



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

Date: 29<sup>th</sup> March 2019

**Before:**

**THE HON MR JUSTICE HENRY CARR**

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**Between:**

**TRUMP INTERNATIONAL LIMITED**

**Appellant**

**- and -**

**DTTM OPERATIONS LLC**

**Respondent**

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

**Intervener**

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**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  
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**Approved Judgment**

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

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MR JUSTICE HENRY CARR

## 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 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, 17<sup>th</sup> 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.

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] E.T.M.R. 26; [2014] F.S.R. 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 W.L.R 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 (SAB 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.