



Neutral Citation Number: [2025] EWHC 1793 (IPEC)

Case No: IP-2023-000120

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY ENTERPRISE COURT

Royal Courts of Justice, Rolls Building
Fetter Lane, London, EC4A 1NL

Date: 18/07/2025

Before:

MASTER KAYE SITTING AS A DEPUTY HIGH COURT JUDGE

Between:

(1) NATASHA COURTENAY-SMITH

Claimants

**(2) NOTTING HILL BAG COMPANY
LIMITED**

- and -

**(1) THE NOTTING HILL SHOPPING BAG
COMPANY LIMITED**

Defendants

(2) NANGIALAI TAKANAI

**(3) THE NOTTING HILL SHOPPER BAG.
LTD**

(4) EHSANULLAH TAKANAI

Joshua Marshall (instructed by **Briffa LLP**) for the **Claimants**
Dr Jamie Muir Wood (instructed by **J P Mitchell Solicitors**) for the **Defendants**

Hearing dates: 7 and 8 April 2025

Approved Judgment

This judgment was handed down remotely at 10.30am on 18 July 2025 by circulation to the parties or their representatives by e-mail and by release to the National Archives.

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MASTER KAYE SITTING AS A DEPUTY HIGH COURT JUDGE

Master Kaye Sitting as a Deputy High Court Judge:

1. This judgment concerns the intellectual property rights in a Brand Name and Logo used on tote bags.
2. The claim was issued on 24 November 2023, and the Particulars of Claim (“**POC**”) are dated 27 November 2023. The Defendants’ defence and counterclaim (“**DCC**”) is dated 9 January 2024 and the Reply and Defence to Counterclaim (“**RDCC**”) is dated 6 February 2024.
3. The list of fourteen issues to be determined at trial was approved at the CMC on 30 July 2024. Those issues are set out in an annex to this judgment with a summary of the decision I have reached on each issue. For the reasons set out in this judgment the overall effect of those decisions is that the Claimants have not succeeded on the claim.
4. The Second Claimant, **The Notting Hill Bag Company Limited** (“**NHBCL**”) claims infringement of a United Kingdom (“**UK**”) trade mark pursuant to the Trade Marks Act 1994 (the “**TMA 1994**”). It also advances a claim in passing off. The First Claimant (“**NC-S**”) claims copyright infringement pursuant to the Copyright, Designs and Patents Act 1988 (the “**CDPA 1988**”).
5. NC-S claims to own the artistic copyright subsisting in a logo sign as set out below (“**the Logo**”).

**the
Notting Hill
shopping
bag.**

6. Having created the Logo in about 2008/2009, NC-S subsequently sold tote bags featuring it, wholesale to traders on the Portobello Road in Notting Hill.
7. On 6 April 2010 NC-S incorporated **The Notting Hill Shopping Bag Company Limited** (company number 07212588), of which she was the director and shareholder, as a trading vehicle for her business selling tote bags featuring the Logo.
8. At NC-S’s request it was voluntarily struck off and dissolved on 10 April 2018.
9. On 7 March 2023, she issued an application to restore it to the register for limited purposes (“**the Application**”) (see below). The company was restored to the register by an order dated 7 September 2023 (sealed on 13 September 2023) (“**the Restored Company**”) (“**the Restoration Order**”). The Restoration Order took effect when it was registered at Companies House on 12 October 2023.
10. The Restored Company was the registered proprietor of a trade mark registered in the United Kingdom under number **UK000030004468** for a figurative device mark, filed on 2 May 2013 and added to the register on 11 October 2013 (“**the Trade Mark**”) in

respect of the Logo and the brand name THE NOTTING HILL SHOPPING BAG (“**the Brand Name**”) (together “**the signs**”).

**the
Notting Hill
shopping
bag.**

11. The Trade Mark was registered for goods in class 18: *Bags; shopping bags, carrier bags*.
12. NHBCL was incorporated on 13 June 2017, Mr Canbolat An is the sole director of NHBCL (“**CA**”). CA is also the director and owner of Organic Hill Limited which was incorporated in May 2013 (“**Organic Hill**”).
13. The Claimants say that the Restored Company and following its incorporation NHBCL manufactured, advertised, offered for sale and/or sold sustainable and eco-friendly bags manufactured from cotton or natural jute known as the Notting Hill Shopping Bag under the signs (“**the Claimants’ Bag**”). The Claimants’ Bag originally featured a strap line “Reducing plastic bag use. Supporting local good causes” followed by the Restored Company’s name and website address but this was not part of the Logo.
14. In the events set out below the Trade Mark was renewed by CA on 22 March 2023 and following two assignments on 22 October 2023 (“**the 2023 Assignments**”) assigned to NHBCL. NHBCL is recorded at the UKIPO as the current registered proprietor of the renewed Trade Mark (“**the Renewed Trade Mark**”). NHBCL relies on the Renewed Trade Mark for its standing in relation to the Trade Mark claims.
15. The Claimants say that there was and is goodwill in the business which used/uses the Logo and the Brand Name and/or the Renewed Trade Mark in respect of the Claimants’ Bag which has subsisted since 2010 and was transferred by NC-S to NHBCL via the Restored Company.
16. The Third Defendant, The Notting Hill Shopper Bag. Ltd (“**NHSBL**”) was incorporated by the Fourth Defendant (“**ET**”) on 30 November 2022. ET is the sole director and shareholder. The similarity between the name of the Third Defendant and the Restored Company and NHBCL will be apparent.
17. The First Defendant, The Notting Hill Shopping Bag Company Limited (“**NHSBCL**”) was incorporated by the Second Defendant (“**NT**”) on 9 January 2023. NT is the sole director and shareholder. NHSBCL has the same name the Restored Company had prior to its dissolution. As a consequence of its use of the name NHSBCL, the Restored Company was unable to be restored to its original name and was restored as 07212588 Limited. Again, the clear and obvious similarity of names is apparent.
18. NT and ET are brothers. NHSBCL, NHSBL, NT and ET together are referred to as the Defendants.
19. Both of NHSBCL and NHSBL (and before their incorporation, NT and ET personally) sell products, including bags in Notting Hill for which they sought to register trade

marks in January 2023. NT and ET say they came up with their ideas for the designs for the Defendants' Bags in about 2016/2017 and were selling them on the Portobello Road from some time in about 2017. This is disputed.

20. NC-S says that the Claimants first became aware that the Defendants were selling the Defendants' Bags from premises on the Portobello Road in competition with the Claimants' Bag in early January 2023. In particular they became aware that the Defendants were selling the Notting Hill Shopper Bag. This led to the discovery that the Trade Mark had not been transferred out of the Restored Company before its dissolution. This resulted in a considerable amount of activity by the Claimants and the Defendants in January 2023.
21. Having incorporated NHSBCL on 9 January 2023, on 11 January 2023 NHSBCL filed a UK trade mark application number 3866831 to register a trade mark in class 16: *gift bags* and also class 18: (*Reusable Shopping Bags; Bags; Carry On Bags; Garment Bags; Casual Bags*) at the UKIPO for the following sign:

**The
Notting Hill
Shopping
Bag**

The Notting Hill Shopping Bag Company Limited, T/As The Notting Hill Shopping Bag.
Wherever you go, take me with you. Stick with me and leave the plastic.
I am 100% Cotton. www.nottinghillgift.com

22. On 17 January 2023 NHSBL filed a UK trade mark application number 3868678 in class 16 (*Gift bags; Carrier bags*) and class 18 (*Bags; Carrying bags; Bags for travel; Shoulder bags; Towelling bags; Knitted bags; Hand bags; Travelling bags; Traveling bags; Beach bags; Knitting bags*). At the UKIPO for the following:



23. Both of the mark applications are subject to Notices of Opposition filed by NC-S in the UKIPO on 5 June 2023.
24. NC-S filed her own trade mark application no 3866628 on 11 January 2023 for the mark THE NOTTING HILL SHOPPING BAG. NHSBL filed a Notice of Opposition in the UKIPO on 27 April 2023.
25. All three trade mark applications have been stayed pending this determination.
26. The Trade Mark was renewed on the 22 March 2023; it had been due to expire on 2 May 2023. On 16 May 2023 NHSBL applied to the UKIPO to revoke the Renewed Trade Mark for non-use. The revocation application has also been stayed pending this determination.
27. By the time this claim was issued therefore ET and NT had incorporated two companies with identical or near identical names to the Restored Company and acquired associated domain names. They had applied to register trade marks which included an application to register a trade mark for the Notting Hill Shopping Bag rather than the Defendants' sign the Notting Hill Shopper Bag about which complaint is made in this claim. The Claimants rely on this course of conduct generally and particularly in relation to the passing off claim.
28. NHBCL relies on the registration of the Trade Mark/Renewed Trade Mark in respect of the Logo only for its trade mark infringement claim. It claims to own goodwill in the UK under the Brand Name and the Logo in respect of the Claimants' Bag.
29. NHBCL complains that the Defendants have infringed the Trade Mark/Renewed Trade Mark under section 10(2) TMA 1994 through use of the sign Notting Hill Shopper Bag ("**the Notting Hill Word Sign**") and the sign THE CAMDEN TOWN SHOPPING BAG ("**the Camden Word Sign**") ("**the Defendants' Signs**") and the following device on its bags ("**the Defendants' Bags**"):

**THE
NOTTING HILL
SHOPPER BAG.**



30. Further NHBCL complains that, by using the Defendants' Signs, the Defendants' have passed themselves off as NHBCL.

31. The relevant comparisons between the Claimants' signs and the Defendants' signs are set out below:

Cs' signs	Ds' signs
THE NOTTING HILL SHOPPING BAG 	THE NOTTING HILL SHOPPER BAG  THE CAMDEN TOWN SHOPPING BAG 

32. NC-S complains that the Defendants have infringed her artistic copyright subsisting in the Logo and that such acts were flagrant within the meaning of section 97(2) CDPA 1988.
33. The Defendants raise multiple defences and counterclaims. In respect of the Trade Mark Infringement claim they deny that the Trade Mark was validly renewed prior to 2 May 2023. If they are right, the Trade Mark claims would fall away both because there would be no subsisting trade mark and because NHBCL would not have any standing to make the Trade Mark claims.
34. Even if they are wrong about that they seek to (i) revoke the Trade Mark for non-use; (ii) invalidate the Trade Mark for being devoid of distinctive character and/or entirely descriptive; and (iii) deny that any of their acts amount to trade mark infringement.
35. In respect of the passing off claim the Defendants deny that NHBCL owns any goodwill in the UK under the Brand Name or the Logo and deny that the Defendants' acts amount to passing off.
36. They accept that there is a similarity between the signs but argue that the differences are sufficient to enable the relevant public or average consumer to distinguish between them particularly in relation to the Camden Town Word Sign.
37. In this claim the goodwill arguments in relation to the passing off claim overlap to some extent with the arguments about the Trade Mark renewal as they are bound up with the consequences of the dissolution of the Restored Company.
38. In respect of NC-S's artistic copyright claim the Defendants deny that artistic copyright subsists in the Logo; deny copying it; and accordingly deny that any of their acts amount to copyright infringement.

39. The Defendants also deny that they are joint tortfeasors, whether as the Defendants as a whole or each of NT and ET with their respective companies.

Representation and Witnesses:

40. I have had the benefit of written and oral submissions from Mr Marshall (instructed by Briffa LLP (“**Briffa**”)) for the Claimants and Dr Muir Wood for the Defendants (instructed by JP Mitchell LLP). I am grateful to both of them and have considered their submissions carefully and taken them into account even if I do not set out every argument or submission made.
41. At the outset of this trial, I refused permission for the Claimants to rely on some very late additional disclosure provided to the Defendants after exchange of skeleton arguments for the reasons I gave at the time. This is an IPEC trial, and it is necessary for the court to take a robust approach to such very late disclosure having regard to CPR 63.23 and CPR PD 29.

Witnesses:

42. Each of NC-S, CA, NT and ET provided witness statements and gave oral evidence at trial. NC-S1 and CA1 were dated 16 December 2024. NT1 and ET1 were dated 19 December 2024 and ET2 was dated 6 February 2025. I have considered that evidence carefully. In the end I do not need to refer to much of it in this judgment because of the effect of the dissolution of the Restored Company.
43. However, it is still necessary for me to have regard to the entirety of the witness evidence as part of my assessment of the witnesses’ credibility and the reliability of their evidence even if I do not set out all of the evidence in any detail. In doing so I keep in mind the guidance about the fallibility and unreliability of memory and how it degrades over time and the natural, even if unconscious, process of reconstruction.
44. Limited documents were disclosed to support or corroborate the evidence of any of the witnesses. The lack of documentation places a heavy reliance on the witnesses’ memories of events that took place some time ago.
45. I consider each of the witnesses below and in doing so touch on some of the factual evidence to assist with explaining my assessment of their evidence. I consider other aspects of their evidence in the main body of the judgment, as necessary. Because of the position on dissolution some of the evidence touched on below is not then considered further in the judgment.
46. This claim relates to trading activity along Portobello Road in Notting Hill. Portobello Road is well known for its market and market stalls. It is not a particularly long road and the area covered by shops and market stalls does not extend to its full length. Portobello Road is a thriving market with a stall holders association. **Mark Barr** as head of the Stallholders Association (“**the Association**”) explains that they represent the individual stall holders who operate within Portobello Market. It appeared to be accepted by the witnesses that there was an active community for the stall holders and others on Portobello Road in which the Association takes an active role.

47. Even prior to the film Notting Hill, Portobello Road was known for its antique market and was a draw for tourists. Mr Gruber's antique shop in Paddington Bear was said to be on Portobello Road. As NT explains, the first of the recent Paddington Bear films was released in 2014. This no doubt only increased the number of tourists and visitors to the area.
48. Each of CA, NT and ET have shops or stalls on and work on the Portobello Road. The proximity of CA, NT and ET and their knowledge of each other undermined the Defendants' evidence.
49. CA explained that he had been running his shops/businesses on Portobello Road since about 2000. Over the relevant period CA had shops on the Portobello Road at 15A/15B Portobello Road, at the Notting Hill end of the Portobello Road, and he continues to trade his current businesses from those shops. He had in the past had units at both 3 and 13 Portobello Road.
50. ET arrived in the UK in about December 2012 and started working on a stall at Portobello Road. He says he started trading from his own stall in 2014. His stalls were in front of 93 and 111 Portobello Road, both towards Westbourne Grove in the middle of Portobello Road, no more than a few hundred metres from CA's shops.
51. One of NC-S/the Restored Company's and later CA's/NHBCL's wholesalers was Delia Hunt at 89 Portobello Road who sold the Claimants' Bag from her shop from about 2009/2010 until her retirement in about 2022.
52. ET explains that in about 2017 he was able to lease the shop premises at 93 Portobello Road. He still runs his business from those premises. He was therefore trading two doors down from Ms Hunt over the relevant period.
53. He leased 89 Portobello Road in June 2022 following Ms Hunt's retirement but gave up that lease in June 2024. He retained his stall at 111 Portobello Road.
54. NT had arrived in the UK in 2014. In about 2017 he had rented a stall opposite Chelsea Gallery at about the middle of Portobello Road. He says that his trading location was changeable as the market management would move the traders to different locations on the same road. In June 2022 ET gave him his stall at 111 Portobello Road and NT now runs his business from that stall.
55. There is a dispute between CA, ET and NT about how well they knew each other, when they knew each other and the extent of any business dealings between them. However, they all ultimately accepted that they knew each other from at least 2017. The question of when the Defendants started to sell the Claimants' Bag and the Defendants' Bags and the extent to which they each knew about the other's activities remained in dispute.
56. On this issue which was primarily focussed on whether the Defendants were selling the Defendants' Bags on Portobello Road from about 2017 I do not accept the Defendants' evidence for the reasons set out below. I prefer the Claimants' evidence which had the benefit of support from the disclosed documents. I am satisfied that on the evidence available the Defendants commenced the sale of the Defendants' Bags using the Defendants' signs in about November 2022.

57. The absence of documents which included a lack of meta data from the Defendants and the deletion of WhatsApp messages by CA contribute to the overall unsatisfactory nature of the evidence available in this claim. Those shortcomings are not one-sided.
58. NC-S gave evidence covering a period from about 2008. The supporting documentation was sparse. The creation of the Logo was said to have taken place in about 2008/2009 as part of a local community project which might in part explain the sparseness of the documents about the design process. She attributed the lack of documents about the original design process to the passing of time and that she no longer had her old computers on which documents about the creation of the Logo may have been kept.
59. NC-S was challenged about when she actually created/came up with the idea for the Logo. Her witness evidence referred to both 2008 and 2009 and the only document supporting the design process was the one dated March 2010. The Defendants rely on this lack of clarity but more particularly on the lack of any creativity or freedom of choice in the design process. I consider her evidence on creativity in the copyright section below. Whilst not entirely satisfactory having had the benefit of seeing NC-S cross-examined I had no reason to doubt her explanation.
60. In 2009 NC-S explains that she started to sell the tote bags with the Logo wholesale to businesses on Portobello Road with the support of the Association. Mark Barr explains that she approached him with her idea and designs in early 2009. Her project was approved and in the end 18 stallholders agreed to stock the bags with the Logo including him and his wife.
61. Although the only design document that NC-S has been able to produce is dated March 2010 I accept her evidence that she created the Logo and was promoting the tote bag with the Logo by sometime in 2009. In doing so I take into account that this is an IPEC claim, the background to the design as explained by NC-S including whether her explanation for the lack of better evidence is credible and the time that has passed since the design process was undertaken.
62. The tote bags with the Logo in cotton and jute captured the zeitgeist and drew interest from the world of celebrity. CA was challenged about his evidence about whether the Logo was always on the tote bags.
63. However, certainly in 2010 there is evidence that the tote bags generally featured the Logo on one side and in some cases another design on the other side of the bag. For example, in October 2010, a cupcake-themed bag which featured a cupcake design on one side and the Logo on the other designed by Natalie Imbruglia was being advertised and sold. This collaboration featured in the local press but also in the Daily Mail and OK! Magazine. In 2011 the Sunday Mail did a short article about NC-S and the Claimants' Bag.
64. In about August 2012 the Claimants' bag was presented to the now Princess of Wales on a visit to Portobello Road although the tote bags in the photo of that visit do not show the Logo side of the tote bags. The Defendants accept that NC-S/the Restored Company made some limited use of the Trade Mark/Logo for shopping bags up to around 2012 and that they may have generated goodwill associated with it.

65. NC-S was a nervous witness. I am satisfied that she was doing her best to assist the court and that her answers were honest and credible even though they did not always accord with the way in which the claim had been advanced. That was to her credit. For example, she agreed that there had been no outright sale of her business to CA. She accepted that she could not point to a document that evidenced a single sale to the member of the public only to the wholesalers and mainly to Organic Hill. She accepted that the social media followers were small in number and that data about where they were or when they started to follow was not available.
66. NC-S explained that she built partnerships of mutual respect and collaboration with traders on Portobello Road including CA. She explains that her “partners” including CA would provide feedback on the designs and colours of the Claimants’ Bag which then influenced the development of the Claimants’ Bag and its colour scheme. She says she ended up with 18 wholesalers by 2017 including Mr Barr and CA.
67. In 2013 NC-S took action against a shop owner who she considered was copying the Logo and taking advantage of the reputation that the Claimants’ Bag had acquired. Other third parties produced bags such as the Notting Hill Book Shop which she did not consider copied the Claimants’ Bag or Logo which she considered remained distinctive and stood out in the market. Her approach to seeking to protect what she considered to be her distinctive design including the subsequent registration of the Trade Mark in 2013 were entirely consistent with her taking action as soon as she found out about the Defendants’ Bags in January 2023 rather than as the Defendants’ suggested having allowed them to compete with the Claimants’ Bag for 6 years. I did not accept the Defendants’ evidence on this issue in any event for the reasons set out below.
68. Her evidence and that of CA about the arrangements with CA in 2017 caused the Claimants to concede that there had been no joint venture but rather that the Restored Company and NHBCL were operating in parallel and that there was a gradual transition of aspects of the Restored Company’s business up to the dissolution of the Restored Company.
69. NC-S was from time to time more combative and argumentative than was entirely necessary but that appeared to stem from both her nervousness and a lack of understanding about the process of cross examination itself. It also appeared to stem from frustration and a lack of understanding about the legal effect of the dissolution and restoration of the Restored Company. It seemed from her answers that she had not been deeply involved with the claim or the events since January 2023 and had relied on both her legal team and CA.
70. Other than NC-S the witnesses were not giving evidence in their first language. However, each of the three other witnesses had signed witness statements in English and all the documents including those sent to and by those witnesses were in English. On that basis the court and the other parties were entitled to assume that the witnesses were sufficiently fluent to give oral evidence including under cross examination in English (see CPR PD32 paragraphs 18.1 and 18.2 and as further guidance PD57AC paragraph 3). No party sought permission to rely on an interpreter.

71. CA's evidence covered a period from about 2009 although NHBCL was not incorporated until 2017. He too had produced very little documentary evidence. He had deleted some WhatsApp messages with the Defendants which took place in 2022, in about February 2022. That was unfortunate but was prior to the dispute that has since arisen between the parties.
72. CA has had a number of companies and a number of different shop premises on the Portobello Road. He is clearly an experienced businessman. Despite this he had not produced any financial information to prove the figures provided for NHBCL's annual turnover attributable to the Claimants' Bag or the annual advertising and marketing budget as set out in the POC despite having been put to proof.
73. This inevitably left him open to challenge and his responses were not always entirely consistent with his witness statement nor were they always entirely straightforward particularly when he appreciated that the course the questioning was taking was one that did not necessarily assist him. The Defendants' counsel described him as evasive, but I consider that to be an unfair characterisation of CA. Whilst he was certainly not straightforward on some issues, on other issues he conceded or accepted the position put to him by the Defendants or simply disagreed with the Defendants' characterisation of events. For example, he also conceded that there was no evidence of a direct sale to the public. He accepted that the domain name used by the Restored Company had remained registered in NC-S's name until it was transferred to him in October 2023. He accepted that there had been a gradual transition/piecemeal transfer of control of the business in 2017/2018. His evidence in relation to the Renewed Trade Mark was less straightforward (see below). I treat his evidence with a measure of caution.
74. ET and NT were not easy witnesses. Both were hampered by a lack of documentary evidence. Even making a generous allowance for the fact they were not giving evidence in their first language I did not find either of them be straightforward. Overall, both ET and NT were unsatisfactory, evasive and inconsistent and on many occasions their evidence was simply not credible or believable and was unsupported by such documents as there were.
75. From time to time each of NT and ET appeared to struggle to understand and/or respond to questions. Even when the questions were reframed two or three times by Mr Marshall as increasingly simple questions NT and ET did not always engage fully with the questions. I was not satisfied that this was entirely due to a language issue. It was at odds with the nature and content of their witness statements which appeared to demonstrate a good grasp of English. It was also at odds with the way in which, for example, ET sought to differentiate "shopping" from "shopper". Their evidence was vague and intangible on key issues for their own DCC. On other questions their answers were not credible which then undermined their evidence in other areas.
76. Neither ET nor NT appeared to have documents that related to their respective businesses before about 2022. Both however, say that they were trading the Defendants' Bags from about August 2017.
77. The only documentary evidence of the existence of the Defendants' Bags was an image said to be of a bag produced by ET from 2018 (which included meta data) which was not initially relied on in these proceedings but had been produced in the UKIPO.

78. Other than the one image for the period from 2017 until about May 2022 the Defendants have not produced any documents to support their position. The Claimants argue this is because the Defendants were not in fact selling the Defendants' Bags until late 2022.
79. ET was challenged about the 2018 image. His evidence about it was vague. He denied having tampered with it but said it had been forwarded to him by someone else – it was not his photo. He did not say who had forwarded it to him or when. He suggested that the date on it in the UKIPO proceedings was the date he received it. He could not explain why in these proceedings he had used a cropped version without meta data. The image is inconsistent with all the other evidence about when the Defendants' signs were first in use. ET's apparent inability to grasp the significance of that or what native format documents or meta data were and/or why it might have been important to produce it despite his own legal team having sought such data from the Claimants did not assist him.
80. He explained that he did not have any documents prior to 27 October 2021 when he obtained leave to remain and that prior to the incorporation of NHSBL in December 2022 he did not need to keep records of his business because he was a sole trader. Remarkably, ET purported to be able to give detailed evidence about financial aspects of his business for a five-year period with no records at all and yet was unable to recall significant events or details about the development of his designs for the Defendants' signs.
81. In his evidence for the UKIPO filed on 27 October 2024 he set out his total annual turnover/trading figures for a 5-year period from 2017 to 2022. He then separately provided precise percentages of the overall sales said to relate to Defendants' Bags for the same period. The figures appeared to be precise and certainly would have given the impression that they were based on some financial information in relation to the sale of his bags. Indeed, his witness statement in the UKIPO explained that the figures were based on a review of his business records. That evidence did not make the cut in these proceedings where not a single document had been produced to support either the trading figures or how he knew or calculated the percentage of the sales that related to his bags.
82. Given that ET was seeking to prove that he had been selling his bags featuring the Defendants' signs since 2017 the apparent failure to deploy this evidence in these proceedings either by way of disclosure or in his witness evidence when the timelines overlapped was all the more surprising.
83. He sought to correct himself to say that in fact the figures were a rough estimation and explained that he kept the figures in his head and that they were not recorded in any documents. That was simply not remotely credible and entirely inconsistent with what he had said in the UKIPO. It also undermined his other evidence including about the image.
84. NHSBL was not incorporated until November 2022 and consistent with that the domain name nottinghillgift.com used by ET was not registered until 22 December 2022. ET sought to maintain that images of his bags featuring the domain name and/or NHSBL could have been taken or produced prior to the registration of the domain name or incorporation of NHSBL. I do not accept that evidence. I do not accept that ET would

have or did produce and sell bags featuring a domain name he did not own or a company he had not incorporated. Even if there had been a short lead in time prior to incorporation which was not his evidence that would not have supported his claim that he had been selling the bags featuring the Defendants' signs since mid-2017.

85. The evidence of bags featuring the Defendant's signs, NHSBL's name and/or the domain name in late 2022 is entirely consistent with the Defendants' signs being used on bags for the first time in about late 2022. It is entirely consistent with NC-S's discovery that the Defendants were selling their bags in January 2023. It is consistent with the documentary evidence that the Defendants had ordered bags from suppliers in May, September and October 2022 with a 30-to-45-day delivery period. It provides no support at all for the Defendants' pleaded position that they were marketing and selling bags featuring the Defendants' signs in 2017.
86. ET provided very vague evidence around the dates in 2016 and 2017 and his process of development and the creation of his designs and his business. On his case this was a period of significant development in his business and the development of the Defendants' Bags and signs and core to his defence of this claim.
87. His explanation for the use of Shopper in the Notting Hill Shopper Bag Word sign underscored the unsatisfactory nature of his evidence. The Claimants' case was that this change was a deliberate attempt to try to differentiate it from the Claimants' sign. ET's evidence was that he had used Shopper rather than Shopping because he was designing a bag for people shopping in the area and not to differentiate it from the Claimants' Bag which he claimed he had never seen. This nuance or attempted differentiation was not credible other than as a means of differentiating the Defendants' Bags from the Claimants' Bag.
88. In order to sustain his position, he explained that whilst he knew that NC-S was delivering the Claimants' Bag in 2017/2018 that was after he had designed his bag. This unravelled completely when he also said that CA had approached him to sell the Claimants' Bag in January/February 2017. On his case he knew about/had seen the Claimants' Bag by early 2017 and before he started to sell the Defendants Bags which on his case was mid-2017. It was completely at odds with his evidence that he had not seen it.
89. ET's position was yet further undermined when he explained that he knew about "rights". He explained the position in relation to Paddington Bear and possible third-party rights. At the same time, he does not appear to have taken any notice of the TM symbol on the Claimants' Bag. But his knowledge of "rights" puts into perspective the decision to use Shopper rather than Shopping and belies the naivety he appeared to demonstrate when giving his evidence.
90. It is notable that ET's opposition to NC-S's 2023 trade mark application relies on a representation of a trade mark "Notting Hill Shopping Bag" as well as Notting Hill Shopper Bag". His evidence in the UKIPO is that he sold bags under both names though that is not the evidence advanced in these proceedings. In these proceedings he limits himself to the Notting Hill Shopper Bag.
91. His evidence that he was influenced or inspired by Edward Sinclair's London Shopping Bag, and other bags he had seen in London souvenir shops on Oxford Street rather than

the Claimant's Bag which was being sold by Ms Hunt two doors away at the time is unbelievable. I do not accept the convoluted evidence that appears to be an after the event reconstruction. And his evidence that he had never seen the Claimants' Bag when he designed his own bags was undone by his own evidence in any event.

92. It is notable that in respect of the Camden Town Word Sign there was no attempt to differentiate it by the use of shopper rather than shopping which again puts into perspective the use of shopper in Notting Hill where there was a Trade Mark in place.
93. Given his explanation of the steps, he took in the period from 2017 and the work with his suppliers one might have expected him to be able to produce some documents from them even if he no longer retained any. His explanation that he had no records of his own trading activities prior to obtaining leave to remain in October 2021 did not appear to me to provide any basis for him being unable to evidence what he said he had been doing between 2017 and 2022. It was of course at odds with his ability to recall the details of his trading figures for the same 5-year period.
94. When explaining how his bags were produced, he explained that he had asked his supplier to produce stickers for him to put on plain bags from sometime in 2017 which he then applied to bags himself at home. He says he had the bags manufactured by a company in Pakistan from about 2019. Not a single document has been produced from that supplier. Instead, the documentary evidence from his suppliers started in May 2022 when he says he started to source products from China. The earliest invoice appears to be an outlier. The other invoices date from September 2022, October, November 2022 and January 2023 with a 30-to-45-day delivery period consistent with the date of incorporation of NHSBL.
95. He agreed that he had lived in the Notting Hill area since 2012 and that it was a community where people know one another. He also agreed that people would act quickly if someone was selling a "rip off". Despite that his evidence was that he and his brother had separately designed manufactured and sold the Defendants' Bags on Portobello Road since about August 2017 and that, at least, NC-S must have failed to spot their activities for 6-years. He said that he had been selling his bags from outside 93 Portobello Road in 2017/2018 when NC-S was delivering the Claimants' Bag to 89 Portobello Road. He says that she must have seen the Defendants' Bags and raised no objection.
96. But that argument works both ways. He and his brother both say they knew who NC-S was and admit to having seen her. They must have known about the Claimants' Bag because their evidence is that CA not only knew about the Defendants' Bags from 2016/2017 but that he also approached them to sell the Claimants' Bag in about January 2017 and that they sold the Claimants' Bags from 2017. Whilst CA does not accept that he approached ET and NT to sell the Claimants' Bag in 2017, the Defendants evidence appears to me to substantially undermine any credibility in the argument that they were manufacturing and selling the Defendants' Bags in 2017 at a time when they did not know about the Claimants' Bag. It simply makes no sense for the Defendants to be invited to stock and sell the Claimants' Bag at the same time the Defendants say they were openly selling the Defendants' Bags which the Claimants' say are infringing products. The Defendants were unable to provide any satisfactory explanation for this. I do not believe their evidence on this.

97. NT's evidence was if anything more evasive and incredible than ET's evidence. His explanation/lack of recollection of his design process including how he came to digitise his designs was incredible. Again, the explanation that he had hand drawn his designs in 2017 and started to put them on his bags from 2017 was unsupported by the documentary evidence. He could not explain with any clarity his design process. Given the importance placed on his design process and his designs his inability to explain the process in any credible detail and the complete failure to provide any evidence to support the creation of his designs between 2017 and 2022 was simply not believable.
98. Although nothing turns on it, NT's explanation for his role in his brother's designs was particularly evasive seeking to deny any role in the design process at all whilst then accepting that he had at least assisted his brother by making the original design on his own computer. Again, the absence of any clear or credible recollection of or documents to support the development of the Defendants' Bags and signs in the period 2017 to 2022 was simply not believable.
99. Even if like his brother he had not retained any documents himself he explains that he had bought the stickers that he applied to the bags from the traders who supplied him with the plain bags. He says he then ironed them on at home. He says he continued to produce his bags in this way from 2017 to 2019 after which he started to source them in a pre-printed form from a supplier in China. He produced no documents from any of his suppliers to provide any support for his timeline. None of this was so long ago that it would have been unreasonable to expect him to be able to produce something even for an IPEC claim.
100. The digitisation process of turning his drawings into digitised copies was undertaken by a friend and a niece in about August and September 2022. That timing was entirely consistent with him sourcing supplies in 2022 and setting up his business in late 2022.
101. NT denied any knowledge or involvement in the Shopper Bag which was his brother's bag but accepted that he did make it up for him on the computer. He accepted that he had started selling a bag called the Notting Hill Shopping Bag amongst others but denied it was a copy of NC-S's design which he said he had not seen at the time he designed his bags in 2016/2017. Like his brother he maintained that CA had encouraged them with their designs and made suggestions. He was unable to explain why CA would do this at the same time as he had just incorporated NHBCL and invested in that business.
102. As with his brother, images of bags with NHBCL on can only have been produced on or around the date of incorporation of NHBCL. He accepted that some of the images of the Defendants Bags that he relied on were taken in 2022 or 2023 and not earlier despite having appeared to suggest they were earlier. He explained that he was not seeking to mislead the court by the suggestion that they were earlier but just intending to provide images as examples of his methods. However, but for the work of Briffa and their analysis of the images it would not have been apparent that the images must have been taken in 2022 or 2023, and the court would have been misled.
103. The first documents supporting the existence of NT's bags date from about August/September 2022. NHBCL was incorporated in January 2023 and the domain name registered in early 2023. That timeline is entirely consistent with the Defendants

having commenced selling the Defendants' Bags no earlier than about November 2022. It certainly does not support the Defendants' evidence that they had been selling the Defendants' Bags since about August 2017.

104. As set out another oddity about the Defendants' evidence was the acceptance that they had been buying the Claimants' Bag from CA. CA accepted that he knew ET and NT and that he had supplied them with Claimants' Bag from shortly before Covid so around early 2020 to 2022 rather than 2017 as they contended. There was a dispute about whether they paid cash for the Claimants' Bag but that adds nothing.
105. It would not make sense for them to be selling the Claimants' Bag and the Defendants' Bags, whether in 2017 or 2020 or 2022, side by side. The Defendants' reliance on this as evidence that the Claimants must have known about the Defendants Bags, when it also meant that they must have known about the Claimants' Bag made no sense and seemed to further undermine any plausible basis for finding that they were selling the Defendants' Bags in 2017.
106. I am satisfied on the evidence available and find that the Defendants did not start trading the Defendants Bags in 2017 but in about November 2022. The precise date in 2022 on which the sale of the Defendants' Bags commenced by each of ET and NT or their companies in this case does not matter in light of other intervening events (see below).
107. I am also satisfied that they knew about the Claimants' Bag when they created the Defendants' Bags. I am satisfied that their conduct including the incorporation of their companies with identical or near identical names to the Restored Company and NHBCL and the use of shopper were deliberate.
108. In so far as necessary I will address any further evidence in the relevant sections of this judgment.

Trade Mark: Issues [1] to [4]

109. Issue [1] addresses validity, Issue [2], revocation for non-use; Issue [3] ownership and Issue [4] Infringement.
110. I intend to first address Issue 1(a) and only set out the chronology and evidence relevant to it since if it is determined in the Defendants' favour the other Trade Mark issues can then be dealt with very shortly. That is consistent with the proportionality of the approach to be adopted in IPEC.

Issue 1(a)

Is the Trade Mark invalidly registered and liable to be deleted from the register because:

- (a) It expired on 2 May 2023 and was not properly renewed on 22 March 2023 by [NHBCL] because it was bona vacantia and, at all relevant times, property of the Crown such that it was not renewed by or with the authority of the Treasury Solicitor.

Conclusion on Issue 1(a)

111. For the reasons set out below:

- i) The Trade Mark was invalidly renewed and registered on 22 March 2023. It expired on 2 May 2023. The Renewed Trade Mark is a nullity not simply invalid and should be deleted/removed or marked dead as appropriate on the register. The Defendants are entitled to declarations to that effect.
- ii) The effect of that is that NHBCL is not the proprietor of the Renewed Trade Mark and never was the proprietor of the Trade Mark and cannot advance claims in its capacity as proprietor of it.
- iii) For the reasons set out below NHBCL did not acquire a beneficial interest in the Trade Mark whether through use or an intention to transfer the Trade Mark prior to dissolution and the business as a whole had not been beneficially assigned to NHBCL in June 2017. NHBCL was not in a position to apply for a vesting order and in any event did not do so.
- iv) Even if NHBCL had had any beneficial interest in the Trade Mark or any licence to use the Trade Mark prior to 2 May 2023 those rights would have fallen away at the latest when the Trade Mark expired and/or when it was not renewed or restored.

Chronology in relation to Issue 1(a):

Date	Event	Comment
2008-2010	NC-S develops the Logo and starts to sell the Claimants' Bag wholesale on Portobello Road	Claimants' Bag initially sold wholesale by NC-S personally before the Restored Company is set up in 2010
6 April 2010	Incorporation of the Restored Company	NC-S director and shareholder. Claimants' Bag continues to be sold wholesale now through Restored Company
May 2013	Organic Hill incorporated	CA's company used as a wholesaler for the Claimants' Bag and continuing to trade
2 May 2013	Application for the Trade Mark	Applicant is the Restored Company
11 October 2013	Trade Mark registered	
3 June 2017	Email between NC-S and CA about the future of the Claimants' Bag business	

7 June 2017	Email NC-S to CA about the transition of the business	
13 June 2017	NHBCL incorporated	
16 December 2017	The Restored Company's accounts to 31 August 2017 are signed by NC-S	
23 January 2018	Notice of proposed dissolution of the Restored Company.	The notice specifically records "Upon dissolution all property rights vested in, or held in trust for, the company are deemed to be bona vacantia and accordingly belong to the Crown."
10 April 2018	The Restored Company is dissolved	The IP rights including the Trade Mark pass Bona Vacantia
January 2023	Prior to 10 January 2023 NC-S confronted Defendants at 93 Portobello Road about their sale of the Defendants' Bags	
January 2023	Prior to 10 January 2023 NC-S/NHBCL discover that the Trade Mark is still registered in the name of the Restored Company.	
10 January 2023	Letter: Briffa to Bona Vacantia Department ("BVD") of Government Legal Department on behalf of NC-S	NC-S seeks to assign the Trade Mark to herself.
11 January 2023	NC-S applied for a trade mark	
30 January 2023	BVD email Briffa	BVD explain that NC-S will either need to restore the Restored Company or purchase the Trade Mark.
16 February 2023	Part 8 application to restore the Restored Company submitted to court (" the Application ")	Application made by NC-S as director and shareholder
7 March 2023	Application is issued.	The purpose of the Application is said to be to enable the Trade Mark to be assigned to NC-S

22 March 2023	CA applies to renew the Trade Mark by filing a TM11 (“ the Renewed Trade Mark ”)	“it is understood that the email from UKIPO was in [NC-S] name. However, I completed the renewal of the trade mark on behalf of [NC-S] and the company.” CA1 at [33]
2 May 2023	Trade Mark expires	
23 August 2023	Organic Hill assigns any IP rights or goodwill associated with the Brand or Logo to NHBCL	However, Organic Hill continues to trade the Claimants’ Bag
7 September 2023	Restoration order	
12 October 2023	Restoration order registered at Companies House	
22 October 2023	Restored Company assigns the Renewed Trade Mark to NC-S	
22 October 2023	NC-S assigns the Renewed Trade Mark to NHBCL	
2 November 2023	End of 6-month grace period to apply to renew Trade Mark	
21 November 2023	Duncan Gordan assigns all IP rights in the Logo to NC-S	
24 November 2023	Claim issued	
2 May 2024	End of period to apply to restore the Trade Mark	

112. It is common ground that when the Restored Company was dissolved on 10 April 2018 the Trade Mark had not been assigned or transferred out of the Restored Company. It remained an asset of the Restored Company which then vested in the Crown bona vacantia.
113. NHBCL’s pleaded position was that there was a joint venture between the Restored Company, NC-S and NHBCL which came into existence in about June 2017 and prior to the dissolution. For the purposes of this joint venture NHBCL and Organic Hill had a licence from the Restored Company to use the Trade Mark, as licensee, for the purposes of the pleaded joint venture and had continued to use the Trade Mark in the course of business after the dissolution (POC [6] and [11]). This would have been a bare licence/permission to use the Trade Mark. This presented a number of insurmountable problems for NHBCL and was not pursued.

114. In short: (i) any licence to use the Trade Mark would have to have been in writing pursuant to section 28(2) TMA 1994 and NC-S accepted there was no written licence; (ii) the Crown would have stepped into any licence in place of the Restored Company as licensor which would have passed bona vacantia on dissolution: any bare permission to use the Trade Mark would not have bound the Crown (iii) any licence would have fallen away/had no purpose in any event when the Trade Mark was not renewed and (iv) NHBCL rightly abandoned any argument that there had been a joint venture in closing.
115. NHBCL argued in the alternative that it had become the beneficial owner of the Trade Mark having taken over the business and/or having used and continued to use the Trade Mark before and after dissolution. This is not its pleaded case which relied on a joint venture having come into existence on about 7 June 2017 through which NHBCL had permission to use the Trade Mark. NHBCL does not plead that the Trade Mark or the business were assigned to it prior to dissolution. Instead, the beneficial interest was said to arise on the basis of a combination of what was said to be an intention to assign the Trade Mark to NHBCL prior to dissolution and continued use before and after dissolution.
116. NHBCL therefore argued that this combination of an intention to assign and use was sufficient to create a beneficial interest in the Trade Mark which had passed to it in equity leaving only the legal title to pass to the Crown bona vacantia. For the reasons set out below I do not accept this analysis of the position but even if the Trade Mark had somehow passed to NHBCL in equity that did not entitle CA to apply to renew the Trade Mark, whether on behalf of NHBCL, the Restored Company or NC-S on 22 March 2023 for the reasons set out below.

Dissolution

117. NC-S applied to voluntarily strike off the Restored Company on 16 January 2018. She had signed the Restored Company's accounts on 16 December 2017 for the extended accounting year to 31 August 2017. The final accounts showed net assets of approx. £24,000 held by the Restored Company as at 31 August 2017.
118. The Restored Company was dissolved on 10 April 2018. It ceased to exist. Its assets at that time, including the Trade Mark, automatically passed bona vacantia to the Crown (s.1012(1) CA 2006) and vested in the Crown. The assets remained vested in the Crown until the restoration order was registered at Companies House on 12 October 2023. The Trade Mark had not been assigned to NHBCL/CA/NC-S or anyone else prior to dissolution. It remained an asset of the Restored Company.
119. Assets that pass bona vacantia to the Crown once brought to the Crown's attention will generally either be disclaimed or sold, and this can include intellectual property rights. Indeed, so common is the problem that the BVD provides a guidance note on the GOV.UK website about how to buy intellectual property that has passed bona vacantia to the Crown.
120. It does not matter that the Crown did not know that the assets had vested in it. It does not matter that between April 2018 and January 2023 no-one else knew that the Trade Mark or any other associated intellectual property rights that had been owned by the Restored Company had vested in the Crown. It does not matter for these purposes that

CA/NHBCL continued to use the Trade Mark, Logo and/or Brand name. From 10 April 2018 the intellectual property rights of the Restored Company including the Trade Mark had vested in the Crown and the Restored Company had ceased to exist. Only the Crown was in a position to give permission for any continued use of the Logo or the Brand name or the Trade Mark that had belonged to the Restored Company. Any continued use was without the permission or consent of the proprietor.

Restoration/Vesting:

121. To revest company assets which have passed bona vacantia to the Crown there are two broad options: restore the company or apply to vest the assets. Both require a court order. The alternative is to buy the assets from the Crown.
122. Once a dissolved English company is restored to the register it is deemed to have continued in existence as if it had not been dissolved. Its assets which were vested bona vacantia will generally be treated as having revested in the restored company unless they have otherwise been disposed of by sale or a vesting order (s.1028(1) and s.1032(1) CA 2006). When a restoration order is made the court will give such directions as seem just in relation to that restored company including for example limiting the purpose for which it is restored, how it is to be restored, or the time period for which it can be restored. The BVD will require undertakings from the party restoring the company.
123. Because restoration deems the company to have continued in existence it can create some unexpected difficulties. Section 1032 CA 2006 provides scope for the restoring party to seek broader directions. Section 1032(3) CA 2006 provides:

“The court may give such directions and make such provision as seems just for placing the company and all other persons in the same position (as nearly as may be) as if the company had not been dissolved or struck off the register.”
124. In *County Leasing Asset Management Ltd and ors v Hawkes* [2015] EWCA Civ 1251 Briggs LJ as he then was provided helpful guidance about its use at [28] to [33]. Section 1032 CA 2006 may in principle provide scope to seek a direction to ratify some act taken by or on behalf of the dissolved company during the period of its dissolution. In some cases, it can enable the court to provide a limitation direction where limitation may have expired during the period of dissolution. But such a direction requires the court to be satisfied that there are exceptional circumstances. The court would consider what it was being asked to do and why and all the circumstances including whether the dissolution was deliberate and the position as against third parties to achieve the balance recognised in the wording of s.1032(3).
125. However, if the assets of the dissolved company are in fact held on trust for the benefit of another party, they do not vest in the Crown on dissolution (s.1012 (1) CA 2006). Whilst they are still held by/pass to the Crown, a third party can apply for a vesting order. The most common examples relate to real property but the need for a vesting order is not limited to real property. Where the property is not real property the most common course would be to apply for a vesting order under s.51 Trustee Act 1925 (“**TA 1925**”) to vest the legal title of the asset in that third party. On any vesting application the court would exercise its power to do justice in all the circumstances.

126. If therefore NHBCL had acquired the beneficial interest in the Trade Mark prior to the dissolution of the Restored Company, the proper course was to apply for a vesting order.
127. If instead NHBCL's interest as pleaded was a bare licence and/or permission to use the Trade Mark neither have the characteristics or substance of a beneficial interest that would have entitled NHBCL to have applied for a vesting order. NHBCL/CA/NC-S would have been left with the option of restoring the Restored Company or to seeking to buy any relevant rights from the Crown.
128. Consistent with that Briffa wrote to the BVD on behalf of NC-S on 10 January 2023. They explained that NC-S was the director of the Restored Company and:
- “Our client has and continues to use the Mark in the course of business as a sole trader. Therefore, our client wishes to protect her business and her brand by assigning the Mark which was previously the property of her company. Our client wishes to assign the Mark to herself in her personal capacity.”
129. This explanation was inconsistent with the submission that the Trade Mark had been/was intended to be assigned to NHBCL in 2017 and/or the existence of any beneficial interest that would have entitled NHBCL to apply for a vesting order. It was entirely consistent with the Application which sought to restore the Restored Company for the purposes of transferring the Trade Mark to NC-S personally. The reference to NC-S using it as a sole trader in connection with her own business appears to be inaccurate.
130. Briffa did not tell the BVD that the Trade Mark had been assigned to CA or NHBCL or that it was held on trust by the Restored Company at the time of dissolution. They did not explain that there was a joint venture (as pleaded) and that entitled NHBCL to the Trade Mark on some basis. NC-S sought to distance herself from the contents of the letter to the BVD explaining that she was working for CA.
131. On 30 January 2023, the BVD explained that it had received interest in the Trade Mark from another party so there would have to be a bidding process. The Claimants did not assert that the Crown held the Trade Mark on trust for the benefit of NHBCL and did not apply for a vesting order, instead they made the Application.
132. The Application was made pursuant to s.1029 CA 2006 by NC-S as director and shareholder. Consistent with the January 2023 letter to the BVD, the Application and evidence in support sought to restore the Restored Company in order to transfer property and legal title (of the Trade Mark) from the Restored Company to NC-S. The Application and the Briffa correspondence is inconsistent with NHBCL holding the beneficial interest in the Trade Mark and/ or there having been a transfer of the business as a whole.
133. On 6 April 2023, Mr Staveley of Briffa confirmed in a witness statement that:
- “5. The specific asset of the [Restored Company] which [NC-S] wishes to acquire is [the Trade Mark] for the registered series trade mark “THE NOTTING HILL SHOPPING BAG.” in the name of the Company (“the Mark”). ...

(a) In addition, the Claimant wishes to acquire any and all goodwill associated with Mark, whether registered or unregistered;

(b) In addition, any and all copyright subsisting in the Mark”

134. At paragraph 6 of that witness statement, he confirmed that the purpose of the restoration was to enable NC-S to assign those rights to herself. Mr Staveley believed that the goodwill associated with the Trade Mark/ the Logo had also passed bona vacantia.

135. As is common in restoration proceedings, the BVD required undertakings to be given on behalf of NC-S. These were:

“(A) the Company will not carry on business or operate in any way other than to take the necessary steps to:

(i) assign from its ownership the UK Trademark for the Mark ‘The Notting Hill Shopping Bag’ registered with the UK Intellectual Property Office under Trademark Number UK00003004468 referred to in paragraphs 5 and 6 of the Second Witness Statement of Thomas Staveley dated the 6 April 2023 and

(ii) settle all outstanding debts to its existing creditors, if any (the actions) according to law

(B) the Claimant will notify the Registrar of Companies immediately on the conclusion of the actions

(C) the director of the Company will immediately on the expiry of 3 months from the conclusion of the actions apply to the Registrar of Companies for the voluntary strike off of the Company under Section 1003 of the Companies Act 2006 and comply with all the relevant requirements for such an application

These undertakings are required in view of paragraph 5 of the evidence in support of the Application from which it appears that the sole purpose for seeking restoration is for the company to assign its trademark ownership registered with the UK Intellectual Property Office”.

136. The undertakings were incorporated into the restoration order on 7 September 2023. The restoration order itself was simply an order that the Restored Company be restored to the register. Such assets as the Crown still held bona vacantia for the Restored Company reverted in it when the restoration order was registered on 12 October 2023.

137. If the Trade Mark had been an asset of the Restored Company on 12 October 2023, it would then have reverted in the Restored Company without further order. However, the Trade Mark had expired on 2 May 2023.

Trade Mark renewal

138. BVD/the Crown will not generally incur costs in relation to assets that have passed to it bona vacantia, instead it will generally disclaim. The BVD confirmed its usual position in relation to Trade Marks on 23 December 2024:

“The Treasury Solicitor does not renew any Trademarks (sic),
nor do we authorise anyone else to do so on our behalf.”

139. The Crown had not been asked to renew the Trade Mark. It had not been asked to, nor had it authorised anyone else to renew it on its behalf. It had not sold, transferred or vested the Trade Mark in anyone else by the time it expired on 2 May 2023.
140. There was therefore no Trade Mark to be re-vested or restored to the Restored Company when the restoration order was made. The Application had not sought any additional directions under s.1032 CA 2006 that may have permitted the Restored Company to take steps to renew or restore the Trade Mark and or extend any time period for doing so or to ratify some act taken or to be taken on behalf of the Restored Company whilst it was dissolved. Whether such an application would have been successful would have depended on the specific circumstances, but no such application was made.
141. Without authority or permission from the Crown, CA had purported to renew the Trade Mark on 22 March 2023. Whether he sought to do so for NC-S, NHBCL or the Restored Company does not matter because he had no authority or legal basis to do so, and any such renewal was void/a nullity. Only the Crown/the BVD would have been in a position to renew the Trade Mark or give authority for someone else to do so.
142. CA and NC-S gave differing accounts as to the basis on which CA made the application to renew. The RDCC pleaded that (i) CA renewed the Trade Mark for and on behalf of NHBCL alternatively for and on behalf of NHBCL acting for the Restored Company. In CA1 he explained he was renewing on behalf of NC-S and the Restored Company. In cross examination he suggested that the reference to “company” at [33] in CA1 was in fact to NHBCL and that he was permitted to renew the Trade Mark in the name of NHBCL. NC-S accepted in cross examination that CA renewed the Trade Mark on behalf of the Restored Company and that she had instructed him to do so.
143. CA explained that he completed the form TM11 online. He did not retain/print a copy of the TM11. The TM11 would have required him to specify the capacity in which he made the application providing three options ‘*Recorded owner*’, ‘*Recorded representative for the owner*’ or ‘*Other (Please specify)*’. When cross examined, he could not remember which of the options he had chosen when he made the application to renew.
144. The Restored Company did not exist even if it remained the registered or recorded owner of the Trade Mark. The Crown had not given CA permission or authority to renew the Trade Mark; his only option would have been “Other” but “Other” has a limited scope. Pursuant to s. 43 TMA 1994 a trade mark “*may be renewed at the request of the proprietor...*”. “Other” is not intended to allow a third party who asserts some interest by way of a licence or beneficial ownership/assignment to renew a Trade Mark registered in the name of another party. That way lie monsters. CA was not making the application at the request of or with the authority of the owner of the Trade Mark.

145. In closing the Claimants sought to argue that NHBCL as beneficial owner of the Trade Mark always had authority to use it and therefore authority to renew it. They submitted that the legal and beneficial interests in the Renewed Trade Mark would then have merged when the 2023 Assignments were entered into.
146. Neither a licence nor a beneficial interest would have given CA or NHBCL standing to override the BVD. If either interest were asserted the proper course would have been to apply for a vesting order and then apply to renew the Trade Mark once legal title had vested. However, NHBCL did not have authority to renew the Trade Mark even if it did have a beneficial interest for the reasons set out above. The 2023 Assignments did not merge any beneficial and legal title in the Trade Mark.
147. The Renewed Trade Mark is a nullity.

Post Restoration

148. Following the restoration of the Restored Company on 22 October 2023 the Restored Company purported to assign the Renewed Trade Mark to NC-S, and she then purported to assign the Renewed Trade Mark on to NHBCL by the 2023 Assignments (separately “**the NC-S Assignment**” and “**the NHBCL Assignment**”).
149. The 2023 Assignments were of no effect in respect of the Trade Mark because the Renewed Trade Mark was a nullity. Whether they were capable of assigning any other intellectual property rights depends on the nature of those rights and whether they had reverted in the Restored Company on restoration and the interpretation of the 2023 Assignments.
150. The 2023 Assignments, appear to have a broader scope than the limited purpose for which the Restored Company was restored.
151. The 2023 Assignments are in similar terms seeking to pass certain rights from the Restored Company via NC-S to NHBCL. The 2023 Assignments record that the purpose of the restoration was to transfer the Registration (which definition was limited to the Trade Mark) and to assign the rights in connection with the Registration including goodwill. However, the operative terms purported to assign much broader rights described as the Assigned Rights defined as “any and all goodwill and Intellectual Property Rights in and to the Registration”. Intellectual Property Rights were extremely broadly defined. It appeared to be a boiler plate definition including rights that plainly had nothing to do with the Trade Mark or indeed the Restored Company. It did however include registered and unregistered rights and the right to sue for passing off and copyright.
152. Dr Muir Wood sought to argue that the 2023 Assignments exceeded the ambit of the restoration order and that the 2023 Assignments were ultra vires. I do not agree with his analysis. The restoration order itself was not limited; it simply restored the Restored Company to the register. As set out above the Restored Company was then deemed to have been in continuous existence from 10 April 2018 to the date of restoration as if it had never been dissolved subject to the effect of for example the expiry of the Trade Mark in the intervening period.

153. If the NC-S Assignment was an assignment that the Restored Company could have entered into as a consequence of its own constitution/articles it was not ultra vires for it to do so once restored. Indeed, had NC-S sought further directions and/or a variation of the restoration order to expand the scope of the Application to encompass any registered or unregistered intellectual property rights and ancillary rights it is quite likely that the BVD would have simply agreed subject to modifying the undertakings.
154. But it is right to recognise that the restoration order was intended to be circumscribed by the undertakings which NC-S had given to the court as a member and director of the Restored Company in return for the BVD's consent to the restoration order.
155. In the absence of further directions or a variation to the restoration order under s.1032 CA 2006 whilst the NC-S Assignment was not ultra vires it was a breach of NC-S's undertakings to the court. Neither counsel addressed me on the consequences of those breaches and whether they could in some way limit the validity of the NC-S Assignment, but it does not seem to me that it would be directly affected by her breach of undertaking – the question is rather – what in fact was capable of being assigned.
156. It was clear from her evidence that NC-S had not appreciated the significance of the undertakings. For example, she accepted in cross examination that on the face of it the undertakings did not include goodwill. Further whilst she had undertaken to the court to apply for the voluntary strike off of the Restored Company within three months of the 2023 Assignments, she had only recently applied to do so 18-months later.
157. The Defendants' counterclaim sought a declaration that the Trade Mark had been *wrongfully renewed by the person or persons who purported to renew it on 22 March 2023*. The DCC dated 9 January 2024 pleaded the expiry of the Trade Mark, that the BVD would not have renewed the Trade Mark and pleaded that someone who was not entitled to renew it must have improperly renewed it. The Defendants put in issue the propriety or validity of the renewal and consequently the Trade Mark and did so before the period for restoring the Trade Mark had expired.
158. Once restored the Restored Company may have been able to take steps to apply to renew the Trade Mark during the six-month grace period permitted in accordance with section 43(3) of the TMA 1994 and rule 36(2) of the Trade Mark Rules 2008 (the “**2008 Rules**”), before 2 November 2023. It may have been able to apply to restore the Trade Mark under section 43(5) of the TMA 1994 and rule 37(1) of the 2008 Rules, before 2 May 2024. Whilst Dr Muir Wood submits that it would have been hard for NC-S to satisfy the conditions of such an application, no such application was made.
159. Any such application would first have required an application for directions under s.1032 CA 2006 whether for retrospective or prospective permission and varied undertakings given the limited scope of the Application. Despite being put on notice by the Defendants in the DCC, NHBCL did not do so. Instead, it relied on the Renewed Trade Mark and the 2023 Assignments.
160. The question of the beneficial interest falls away for the purposes of the Renewed Trade Mark because even if such a beneficial interest had existed there was no application to vest the legal interest prior to the expiry of the Trade Mark.

Beneficial Interest?

161. NC-S had started to sell the Claimants' Bag wholesale initially from 2009 and then through the Restored Company from 2010. CA was one of her largest wholesale customers. He sold the Claimants' Bag through his shops and through Organic Hill from May 2013. The Claimants disclosed a number of invoices evidencing sales by the Restored Company to Organic Hill, one of the largest wholesalers, between 2014 and 2017.
162. Over the years NC-S and CA had become friends. By 2017 NC-S was finding that the combination of running the Restored Company, her other interests and two young children was not sustainable. She discussed this with CA. NC-S and CA say they agreed that he would take on the business of the Restored Company. Despite stepping away NC-S would still have some input particularly on the design side. Both NC-S and CA confirmed her continued involvement.
163. There was no written agreement setting out what NC-S/the Restored Company was intending to transfer to CA or when or how. The Claimants relied on two emails dated 3 and 7 June 2017 from NC-S to CA. There is no responsive email from CA.
164. NC-S emailed CA on 3 June 2017, setting out what she considered her options to be:

“ ...

I have made the (actually quite hard!) decision to pull out of the bag business and have extended my year end to prepare the business for closure once the stock is sold out and the payments due are collected in.

My options are

- 1) To close the business but hold on to the trademark ...
- 2) For someone such as you to take over the business and grow it in a way that I have never done but you have always told me I should!!

Do you want to have a read of the key facts below and let me know your thoughts.”

165. She explained that the Restored Company had sold 22,000 tote bags the previous year and similar numbers of bags over the previous couple of years. She had 18 stockists three of whom were not recorded because they dealt in cash (the evidence from all the witnesses was that at least some of their respective business was conducted in cash). NC-S explained that the Restored Company made a profit of between £13K and £21K per annum.
166. She explained how much stock she was holding:
- “I currently have around 800 brown bags and 1800 cotton bags (train and logo both sides) in stock. I currently have no more stock on order. I do not expect this stock to last long but my sales will be limited by lack of variation of designs.”

167. She told CA that “*the logo 'The Notting Hill Shopping Bag' is trademarked*”.

168. After a further meeting on 7 June 2017 NC-S emailed CA recording:

“Hi Jan, good to see you today. Thank you for the 'deal'. I don't know what to do with all this cash!

So next steps

- I am going to package up all the info, organise everything and give it to you in a way that is easy to understand!

- ...I have contacted Rahul my long term supplier to update him on what is going on and see if he can pull himself together to be the supplier...

- I will do the deliveries this week and also update everyone on price increase and as I see them all, explain to them that someone else is going to be helping me more. What is the name of your girl again? Then I will take her to meet them all.

- I will also change the address on trademark and direct debit on the storage unit (and remove my rubbish from the storage unit)”

169. Both NC-S and CA accepted the reference to the cash was to a payment made by CA for NC-S/the Restored Company’s existing stock. Of course, it cannot have been a payment by NHBCL since it was not incorporated until 13 June 2017. CA explained the subsequent steps he took to source a supplier of the Claimants’ Bag including travelling to India. CA and NC-S’s evidence about the process by which CA slowly took over aspects of the business over time was entirely consistent between them and consistent with the limited documentary evidence. The only reference to the Trade Mark was in relation to the change of address.

170. By 9 June 2017 NC-S and CA had agreed the terms of an email to be sent to the wholesalers in which NC-S referred to a new business partner and a new invoicing system. The wholesalers were not told there was a transfer of the business to CA (NHBCL had not yet been incorporated). Whilst NC-S refers to CA as “owner” and expresses her intention to gradually fade out as between them this does not seem to have been what the wholesalers were told. The overall content was consistent with the gradual transition described by both CA and NC-S in evidence and not with an immediate transfer of the business or an assignment of the business in June 2017 or indeed at all.

171. NHBCL was incorporated on 13 June 2017. The domain name nottinghillbag.com was registered in the name of CA on 21 June 2017 rather than to the newly incorporated NHBCL. The registrant details were not updated to NHBCL until 2 October 2023. Meanwhile NC-S continued to maintain the domain names nottinghillshoppingbag.com and nottinghillshoppingbag.co.uk with the last renewal in evidence being dated March 2023. The eventual transfer to NHBCL/CA was not until October 2023. This was consistent with CA and NC-S's explanation of a gradual transition rather than any wholesale assignment of the business to CA/NHBCL in June 2017. NC-S’s evidence

was that the website was on her server and whilst she had intended to close it down in June 2017, she instead transitioned it. That also does not appear to have happened immediately and there was no reason for it to do so as the Restored Company and NHBCL and indeed Organic Hill were working side by side in this period. She explains that CA took on operational aspects of the business and at some point, CA/NHBCL took over payment for the storage unit used to hold stock.

172. Both NC-S and CA described the Restored Company, CA and then NHBCL (and Organic Hill) as working in parallel from about June 2017. The Restored Company and NHBCL and Organic Hill were all using the Trade Mark and selling the Claimants' Bag together.
173. The Restored Company continued to trade with net assets of approximately £24,000 recorded in its accounts at the end of its extended financial year on 31 August 2017.
174. Between June 2017 and April 2018 nothing was done to transfer the Trade Mark. That was not surprising given the continuing activity of the Restored Company and NC-S's continued involvement.
175. NC-S explained that she had intended to do something with the Trade Mark, but she did not and was not chased. This was inconsistent with the Trade Mark having been transferred or assigned beneficially to CA/NHBCL prior to dissolution and/or with any assignment of the business as a whole. It was, however, consistent with the correspondence with the BVD in January 2023 which rather than asserting that NHBCL were the beneficial owner of the Trade Mark sought to transfer it to NC-S.
176. Whilst NC-S's evidence might just about have supported a submission that there had been a future intention to transfer the Trade Mark the evidence was one sided. CA's evidence simply does not engage with the intention to transfer the Trade Mark in June 2017. CA accepted that his explanation of what he had discussed with NC-S about taking over the business did not refer to the Trade Mark. It was quite striking that CA's evidence made no reference to the assignment, licence or transfer of the Trade Mark at all when explaining what happened in 2017.
177. CA1 explained that NC-S continued to work with him after the transition and after the dissolution. His evidence at [33] about the renewal of the Trade Mark referred to NC-S taking steps to restore the Restored Company to get the Trade Mark back consistent with his understanding that the Trade Mark had not in fact been assigned to NHBCL or CA.
178. Although conceptually it is possible for there to be a separation of the beneficial and legal interest in the Trade Mark there would have to be some evidence of it. Whilst an equitable assignment does not have to follow a particular form to be valid there needs to be something from which one can glean that there was an intention to assign and what is being assigned.
179. Here it is difficult to discern from the evidence when exactly it is said that any beneficial interest/equitable assignment was said to have arisen. It certainly cannot have been June 2017. Neither is there any clarity about its terms or what the consideration was. The piecemeal transition of aspects of the business over time with not everything in fact being transferred at all – see for example the domain names as well as the Trade Mark

do not support any beneficial assignment of the business as a whole. And there is no identification of what the consideration for any transfer of the Trade Mark might have been or when it occurred if it was separate to any submission that the assignment was of the business as a whole.

180. NC-S explained that she had agreed that CA could use the Trade Mark/Logo. Use is not an assignment of the Trade Mark. And any licence to use it would have to be in writing (s.28 TMA 1994) and of course would have passed bona vacantia on dissolution. And nor would any licence survive the expiry of the Trade Mark.
181. The precise legal characterisation of the transition period between 2017 and 2018 does not matter in this context but it is clear from the evidence that there was no assignment of the business as a whole or the Trade Mark in June 2017, whether to CA or NHBCL, or at any point before the dissolution.
182. NHBCL sought to advance an argument that its beneficial interest arose from the continued use of the Trade Mark after dissolution. However, use alone even with the consent of the Restored Company prior to dissolution would not have been sufficient to create a proprietary or beneficial interest without more. Use after the dissolution cannot have accrued a beneficial or proprietary interest in the Trade Mark if it had not already arisen prior to dissolution. Continued use after the dissolution was without the consent or knowledge of the Crown in whom the Trade Mark was vested. And use after the expiry of the Trade Mark does not assist at all.
183. In any event the claim had been advanced as joint venture between NHBCL and the Restored Company from about June 2017 to 10 April 2018 after which NHBCL carried on the “business”. The terms of the joint venture were not pleaded. At best a joint venture may have provided some basis for applying for a vesting order or directions under s.1032 CA 2006.
184. Whilst the joint venture was abandoned in closing, a joint venture by its nature would not have been consistent with the submission now advanced that there had been an assignment of either the business of the Restored Company or the Trade Mark to CA (or NHBCL when it was subsequently incorporated) during the period June 2017 to 10 April 2018. However, the abandonment of the joint venture left the Claimants in some difficulties as to the legal basis for the transfer of the Restored Company’s business to NHBCL.
185. The additional pleaded licence to Organic Hill from the Restored Company was also inconsistent with the transfer or assignment of either the business as a whole and/or the Trade Mark to NHBCL.
186. NHBCL is not and never was the legal proprietor of either the Trade Mark or the Renewed Trade Mark. It did not have a beneficial interest in the Trade Mark prior to dissolution and its use of the Trade Mark after dissolution could not create one. Had it had a beneficial interest it may have been able to apply for a vesting order. It did not have a beneficial interest in the Trade Mark and it would not have given it the right to apply to renew it without the consent of the Crown. Any beneficial interest could not have survived the expiry and subsequent non-restoration of the Trade Mark.

187. The answer to the Trade Mark Issues are all subsumed within the answer to Issue 1(a). The Trade Mark claims are brought by NHBCL which does not have standing to bring those claims as it is not and never was the proprietor of the Trade Mark and had no authority to renew it in 2023. The Trade Mark has expired.
188. Each of Issues [1(b)] to [4] would need to be brought by the proprietor of the Trade Mark which for the reasons set out above NHBCL is not. There is no subsisting registered trade mark. For completeness I address each briefly:

Issue [3] – Ownership:

189. For the reasons set out above NHBCL was not and never has been the owner of the Trade Mark nor did it have a beneficial interest in the Trade Mark before its expiry. It is not therefore the proper party to make any of the Trade Mark claims.

Issue [2] – revocation for non-use.

190. For the purposes of the revocation/non-use defences the Defendants rely on two separate five-year periods.
- i) The period of five years from the dissolution of the Restored Company being 11 April 2018 to 10 April 2023. The Restored Company remained dissolved throughout that period during which time the Trade Mark was vested in the Crown.
 - ii) The period 12 October 2018 to 11 October 2023. Although the restoration order was made on 7 September 2023, it was not in fact registered at Companies House until 12 October 2023. The Restored Company remained dissolved throughout this period. Had the Trade Mark not expired on 2 May 2023 it would have continued to have been vested in the Crown. Even the Renewed Trade Mark would have been vested in the Crown if there had been any valid renewal.
191. It would be for the Trade Mark proprietor to prove use. Although there was some limited evidence of use by the Restored Company (and NHBCL with the Restored Company's consent) prior to the dissolution there cannot have been any use of the Trade Mark by the proprietor or with its consent from 11 April 2018 to 11 October 2023 for the reasons set out above.
192. If the Trade Mark had not expired it would have reverted in the Restored Company on restoration. In those circumstances use by the Restored Company or with its consent could have recommenced on 12 October 2023.
193. The counterclaim for revocation for non-use was filed on 9 January 2024 before the three-month period for resuming use had expired. The timing means that resumption of use after 11 October 2023 would not overcome non-use prior to 11 October 2023. The Claimants have to therefore rely on preparation for resumption of use under s.46(3) TMA 1994.
194. In opening NHBCL argued that the Application made by NC-S showed an intention to resume use from February 2023. However, NC-S was not the proprietor of the Trade Mark and cannot have been preparing to resume use with the consent of the proprietor

as that was the Crown at the time. Dr Muir Wood argues that the Application was not evidence of preparation to resume use on the part of either the Restored Company or NHBCL. Given my findings resumption of use by NHBCL would not assist. Further the purpose of the Application as set out in the evidence in support of it and the correspondence with the BVD was to transfer the Trade Mark from the Restored Company to NC-S for her to use it for her business as a sole trader. The purpose of the Application was not for the proprietor of the Trade Mark to prepare to resume its use but to enable the Trade Mark to be transferred.

195. NHBCL relies on use by it in the period between the dissolution and restoration as genuine use for these purposes for both five-year periods. This was based in part on its assertion that it had a beneficial interest in the Trade Mark as a consequence of its use of it. For the reasons set out above it did not. It was not using the Trade Mark with the authority of the proprietor after 10 April 2018 and prior to its expiry on 2 May 2023. Even if any of this were to amount to preparation for resumption of use, the Trade Mark then expired on 2 May 2023 and was not validly renewed for the reasons set out above.
196. Consequently, even if NHBCL were now the proprietor of a relevant trade mark it was not using it in the period of the dissolution with the proprietor's consent.
197. There can have been no genuine use of the Trade Mark in the first 5-year period the Defendants relied on. Although the Trade Mark had not expired it was vested in the Crown during that entire period.
198. If NHBCL had had some proper basis for seeking a vesting order it could have done so. But simply using the Trade Mark without the permission, knowledge or consent of the proprietor does not amount to use for the purposes of s.46 TMA 1994.
199. Had the Trade Mark not subsequently expired before the Restored Company was restored then the Trade Mark would have vested back in the Restored Company. Subject to the matters raised above the Restored Company (not NHBCL) may then have been able to seek to renew or restore the Trade Mark and/or seek appropriate directions from the court to vary the restoration order. It may even be that the fiction created by the restoration of the Restored Company would have provided an argument that the Restored Company would then have been able to rely on the use of NHBCL in the period of its dissolution. But the Trade Mark did expire, no application to renew or restore was made and no other directions were sought by the Restored Company from the court either as part of the Application or subsequently. And none of this would have helped NHBCL which is relying on its use of the Trade Mark and the Renewed Trade Mark to defeat the revocation claim.
200. Finally, there could not have been any genuine use after 2 May 2023 when the Trade Mark expired. The second five-year period relied on for revocation for non-use appears to be at least as strong as the first period.
201. On 12 October 2023 after the expiry of the second five-year period relied on the Restored Company at best, had an entitlement to seek to restore or renew the expired Trade Mark and to seek to vary the restoration order, as necessary.

202. Since the revocation for non-use relies on the dissolution of the Restored Company, the answer would be the same even if I were wrong about the effect of the dissolution on the renewal of the Trade Mark.
203. The Defendants would therefore be entitled to revocation for non-use for each of the five-year periods in any event.

Issue [1(b)] – Invalidity:

204. Invalidity in the trade mark sense is assessed at the date of filing of the relevant trade mark. For these purposes, the relevant date would be 2 May 2013.
205. The counterclaim for invalidity was filed on 11 January 2024. NHBCL had until then to demonstrate that the Trade Mark had acquired distinctiveness in the UK.
206. The Trade Mark expired on 2 May 2023, and the Renewed Trade Mark was a nullity for the reasons set out above. There is no current valid and subsisting Trade Mark. That is the end of this Issue.
207. Distinctiveness is acquired through use. It would have been for NHBCL to demonstrate that the Trade Mark had acquired a distinctive character through use. Even if the Claimants had been able to evidence some use or acquired distinctiveness or character up to 10 April 2018, they cannot demonstrate use of the Trade Mark by the Restored Company or with its consent from 11 April 2018 and its expiry on 2 May 2023.
208. The Defendants say that the Trade Mark was invalidly registered in any event because it was devoid of distinctive character or consists of a sign designating the intended purpose of the goods and services for which it was registered (s.3(1)(b) and (c) TMA 1994) (see Arnold J in *Starbucks HK Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch)).
209. Given my decision about the Renewed Trade Mark and the pending applications to the UKIPO I do not intend to consider distinctiveness or the other aspects of the invalidity issue.

Issue [4] – Infringement:

210. This is a claim under s.10(2) TMA 1994, but it is made by NHBCL. For the approach to a claim under s. 10(2) TMA 1994 I was referred to *Match Group LLC v. Muzmatch Ltd* [2023] EWCA Civ 454; [2023] Bus. L.R. 1097, at §§26-29 and *Sazerac Brands, LLC v. Liverpool Gin Distillery Ltd* [2021] EWCA Civ 1207; [2021] E.C.C. 25, at §§10-14.
211. An infringement action has to be brought in relation to a registered trade mark. When this claim was issued there was no subsisting registered trade mark for the reasons set out above.
212. Further an infringement action has to be brought by a proprietor or with its consent. NHBCL are not and never were the proprietor of the Trade Mark. Although it may have used the Trade Mark with the Restored Company's consent between June 2017 and April 2018 (or indeed prior to that as a wholesaler) it did not have any consent from the

proprietor to use it from 10 April 2018. There cannot have been any use by the proprietor or with its consent in the course of trade after that date.

213. The date for assessing infringement is the date when the alleged infringing acts occurred. For the reasons set out above I have found that the earliest dates on which the Defendants were selling infringing goods based on the evidence available was from around November 2022.
214. The Trade Mark passed bona vacantia to the Crown on 10 April 2018 and remained vested in the Crown when the infringing acts are said to have commenced in about November 2022. There can have been no use of the Trade Mark in the course of trade with the consent of the proprietor between 10 April 2018, and the time when the infringing acts were said to have commenced in November 2022 and the expiry of the Trade Mark.
215. The Trade Mark expired on 2 May 2023 and was not validly renewed on 22 March 2023. From 3 May 2023 there was no subsisting Trade Mark to infringe. The Trade Mark was not subsequently renewed or restored following restoration of the Restored Company, and it is too late to do so now.

Passing Off - Issues [5] to [8]

216. The claim in the tort of passing off is intended to protect a claimant's goodwill generated by their business as a whole. It is not about the Logo as such. Unlike the trade mark claims, claims in passing off can be brought by anyone who can establish the three ingredients of goodwill, misrepresentation and damage. That is a question of fact. In principle therefore a claim by NHBCL does not suffer from the same issues in relation to proprietorship as the Trade Mark claims.
217. Arnold LJ summarised the fundamental principle underlying the law of passing off in *Lidl Great Britain Ltd v Tesco Stores Ltd* [2024] EWCA Civ 262 ("***Lidl***") at [27] as "*no person may misrepresent their good or services to be those of another person.*". The most well-known formulation is that set out in *Reckitt & Colman Products Ltd v Borden Inc* ("*Jif Lemon*") [1990] 1 WLR 491 at 499.
218. NHBCL must establish that it owned any goodwill which had been, or which continued to be generated by the business selling the Claimants' Bag using the Logo and the Brand Name as at around November 2022 when the Defendants commenced the acts complained of. Mere use of the Logo would not be sufficient to establish goodwill in the business.
219. For those purposes subsequent evidence of activity by NHBCL after the discovery of the Defendants' activities in January 2023 and/or after the issue of this claim in November 2023 do not assist in establishing goodwill at the relevant date. That includes the efforts by the Claimants to engage with social media and the press including the MailOnline article in September 2024. They may be relevant to other aspects of the claim.
220. Goodwill is the gateway requirement. If NHBCL cannot establish goodwill in the business on the facts, then misrepresentation and damage fall away even if there might

be facts that would support a finding of misrepresentation subject to the establishment of goodwill.

Goodwill

221. The Claimants plead that NHBCL is the current trading vehicle for the Logo and the Brand Name having built up substantial and valuable goodwill in the business in the UK. They plead that the Logo and the Brand Name have become associated with the Claimants with the relevant public – they had a reputation before the date on which the Defendants commenced trading the Defendants’ Bags. They say the Logo and Brand Name are unique.
222. NHBCL submit that any goodwill generated in the Logo and the Brand Name prior to 13 June 2017 had been passed to NHBCL. This would have been a combination of the goodwill generated by NC-S herself and/or by the Restored Company.
223. Goodwill can pass more informally between businesses where it relates to an unregistered right rather than say a trade mark, but NHBCL still has to establish that the ownership of the goodwill had passed to it.
224. It was common ground that goodwill could not be assigned or otherwise dealt with in gross and must remain in the same ownership as the business to which it relates. It had no independent existence. It could therefore only be assigned with the business to which it attached and not on its own.
225. The Claimants sought to argue that goodwill could be assigned with and attach to for example the Trade Mark/Renewed Trade Mark rather than the business as a whole and relied on the 2023 Assignments: see *Wadlow on the Law of Passing Off* 6th Edition at 3-403:

“An assignment of goodwill does not have to be in writing or any particular form and need not mention goodwill by name. A transaction intended to assign a business as a whole necessarily passes the goodwill to the assignee. A transaction which purports to deal with specific brands or marks may be interpreted as dealing with the goodwill of the business in which they are used.”
226. However, the passage in *Wadlow* is not authority for any general proposition that goodwill can be uncoupled from the business. Instead, it simply identifies that as a matter of interpretation it may be that a transaction does in fact deal with the goodwill of a business even though it appears to only deal with a specific mark.
227. The goodwill must remain in the same ownership as the business to which it related and something less than that is not sufficient (*The Commissioners of Inland Revenue v Muller & Co’s Margarine Ltd* [1901] A.C. 217 (UKHL), at p224 and *Barnsley Brewery Co Ltd v RBNB* [1997] FSR 462 per Robert Walker J at p.469).

Has the goodwill passed to NHBCL?

228. At POC [13] to [15] NHBCL sets out the basis for its claim to goodwill. It relies in part on goodwill that had accrued to Organic Hill said to have been assigned to it by the Organic Hill assignment and on the 2023 Assignments for the assignment of the goodwill of the business of the Restored Company both prior to its dissolution and between June 2017 and April 2018.

Organic Hill goodwill

229. NHBCL pleads that in so far as Organic Hill generated goodwill between 2013 and 2018 that was assigned to NHBCL by the Organic Hill assignment. The Organic Hill assignment was said to be confirmatory of a transfer or assignment of Organic Hill's goodwill to NHBCL.
230. However, CA confirmed that Organic Hill had been continuously trading in the Claimants' Bag using the Logo and the Brand Name (and the Trade Mark) since 2013 and continued to do so. As a matter of fact, therefore it did not appear that there had been any transfer or assignment of any goodwill by Organic Hill. In light of the evidence, the Claimants accepted in closing that there had not been a transfer of the goodwill from Organic Hill to NHBCL.
231. There was a further difficulty in that the Organic Hill assignment would have been an assignment in gross. There was no assignment of any business but an assignment of the goodwill and intellectual property rights in and to the "Sign" where the sign was the Logo and the Brand Name. Consequently, it would have been ineffective to assign any goodwill from Organic Hill to NHBCL in any event.
232. Dr Muir Wood argued that the sales to Organic Hill could not be treated as evidence of any onward sale either since Organic Hill continues to sell the Claimants' Bag using the Logo and the Brand Name itself.
233. Organic Hill had clearly generated its own goodwill by 2018 given the attempt to assign it and will have continued to do so given they have been continuously trading. They provide a shopfront for the sale of the Claimants' Bag. NHBCL relied on photos of Organic Hill's shop front (the shop itself is now called Cotton Hill) to support their claim to goodwill and generally.
234. I agree that NHBCL cannot rely on any goodwill generated by its onward sales to Organic Hill to support the passing off claim in the circumstances of this case but do not accept a more general proposition that they would not be able to seek to rely on goodwill generated by sales to wholesalers or stockists. In relation to other stockists, it would depend on the facts.

The Restored Company's goodwill:

235. NHBCL pleads that the Claimants' Bag was manufactured and offered for sale by the Restored Company between September 2010 and June 2017 and that by the 2023 Assignments any goodwill attaching to the Trade Mark including the right to bring proceedings for passing off was vested in NHBCL.

236. For the period between June 2017 and April 2018, NHBCL relied on the pleaded joint venture. In light of the effect of the dissolution and the fact that it is now accepted by NHBCL there was no joint venture the position is rather different.
237. Whilst an assignment of goodwill does not require the same formalities as would have been required for the Trade Mark there would need to be some evidence that goes beyond mere use that evidenced an assignment of the Restored Company's goodwill prior to the dissolution. And that assignment would have to have been of the business as a whole to which the goodwill attached.
238. Since NHBCL sought to acquire the goodwill through the restoration itself in 2023 (see Mr Staveley's witness statement referred to above) and then by the 2023 Assignments it seems tolerably clear that it accepts it had not been assigned earlier. This further supports the fact that there was no beneficial assignment of the Trade Mark or the business as a whole prior to the dissolution.
239. Whilst on one view NHBCL was the successor to the Restored Company the effect of the Restored Company being struck off and dissolved is that the goodwill in the Restored Company did not accrue to it.

Abandonment:

240. The existing goodwill subsisting to the Restored Company (which included any goodwill which had passed from NC-S to it) was abandoned or extinguished as a consequence of the dissolution on 10 April 2018. The dissolution of the Restored Company on 10 April 2018 was more than merely the cessation of a business. It was a voluntary, positive and deliberate choice by NC-S to cease to trade. As set out in NC-S1 at [40] "... *I then dissolved [the Restored Company] as it was no longer required...*" resumption was not contemplated. There was no intention that it would ever be restored.
241. The subsequent restoration was intended to be for the limited purpose of enabling the Restored Company to transfer the Trade Mark to NC-S. It was not for the purpose of transferring any residual business or for trading purposes. Indeed, restoration for the purpose of transferring the business to NC-S would have been entirely inconsistent with the position adopted by the Claimants in relation to the business of the Restored Company and would have further undermined NHBCL's position.
242. Professor Wadlow explains in *Wadlow* at §3-460:
- "...The better view is that if a business is deliberately abandoned in circumstances which are inconsistent with its ever being recommenced then the goodwill in it is destroyed unless contemporaneously assigned to a new owner.[*as approved by Lewison J in Ultraframe (UK) Ltd v Fielding [2005] EWHC 1638 (Ch); ... and Arnold J in Maslyukov v Diageo Distilling Ltd [2010] EWHC (Ch) ... and W3 Ltd v Easygroup Ltd [2018] EWHC 7 (Ch)...*]"
243. Consequently, any goodwill subsisting in the Restored Company at the time of its dissolution was destroyed.

244. The destruction of the goodwill in April 2018 means that it cannot have revested in the Restored Company in October 2023. The starting point therefore is that there was no goodwill to assign in the 2023 Assignments even if the 2023 Assignments were otherwise likely to be effective.
245. However, Professor Wadlow explains that there may be circumstances in which the goodwill is not destroyed immediately at §3-460:
- “Otherwise, the goodwill in a discontinued business may continue to exist and be capable of being protected, **provided the claimant intended and still intends that his former business should resume active trading**. It is not necessary that the prospect should be imminent, but the mere possibility of resumption if circumstances should ever change in the claimant’s favour is not enough. The claimant’s intention to resume business may be more readily believed where the original cessation was forced on him by external circumstances, although this factor is not conclusive either way.” (my emphasis)
246. Here the dissolution was no accident and nor was it forced on NC-S by any external circumstances. It was a deliberate and positive decision, a choice, to abandon the Restored Company. The goodwill was immediately abandoned and destroyed on dissolution.
247. Whilst residual goodwill may continue to subsist for a time after the business has ceased trading if it has not been abandoned in a manner that means that the goodwill has been destroyed that is not the case here. There is a difference between a business that has simply ceased trading for some reason and one that has been voluntarily struck off and dissolved as was the case here.
248. The extent of any residual goodwill is a question of fact (*Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch); [2013] FSR 29 at [138]). But even any residual goodwill would evaporate/dissipate over time.
249. In 2023 there was no intention to resume active trading on restoration 5½ years later but rather an intention to restore for the limited purpose of assigning the Trade Mark and not to trade at all. If there were residual goodwill in 2018, I am satisfied that it was not protected and would have evaporated/dissipated in the interim in the events that have occurred.
250. The 2023 Assignments then purport to assign the Renewed Trade Mark and the goodwill amongst other intellectual property rights to NHBCL. But there was no goodwill to assign as it had been destroyed.
251. Even if the goodwill had not been destroyed, they would have been assignments in gross because (i) the Renewed Trade Mark to which the goodwill was said to attach was a nullity and (ii) the 2023 Assignments do not in fact assign anything to which the goodwill attaches even if the Renewed Trade Mark were not a nullity.
252. The definition of the Assigned Rights alone makes it clear that it was never the intention that the 2023 Assignments would assign the business and that is not least because the

Claimants' case was that the business had already transitioned to NHBCL between June 2017 and April 2018.

253. If there was any goodwill which had not been destroyed the 2023 Assignments were assignments in gross and not capable of effectively assigning any goodwill to NHBCL.

NHBCL's goodwill?

254. NHBCL relies on its continuing manufacture and sale of the Claimants' Bag after dissolution. It says that it had generated substantial goodwill in the intervening period in relation to sales of the Claimants' Bag.
255. For the period June 2017 to April 2018, it is not at all clear that NHBCL will have generated any of its own goodwill given the nature of the transition and the evidence of for example what the wholesalers were told. The Restored Company was continuing to trade. Organic Hill was continuing to trade. It seems to me that the goodwill generated in that period continued to accrue to the Restored Company and/or potentially to Organic Hill.
256. Organic Hill presents another difficulty for NHBCL. It had been the largest wholesaler/stockists for the Restored Company from 2013 when it was incorporated. It was accepted both that it had goodwill and that it was continuing to trade and had been trading continuously. NHBCL continued and continues to provide stock to Organic Hill.
257. A further minor wrinkle arises in that in so far as the Logo and the Brand Name were assets of the Restored Company as distinct from the Trade Mark they too will have passed to the Crown bona vacantia. This is resolved in two ways: (i) when the Restored Company was restored the Logo and Brand Name will have reverted in it. The deemed continuation of the Restored Company throughout the period of its dissolution may then resolve any issue of permission to use the Logo and Brand Name so far as it was required; and (ii) in any event NHBCL could have generated its own new goodwill (see *Barnsley Brewery* at [462]).
258. It is therefore possible that NHBCL had generated some goodwill in its business from 10 April 2018. It therefore needs to establish its own goodwill in the business of the Claimants' Bag using the Logo and the Brand Name for the purposes of the passing off claim between 10 April 2018 and November 2022. Such goodwill would need to be more than nominal. It cannot be inferred; there must be an evidential base for it, and it must be more than mere use. It is a question of fact.

Evidence of NHBCL goodwill

259. The Defendants had accepted that some goodwill had built up in the Restored Company, at least in the period up to 2012, however, for the reasons set out above it cannot be relied on by NHBCL. There was evidence of invoices to Organic Hill and social media and other evidence in the period up to June 2017 but again for the reasons set out above that cannot be relied on.

260. The burden of proof rests with NHBCL which was of course uniquely placed to know what evidence it had to support its claim to have goodwill in its business arising from its use of the Logo and the Brand Name.
261. The Claimants argued that the Logo and the Brand Name on the Claimants' Bag had become associated in the minds of the relevant public and therefore the goodwill was valuable and substantial. Mr Marshall reminds me that this is an IPEC case and these are modest companies. But there still has to be some evidential basis for a claim advanced and where, as here, the Defendants have put the Claimants to proof in relation to certain matters that cannot be ignored.
262. Even if NHBCL can overcome the effect of the dissolution, there was, however, little evidence of NHBCL's trading activity in relation to the Logo, Brand Name or the Claimants' Bag in the period 2018 to late 2022.
263. I have identified three disclosed invoices to wholesalers/stockists in the trial bundle for the relevant period. One to Mark Barr in September 2022 for 640 bags, one to Paul & Pesi Lau in June 2022 for 40 bags and one to 210 Portobello Souvenirs in May 2022 for 418 bags. However, as set out below this is deceptive. There is no way of knowing from those three invoices what bags were in fact included and whether or how many were the Claimants Bag. Mr Marshall complains that the late disclosure which I refused to permit would have provided further evidence of trading and sales.
264. Although there was evidence of the deliveries from the suppliers and sales to the stockists there was no evidence of a single sale of the Claimants' Bag directly to a member of the public/customer in the UK between 2018 and 2022 or indeed at all. NC-S and CA accepted that there was no such evidence at all let alone for that period.
265. Whilst the sale of goods to the stockists/wholesalers and consequently on to the public may generate goodwill, NHBCL cannot rely on the onward sales in respect of Organic Hill. In fact, for the period 2018 to 2022 the Organic Hill invoices had not been produced.
266. There were two invoices from suppliers in the period August 2018 and January 2019 and then two in May 2020.
267. Dr Muir Wood submitted that since the evidence of shipping from the suppliers in India did not include images of the bags that were being shipped there was in fact no certainty that they were the Claimants' Bag and not some other bag that did not bear the Logo or the Brand Name. There was something in this point.
268. The images of the Claimants' Bag relied on do not always show the Logo and the Brand Name. When challenged about this in cross examination CA insisted that the Claimant's Bag always included the Logo and Brand Name on one side with a design on the other.
269. Whilst in principle I am prepared to accept CA's evidence that the Claimants' Bag he sourced and sold through NHBCL were two sided with an image of something on one side and words on the other side in fact not all the bags were the Claimants' Bag. The documentary evidence he relied on demonstrates that the bags sourced from the suppliers and/or therefore sold to the wholesalers were a range of products and not all

the Claimants' Bag. They will not therefore always have featured the Logo. This is clear from the supplier invoices and from CA and NC-S's evidence.

270. CA's own evidence makes clear there are other tote bags. In CA1 at [22] he explains that he sometimes sold NT the Claimants' Bag and sometimes other tote bags. This was between 2020 and 2022.
271. The invoices from the suppliers in 2018 and 2019 describe cotton and jute bags covering a number of other areas of London or sights of London not obviously connected with Notting Hill such as Oxford Street, Covent Garden, Piccadilly Circus and the like. It was not immediately obvious that they would feature the Logo relied on in these proceedings. It seems likely therefore that there were other combinations which were very unlikely to have featured the Logo.
272. The existence of other types of bags was consistent with CA's evidence in which he explained that he introduced a range of designs for other areas of London including Camden Town into his store using the same style in October 2018. From at least October 2018 therefore NHBCL was diversifying its stock. This would tend to suggest that at least a proportion of the supplies received by NHBCL would not be the Claimants' Bag as relied on in these proceedings.
273. By 2020 the invoices from the suppliers were even less helpful referring to design numbers. It is impossible to tell from those design numbers which type of bag each design relates to. Given the evidence that some of the supplies relate to bags that are not the Claimants' Bag that does not assist in establishing goodwill.
274. This raises further questions about what was actually supplied to the stockists/wholesalers. The three invoices referred to above described the goods as "Cotton bags" and "Cotton bags MIX". It is impossible to discern from that description whether any or all of those few 100 bags were the Claimants' Bag rather than another design.
275. This was not addressed at all in the evidence and leads me to treat with considerable caution the reliance on the suppliers' and wholesalers' invoices as evidence that establishes goodwill in the business connected to the Claimants' Bag, the Logo or the Brand Name.
276. There were screenshots of the website including using the Way Back machine and there was evidence of limited social media activity.
277. The POC at [24] explains that as at the date of issue of this claim the Instagram account set up by NC-S on 29 November 2015 had 923 followers when the claim was issued. As at June 2023 the Instagram account had 798 followers an increase of 125 followers in 6 months but all after any relevant date. It is clear that following the discovery of the Defendants' Bags in early 2023 there was considerable activity. For the purposes of the establishing goodwill in the business by November 2022, NC-S fairly accepted that it was not possible to identify when the followers started to follow the Instagram account and/or where they were.
278. Additionally, of course, there is no means of assessing how many of the 798 became followers before 10 April 2018 or after November 2022 but on any basis a total of 798

followers over a period of 7-years (2015 to 2022) does not establish goodwill or reputation. Those who joined pre-dissolution are likely to be part of the destroyed goodwill of the Restored Company even if they remain followers now. They would have to be excluded from any assessment of the goodwill accruing to NHBCL.

279. Being generous and dividing the followers roughly equally across the 7-years when in reality there would more likely have been an initial surge and a recent surge that would give a potential of say 450 followers over the period 2018 to 2022 for the purposes of establishing goodwill. As set out below the followers do not appear to be active which raises another question of the weight or value to be given to the Instagram account for the purposes of establishing goodwill.
280. The Facebook account had 216 followers by the time of issue at the end of 2023 and 205 in June 2023. The Facebook account provides even less evidence to establish goodwill. It was set up in November 2013 so had been in operation for 10 years by the time the claim was issued and had gained 11 new followers between June and November 2023. Working from the June figure and again being generous and simply dividing it roughly equally across the years that would allow for say 20 new followers a year so 80 to 90 over the period. Again, those who joined prior to the dissolution are likely to be part of the destroyed goodwill of the Restored Company. Again NC-S accepted that it was not in fact possible to identify who had joined or when or where they were.
281. Mr Marshall argued that given the nature of the claim it would not have been proportionate or reasonable to have required the Claimants to have chased down the geographic location evidence but that is only one element of the problem.
282. Much of the social media was what one might loosely call “marketing” in that it related to social media posts by the Claimants rather than independent social media posts. The focus of this social media was either pre 2018 or from late 2022 onwards neither of which period were of assistance in establishing goodwill in the business in the period 2018 to 2022.
283. The posts from the Instagram account demonstrate very very low usage. On the evidence available the vast majority are posts by NHBCL. Dr Muir Wood had counted 10 independent ones. NHBCL has disclosed evidence of 4 posts in 2018 – three of which were after 10 April. In 2019, 2020 and 2022 there were 5 posts each year. The disclosed posts on the Facebook account all pre-date April 2018.
284. The website for which there were a number of pages produced from the Way Back machine on various dates did not advance the Claimants’ position any further. The mere existence of a website albeit branded was not evidence of goodwill in the business. There is no evidence of any direct sales made through the website during the relevant period and no evidence about the activity or use made of it. It ought to have been possible to have provided statistics about the number of visitors to the site for example and/or whether any sales had been made through it. I note that in June 2017 NC-S had been able to tell CA that she had 1 – 3 orders a week through the website.
285. I am not satisfied that the evidence available enables me to find that NHBCL has established goodwill and reputation in its business. Whilst the threshold is not high it is not even clear on the evidence available that NHBCL can actually demonstrate a single

sale involving the Logo on the Claimants' Bag even through its wholesalers given the lack of clarity about what the wholesalers were being sold. CA and NC-S accepted there was no evidence of a single sale to a member of the public. The supplier evidence clearly includes tote bags which do not bear the Logo, and the social media evidence goes nowhere.

286. This may be an IPEC claim but there needs to be something on which to base a finding of goodwill.
287. Other evidence relied on by NHBCL to support its claim to have generated goodwill relied on turnover said to be attributable to the Claimants' Bag and a marketing budget rather than any actual marketing or advertising spend for the years from 2018 to 2022. This was set out in POC at [26] and [27]. The turnover was said to have risen from £30,201 in 2018 to £57,815 in 2022 with a significant dip during Covid. The marketing budget was said to be £1000 per annum. The Defendants did not admit the turnover and marketing budget figures and put the Claimants to proof.
288. There was no explanation in CA's witness statement about these figures and no accounting information had been produced. There is no evidence of the total turnover of NHBCL to enable any assessment to be made about the sums he said were attributable to the Claimants' Bag rather than any of the other products sold by NHBCL. Given the evidence produced in relation to the Restored Company including its accounts this was surprising. It was not even part of the refused late disclosure.
289. There is no explanation as to whether these figures included all the sales to Organic Hill, but this seems likely given that NHBCL only conceded the position in relation to Organic Hill in closing. This is likely to substantially reduce any relevant turnover for the purposes of establishing goodwill. There is no evidence of any marketing activity between 2018 and 2022 for which the marketing budget might have been used (see for example the limited use of social media above). CA accepted he had provided no evidence to prove the figures.
290. The Claimants had been critical of the Defendants in respect of their financial evidence (see above), and I agree that it was not credible. The Claimants cannot on the one hand rightly complain about the Defendants and then seek to argue that I should not apply the same standards to the Claimants' evidence. Whilst this is an IPEC claim the Claimants had been put to proof on the turnover and marketing budget and had provided no evidence at all. It is not enough in those circumstances to say that the POC was signed with a statement of truth.
291. As set out above the goodwill which had accrued to the Restored Company was destroyed on dissolution, any goodwill belonging to Organic Hill remains with Organic Hill which continues to sell the Claimants' Bag bearing the Logo.
292. All that remains is the period 2018 to 2022. Whilst a modest level of goodwill can be sufficient, I am not satisfied that the evidence establishes goodwill in the business related to the Logo and the Brand Name and the Claimants' Bag between April 2018 and November 2022.

293. As set out above goodwill is a gateway requirement to be able to sustain a claim in passing off. I am not satisfied that NHBCL has been able to establish goodwill in its business for the relevant period.

Misrepresentation and damage:

294. Arnold LJ in *Lidl* at [32] to [35] set out a summary of the law on the elements of misrepresentation and damage. The misrepresentation must be one that is likely to cause substantial damage to the goodwill in the business. If NHBCL has not established goodwill it is not necessary to consider misrepresentation or whether any misrepresentation has caused damage (or the likelihood of damage).

295. The claim for passing off therefore fails.

Copyright - Issues [9] to [12]

296. I have already considered aspects of the evidence and made findings relevant to the copyright claims earlier in this judgment and they come back into account here.
297. The law on subsistence in relation to copyright is governed by the CDPA 1988 at ss. 1, 4, 9 and 11. For there to be artistic copyright it must be original in the sense that it is its author's own intellectual creation (see *Infopaq International A/S v Danske Dagblades Forening* (C-5/08) EU:C:2009:465;). But the test is not about artistic merit but rather about making free and creative choices (*Painer v Standard Verlags GmbH* (C-145/10) EU:C:2011: 798).
298. The question of whether there is artistic copyright is objective, but the burden of proof lies with NC-S. Given the nature of the artistic work in issue it is necessary to consider the work for which artistic copyright is claimed as a key part of the evidence in support of the claim. For the copyright claim, only the Logo is relied on.
299. In about 2008/2009 NC-S says that she created the Notting Hill Shopping Bag Logo. NC-S explained that the idea of the bag was in her head at the time when her son was born in September 2008. She explained that the graphic design process came alive later in 2009.
300. She explains that the idea for the Logo and the tote bag came to her because of the convergence of a number of ideas at the same time. The idea of the need to reduce the use of plastics/plastic bags which was beginning to gain some traction, her brother's use of a tote bag at his shop in Cornwall to reduce plastic waste, meeting Anya Hindmarch who was the designer behind a tote bag with the Logo "I'm Not a Plastic Bag" and the desire to create something that could serve locals and tourists. NC-S explains that the Notting Hill Shopping Bag was conceived as a community project. Mr Barr explains that it was supported by both the Association and Mark Atkinson who was the manager of the Royal Borough of Kensington & Chelsea Market Office.
301. NC-S explained that she wanted to create something simple but impactful. She enlisted the assistance of Duncan Gordon (her brother-in-law) a graphic designer to help her develop the artistic logo. She researched and read several books about design and typography. She wanted the design to have a bold, graphic, and impactful look that would instantly capture attention. She refers in her evidence to the "I ♥ NY" logo and

how it inspired her to develop a design that was simple yet distinctive, giving her bag its own unique identity.

302. She has been unable to locate any contemporaneous documents that support this process of design. She had produced a document consisting of 18 different versions/designs for the Logo which the meta data dates from 25 March 2010. The actual Logo is not one of the 18 designs in the 2010 document. The closest design still has a dot on the i in Shopping which does not feature in the final Logo. She explains that she does not have her old computers from 2008/2009 from which to extract this information.
303. She explains that she had a variety of different designs prepared and then decided to use the particular design for which the Trade Mark was subsequently obtained and put the artistic Logo design onto a tote bag.
304. NC-S explained the design process:

“16. As briefly mentioned in paragraph 13 above, I worked closely with my brother-in-law, Duncan Gordon, who was a graphic designer and had a good understanding of typography and fonts. I shared my vision for the Notting Hill Shopping Bag and how I wanted the words "the Notting Hill Shopping Bag" to be the focal point. The inclusion of the word "the" was intentional. I did not want to portray the brand as the cheap souvenirs which had saturated the market at that time, but a unique and quality tote bag; the Notting Hill Shopping Bag. The inclusion of the word “the”, along with the ‘full stop (.)’ emphasised the bags unique qualities and exclusivity. I wanted to stylise the wording of “the Notting Hill Shopping Bag” so that the text was justified to the left and was separated onto different rows. I wanted the Notting Hill Shopping Bag to be seen as a fashionable bag, rather than a souvenir.

17. ... I provided Mr Gordon with all the necessary information which I wanted to be included in the Notting Hill Shopping Bag, such as font, boldness, words and Mr Gordon with his abilities as a graphic designer, helped create the designs as a result. While all the designs were strong, one of them stood out immediately—it had the perfect balance of simplicity and modernity while making a bold statement. The clean typography and strong lines embodied the elegance and charm of Notting Hill while remaining versatile and easy to recognize. Ultimately, I chose the final artistic work for the logo of the Notting Hill Shopping Bag because it was simple yet striking, and it captured exactly what I envisioned: a stylish, timeless bag that represented the essence of Notting Hill while being practical and impactful.”

305. The evidence in relation to when and how the Logo was created is very limited. However, it seems clear that it was being sold by no later than 2009/2010 even if the only design document is dated March 2010.

306. On 21 November 2023 shortly before issuing this claim NC-S entered into a legal assignment with Mr Gordon by which he assigned all his intellectual property rights in the Logo to NC-S. Although Mr Gordon could have been asked to provide a witness statement which explained the design process and his involvement, I keep in mind the need for proportionality in an IPEC case. I am satisfied that any artistic copyright in the Logo would be owned by NC-S and would not have been assigned to the Restored Company.

Artistic Copyright

307. The artistic threshold is not high, but NC-S has to demonstrate that she made creative choices in relation to the Logo.
308. Dr Muir Wood submits that NC-S cannot claim any creative choices in the order of the words within the Logo and that the words themselves must be ignored when considering the artistic copyright subsisting in the Logo because it would not make sense if the words were reordered. This he says limits the creative choices if any in relation to the layout of the Logo.
309. He therefore submits that the creative choices made by NC-S are limited. He suggests that all she has done is chosen one layout from a series created in a computer using basic word processing. He submits that the nature of the Logo prevented it from being an artistic work. NC-S was constrained by the words and that simply formatting the words was not sufficient to overcome even the low threshold for artistic copyright.
310. Whilst he accepted that that it may have become distinctive in 2010/2011, he does not accept that would create copyright in the Logo.
311. NC-S's evidence explained the choices she had made in relation to the layout. She emphasised the use of lower-case "t" at the start of "the", the full stop, the left justification and the 4 rows of text as well as the bold modern fonts.
312. Dr Muir Wood submitted that the use of the arial font and the capitalisation of the name Notting Hill itself are banal whilst the left justification was simply a technical constraint.
313. Conversely, Mr Marshall argued that despite being a simplistic graphic work the Logo still attracted copyright protection relying on *Lidl* as an example of a simplistic logo which nonetheless attracted copyright. He argues that the Logo was unique and that the myriad of alternatives in the March 2010 design document (even if not showing the precise version used for the Logo) only emphasised the originality of the Logo and the creativity involved in its design.
314. The very same choices that the Defendants say are banal are said to be the distinctive and unique choices made by NC-S.
315. Arnold LJ confirmed in *THJ v Sheridan* [2023] EWCA that the correct test for originality was as set out in *Infopaq* but that the threshold for originality was a low one. There needs to be some room for creative freedom but even a simple logo such as the one here can attract protection. Arnold LJ explained that even where the degree of visual creativity was low it did not imply an absence of copyright instead it affected the

scope of the protection conferred by the copyright. The protection in such a case may be correspondingly narrow so that only a close copy would infringe (see *THJ*)

316. Here adopting that approach I find that despite the limitations of the evidence I am satisfied that the various components of the Logo relied upon by NC-S do demonstrate some creative freedom of choice in the way in which they are put together to create the Logo.
317. The lower-case t, the full stop and the use of the left justified 4 lines of text were each the result of creative choices. None was necessary, the Logo could have had a capital T which would have been more usual if using sentence case, it could have been justified in the centre, spread over 3 lines or 5 lines and the full stop was not necessary either. At some point the dot over the “i” in shopping had been removed which added to the creative choices that had been made. The font is said to have been chosen to be bold and modern. Arial may appear to be banal but given the myriad of fonts available the choice of a particular font with a particular idea in mind coupled with the other aspects of the design adds to the creative choices which NC-S made when deciding which design to use for the Logo.
318. However, I do not consider that the Logo was unique or demonstrated a high degree of creativity. I agree with the Defendants that there were natural limits constraining her use of the five words including the use of a place name, Notting Hill, which naturally limited the extent of any creativity when using only five words in total. Whilst NC-S had made choices about certain elements of the Logo that were not restricted by technical constraints other parts of the Logo for example the use of the place name Notting Hill, as two words out of the five significantly reduced the elements of creativity.
319. Although I accept that the use of the lower-case t, the full stop at the end and the absence of the dot on the i coupled with the left justification were ultimately an exercise of creative choices so as to stamp the Logo with her personal touch, I find that the degree of creativity was low.
320. Although NC-S is the author of the Logo and I am satisfied that she has artistic copyright in the Logo the level of creative freedom used in creating it was low which then affects the level of copyright protection to which it is entitled which is correspondingly low. I find that the protection to which the Logo is entitled is limited in scope such that only a close copy would infringe the Logo (see *THJ* at [27]).

Copyright infringement

321. Copyright infringement is governed by s.16 CPDA 1988. An artistic work will only be infringed if a substantial part of the work has been copied see s.16(3)(a). Arnold LJ summarised the position on infringement in *Lidl* at [43] referring to both *Infopaq* and *THJ*.
322. The Defendants admit selling the Defendants’ Bags. The question in relation to the Defendants signs and Bags is whether they have reproduced a substantial part of the Logo given the limited scope of the protection to which NC-S is entitled. This requires consideration of what parts of the Logo have been copied and whether they are the parts

that provide it with the benefit of copyright protection. It is a qualitative assessment not quantitative.

323. For the reasons set out above I am satisfied that ET and NT had been aware of the Claimants' Bag and the Logo from at least 2017 given their own evidence. I have not accepted their evidence about their own independent design processes. I do not accept ET's evidence in relation to the source of his inspiration and when and how he designed the Notting Hill Word Sign including the use of the word Shopper. I consider that the use of Shopper was a deliberate attempt to distinguish the Notting Hill Word Sign from the Logo. His attempts to seek to differentiate the Notting Hill Word Sign and to justify the design by reference to other influences had an air of unreality. I have not accepted his evidence that he was unaware of the Claimants' Bag or that he had been trading in the Defendants' Bags and/or using the Notting Hill Word Sign since sometime in 2017.
324. The Camden Town Shopping Bag Sign undermines the evidence that Shopper was chosen because it reflected the use of the bag in Notting Hill. ET accepted that the Camden Town Shopping Bag could be more similar to the Claimants' Bag but denied that he thought he could use it in Camden because there would be clear water between it and the Notting Hill Shopping Bag. Instead he said he chose the style because it was attractive, and it was just a design and purely descriptive. This came across as entirely contrived and undermined his explanation of the use of Shopper in Notting Hill.
325. I accept NC-S's evidence that she acted as soon as she found out about the Defendants' Bags in January 2023. She acted immediately.

The Defendants signs:

326. Does the Notting Hill Word Sign substantially copy the Logo? The Claimants rely on the Defendants' use of the Notting Hill Word Sign as set out in this judgment and a further version in Annex 13 of the POC. The difference between the two versions is that the text in the version in Annex 13 is on four lines and the text for the Notting Hill Word Sign as set out above is on three lines. They also rely on the Camden Hill Sign set out above.
327. I consider the visual difference between the Defendants' Signs and the Logo when considered side by side is striking. The elements relied on by NC-S are the lower-case t, the full stop, the left justification and the font.
328. Three of those elements are not copied in the Notting Hill Word Sign which also uses Shopper not Shopping. Two of those elements are not copied in the Camden Town sign which also uses Camden Town.
329. Whilst the words themselves are to be ignored when considering the artistic copyright subsisting in the Logo, when making a qualitative assessment about whether the Defendants signs have appropriated a substantial part NC-S's artistic copyright the entirety of the Defendants signs need to be considered against those elements which entitle NC-S to copyright protection. As Arnold LJ said in *THJ* only a close copy would infringe.
330. The Notting Hill Word Sign does not use the lower case "t". It does not even use sentence case but instead is made up entirely of capital letters. That is significant given

that the lower-case t is relied on for the artistic copyright. The lower-case t is obviously not copied when all the words are in capital letters. The look is entirely different.

331. The Notting Hill Word Sign uses a different font. One of the creative choices relied on and a distinguishing artistic feature was the Arial font used in the Logo.
332. The Notting Hill Word Sign is justified to the left but is on three lines not four lines. This is again a significant difference given there are only 5 words overall.
333. The alternative version of the Notting Hill Word Sign relied on by the Claimants had all the same features but was instead on four lines not three. This would inevitably mean it was closer to the Logo but still critically it was all capital letters, no lower-case t and used a different font. The layout, font and appearance are therefore different.
334. The Camden Town Sign is both more similar to the Logo and different given it relates to an entirely different part of London. Mr Marshall argues it might be thought to be some sort of brand extension. However, the differences are equally marked. It features capital letters at the beginning of each word and is in a different font.
335. Given the nature of the artistic copyright work and those features that were relied on as giving rise to the copyright as setting the Logo apart as a creative work, I am not satisfied that the Defendants have in fact copied a substantial part of the copyright work.
336. Given the low degree of creativity, the scope of the protection conferred by the copyright is correspondingly narrow and on the basis of a qualitative assessment I am not satisfied that these are close copies. The Defendants are not therefore liable for copyright infringement by their use of the Defendants' Signs.
337. It follows that if there was no copying it cannot be flagrant within the meaning of section 97(2) of CDPA 1988.

Joint Venture - Issue [13]

338. This was conceded by the Claimants in closing. There was no joint venture.

Joint Tortfeasors - Issue [14]

339. This leaves only the question of joint liability. Since on the basis of the facts as found the Defendants are not liable for any act of trade mark infringement, passing off and/or copyright infringement the question of joint liability would not arise.
340. However, the claim as advanced lacks sufficient particularisation. It was not clear whether for example the claim was simply one that sought to argue that ET and his company were jointly liable for any findings against ET and his company whilst NT and his company were jointly liable for any findings against NT and his company or whether in fact the Claimants were seeking to argue that all four Defendants were joint tortfeasors.
341. It was not clear how liability for any acts of trade mark infringement, passing off or copyright infringement that had been carried out by ET and NT were passed on to the

companies when they were incorporated. Once the companies were incorporated it was not clear how or why it was said their directors would also have personal liability.

342. The POC do not set out the essential facts said to demonstrate that there was a common design between all four defendants or even each pair of defendants. The fact that ET and NT purchased bags from NHBCL prior to the incorporation of the companies is not sufficient of itself. Given these difficulties were it necessary to do so on the basis of the claim as advanced and such evidence as there was, I would find against the Claimants on Issue 14.

Next Steps

343. This judgment will be handed down remotely. A form of order hearing has already been listed should it be necessary. I will extend time in relation to any consequential matters to that hearing.

Annex 1

List of Issues

Trade Mark Infringement

Validity

1. Is the Trade Mark invalidly registered and liable to be deleted from the register because:

a. It expired on 2 May 2023 and was not properly renewed on 22 March 2023 by the Second Claimant because it was bona vacantia and, at all relevant times, property of the Crown such that it was not renewed by or with the authority of the Treasury Solicitor; and/or

A: The Trade Mark is invalidly registered and liable to be deleted from the register as a nullity. The renewal on 22 March 2023 was a nullity. The Trade Mark expired on 2 May 2023 and has not been renewed or restored.

b. Pursuant to s.47(1) of the TMA 1994:

i. It is devoid of distinctive character, pursuant to s.3(1)(b) of the TMA 1994; and/or

ii. It consists exclusively of a sign which may serve in the trade to designate the kind, intended purpose and geographical origin of the goods for which it is registered pursuant to s.3(1)(c) of the TMA 1994?

A: It is not necessary to determine this issue given the answer to Issue 1(a) and Issue 2.

2. Is the Trade Mark liable to be revoked on the basis that it has not been put to genuine use for a continuous period of five years ending on 10 April 2023 or 11 October 2023 pursuant to sections 46(1)(b) and 46(3) of the TMA 1994?

A: If the Trade Mark had not expired on 2 May 2023, it would in any event have been liable to be revoked for non-use for the period of five years ending on 10 April 2023. If the Renewed Trade mark were not a nullity it would be liable to be revoked for non-use for both the five-year period ending 10 April 2023 and/or the five-year period ending 11 October 2023.

Ownership

3. Is the Second Claimant the proprietor of the Trade Mark

A: The Second Claimant was not the proprietor of the Trade Mark and is not the proprietor of the Renewed Trade Mark which is a nullity. The Second Claimant has no standing to bring the trade mark claims.

Infringement

4. As a result of the similarity between the Trade Mark and the Notting Hill Word Sign and because the Notting Hill Word Sign has been used in the course of trade in relation to

goods which are identical to those for which the Trade Mark is registered, is there a likelihood of confusion on the part of the public including a likelihood of association?

A: In light of the answers to Issues 1(a), 2 and 3 this issue does not arise.

Passing Off

Goodwill

5. Is the Second Claimant the proprietor of any goodwill associated with the Brand Name and/or the Logo?

A: The Second Claimant has not established that it is the proprietor of any goodwill in the business associated with the Brand Name and/or the Logo.

Issues 6,7 and 8 do not arise.

Consent

6. Have the Claimants expressly consented to the acts carried out by the Defendants about which complaint is made such that the Claimants are estopped from bringing a claim for passing off?

Misrepresentation

7. Has the Defendants' offering for sale of the Defendants' Bags under and/or by reference to the Defendants' Signs lead to and/or is likely to lead to a substantial proportion of the relevant public in the United Kingdom being deceived into believing that those goods are the goods of the Claimants and/or, alternatively, goods connected with and/or authorised or approved by the Claimants or otherwise subject to some commercial arrangement with the Claimants, contrary to the fact?

Intention to Deceive

8. Did the Defendants carry out the acts complained of with an intention to deceive?

Copyright

Subsistence

9. Is the Logo an original artistic work within the meaning of sections 1(1)(a) and 4(1)(a) of the CDPA 1988?

A: The Logo is an original artistic work within the meaning of sections 1(1)(a) and 4(1)(a) of the CDPA 1988.

Ownership

10. Is the First Claimant the proprietor of any copyright which subsists in the Logo?

A: The First Claimant is the proprietor of the copyright which subsists in the Logo.

Infringement

11. Have the Defendants infringed any copyright which subsists in the Logo by doing and/or, pursuant to s.16(2) of the CDPA 1988, authorising another to do any of the following:
- a. Copying the Logo (or a substantial part thereof) contrary to section 17 of the CDPA 1988;
 - b. Issuing copies of the Logo to the public contrary to section 18 of the CDPA 1988; and/or
 - c. Possessing, in the course of business, selling or exposing for sale an article (namely the Defendants' Bags) which is and which the Defendants knew and/or had reason to believe is an infringing copy of the Logo, contrary to section 23 of the CDPA.

A: The Defendants' Bags have not infringed the First Claimant's copyright.

Flagrancy

12. To the extent that the Defendants are liable for any act of copyright infringement, were those acts flagrant pursuant to section 97(2) of the CDPA 1988.

A: The Defendants are not liable for any act of copyright infringement. This issue is therefore answered in the negative.

Joint Venture

13. Was there a joint venture between the between the First Claimant, the Restored Company and the Second Claimant and/or between the Restored Company and the Second Claimant, as alleged? If so, what were the terms and nature of the joint venture?

A: No.

Joint Liability

14. Are the Defendants jointly liable for any act of trade mark infringement, passing off and/or copyright infringement?

A: There was no trade mark infringement, passing off and/or copyright infringement. This issue is therefore answered in the negative.