Decision established that even if Trump International did intend to use, its motivation was not honest but was to take advantage of the reputation of DTTM and Mr Trump or otherwise to interfere with DTTM's legitimate interests. Therefore, there was no reason to stay the proceedings pending the result of the *Skykick* reference, since it was not of direct relevance to the current proceedings.

The second basis of the appeal: the Appellant's application to adduce further evidence

The content of the further evidence

60. Trump International filed three additional witness statements which it sought permission to adduce on appeal.

61. First, it relied upon a statement by Mr Michael Gleissner, about his concerns over the Decision and his desire to "set the record straight" and "clear his name" (Gleissner [3]). Among other things, Mr Gleissner alleged that:

i) the Hearing Officer's proposition that Trump International had no intention of using the trade mark as at the Application date was "emphatically untrue"; Gleissner [26];

ii) he took steps to ascertain the clearance and investment in the planned activities under the TRUMP TV brand, particularly by obtaining confirmation from his "trade mark research department" that the brand was "not of any interest to any third party in connection with International Class 38 online telecommunications services"; Gleissner [29] – [31];

iii) although his motivations and business strategy have been the subject of speculative writing and published commentary, he had not traded in a secretive or illegal manner; Gleissner [32] – [34]; and

iv) his business investment model is to invest primarily in entities that possess unrestricted and unfettered global intellectual property rights to their brand, particularly so following the advent of the internet; Gleissner [14] and [16].

62. Mr Gleissner also gave extensive evidence at paragraphs [9] – [25] about various businesses that he has established, including "Fashion One" and "Sherlock". He complained about the difficulties he had encountered in respect of branding, and various trade mark disputes he had been involved in, as follows:

i) in respect of Fashion One, Mr Gleissner stated at [11] that he expended more than \$5 million on legal fees and the acquisition of relevant branding rights, due to proceedings before the High Court in *A & E Television Networks LLC & Anor v Discovery Communications Europe Ltd* [\[2013\] EWHC 109](#)

(Ch). At [12], Mr Gleissner explained that an injunction was entered by the Commercial Court in Vienna preventing Fashion One from using the brand name in connection with television broadcasting services across the European Union; and

ii) in respect of Sherlock, Mr Gleissner noted at [19] that he succeeded in his global effort to invalidate the Sherlock brand as held by Apple based on non-use in the EUIPO and Singapore. Mr Gleissner stated at [21] that subsequent to his founding of Sherlock Technologies Limited and filing trade mark applications for the term Sherlock, Apple successfully defended the brand in proceedings before the United States Patent and Trademark Office. Mr Gleissner concluded at [23] that despite over \$500,000 having been invested for marketing and development of its mobile software application (and over \$100,000 to attempt to obtain global protection for the brand), Sherlock Technologies Limited is not expanding or progressing due to it not having secured unfettered and unencumbered rights to the brand Sherlock in the United States.

63. Trump International also relied upon a statement by Mr Roman Popov, a lawyer and partner of Morton & Associates LLP, who said that he works closely with Mr Gleissner and his companies globally and has typically been instructed by Mr Gleissner to negotiate contracts, register trade marks, engage in correspondence with third parties and/or assist with litigation. At [3] Mr Popov referred to the purchase of the trump.org and trump.tv domain names for the sum of \$50,000 on 4 May 2017.

64. Finally, Trump International relied upon a statement from Alfean Samad, a senior paralegal at Fashion One (Asia) Limited, who assists Mr Gleissner with the incorporation of companies and the registration of trade marks. At paragraphs [3] – [6], Mr Samad explained the steps he took (as instructed by Mr Gleissner) to seek to register Trump International as a limited company in the UK (which he attended to on 30 October 2016) and thereafter to apply for the UK trade mark in the new company's name.

Admission of additional evidence on appeal - legal principles

65. This Court set out principles in relation to the exercise of the Court's discretion to admit additional evidence in trade mark appeals in *Consolidated Developments Ltd v Cooper* [2018] EWHC 1727 (Ch); [2019] FSR 2 ("the CDL case). Paragraph [19] of the CDL case states that:

"19. As Lewison LJ memorably observed in *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5; [2014] ETMR 26; [2014] FSR 29 at [114], the trial is not a dress rehearsal: it is the first and last night of the show. This emphasises the need to adduce all relevant evidence at the first hearing, rather than to attempt to adduce further evidence on appeal. Once the last night of the show has finished, the audience are unlikely to be interested in additions to the script."

66. However, there may be exceptions to this general principle. In *Ladd v Marshall* [1954] 1 WLR 1489 at 1491 Denning LJ set out a three-part test for the admission of fresh evidence on appeal. In particular:

i) it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial;

ii) the evidence must be such that, if given, it would probably have an important influence on the result of the case, though it need not be decisive; and

iii) the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, though it need not be incontrovertible.

67. Having considered the case law subsequent to *Ladd v Marshall*, the relevant principles in respect of the admissibility of fresh evidence in trade mark appeals, sought to be introduced for the first time on appeal, are summarised at [33] of the CDL case as follows:

"i) the same principles apply in trade mark appeals as in any other appeal under CPR Part 52. However, given the nature of such appeals, additional factors may be relevant;

- ii) the *Ladd v Marshall* factors are basic to the exercise of the discretion, which are to be applied in the light of the overriding objective;
- iii) it is useful to have regard to the *Hunt-Wesson* factors;
- iv) relevant factors will vary, depending on the circumstances of each case. Neither the *Ladd v Marshall* factors nor the *Hunt-Wesson* factors are to be regarded as a straightjacket;
- v) the admission of fresh evidence on appeal is the exception and not the rule;
- vi) the *Gucci* decision does not establish that the Court or the Appointed Person should exercise a broad remedial discretion to admit fresh evidence on appeal so as to enable the appellant to re-open proceedings in the Registry; and
- vii) where the admission of fresh evidence on appeal would require that the case be remitted for a rehearing at first instance, the interests of the parties and of the public in fostering finality in litigation are particularly significant and may tip the balance against the admission of such evidence."

Discussion

68. I have reached the conclusion that in the circumstances of this case, the application by the Appellant to adduce additional evidence on appeal should be refused. My reasons are as follows:

The evidence could have been obtained with reasonable diligence and no adequate explanation has been offered for the failure to serve it in the Registry

69. The evidence has been filed by Mr Gleissner himself, an employee of Trump International of which he is the sole director, and a lawyer who works closely with Mr Gleissner and his companies globally. That evidence could have been filed on 5 December 2017, in accordance with the directions of the Hearing Officer.
70. In Trump International's notice of appeal, supported by a statement of truth, it is asserted that the basis for its application to admit evidence is that "the applicant (appellant) was not legally represented at the first instance". The grounds of appeal state that the failure to file the evidence (or any evidence at all) resulted from the "sincere but naive attempt to control costs by managing the matter internally".
71. An explanation offered for the failure to file the additional evidence before the IPO is also contained in Mr Gleissner's witness statement. He stated at paragraph [2] that no disrespect was meant by the failure to file evidence or a substantive response to the Opponent's evidence or written submissions: this was merely because the matter was handled internally. He stated that his business is complex with hundreds of ongoing matters simultaneously. Having outside counsel advising on and managing each one would increase costs and the administration substantially. Mr Gleissner asserted that he attempted to manage the matter himself. He claimed that he has now sought professional advice and requests an opportunity to explain on behalf of the Appellant all of the background circumstances related to the filing of the Application.
72. I do not accept these explanations. As to the Appellant's notice and grounds of appeal, it is untrue to assert that Trump International was not legally represented at first instance. As I have noted, its TM8 and counterstatement were signed by Mr Alfean Samad who claims in his witness statement to be a senior paralegal. He executed the documents on behalf of Trump International's Legal Affairs Department. Mr Bedford of Morton & Associates LLP faxed to the IPO the 30-page defence. This gives rise to an inference that Morton & Associates LLP at least reviewed the document before filing it with the IPO. This inference is not rebutted by the evidence of Mr Samad or Mr Popov, who do not deal with their involvement in the preparation of the document.
73. Nor do I accept Mr Gleissner's evidence that he decided to manage the matter himself. The document was obviously drafted by a person with considerable experience of European trade mark law.

74. Even if the explanation was credible, which it is not, I do not accept that it is adequate to explain the failure to file the additional evidence at first instance. As the procedural history shows, the allegations of bad faith against Trump International, supported by similar fact evidence, were very clearly set out, well before the deadline for filing evidence. Trump International knew or ought to have known that those allegations needed to be rebutted, in detail, by evidence in answer, but it chose not to file any such evidence.

The evidence, if given, would not have an important influence on the result of the case

75. Whilst I note Mr Gleissner's assertion that his company intended to use the name "TRUMP TV", the Hearing Officer's Decision was not dependent on a finding of no intention to use the mark. The Hearing Officer decided that the Application was filed in bad faith because the intention of Trump International was to gain some advantage deriving from the notoriety of Mr Trump. In order to refute that finding, the additional evidence would need to deal, on a point by point basis, with the substance of the evidence filed on behalf of DTTM. It makes no attempt to do this. In my judgment, the additional evidence would make no difference to the result of the Decision.

76. I should add that the fresh evidence appears to be based on a number of misconceptions of law, namely; i) that protection for earlier third-party trade marks is limited to identical goods or services to those in respect of which it has been used and ii) that an assertion of a satirical purpose would provide a defence to the grounds of opposition in the present case. *Kerly's Law of Trade Marks and Trade Names (Sixteenth Edition)* states at [16.127] that:

"No defence of parody or satire is provided by the 1994 Act but it seems likely that, if the use complained of is truly parodic or satirical, then this is a matter which may be taken into account by the court in determining whether the use complained of is "without due cause." Nevertheless the scope for any such defence is likely to be limited where the other requirements necessary to establish infringement are satisfied. To fall within the scope of s.10 the use must be in the course of trade as a trade mark. Accordingly any such use will be commercial and is likely to be for the purpose of furthering the sales of the defendant's goods or services. Assuming also that the use either causes detriment to the trade mark owner or provide an advantage to the alleged infringer, it is suggested that in most cases a defence of satire or parody is unlikely to be viewed by the court with much sympathy."

77. Interesting questions may arise in some cases as to whether satirical or parodic use is "with due cause" or otherwise permissible in the interests of freedom of expression; see for example *South African Breweries International (SAP Mark International) v Laugh It Off Promotions SA* Court of Appeal (242/2003). But not on the facts of the present case.

Is the evidence apparently credible?

78. Mr Gleissner's assertion of an intention to use the mark is, in my judgment, not credible. Mr Bartlett, who appeared on behalf of DTTM, pointed out that the evidence gives no details as to how the business would operate, how revenue would be generated, what markets and demographic would be addressed, nor in what geographical regions or on what platforms the service would operate. Nothing is said about when the planned business was or would be launched.

79. No corroboration is given by any document produced by Mr Gleissner and neither Mr Popov nor Mr Samad corroborate his evidence in any material respect. Mr Popov's evidence regarding purchase of the domain names trump.org and trump.tv is consistent with reverse domain name hijacking, which allegation was established against Bigfoot by the UDRP complaint brought by Compania Mexicana de Aviacion, and which the fresh evidence does not attempt to answer.

80. I agree that these are deficiencies in the evidence. There is a further and fundamental issue in relation to credibility. No reference was made in Trump International's defence and counterstatement to the alleged intention to use the mark for a satirical online publication. If it was credible, that simple fact would surely have been referred to somewhere in that 30 page document.

Would the admission of the additional evidence on appeal require that the case be remitted for a rehearing at first instance?

81. In my judgment, the admission of the additional evidence would require that the case be remitted for a rehearing at first instance. Given the issues as to its credibility, DTTM would be entitled to cross-examine the deponents, and to seek disclosure of documents. This would be unfair, since DTTM has already won the Opposition. The interests of the parties and of the public in fostering finality in litigation are particularly significant and indicate that the additional evidence should not be admitted.

Intervention by the Comptroller

82. The Comptroller General of Patents, Designs and Trade Marks sought permission to intervene on this appeal, which I granted. Mr Nicholas Saunders QC, representing the Comptroller, explained why this case raised general issues of concern to the Trade Marks Registrar.

83. This is the first time that a case involving Mr Gleissner has come before the Court. The Registrar is concerned that there is a substantial risk that behaviour of the sort identified in the evidence in this case, if left unchecked, will bring the trade mark system into disrepute. Mr Saunders submitted, and I accept, that at its core, the purpose of trade marks is to enable signs to be registered which distinguish the goods or services of one undertaking from those of other undertakings. Genuine disputes arise in that context and it is the job of the Registrar and the Courts to resolve them. However, he argued that "gaming" the system of registration and the procedure before the Registrar by filing unmeritorious applications time and time again through a myriad of non-trading and impecunious corporate entities is an abuse of the process of registration.

84. The nature and scale of the problem presented by Mr Gleissner's activities is shown by the following:

i) In 2016 (the year in which the Application was made) companies controlled by Mr Gleissner applied for over 800 UK trade marks resulting in a substantial number of oppositions and other litigation;

ii) As at 30 November 2017, various legal entities of which Mr Gleissner was a director were a party to 97 live contested trade mark cases before the IPO. This is about 5% of all the live contested trade mark cases before the IPO. During other periods, this percentage has been much higher;

iii) The IPO publishes lists of parties who have not paid costs orders. Companies controlled by Mr Gleissner have not paid 49 costs orders, which amounts to about one third of the entirety of unpaid costs orders; and

iv) Even where costs orders are paid, in general, costs before the IPO in opposition proceedings are only awarded on the basis of a scale of costs, which may represent a small proportion of the costs actually incurred. The Registrar expressed concern that Mr Gleissner's companies were pursuing an abusive strategy where settlement of unmeritorious applications made by such companies was cheaper for the owners of famous brands than the legal costs incurred in opposing such applications.

85. In these circumstances, the Registrar seeks guidance from the Court as to how the IPO should deal with such applications in the future. Whilst the decisions discussed in this judgment suggest that the IPO is applying the correct approach, the following may be of some assistance:

i) Where an application is made for a well-known trade mark with which the applicant has no apparent connection, this requires explanation and justification by the applicant;

ii) Other instances of such applications by the applicant (or persons or companies connected to the applicant) may be admissible as similar fact evidence and may refute the explanation and justification provided by the applicant;

iii) It is necessary to distinguish between unsubstantiated allegations and established facts of direct relevance to the case before the IPO. In the present case the similar fact evidence was potentially probative and it was just to consider it;

iv) The *Alexander* questions provide a useful structure for considering allegations of bad faith, as shown by the Decision of the Hearing Officer in the present case. However, like the *Pozzoli* questions, which provide a structured approach to the issue of inventive step in relation to patents, they are not a substitute for the statute and do not have to be used in every case. Bad faith has numerous manifestations and cannot be classified comprehensively;

v) The Registrar may strike out proceedings brought for an ulterior and improper purpose as an abuse of process; and

vi) The power to strike out must be exercised with caution. However, where a *prima facie* case of bad faith is established, and no evidence in answer is filed on behalf of the applicant, it may well be appropriate to exercise that power.

86. I should add that the remedies of brand owners, when faced with bad faith applications, are not limited to those available in proceedings before the IPO, which may take some considerable time to resolve. Section 32(3) of the Trade Marks Act 1994 requires an application to state that the mark applied for is being used, by the applicant or with his consent in relation to the goods or services for which it is sought to be registered, or that the applicant has a bona fide intention that it should be so used. Such a statement, in relation to a well-known third-party trade mark with which the applicant has no connection, may give rise to causes of action for infringement of trade mark and passing off.

87. The remedies open to the Court include preliminary injunctions, which may be granted rapidly, and wide powers in respect of costs, including costs orders against non-parties made pursuant to s.51 of the Senior Courts Act 1981. If the case is sufficiently serious, such orders may be appropriate.

Conclusion

88. For the reasons set out above, this appeal is dismissed.

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O-036-18

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Monday, 18th December 2017

An Appeal to the Appointed Person
(from a Decision of Mr Allan James acting on behalf of the Registrar of Trade Marks)

Before:

THE APPOINTED PERSON

Mr Geoffrey Hobbs QC

In the Matter of:

The Trade Marks Act 1994

-and-

In the matter of:

Trade Mark Application No. UK00003146477 by CKL HOLDINGS NV

-and-

Opposition No. OP000406941 by PAPER STACKED LIMITED

Written submissions were filed by Trademarkers Merkenbureau C.V. on behalf of CKL Holdings NV (the Appellant)

Written observations were filed by Mr Raoul Colombo on behalf of the Registrar

DECISION (AS APPROVED)

Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd.,
1st Floor, Quality House, 6-9 Quality Court, Chancery Lane, London WC2A 1HP.
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O-036-18

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Mr Geoffrey Hobbs QC:

1. This is an appeal from the decision of Mr Allan James issued on behalf of the Registrar of Trade Marks under reference BL O/442/17 on 19th September 2017 in opposition proceedings brought by Paper Stacked Limited under no. 406941 in relation to trade mark application no. 3146477 filed in the name of CKL Holdings NV on 27th January 2016.
2. CKL initially sought by means of that application to register the name **ALEXANDER** as a trade mark for use in relation to a range of goods in classes 18, 20 and 25, but ultimately for use in relation only to mirrors and picture frames in class 20. The opposition succeeded and registration was refused under section 3(6) of the Trade Marks Act 1994, which provides (consistently with the provisions of Art 3(2)(d) of the Trade Marks Directive: Directive 2008/95/EC; and symmetrically with the provisions of Arts 59(1)(b) and (3) of the EU Trade Mark Regulation: Regulation (EU) 2017/1001) that: “A trade mark shall not be registered if or to the extent that the application is made in bad faith”. Paper Stacked’s objection under s. 3(6) was pleaded in its Notice and Statement of Grounds of Opposition in the following terms:

“The applicant has no bona fide intention to use the mark. The Applicant has filed several hundred trade mark applications in numerous territories (mostly within the European Union), the majority of which comprise of common first names. There is no commercial logic for the present trade mark application and the purpose of this application therefore appears to be solely for the purpose of preventing third parties from entering the market or registering genuine trade marks in the United Kingdom or the European Union. The Applicant’s conduct and trade mark filing activity (including the present application) depart significantly from the accepted principles of ethical behaviour or honest commercial and business practices. In particular, the trade mark covers goods for which the full name of the designer or producer is used as a trade mark, and where there are numerous legitimate designers/producers with the forename ALEXANDER already on the market.”

3. It is relevant to note in this connection that the contested application for registration contained a declaration pursuant to the statutory requirement in s.32(3) of the 1994 Act that:

“The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.”

This required CKL to be a person who could truthfully claim to have a bona fide intention that **ALEXANDER** should be used (by it or with its consent) as a trade mark for goods of the kind listed in the application.

4. CKL filed a counterstatement denying that its application for registration was objectionable under s. 3(6). It maintained that it had acted lawfully and entirely properly with regard to the filing of the application. It specifically contended that “The bona fide intention to make use of the subject mark if and when it achieves registration can, according to UK law, only be evaluated in the course of a revocation action due to non-use after five years of registration” and appears thereby to have been claiming that it was entitled, notwithstanding the provisions of s.3(6) of the Act, to obtain and retain registration of the trade mark **ALEXANDER** for as long as it might take for the five year period of immunity from revocation on the ground of non-use to begin and end.
5. Paper Stacked filed evidence in support of its opposition in the form of two witness statements from its professional representative, Mr Reddington of Messrs Williams Powell. The first of these was a witness statement with nine exhibits dated 3rd January 2017. The second was a witness statement with two exhibits dated 13th April 2017. The exhibits to the witness statements were voluminous. The Hearing Officer summarised the evidence in his decision in the following terms (with footnotes omitted):

“9. The opponent’s evidence consists of two witness statements by Mr John Reddington who is a trade mark attorney at Williams Powell. Mr Reddington’s first statement shows that the applicant is incorporated in Holland. The company is trading and its main activities are recorded as ‘*motion picture, video and television programme activities.*’ I note that until 20-13 the company was called ‘Bigfoot Properties (Europe)’. The sole director of the company is Mr Michael Gleissner.

10. Mr Reddington’s evidence also shows that Mr Gleissner is a director of over 1200 UK companies, which I note include Trump Internation Ltd and EUPIO International Ltd.

11. According to an extract from the Wikipedia in evidence, Mr Gleissner is an entrepreneur who established an e-commerce business called Telebuch which he later sold to Amazon. In 2002, he established Bigfoot Entertainment to finance and develop features films, documentaries and reality TV shows for the US Market. In 2010 he co-founded Fashion One TV, an international channel that broadcasts all around the world.

12. Although the applicant only holds 8 UK trade marks it holds hundreds of marks in the US, Benelux and elsewhere. Many of the marks applied for or registered by the applicant consist of common names, such as ANNA, JESSICA, JULIA, ALAN, HOWARD, CHRISTINE, ELIZABETH, RYAN, PAUL, PETER or other words, such as the names of colours, BLUE, SAND, EBONY, EMERALD. I note that 6 of the 8 applications applied for in the UK (including the subject application, were opposed by third parties. This contrasts with a usual opposition rate of 4.5% of published marks.

13. The applicant has also registered more distinctive names, such as EUIPO and TESLA in the Benelux and holds an international registration for BAIDU, which is the name of the largest web services company in China. Other companies controlled by Mr Gleissner are reported to have applied to register marks which are well known in the US or Europe, such as THE HOME DEPOT, ENRON, THE LEARNING CHANNEL and PAN AM.

14. Mr Reddington exhibits the results of a Google search he conducted which failed to reveal any use of the marks applied for by the applicant in the UK, or around 50 similar (forename) marks applied for in the US.

15. Mr Reddington also provides examples of the applicant using trade marks consisting of a forename in order to oppose third party marks consisting of a full name including the same forename. Two of these involve oppositions at the EUIPO to applications to register ALEXANDER SMITH and ALEXANDER BENNETT.

16. The cancellation division of the EUIPO appears to have cancelled the applicant's registration of BAIDU as an EU trade mark. I note that the EUIPO held that the applicant must have known about the well known identical Chinese trade mark, that the applicant's website contained reports indicating that when approached the applicant expected to sell the mark to the Chinese company, that the applicant had no intention of using the trade mark in accordance with its essential function, and had registered the trade mark in bad faith.

17. Mr Reddington draws attention to my own decision in case BL O-015-17 in which I struck out applications filed by three companies owned by Mr Gleissner to revoke 68 of Apple Inc.'s UK trade marks for non-use on the grounds that the applications for revocation were an abuse of process. In relation to this point, Mr Reddington provided copies of articles from, inter alia, World Trade Mark Review, IPKat and DomainNameWire about Mr Gleissner, which speculate as to the reasons Mr Gleissner has registered thousands of companies and trade marks in the UK, US, EU, Benelux, Portugal and elsewhere. One of the theories being that he is a trader in domain names and uses registered trade marks to obtain ownership of them.

18. In this connection, Mr Reddington provides some evidence about attempts by companies controlled by Mr Gleissner to obtain domain names corresponding to third party trade marks. In *Compania Mexicana de Aviacion, S.A. de C.V. v Bigfoot Ventures LLC* (another of Mr Gleissner's companies), a UDRP panel found (in 2008) that the respondent had obtained the domain name vtp.com in bad faith. According to the panel's

findings, VTP was a trade mark of a Mexican airline which had been in use for 75 years. The respondent was using the domain name to direct traffic to a parking website which contained links to travel offers from competitors of the complainant. It also contained a link to another site which offered the domain name for sale for \$148k. The panel directed that the domain name should be transferred to the complainant.

19. In a more recent case Bigfoot Ventures LLC has been held to have engaged in attempted ‘reverse domain name high jacking.’ That is using the Uniform Domain Name Dispute Resolution system in an attempt to acquire the domain name slized.com. The report of the case indicates that Bigfoot Ventures LLC claimed, without justification, that its registered trade mark SLIZED had a reputation as a ‘*global brand.*’ The adjudication panellist upheld the respondent’s complaint that the applicant had misrepresented its use of the trade mark and was trying to hijack the domain name.

20. Finally, according to an article published on worldtrademarkreview.com on 18th November 2016, the Trademarks Manager at Bigfoot Entertainment Pte Ltd (another of Mr Gleissner’s companies) who is called Marco Notarnicola, once listed his job responsibilities on LinkedIn as including ‘*manipulating trademarks to reverse hijack domain names through UDRP*’, although this comment was subsequently removed. A copy of the original post is in evidence. I note that Mr Notarnicola also recorded his duties as ‘*personally filing, prosecuting and supporting litigation for -20 per month oppositions and cancellation action based n non-use, invalidity at all procedural stages, including appeals*’ and ‘*exploitation of legal instruments such as “priority chains” in country members of the Paris Convention*’.

21. I note that the applicant’s counterstatement in this case was signed by Marco Notarnicola.”

6. CKL filed no evidence in answer to the opponent’s evidence. It responded by way of written submissions filed on 3rd March 2017 in which it stated (with paragraph numbering as per the document as filed, which goes awry between the second and third pages of the document):

“4. The Opponent has submitted a counterstatement and a number of Exhibits in relation to this ground of Opposition. Unfortunately, the Witness Statement submitted by the Opponent, although referring to the attached exhibits, does not explain their relevance to the case at hand.

5. We reiterate that there is a presumption of good faith unless the contrary is proven. In the case at hand, the evidence submitted by the Opponent has not provided sufficient

arguments or evidence to show that the application of the subject mark was made in anything other than good faith.

12. In the case at hand the Opponent claims that the Applicant has no commercial logic in its trade mark filings. The Applicant refutes this claim in its entirety.

13. We reiterate that the Applicant is the registered owner of only eight trade mark applications at the Office. All of these applications are for trademarks of distinctive character, which will be used as the commercial badge of origin for the goods and services laid out in their specifications. Attempting to register eight trade marks in one territory does not 'fall short of the standards of acceptable commercial behaviour'. It is simply the aim of the Applicant to achieve protection of their brands in the relevant territory. This cannot be in any way construed as an attempt to deceive the Office or any third party, none of the information provided to the Office has been untrue or misleading and the marks of the Applicant are all intended to protect the brands of the Applicant in the relevant territory of the United Kingdom.

14. Furthermore, it must be noted that according to the law of the UK, the owner of a trade mark is not expected to make genuine use of the mark while examination or opposition proceedings are pending or, under any circumstance, before the five-year 'grace period' has begun.

Considering the above, there is no requirement for the Applicant to show intent to use the subject mark, as the registration is pending and the application is under opposition proceedings. In any case, a registered proprietor is entitled to make use of a trade mark at any point during the five-year grace period; there is no strict requirement to prove the intent to put a mark to use immediately before or after the registration. In certain cases, according to the UK law, an owner is not required to put its trade mark to use until 1 day before the expiration of the 'grace period' granted by the Act upon registration. The *bona fide* intention to make use of the subject mark if and when it achieves registration can, according to UK law, only be evaluated in the course of a revocation action due to non-use after 5 years of registration. Accordingly, and in any other circumstances, the present application for registration was made in good faith and the claims of the opponent to the contrary should be dismissed."

7. CKL's case as presented in these submissions was that the evidence tendered by the opponent established no basis sufficient in point of fact or in point of law to justify rejection of the contested application for registration on the ground of bad faith. Having chosen to file no evidence directed to the specifics of the facts and matters relied on by the opponent, CKL was, in essence, asking the Registrar to say that it had no case to answer.

8. The key questions for determination by the Hearing Officer were: (1) what, in concrete terms, was the objective that CKL had been accused of pursuing? (2) was that an objective for the purposes of which the contested application could not properly be filed? (3) was it established that the contested application was filed in pursuit of that objective? The first question serves to ensure procedural fairness and clarity of analysis. The second question requires the decision taker to apply a moral standard which, in the absence of any direct ruling on the point from the CJEU, is taken to condemn 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 (Lindsay J). The third question requires the decision taker to give effect to the principle that innocence must be presumed in the absence of evidence sufficient to show that the applicant has acted improperly as alleged.

9. The Hearing Officer addressed the first question in paragraph 30 of his decision:

“The opponent’s case appears to be based on the following factors. Firstly, that the sole director of the applicant, Mr Gleissner, owns a very large international network of companies through which he has acquired and holds a wide portfolio of trade marks. Secondly, that the only evidence of use of these marks is in legal proceedings in order to oppose or cancel third party trade marks and/or to acquire domain names. Thirdly, that the present application forms part of a pattern of behaviour whereby applications are made to register trade marks consisting of common words which are most likely to come into conflict with the trade marks of third parties. Fourthly, that this is part of a wider strategy to register multiple trade marks and companies in numerous jurisdictions in order to gain commercial benefit from blocking the use of identical or similar trade marks by third parties and/or acquiring domain names with commercial value. In short, the application is said to be part of a systematic abuse of the trade mark registration system.”

10. That appears to me to be an accurate encapsulation of the objection raised for determination under s.3(6). CKL does not appear to suggest otherwise on this appeal.

11. With regard to the second question, the Hearing Officer directed himself as to the applicable principles of law by reference to the judgment of Arnold J. in *Red Bull GmbH v Sun Mark Ltd* [2012] EWHC 1929 (Ch) and by reference to the judgment of the General Court in Case T-82/14 *Copernicus-Trademarks v EUIPO* EU:T:2016:396.

12. Arnold J. summarised the law relating to bad faith filing at paragraphs 130 to 138 of his judgment in the *Red Bull* case in the following terms:

“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)(d) 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* [2009] EHWL 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 Plastics 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 take 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).”

13. In the *Copernicus Trademarks* case, the General Court upheld an objection on the ground of bad faith in relation to an application for registration which evidently formed part of a strategy of systematically filing and re-filing applications simply for the purpose of providing the organisers of the scheme with blocking positions in respect of the relevant trade marks which they could assert against third parties for as long as it might take for the applicable five year period of immunity from revocation on the ground of non-use to begin and end.
14. The Court reviewed the relevant legislation and case law in paragraphs [26] to [34] of its judgment as follows:

“26. The European Union trade mark registration system is based on the ‘first-to-file’ principle, laid down in Article 8(2) of Regulation No 207/2009. In accordance with that principle, a sign may be registered as a European Union trade mark only in so far as that is not precluded by an earlier mark (see Judgment of 11 July 2013 in *SA.PAR. v OHIM — Salini Costruttori (GRUPPO SALINI)*, T-321/10, EU:T:2013:372, paragraph 17 and the case-law cited).

27. However, the application of that principle is qualified, inter alia, by Article 52(1)(b) of Regulation No 207/2009, under which, following an application to EUIPO or on the basis of a counterclaim in infringement proceedings, a European Union trade mark is to be declared invalid where the applicant was acting in bad faith when it filed the application for a trade mark (see judgment of 11 July 2013 in *GRUPPO SALINI*, T-321/10, EU:T:2013:372, paragraph 18 and the case-law cited).

28. The concept of bad faith referred to in Article 52(1)(b) of Regulation No 207/2009 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 principles of ethical behaviour or honest commercial and business practices (see, to that effect, judgment of 14 February 2012 in *Peeters Landbouwmachines v OHIM – Fors MW (BIGAB)*, T-33/11, EU:T:2012:77, paragraphs 35 to 38, and the Opinion of Advocate General Sharpston in *Chocoladefabriken Lindt & Sprüngli*, C-529/07, EU:C:2009:148, paragraph 60).

29. In order to assess whether a depositor is acting in bad faith, it is necessary inter alia to examine whether he intends to use the mark applied for. In that context, it should be noted that the essential function of a trade mark is to ensure 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 (judgment of 11 June 2009 in *Chocoladefabriken Lindt & Sprüngli*, C-529/07, EU:C:2009:361, paragraph 45).

30. The intention to prevent the marketing of a product may, in certain circumstances, be an element of bad faith on the part of the applicant. That is in particular the case when it becomes apparent, subsequently, that the latter applied for registration of a European Union trade mark without intending to use it, solely with a view to preventing a third party from entering the market (judgments of 11 June 2009 in *Chocoladefabriken Lindt & Sprüngli*, C-52907, EU:C:2009:361, paragraphs 43 and 44, and of 8 May 2014 in *Simca Europe v OHIM – PSA Peugeot Citroën (Simca)*, T-327/12, EU:T:2014:240, paragraph 37).

31. The intention of the applicant at the relevant time is a subjective factor which must be assessed by taking into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration of a sign as a European Union trade mark. Those grounds are normally established by reference to objective criteria, including, in particular, the commercial logic underlying the filing of the application for registration (see, to that effect, judgment of 11 June 2009 in *Chocoladefabriken Lindt & Sprüngli*, C-529/07, EU:C:2009:361, paragraphs 37, 42 and 53).

32. In the context of the overall analysis undertaken pursuant to Article 52(1)(b) of Regulation No. 207/2009, account may also be taken of the origin of the contested sign and its use since its creation, the commercial logic underlying the filing of the application for registration of that sign as a European Union trade mark, and the chronology of events leading up to that filing (see, to that effect, judgment of 14 February 2012 in *BIGAB*, T-33/11, EU:T:2012:77, paragraphs 21 to 23).

33. Where the applicant for a declaration of invalidity seeks to rely on that ground, it is for that party to prove the circumstances which substantiate a finding that the European Union trade mark proprietor had been acting in bad faith when it filed the application for registration of that mark (judgment of 11 July 2013 in *GRUPPO SALINI*, T-321/10, EU:T:2013:372, paragraph 18).

34. The applicant's arguments must be examined in the light of that legislation and that case-law."

15. In paragraph [52] it went on to observe:

52. Therefore, it must be noted that not only the filing strategy practiced by Mr A. is incompatible with the objectives pursued by Regulation No 207/2009, but that it is not unlike the cases of 'abuse of law', which are characterised by circumstances in which, first, despite formal observance of the conditions laid down by European Union rules, the purpose of those rules has not been achieved, and, secondly, there exists an intention to

obtain an advantage from those rules by creating artificially the conditions laid down for obtaining it (judgments of 14 December 2000 in *Emsland-Stärke*, C-110/99, EU:C:2000:695, paragraphs 52 and 53, and of 21 July 2005 in *Eichsfelder Schlachtbetrieb*, C-515/03, EU:C:2005:491, paragraph 39).”

16. I note that the judgment of the General Court is the subject of a pending appeal to the CJEU in case C-101/17P *Verus Eood v EUIPO*. The Grounds of Appeal and main arguments as published in the Official Journal of the EU at OJ C 195, 19.6.2017 p.10 are terse and quite uninformative. The paragraphs I have quoted from the judgment of the General Court appear to me to provide relevant guidance in orthodox terms and I see no reason to discount them on the basis that they form part of a judgment which is under appeal.
17. CKL does not appear to contest the legal principles I have referred to. It nonetheless maintains that the focus of attention must be upon the particular application to register the particular mark for the particular goods specified in the case at hand. It points out that the trade mark should, for present purposes, be regarded as a registrable trade mark for such goods and more especially so in view of the findings made in paragraphs 26 and 27 of the Hearing Officer’s decision:

“26. Firstly, there is no evidence that ALEXANDER is currently used by third parties in relation to mirrors or picture frames or similar goods. Secondly, the fact that ALEXANDER is used or registered by third parties as a trade mark, or as part of a trade mark, is irrelevant to the distinctiveness of the contested mark. If anything, this suggests that the name is capable of functioning as a trade mark.

27. Although ALEXANDER is a common forename (and a surname) I see no reason why, as a matter of principle, it is not capable of distinguishing the trade source of mirrors and picture frames. Absent any relevant evidence to the contrary, I find that the opposition under s.3(1)(b) fails.”
18. It contends that the law relating to bad faith filing must recognise and give effect to the concept of legitimate self-interest. In that connection, it maintains that it should be seen to have had a legitimate interest in doing what it did for its own benefit and on its own account. It further maintains that s. 32(3) of the 1994 Act should not be taken to establish a requirement for an intention to use a mark prior to the beginning or end of the five year period of immunity from revocation for non-use.
19. At this point I must emphasise that s. 3(6) proceeds upon the premise that the right to apply for registration of a trade mark cannot validly be exercised in bad faith. The invalidity of the application is not conditional upon the trade mark itself being either registrable or unregistrable in relation to any goods or services of the kind specified. The objection is absolute in the sense that it is intended to prevent abusive use of the system for acquiring title to a trade mark by registration. Any natural or legal person with the capacity to sue and be sued

may pursue an objection on this ground: see the judgment of the CJEU in Case C-408/08P *Lancôme parfums et beauté & Cie SNC v OHIM*, EU:C:2010:92 at paragraph [39] and the Opinion of Advocate General Ruiz-Jarabo Colomer in that case EU:C:2009:634 at paragraphs [63] and [64]. Since there is no requirement for the objector to be personally aggrieved by the filing of the application in question, it is possible for an objection to be upheld upon the basis of improper behaviour by the applicant towards persons who are not parties to the proceedings provided that their position is established with enough clarity to show that the objection is well-founded.

20. I do not doubt that any attempt to establish bad faith must allow for the fact that there is nothing intrinsically wrong in a person exercising “*the right to apply the rules of substantive and procedural law in the way that is most to his advantage without laying himself open to an accusation of abuse of rights*” as noted in paragraph [121] of the Opinion delivered by Advocate General Trstenjak in Case C-482/09 *Budejovicky Budvar NP v Anheuser-Busch Inc* EU:C:2011:46. See also the observations of Arnold J in paragraph [189] of his judgment at first instance in *Hotel Cipriani SRL v. Cipriani (Grosvenor Street) Ltd* [2009] EWHC 3032 (Ch), which were not called into question in the judgment of the Court of Appeal in that case: [2010] EWCA Civ 110. They were re-affirmed by Arnold J. in *Och-Ziff Management Europe Ltd v. Och Capital LLP* [2010] EWHC 2599 (Ch) at paragraph [37].
21. The line which separates legitimate self-interest from bad faith can only be crossed if the applicant has sought to acquire rights of control over the use of the sign graphically represented in his application for registration in an improper manner or for an improper purpose. I accept that the provisions of s.32(3) of the Act should not be interpreted and applied so as to establish a more onerous requirement for use than that which is substantively imposed and regulated by the provisions of the legislative scheme relating to revocation of trade mark registrations for non-use.
22. However, that does not detract from the proposition that a declaration made pursuant to the requirements of s.32(3) can be false by reason of the absence of any bona fide intention to use a mark, with that in fact being indicative or symptomatic of the relevant mark having been put forward for registration in relation to goods or services of the kind specified in an improper manner or for an improper purpose, such as to justify refusal of the relevant application for registration on the ground of bad faith.
23. In agreement with the Hearing Officer, I consider that the objective which CKL was accused of pursuing was an objective for the purposes of which the contested application for registration could not properly be filed.
24. When assessing the evidence for the purpose of answering the third question, the Hearing Officer was entitled to draw inferences from proven facts provided that he did so rationally and without allowing the assessment to degenerate into an exercise in speculation. The CJEU has confirmed that there must be an overall assessment which takes into account all factors relevant to the particular case. As part of that assessment, it is necessary to consider the intention of the applicant at the time when the application was filed, with intention being

regarded as a subjective factor to be determined by reference to the objective circumstances of the particular case. I note that the concept of assessing intention objectively when determining the propriety of a person's conduct was recently considered in *Ivey v Genting Casinos (UK) Ltd t/a Crockfords* [2017] UKSC 67. The Supreme Court confirmed that although a dishonest state of mind is a subjective mental state, the standard by which the law determines whether it is dishonest is objective and if by ordinary standards a person's mental state would be characterised as dishonest, it is irrelevant that the defendant judges by different standards: see paragraphs [62] and [74] per Lord Hughes JSC. This appears to me to accord with treating intention as a subjective factor to be determined by reference to the objective circumstances of the particular case, as envisaged by the judgments of the CJEU relating to the assessment of objections to registration on the ground of bad faith. Bad faith, for these purposes, is, in any event, an independent concept of EU law.

25. The Hearing Officer concluded as follows in paragraphs [34], [35] and [38] of his Decision:

“34. In my judgment, the opponent has presented a *prima facie* case that the contested mark is part of a blocking strategy intended to obtain financial benefit from third parties who are likely to be already using, or who are likely in the future to wish to use, trade names including, in this case, the name ALEXANDER in order to distinguish their goods or services.

35. Taken together with the opponent's evidence that (1) none of the marks applied for in the UK (or US) appear to have been used, (2) the absence of any apparent commercial logic for the filing pattern of the applicant and/or Mr Gleissner's other companies, and (3) the evidence that companies controlled by Mr Gleissner have been found to have abused legal systems, I find that opponent has also made out a *prima facie* case that, at the time of filing the application, the applicant had no intention of using the mark in accordance with its essential function. That is to say using the mark to distinguish the goods/services of the applicant from those of other traders.

...

38. The applicant has not really answered the opponent's *prima facie* case. In these circumstances I accept the opponent's case and reject the applicant's denials. Consequently, the opposition based on s.3(6) succeeds and the application will be refused.”

26. I am satisfied that it was open to the Hearing Officer to come to the conclusion he did on the basis of the evidence and materials before him. I am not persuaded otherwise by the criticisms of the evidence which CKL has raised in support of its appeal. I am reinforced in my view that the Hearing Officer's decision should be upheld by the following matters identified in the written observations filed on behalf of the Registrar (without objection from the appellant) for the purpose of the present appeal:

“(i) As at 30th November 2017, various legal entities of which Mr Michael Gleissner is a director, and which communicate from the same email address as the appellant in these proceedings, were a party to 97 live contested trade mark cases before the UK IPO. This is about 5% of all the live contested trade mark cases before the UK IPO.

(ii) The volume and proportion of cases involving Mr Gleissner’s companies has reduced over recent months. At one point they accounted for 8% of all the contested UK trade mark cases.

(iii) Although the various legal entities communicating from the above email address rarely file any factual evidence before the UK IPO, an unusually high proportion proceed to a final decision. The registrar issued 42 final decisions in contested trade mark cases in November 2017. The various legal entities communicating from the appellant’s email address were a party to 8 (nearly 20%) of those decisions.”

27. The appeal is dismissed for the reasons I have given. I have no reason to believe that Paper Stacked has incurred any significant costs in connection with the appeal. I therefore dismiss the appeal with no order as to costs.

O-015-17

TRADE MARKS ACT 1994

**68 APPLICATIONS BY ENTITIES UNDER THE CONTROL
OF MR MICHAEL GLEISSNER
TO REVOKE 68 TRADE MARKS OWNED BY APPLE INC. FOR NON-USE**

AND

**APPLE'S APPLICATION FOR THE REVOCATION APPLICATIONS
TO BE STRUCK OUT AS AN ABUSE OF PROCESS**

The issue

1. Between October and 13th December 2016, Sherlock Systems C.V., American Franchise Marketing Ltd and Fashion International Ltd, filed 68 applications to revoke trade marks owned by Apple Inc. (“Apple”) for non-use. Some of these are well known trade marks such as iPHONE, iTUNES and APPLE itself. A complete list of the marks is set out in annex A.

The applicants and Mr Gleissner

2. Sherlock Systems C.V. (“Sherlock”) was incorporated in the Netherlands on 11th July 2016. It is a limited partnership. There is no evidence that it has started trading. American Franchise Marketing Ltd (“AFML”) was incorporated in the UK on 11th February 2014. According to the latest accounts filed at Companies House, the company was dormant at 28th February 2016 with net assets of £1. Fashion International Ltd (“FIL”) is also a UK company. It was incorporated on 24th March 2016 with 500 unpaid shares. There is no evidence that this company has started trading either.

3. Apple says that all three entities are controlled by Mr Michael Gleissner who has an address in Belgium. Mr Gleissner does not dispute this. Indeed he represented all three applicants at the case management conferences (“CMCs”) described below and has offered to be joined as a joint applicant in each of the 68 applications for revocation.

Apple’s claims

4. Apple claims that the applications are an abuse of process and should be struck out for one or both of the following reasons. Firstly, Apple says that the applications were filed for a collateral and improper purpose, namely as a “tit for tat” response to Apple’s position in revocation proceedings in Singapore and elsewhere, where it is continuing to resist an application by another company associated with Mr Gleissner (called Bigfoot Internet Ventures Pte. Ltd) to revoke the trade mark SHERLOCK for non-use. According to Apple, the current applications are an attempt to coerce it into giving up the SHERLOCK mark in these other jurisdictions. Secondly, Apple says that the sheer scale of the applications is such that the cost of defending them is out of all proportion to any likely legitimate benefit to the applicants.

5. A CMC was held on 29th November 2016 to decide upon the management of the applications for revocation filed up until that time. Mr Janni Riordan took part as counsel for Apple, instructed by Locke Lord LLP. Mr Gleissner represented the applicants.

6. Prior to that CMC, Apple filed two witness statements. One from Mr Thomas La Perle of its legal department and one from Mr John Olsen of Locke Lord, its UK legal representatives. Mr La Perle's statement set out the basis on which Apple estimated that it would take 8 months diligent work for Apple to assemble the evidence required to defend the first 30 applications for revocation.

7. Mr Olsen's statement made the following points:

- In addition to the UK applications for revocation (and the revocation proceedings in Singapore), companies under Mr Gleissner's control had earlier filed applications at the EU IPO to revoke 120 of Apple's EU trade marks for non-use.
- The same undertakings had filed 21 applications at the Benelux IPO to register some of these trade marks in their own name(s).
- Mr Gleissner owns or controls over 1000 UK companies as well as many more in the USA, Belgium, Latvia, Italy, China and elsewhere. Many of the UK companies are linked to the same serviced office address in Regent Street, London.
- Mr Gleissner is the owner of over 900 domain names. According to Mr Olsen, few, if any, of these are used for legitimate websites.
- On the basis of the contents of an article published on the IP blog site called IPKAT, Mr Olsen believed that Mr Gleissner is a 'trade mark troll', i.e. an individual who abuses the trade mark system by filing oppositions and revocation actions without legitimate commercial grounds for doing so, and for the collateral purpose of extracting revenue from trade mark applicants and proprietors.

8. Mr Riordan pursued these points at the first CMC as well as Apple's application for an order for payment of security for costs in the event that the applications were allowed to proceed.

9. The applicants' skeleton argument for the first CMC made the following points:

- The applicants are part of a portfolio of companies linked to Bigfoot Ventures LLC of New York, a *“venture capital investor and incubator involved in several start-ups”*.
- Sherlock Systems C.V. had intended to launch a mobile phone application under the brand SHERLOCK, but had been prevented from doing so because Apple held several trade mark registrations for this mark.
- Sherlock initiated revocation proceedings at the EU IPO to cancel Apple’s registration of SHERLOCK for non-use.
- The application for revocation was successful, both at first instance and on appeal.
- Apple is abusing the trade mark system by routinely registering marks that it does not intend to use, or at least use in relation to the goods/services for which they are registered, e.g. ‘ipod’ is registered as an EU trade mark for, inter alia, chemicals for use in industry, pasta makers, live animals and medical services.
- By contrast to businesses such as L’Oreal, Mr Gleissner holds *“fewer than 3000 trade marks.”*
- The legislation has not limited, nor made conditional, the right of third parties to challenge the use of registered marks.

Directions from the first CMC

10. Following the first CMC on 29th November 2016, I issued these directions to Mr Gleissner as the representative of the applicants:

“5. Having listened to the arguments and read the papers, some of which arrived only just before the CMC, I took the view that it was inappropriate for me to rule on Apple’s applications today. Instead you should be given (by close of play on 9th December) the opportunity to:

- (i) Provide a witness statement setting out any information that you wish me to take into account in relation to Apple’s application for the revocation applications to be struck out as an abuse of process;
- (ii) Using the same means, provide any information that you wish me to take into account in assessing the merits of Apple’s application for security

for costs, particularly the allegation that the applicants do not have the assets or resources to meet the likely level of normal scale costs for the multiple proceedings, if Apple is successful;

(iii) Indicate if you wish to amend the applications so as to require proof of use only for those trade marks and/or goods/services for which use is not apparent to the applicants.”

The applicants’ response

11. Mr Gleissner filed a document entitled ‘Response to Arguments’ dated 9th December 2016’. I note that, contrary to my directions, this was not a witness statement because, apart from the title, it did not include a statement of truth. The following points were made in this document:

- It was denied that the applicants, or Mr Gleissner, were ‘trade mark trolls’.
- It was denied that they had ever approached Apple, or anyone else, in any shape or form, with the intention of seeking compensation.
- The applicants denied that they had targeted Apple. They claimed that they reviewed any registered trade marks that they may be interested in using and exercised their right to verify the use of such marks through the processes set out in the relevant laws.
- In support of the previous point, the applicants provided details of 12 applications filed at the EU IPO between 12th December 2015 and 28th November 2016 by TV Brand Holdings C.V., Fashion Television International Ltd, Trademarkers Merkenbureau C.V., AFML and FIL, to revoke 12 EU trade marks in the name of third parties for non-use.¹
- The applicants claimed that the applications filed at the Benelux IPO to register some of the attacked EU trade marks in their names (or those of associated companies) were filed for “*strategic reasons*”, i.e. to obtain an international priority right that could be used to thwart any attempt by Apple to circumvent the applications for revocation by filing new applications to re-register unused marks.
- The applicants denied that it would unduly burden Apple to show use of the marks covered by the applications for revocation. It was pointed out that

¹ I note that only 4 of these applications were filed by the applicants in these proceedings

proof of use is routinely required to obtain a registration in some countries, including in Apple's home territory, the USA.

- The applicants provided information about Apple's finances drawn from publicly available data in the USA. It was said that this showed Apple was more than capable of dealing with the cost of these proceedings. It was therefore denied that there were any grounds for requiring security for costs.
- The applicants were prepared to limit the scope of the applications for revocation of 8 of Apple's marks. For example, the application to revoke trade mark 2460664, IPHONE, for non-use would be limited to exclude mobile phones and analogous terms (but not, I note, parts and accessories for such goods).

Further evidence from Apple

12. Apple filed a second witness statement from Mr Olsen. It was dated 9th December 2016, the same date as the applicants' 'Response to Arguments'. Despite this it appears to have been prepared with sight of that document and purported to reply to matters raised in it, as well as to points made by Mr Gleissner at the CMC on 29th November 2016.

13. I note the following claims:

- The application made to the Singapore IPO to revoke Apple's registration of SHERLOCK in that jurisdiction was signed by Mr Gleissner himself. So far as Mr Olsen was aware, the application was still pending.
- On 30th September 2014, another company under Mr Gleissner's control, Trademarkers N.V., applied to revoke Apple's registration of SHERLOCK as an EU trade mark.
- The application for revocation of the EU trade mark was successful at first instance but, contrary to Mr Gleissner's account, Apple's appeal against that decision is still pending.
- A company called Sherlock Systems LLC has applied to cancel Apple's registration of SHERLOCK in the USA, but that application is still pending.
- Applications by companies controlled by Mr Gleissner have been made to register SHERLOCK or SHERLOCK related marks, such as

SHERLOCK.COM, in the UK, Portugal, USA, and a number of other territories.

- The applicants' applications at the Benelux IPO cover, in general, the same goods/services as Apple's corresponding EU trade mark registrations, which are attacked for non-use.
- Companies called KNR Technologies Ltd and EBB Development Ltd, which Apple believes to be under Mr Gleissner's control, made applications in Portugal in November 2016 to register APPLE, IPAD and ITUNES.
- Mr Olsen was unaware of any applications by Mr Gleissner, or his companies, to revoke or register Apple's existing trade marks filed prior to Apple's defence of its SHERLOCK trade mark in Singapore and the USA, and its appeal against the revocation of the SHERLOCK mark in the proceedings at the EU IPO.
- There is no evidence that the applicants, or any other business under Mr Gleissner's control, has launched, or is preparing to launch, a mobile phone application.
- Companies controlled by Mr Gleissner have filed over 250 applications in the USA to register marks identical to established brands. Two examples are cited: BAIDU and THE HOME DEPOT.
- Companies controlled by Mr Gleissner have filed applications in Portugal and at the Benelux IPO to register 'EU IPO' as a trade mark for a wide range of goods and services. The former was filed by a company called EUIPO International Ltd, which uses the same address in Regent Street as the applicants in these proceedings.
- The Apple marks under challenge, such as MACINTOSH, have acquired a valuable goodwill. A "*significant*" purpose of the revocation applications is to appropriate that goodwill by revoking Apple's marks and re-registering them in the name of companies under Mr Gleissner's control.
- Another collateral purpose of the applications is reverse domain name hijacking. This tactic involves filing a trade mark application and simultaneously applying to revoke earlier trade marks which could have been used to oppose the application. Once registered, the new trade mark is used as the basis of a UDRP complaint against the domain name corresponding to the revoked trade mark. After the domain name has been

transferred to the owner of the new trade mark as a result of the complaint, it is re-sold for a profit.

- Three such UDRP complaints have been made by entities controlled by Mr Gleissner.²
- In *Compania Mexicana de Aviacion, S.A. de C.V. v Bigfoot Ventures Ltd* (one of Mr Gleissner's companies), a UDRP panel found (in 2008) that the respondent had obtained the domain name vtp.com in bad faith. According to the panel's findings, VTP was a trade mark of a Mexican airline which had been in use for 75 years. The respondent was using the domain name to direct traffic to a parking website which contained links to travel offers from competitors of the complainant. It also contained a link to another site which offered the domain name for sale for \$148k. The panel directed that the domain name should be transferred to the complainant.
- According to an article published on worldtrademarkreview.com on 18th November 2016, a lawyer for Bigfoot Entertainment called Marco Notarnicola described one of his job responsibilities on LinkedIn as "*manipulating trademarks to reverse hijack domain names through UDRP*", although this comment was subsequently removed.
- The outcome of negotiations about Apple's disputed Singapore registration of SHERLOCK was that Mr Gleissner offered to purchase the trade mark for \$1k.
- According to public records, Mr Gleissner has sold 5 of the most valuable domain names for a total of over \$1m.
- Apple should be granted security for costs to the sum of £482k. This represented maximum scale costs of £6700, plus £500 to cover official fees, for each of the (then) 67 applications for revocation.

The second CMC on 13th December 2016

14. A second CMC took place on 13th December. The parties' were represented as before. As Apple had served a second witness statement only days before the CMC, I allowed Mr Gleissner until 24th December to file a witness statement in response.

² I note that these were either withdrawn or rejected by the UDRP panels.

The applicants' response to Apple's additional evidence

15. Mr Gleissner filed a witness statement dated 24th December 2016. The statement confirmed that Mr Gleissner is:

"...a principal of several investment companies under the brand "Bigfoot Ventures" such as New-York based Bigfoot Ventures LLC. and Singapore-based Bigfoot Internet Ventures Pte. Ltd. and have made venture capital investments in excess of £50 million to date, mostly in technology startup companies."

16. He says that:

"2. Many of those startups have struggled with their choice of a company and/or brand name for their products and services, especially as technology has changed the world, and such companies must ensure that any brand they chose has not only protection in regional markets, but because of the nature of the Internet, is available for use worldwide.

3. Consumers and potential customers today expect nowadays to find a web presence of relevant companies using their brand name and the extension .com, such domain names have become scarce and due to the low costs of holding on to a domain name, a large number of individuals and companies block existing .com names as well as their national equivalents (i.e. .co.uk, .de, .fr etc.)

4. Even after a domain name can be secured, which usually requires lengthy negotiations and payment to the owners of existing domains, adverse trademarks often pose a threat to the worldwide use of a brand.

5. To address this vital problem that is not only of paramount importance of new startup companies, but often beyond the means and experience of the entrepreneurs, Bigfoot Ventures has established an Intellectual Property Group with the objective to secure rights to brands in form of domain names and trademarks that can be used for startups."

17. This is achieved by filing applications for the registration of marks and by challenging registered marks that are no longer in use. Mr Gleissner says that:

“12. I control directly and indirectly a portfolio of 15,000+ domain names, which Bigfoot Ventures LLC. and related companies have purchases for an excess of £10 million.

13. Out of these 15,000+ domain names, we have decided to sell 19 domain names in 2015, and 70 domain names in 2016, mainly due to the fact that a third party had approached us and proactively inquired about purchasing said domain names, and our conclusion that the brands related to the domain names could not likely be used due to the amount of potentially adversary trademark claims.”

18. As regards Apple’s allegations that he is a ‘trade mark troll’, Mr Gleissner repeats (this time in a witness statement) that:

“I have never demanded or suggested as a way of settlement, directly or through companies under my control, any payments related to any cancellation actions of trademarks.”

19. As regards the background to the revocation applications, Mr Gleissner states that:

“14. I am not a user of Apple's products, but those I asked personally about "Sherlock" confirmed that Apple changed the name of the program that used to be called "Sherlock" into "Spotlight", and none of the people I asked had any information of a different programme or service offered by Apple under the brand "Sherlock". Apple's apparent attempt to "cling on" to a trademark "Sherlock" despite the apparent abandonment of such mark prompted me to investigate Apple's other trademark registrations.

15. This prompted me personally to look into all trademark registrations that Apple holds in the European Union and the United Kingdom, reviewing the often wide scope of classes and goods and services claimed in such registrations, the scope and extend of which seemed excessive and abusive to me.

16. As a result, I decided to initiate revocation proceedings, as it is my right under the rules of the intellectual property offices who specifically leave the enforcement of the general use requirement up to the marketplace by allowing a third party challenge of a registered trademark based on the lack

of use on a case-by-case basis, and dependent on the payment of a fee, instead of the trademark office committing resources to supervise and enforce use requirements.”

20. Finally, I note that Mr Gleissner denies that:

“I have and never had any intentions or expectations of "coercing" Apple into a settlement related to other cases.”

The tribunal’s power to strike out the applications as an abuse of process

21. Mr Riordan submitted that Rule 62 of the Trade Mark Rules 2008, gave the registrar a power to strike out the applications as an abuse of process. The relevant parts of the Rule are as follows.

“62.—(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may—

(f) stay the whole, or any part, of the proceedings either generally or until a specified date or event”

22. According to Mr Riordan, the registrar’s wide ranging power to manage the proceedings includes the power to strike them out. In any event, granting a permanent stay of proceedings (which is clearly within the Rule) is equivalent to a strike out. If there was any doubt, Mr Riordan submitted that the words of the Rule should be interpreted so as to give effect to Apple’s right to property under the Human Rights Act 2008 and/or the requirements of the EU Enforcement Directive³ that measures, procedures and remedies for the enforcement of intellectual property rights *“shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide safeguards against abuse”*.

23. In support of these points, Mr Riordan drew my attention to a number of decisions of the courts and Appointed Persons which indicated that, in principle, the registrar has the power to strike out proceedings as an abuse of process. It is

³ Directive 2004/48/EC, particularly Article 3(2)

sufficient to recall that in *T-Mobile (UK) Ltd v O2 Holdings Ltd*,⁴ Ms Amanda Michaels as the Appointed Person said that:

“Making an application under section 47 [of the TMA] is not subject to any statutory preconditions. If an applicant is to be denied his statutory right to a fair hearing of such an application, bearing in mind the Court/Tribunal’s obligations under Article 6 ECHR, that denial must flow from a finding that the particular applicant is — on the particular facts of the case — exercising his rights under section 47 in an improper and abusive manner.”

24. This was in 2007 and therefore before the coming into force of the current Rules. However, even prior to the 2008 Rules it was established that the registrar has an inherent power to regulate his own procedures, provided that in doing so he neither created a substantive jurisdiction where none exists, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction on the registrar.⁵ In other words, the tribunal has an inherent power to fill gaps where the statutory procedural rules are silent, provided that is necessary and it is proper to do so.

25. Consequently, I am satisfied that the registrar has the power, in principle, to strike out the current revocation proceedings as an abuse of process. Indeed at the second CMC Mr Gleissner appeared to accept as much. Consequently, it is not necessary to decide whether that power stems from a purposive interpretation of Rule 62 or the registrar’s inherent power to regulate his own procedures. If necessary, I would have relied upon the latter.

The cost of defending the applications is out of proportion to any legitimate commercial benefit to the applicants

26. Mr Riordan relied upon *Summers v Fairclough Homes Ltd*⁶, *Ashley v Chief Constable of Sussex Police*⁷ and, particularly, *Jameel v Dow Jones & Co Inc.*⁸ as support for his submission that the applications should be struck out as an abuse of process because the cost to Apple of defending the applications was out of all

⁴ BL O/364/07

⁵ See *Pharmedica’s Trade Mark Application* [2000] RPC 536 at 541.

⁶ [2012] 1 WLR 2004

⁷ [2008] 1 AC 962, 991

⁸ [2005] QB 946 at 54

proportion to any legitimate commercial benefit to the applicants. He reminded me that in the latter case Lord Phillips MR said:

“An abuse of process is of concern not merely to the parties but to the court. It is no longer the role of the court simply to provide a level playing field and to referee whatever game the parties choose to play on it. The court is concerned to ensure that judicial and court resources are appropriately and proportionately used in accordance with the requirements of justice.”

27. The *Jameel* principle has been held to be apply to intellectual property cases⁹ where the likely cost of dealing with claims for infringement was considered to be disproportionate to the damages claimed.

28. Mr Riordan submitted that it was necessary for the registrar to give effect to the *Jameel* principle in this case so as to protect Apple’s right to property under Article 1 of Protocol 1 to the European Convention on Human Rights, which UK courts and tribunals are required to uphold under the Human Rights Act 1998. In this connection, Mr Riordan pointed out that the applicants have not shown any commercial interest in trading under any of the marks covered by the UK applications for revocation, none of which are for the mark SHERLOCK. Further, given Apple’s goodwill and reputation under the UK marks, it was inconceivable that the applicants could trade under them irrespective of the goods or services concerned.

29. For his part, Mr Gleissner emphasised that s.46 of the Act includes no conditions for making applications to revoke trade marks for non-use. The relevant part of the section states that:

“(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that -
(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

⁹ See *Lilley v DMG Evants Ltd* [2014] EWHC (IPEC) and *Sullivan v Bristol Film Studios Ltd* [2012] EWCA Civ 570.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.”

30. Mr Gleissner accepted that some of the trade marks covered by the applications were known to be used in relation to certain goods or services, such as iPhone for mobile phones. However, he submitted that even these marks were registered for many more goods and services than those for which they were known to be used.

31. According to Mr Gleissner, Apple’s strategy of registering marks for a wide range of goods/services and then not using the marks, or using them only for a subset of the registered goods/services, created a major problem for businesses looking for a trade mark that was available for international trade. For example, Mr Gleissner believed that Apple had ceased use of the SHERLOCK mark some years ago, when it renamed a search software tool as SPOTLIGHT. However, the continued registration of SHERLOCK by Apple had caused his business inconvenience. It was therefore important that large companies like Apple were not protected from non-use revocation proceedings under the guise of abuse of process.

32. The Act (and the underlying EU Directive) requires that registered trade marks must be put to genuine use or else become subject to revocation for non-use. There is no requirement to show use of a mark at the time of registration, but any person is entitled to make an application to revoke an unused mark. This is one of the checks and balances in the UK and EU systems for the registration of trade marks. Other countries have adopted different procedures to achieve the same objective. Notably, the procedure in the USA requires trade mark applicants to show use of the marks in relation to the goods/services listed in their applications, prior to registration. I therefore accept Mr Gleissner’s submission that the tribunal should be slow to shield trade mark owners from applications for revocation for non-use. This is because such applications may serve the public interest in removing unused trade marks from the register, thereby potentially freeing them up for use by undertakings who have a real commercial interest in trading under the marks.

33. Whether Apple could use its common law rights, or its rights under s.10(2) or (3) of the Act to prevent another undertaking from using the same mark in relation to similar, or even dissimilar, goods/services to those which Apple's mark is actually used is irrelevant. This is because the exercise of any such rights would depend on Apple showing there was a misrepresentation and damage to its goodwill, as required by the law of passing off, or that the conditions set out in s.10(2) or (3) of the Act are satisfied. Therefore, the existence of such rights as Apple may be able to assert against third parties on the basis of the use it has actually made of its marks in no way deprives the revocation applications of purpose. However, I accept that the applicants have not claimed or shown any plans to trade under any of the marks covered by the UK applications for revocation. So in that sense the applicants do not appear to have any commercial interest in the marks.

34. The equivalent provision of the previous Trade Marks Act¹⁰ required an applicant for what was then called 'rectification' of the register, to show that he or she was a "*person aggrieved*" by the registration of the trade mark. I am concerned that applying the *Jameel* principle in the manner advocated by Apple would, in effect, reintroduce a 'sufficient interest' type requirement. That would appear to be contrary to the plain wording of s.46(4) of the current Act. Mr Riordan accepted that the reintroduction of a 'sufficient interest' type requirement would be inappropriate. He sought to persuade me that applying the *Jameel* principle in the manner advocated by Apple would not lead to such a result. He submitted that it was a matter of degree: a large number of applications made by someone without a commercial interest in the trade marks could be an abuse, whereas a single such application might not.

35. In the case of an application made under s.46 of the Act, which does not require the applicant to have any commercial interest in the matter, I find that applying the *Jameel* principle in the manner advocated by Apple would be artificial and inappropriate. Where the applicant has no commercial interest in the mark, it would always lead to the result that the cost of defending the proceedings would be disproportionate to the legitimate commercial benefit to the applicant. It is true that the number of applications filed against the marks of a single proprietor serves

¹⁰ Section 26(1) of the Trade Marks Act 1938

to magnify the disproportionality between the cost of defending the marks and the lack of commercial benefit to the applicant, but this disproportionality would be present even in the very first such application. Further, although it is true that the 'benefit' in the IP cases that have been rejected by the courts on the application of the *Jameel* principle was the commercial benefit to the claimants, this was determined by the nature of the proceedings and the relief sought. In the case of an application for revocation of a trade mark for non-use, I am not persuaded that the 'benefit' side of the equation should be limited to the commercial benefit to the applicant. The removal of an unused mark from the register is itself a beneficial effect of an application for revocation. The removal of 68 unused marks would increase this benefit, not reduce it. Accordingly, if as Mr Riordan submitted, the essential test is simply "*whether the game is worth the candle*", my answer would be 'yes'.

36. I do not consider that the Human Rights Act has any bearing on this matter. This is because Apple's right to property is not absolute. The continuation of trade mark rights is conditional on the marks being used. Therefore, using the procedures set out in the legislation in order to challenge trade mark registrations for non-use in no way infringes Apple's right to property.

37. I do not accept that the EU Enforcement Directive has any bearing on the matter either. It is concerned with measures, procedures and remedies for the enforcement of intellectual property rights. By contrast, revocation proceedings are concerned with establishing the [legitimate] existence of such rights. Even if that Directive applies to revocation proceedings, it cannot possibly make it an abuse simply to use a statutory procedure to revoke trade marks for non-use.

38. Consequently, if the applicants are simply using the established procedures to challenge Apple's trade marks, the mere fact that the applicants have not shown that there is any commercial benefit to them in revoking the marks and/or that there are 68 such applications, is not sufficient to justify striking out the applications as an abuse of process.

Collateral purpose

39. Mr Riordan relied upon *Grovit v Doctor*¹¹ and *Goldsmith v Sperrings*¹² as support for the proposition that bringing proceedings for an improper collateral purpose amounts to an abuse of process. I find the latter case more helpful and note that in that case Lord Bridge stated the law to be as follows.

“Mr. Comyn relied, in support of the submissions which I have summarised in paragraphs 1 and 2 above, on the dictum of Lord Evershed M.R. in *In re Majory* [1955] Ch. 600 , 623:

“The so-called ‘rule’ in bankruptcy is, in truth, no more than an application of a more general rule that court proceedings may not be used or threatened for the purpose of obtaining for the person so using or threatening them some collateral advantage to himself, and not for the purpose for which such proceedings are properly designed and exist; and a party so using or threatening proceedings will be liable to be held guilty of abusing the process of the court and therefore disqualified from invoking the powers of the court by proceedings he has abused.”

For the purpose of Lord Evershed's general rule, what is meant by a “collateral advantage”? The phrase manifestly cannot embrace every advantage sought or obtained by a litigant which it is beyond the court's power to grant him. Actions are settled quite properly every day on terms which a court could not itself impose upon an unwilling defendant. An apology in libel, an agreement to adhere to a contract of which the court could not order specific performance, an agreement after obstruction of an existing right of way to grant an alternative right of way over the defendant's land — these are a few obvious examples of such proper settlements. In my judgment, one can certainly go so far as to say that when a litigant sues to redress a grievance no object which he may seek to obtain can be condemned as a collateral advantage if it is reasonably related to the provision of some form of redress for that grievance. On the other hand, if it can be shown that a litigant is pursuing an ulterior purpose unrelated to the

¹¹ [1997] 1 WLR 640

¹² [1997] 1 WLR 478

subject matter of the litigation and that, but for his ulterior purpose, he would not have commenced proceedings at all, that is an abuse of process. These two cases are plain; but there is, I think, a difficult area in between. What if a litigant with a genuine cause of action, which he would wish to pursue in any event, can be shown also to have an ulterior purpose in view as a desired byproduct of the litigation? Can he on that ground be debarred from proceeding? I very much doubt it. But on the view I take of the facts in this case the question does not arise and it is neither necessary nor desirable to try to lay down a precise criterion in the abstract.”

40. Apple has identified a number of potential collateral purposes behind the applications. Firstly, it is suggested that a purpose of the revocation applications is to extract revenue from Apple. Mr Gleissner denies the applicants have ever approached Apple, or anyone else, in any shape or form, with an intention to seek compensation. There is no evidence to the contrary. The single example of communications between the parties where money was mentioned, was Mr Gleissner’s offer to purchase the SHERLOCK mark from Apple. I note that in that instance Mr Gleissner offered to pay Apple \$1000. I recognise that a well advised party may not have to positively seek payment in order to receive it. However, in my judgment, the evidence in this case is far too flimsy to justify a finding that the applications were filed in order to extract revenue from Apple.

41. Secondly, it is suggested that the revocation applications are a means of acquiring Apple’s valuable trade marks and/or the domain names in which they appear. I see a little more credibility in this claim. It appears that Mr Gleissner and his businesses have a track record of trading in domain names. The VTP case mentioned above appears to be the most telling example of illegitimate ownership of, and a linked offer to sell, a domain name. Further, I have noted the published report indicating that one of Mr Gleissner’s associates at one time stated on his social media site that his job entailed reverse domain name hijacking. Additionally, the filing by companies said to be under the control of Mr Gleissner of trade mark applications in Portugal, the Benelux and the USA to register well known marks, including some of Apple’s, as well as BAIDU, HOME DEPOT and EUIPO, strongly suggests that they were filed for some improper ulterior purpose.

42. Mr Gleissner pointed out at the second CMC that the applications filed at the Benelux and Portuguese IPOs covered different goods and services to those for which Apple and the EUIPO are widely known. That may be literally true, but making applications to register APPLE for, inter alia, “interactive entertainment software”, IPAD for, inter alia, “computer software” and EUIPO for, inter alia, “publication of electronic books and journals” points strongly towards an improper motive, or at least a persistent pattern of using the trade mark system for purposes other than that for which it is intended. Mr Gleissner sought to explain the application to register BAIDU in the USA on the basis that there were two entities called BAIDU, one of which was a Netherlands-based company with some connection to him (the other being a Chinese business of some international repute). Thus the application to register BAIDU in the USA was said to be just a normal commercial step. He offered no explanation for the application to register HOME DEPOT, which I understand is well known in the USA.

43. However, the relevant question is not whether Mr Gleissner and his many companies filed the “fewer than 3000 trade marks” and 15000 domain names he mentions in his written submissions/evidence for collateral and improper purpose(s), or whether he has incorporated thousands of companies around the world, filed trade mark oppositions and revocations or UDRP complaints, for the same illegitimate purpose. The specific question I am concerned with is at this point in my decision is whether the 68 revocation applications before me were filed as part of a scheme to appropriate Apple’s valuable trade marks and/or domain names.

44. When I asked Mr Riordan to explain how a scheme to obtain Apple’s domain names could succeed if Apple’s marks were valid, he could not. I cannot see how it could succeed. Leaving aside the goodwill and reputation associated with some of Apple’s marks, and even if the registrations of the marks were partially revoked, Apple’s registrations would be senior in time to any corresponding trade mark applications filed by Mr Gleissner. Further, there could be no question of Apple having registered the domain names related to its trade marks in bad faith. The absence of any credible theory as to how the current revocation applications could lead to the result that Apple purports to be concerned about therefore leads me to believe that the revocation applications were not filed to appropriate Apple’s domain names. Similarly, to the extent that Apple’s trade marks are used and valid

(and therefore valuable), it is difficult to imagine how Mr Gleissner's later filed applications to register the same marks could allow him or his companies to appropriate Apple's earlier registered marks. I therefore reject Apple's submission that the collateral purpose behind the revocation applications is the misappropriation of Apple's trade marks or domain names.

45. The third suggested collateral purpose behind the revocation applications is that the revocation applications are an attempt to pressurise Apple into giving up its SHERLOCK trade marks and/or assign the registrations of the mark to Mr Gleissner, or to one of his companies. By the time of the second CMC, this was Apple's primary contention.

46. The timing of the revocation applications, both in the UK and at the EU IPO, is consistent with them having been filed being in response to Apple's decision to contest, or appeal against, the revocation of its registrations of SHERLOCK in Singapore, the USA and at the EU IPO. The fact that Mr Gleissner himself cited the conflict with Apple about the SHERLOCK mark as part of his explanation for having filed the revocation applications reinforces my belief that these events are connected. Further, the absence of any information about the applicants plans to trade under any of the marks covered by the revocation applications stands in contrast to the provision of information about Mr Gleissner's plans for one of his companies to launch a mobile phone application under the SHERLOCK mark. This also points to the revocation applications being a tactical response to Apple's position in the SHERLOCK revocation proceedings.

47. Mr Geissner denies that the applications are just a means of pressurising Apple in the SHERLOCK revocation proceedings. However, he is clearly very perturbed at what he perceived to be Apple's policy of hoarding unused or partially used marks and resisting attempts to revoke them for non-use.

48. Mr Riordan reminded me of the evidence which, according to Apple, showed that Mr Gleissner's claim to be acting in the public interest was not credible. In particular, the absence of evidence that Mr Gleissner was publicly trading through any of his companies, despite holding "*fewer than 3000 trade marks*", combined with the scope of his own applications to register Apple's trade marks, which

generally mirrored the goods/services covered by Apple's marks, showed that Mr Gleissner was most unlikely to be acting in the public interest. The object of the revocation applications was therefore to obtain ownership of the SHERLOCK mark in the territories in which Apple's registration of SHERLOCK is currently frustrating his plans.

49. I accept this submission. This means that I reject Mr Gleissner's evidence that the object of the applications is not to coerce Apple into giving up the SHERLOCK mark. This is because, given all the surrounding circumstances, I do not find this evidence to be credible. Given the cost of filing the numerous revocation applications in the EU IPO and in the UK, I find it unlikely that the applications are merely a 'tit for tat' response to Apple's position in the various SHERLOCK proceedings, in the sense that they intended just to vex or 'get back' at Apple, although this by itself might constitute an ulterior purpose. I am satisfied that the real purpose of the revocation applications is to coerce Apple to surrender or assign its SHERLOCK registrations. Whether Mr Gleissner's commercial purpose in obtaining registration of the SHERLOCK marks in Singapore and the EU etc. is really to launch, or facilitate the launch, of a mobile phone application under that mark is irrelevant for present purposes.

50. Does this mean that the applications for revocation are an abuse of process? I remind myself the test is whether it has been shown:

“...that a litigant is pursuing an ulterior purpose unrelated to the subject matter of the litigation and that, but for his ulterior purpose, he would not have commenced proceedings at all.”

51. I find that the applications for revocation were brought for an ulterior purpose without which these proceedings would not have been commenced. Further, the ulterior purpose is an improper purpose, at least in the sense that it is improper purpose for these proceedings. The revocation applications are therefore an abuse of process and will be struck out accordingly.

52. It makes no difference to this finding that Apple may itself have been abusing the trade mark system by registering trade marks in relation to goods/services that

it has no intention of using them for, or maintaining registrations for marks that it has long since ceased to use. Although this may help to explain the applicants' revocation applications, any such abuse by Apple cannot justify or excuse the applicants' own abuse of process.

Costs

53. I agreed to allow the parties the opportunity to make submissions on costs after they had had sight of this decision. Apple has 14 days from the date shown below to make written submissions about appropriate costs for responding to the revocation applications and the two CMCs with the associated paperwork. I will permit the applicants 14 days from the date of receipt of Apple's submissions to respond to those submissions.

Status of this decision

54. This is a provisional decision. I will issue a final decision after deciding on costs. The period for appeal against my decision to strike out the applications and whatever decision I make on costs, will run from the date of my final decision.


Dated this 18th day of January 2017

A handwritten signature in black ink, appearing to be 'Allan James', written in a cursive style.





Allan James













For the Registrar

ANNEX A**OWNER: APPLE INC./CANCELLATION APPLICANT: SHERLOCK SYSTEMS C.V.**




No.	Cancellation number	Trade mark number	Mark	Date of filing TM26N
1	501375	2256997A	SUPERDRIVE	17.10.2016
2	501376	2256997B	APPLE SUPERDRIVE	17.10.2016
3	501377	2254985	APPLE ISERVICES	17.10.2016
4	501378	2194291		17.10.2016
5	501379	2247016	DVD STUDIO PRO	17.10.2016
6	501381	2249936	ITUNES	18.10.2016
7	501382	2246316B	APPLE IPICTURE	18.10.2016
8	501383	2246316A	IPICTURE	18.10.2016
9	501386	2249396	IREVIEW	19.10.2016
10	501367	922669	Apple	10.10.2016
11	501368	2537795		10.10.2016
12	501374	2460664	IPHONE	18.10.2016
13	501388	2529387	IPAD	10.10.2016

OWNER: APPLE INC./CANCELLATION APPLICANT: AMERICAN FRANCHISE MARKETING LIMITED

No.	Cancellation number	Trade mark number	Mark	Date of filing TM26N
14	501385	2114996	COCOA	19.10.2016
15	501387	2460723		19.10.2016
16	501392	2465414		24.10.2016
17	501411	1292930	APPLEWORLD	28.10.2016
18	501415	1286063	APPLECENTRE	28.10.2016
19	501412	1292929	APPLEWORLD APPLE WORLD	28.10.2016
20	501435	2106556	TIME MACHINE TIME/MACHINE	11.11.2016
21	501440	1348454	APPLE	11.11.2016
22	501437	922942		11.11.2016
23	501436	2105968	IPHOTO EXPRESS	11.11.2016
24	501439	2061476	 (Mark text – THE APPLE CAFE)	11.11.2016
25	501438	1384641	IPOD	11.11.2016
26	501447	1419567	APPLELINK	14.11.2014

27	501446	960824		14.11.2016
28	501444	960826		14.11.2016
29	501448	1419566	APPLELINK	14.11.2016
30	501443	960827		14.11.2016
31	501445	960825		14.11.2016
32	501395	2190057	MYAPPLE	26.10.2016
33	501396	1158660	APPLE	25.10.2016
34	501397	1569623	QUICKTIME	25.10.2016
35	501408	1300909		28.10.2016
36	501409	1300907		28.10.2016
37	501410	1300908		28.10.2016
38	501407	1300910		28.10.2016
39	501414	2003089		28.10.2016
40	501416	1300913		31.10.2016
41	501417	1300912		31.10.2016
42	501419	1300911		31.10.2016
43	501393	2216890	VELOCITY ENGINE	24.10.2016

OWNER: APPLE INC. /CANCELLATION APPLICANT: FASHION INTERNATIONAL LIMITED

44	501454	1457422	LASERWRITER	17.11.2016
45	501457	2193436	APPLE CINEMA DISPLAY	21.11.2016
46	501459	940903	ZAPPLE	21.11.2016
47	501458	1459942	MACINTOSH	21.11.2016
48	501463	2193439	FONTSYNC	24.11.2016
49	501464	2194987	IBOOK	24.11.2016
50	501466	1489709	MACINTOSH	25.11.2016
51	501479	1110977	IMAC	25.11.2016
52	501479	1158661		28.11.2016
53	501453	1348427		17.11.2016
54	501452	1348433		17.11.2016
55	501456	1396907	AppleCare	21.11.2016
56	501455	1404273	MACINTOSH	21.11.2016
57	501470	1404275	Mac	24.11.2016
58	501471	1404274	MACINTOSH	24.11.2016
59	501472	1404276	Mac	24.11.2016
60	501467	1479626	APPLEPOINT	25.11.2016
61	501478	1493289	PROCARE	28.11.2016
62	501477	1493290	PROCARE	28.11.2016
63	501475	1479625	APPLEPOINT	28.11.2016
64	501469	2412793	PODGETS	24.11.2016

65	501451	1319972	HYPERCARD	17.11.2016
66	501465	1471773	POWERBOOK	23.11.2016
67	501476	1473431	STYLEWRITER	28.11.2016
68	501474	1473434	POWERBOOK	28.11.2016