

O/0061/26

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003939529
BY THE NEW YORK TIMES COMPANY TO REGISTER:**

WORDLE

AS A TRADE MARK IN CLASSES 16, 28 & 41

AND

**THE OPPOSITION THERETO UNDER NO.
444378 BY STEFAN HEINE**

AND

**IN THE MATTER OF INTERNATIONAL REGISTRATION
DESIGNATING THE UK UNDER NO. WO0000001686095 IN THE NAME
OF STEFAN HEINE FOR THE FOLLOWING TRADE MARK:**

Wordle

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 506407 BY THE NEW YORK TIMES COMPANY**

BACKGROUND AND PLEADINGS

1. This decision involves proceedings wherein Stefan Heine and The New York Times Company (“NYT”) brought actions against one another. I will summarise the relevant proceedings below, beginning with NYT’s invalidation application, on the basis that it was brought first.

NYT’s invalidation

2. Mr Heine is the registered proprietor of an international registration designating the UK for the word only mark ‘Wordle’ under registration number 1686095 (“the IR”). The IR was registered internationally on 1 August 2022 and, with effect from the same date, Mr Heine designated the UK as a territory in which he seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. Mr Heine’s IR was accepted and published in the Trade Marks Journal for opposition purposes on 21 October 2022 and protection was conferred on 22 December 2022. The IR stands registered for the following goods and services:

Class 16: Calendars; children's activity books; books; books for children; magazines in the field of games; books in the field of games; crossword puzzles [printed matter]; non-fiction books.

Class 28: Memory games; guessing games.

Class 41: Organization of quiz programs, games and competitions.

3. The IR enjoys a priority date of 1 February 2022 stemming from the German trade mark 30 2022 001 729.
4. On 11 August 2023, NYT applied to invalidate the IR under sections 5(4)(a), 3(6) and 56 of the Trade Marks Act 1994 (“the Act”). Under the section 5(4)(a) ground of the application, NYT claims to be the owner of an earlier unregistered sign for the word ‘WORDLE’ which it claims to have been in use since June 2021 throughout the UK. It is claimed that NYT’s sign has been used for “puzzles and

guessing/memory games and publications and software relating thereto". NYT claims that the original owner of the sign, Mr Josh Wardle, acquired substantial goodwill in the sign in connection with the above mentioned goods and services¹ and that, prior to the relevant date, NYT acquired this goodwill by purchasing it from Mr Wardle on 31 January 2022. In light of this, NYT's position is that use in the UK of the IR would cause a misrepresentation by way of deception being caused to a substantial number of members of the UK public. It is claimed that the deceived public would believe that Mr Heine's use was authorised, licensed and/or approved by NYT. NYT claims that such a misrepresentation would be likely to cause damage to its goodwill.

5. Under the section 56 ground, NYT claims to be the owner of a well-known trade mark, being 'WORDLE', in accordance with section 6(1)(c) of the Act. It is claimed that by the relevant date, NYT's mark became well known pursuant to Article 6bis of the Paris Convention and section 56 of the Act. It is claimed that NYT's mark is protected for "puzzles and guessing/memory games and publications and software relating thereto". Upon the conclusion that NYT is the owner of a well-known mark, it claims that:
 - a. The IR is identical to NYT's well-known mark and is protected for identical goods and services and, in accordance with section 5(1) of the Act, it should be declared invalid;
 - b. There exists a likelihood of confusion between the marks in accordance with section 5(2)(a) of the Act because they are identical and the IR is registered for similar goods and services; and
 - c. By virtue of NYT's well-known mark having a reputation in the UK, consumers would make a mental link between it and the IR. Further, use of the IR would, without due cause, take unfair advantage of NYT's mark and be detrimental to the distinctive character and/or reputation of NYT's mark. The IR should, therefore, be declared invalid in accordance with section 5(3) of the Act.

¹ I say 'services' because the phrasing of the terms is sufficiently broad that it may cover software provided as a service and not solely software as a good.

6. Under the section 3(6) ground, NYT claims that prior to the application for his IR, Mr Heine knew or believed that 'WORDLE' was created and initially used by Josh Wardle and that the game and the name had become very popular. In addition, it is claimed that Mr Heine was aware that the game and the name were owned by Mr Wardle and that they were then transferred to NYT. NYT claims that Mr Heine, in applying for his IR, intended to apply for an identical trade mark to that used by Mr Wardle and that he sought to undermine the system of undistorted competition and indications of origin by preventing the average consumer from distinguishing, without any possibility of confusion, the origin of his IR. It is also claimed that Mr Heine was using or was planning to use his IR in relation to a copycat game. Further, NYT claims that the goods and services covered by the IR cover those that NYT either already engaged in or would likely want to engage in under, or by reference, to the name 'WORDLE'. By applying to designate the IR in the UK, it is claimed that Mr Heine indicated an intention to use the mark in the UK, to acquire a registered monopoly in a trade mark that was created and owned by someone else and to use it to detriment and/or exclusion of that party (such as by using it as a legal impediment to the applicant). Lastly, NYT's position is that there is no justification for Mr Heine to have designated his IR for protection in the UK and, in the circumstances, he had a dishonest motivation from a trade mark law perspective.

Mr Heine's opposition

7. On 28 July 2023, NYT applied to register the trade mark 'WORDLE' in the UK ("NYT's contested mark") for the following goods and services:

Class 9: Video game software; mobile apps; games software; media content; downloadable publications; electronic publications; electronic publications in the field of games; computer games; downloadable information relating to games and gaming; educational software featuring instructions for playing games; downloadable software in the nature of a mobile application for playing games; computer apparatus, peripherals and accessories for use in playing games.

Class 16: Printed matter and stationery; printed publications; art prints; printed publications in the field of games; books in the fields of games and gaming; books; rule books for playing games; magazines; publications; printed publications containing puzzles; posters; instructional and teaching materials.

Class 18: Bags; tote bags; handbags; purses; wallets; credit card holders; key cases; umbrellas.

Class 25: Clothing; footwear; headgear.

Class 28: Toys, games and playthings; games; board games; card games; memory games; guessing games; puzzles.

Class 41: Educational and entertainment services; providing online electronic publications; publication of printed matter and printed publications; production of TV shows; arranging of entertainment shows; game shows; entertainment in the nature of ongoing game shows; organization of quizzes, games and competitions; providing games; organizing of games and competitions; providing on-line interactive computer games; electronic games services provided by means of the internet; organization of conferences, exhibitions and competitions.

8. NYT's contested mark was published for opposition purposes on 1 September 2023. On 29 November 2023, Mr Heine opposed NYT's contested mark insofar as it related to the goods and services in classes 16, 28 and 41. On this point, it is noted that NYT requested a division of its mark (via a Form TM12 filed on 8 December 2023) so that the unopposed goods (being those in classes 9, 18 and 25 above) may proceed to registration under the trade mark numbered UK00004006054. This was accepted and communicated to the parties on 24 January 2024. The newly created mark proceeded to registration on 2 February

2024. As a result, the present opposition essentially continues as one aimed against the entirety of NYT's contested mark.

9. The opposition was brought under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act"). Under all three grounds, Mr Heine relies on the IR, the details of which are set out above.
10. Under the section 5(1) ground, Mr Heine's position is that both the marks and the goods and services at issue are identical. As such, registration of NYT's contested mark should be refused. As for the section 5(2)(a) ground, Mr Heine's position is that the marks are identical but that the goods and services at issue are similar, thereby resulting in a likelihood of confusion. Lastly, under the section 5(2)(b) ground, Mr Heine's position is if the marks are deemed similar, then the identity or similarity of the goods and services at issue are such that there remains a likelihood of confusion between them.
11. NYT filed a counterstatement wherein it claimed that the IR was invalid (by reference to its own invalidation application) and, as such, requested that the opposition against it be refused in its entirety. Further, NYT requested that the proceedings be consolidated.
12. Upon the filing of the counterstatement in respect of the opposition and in light of NYT's request, the Tribunal consolidated the proceedings under the power given to it under Rule 62(1)(g) of the Trade Marks Rules 2008. This was communicated to the parties by way of written correspondence dated 13 February 2024.
13. Both parties filed evidence in chief as well as evidence in reply in the respective proceedings. A hearing took place before me on 29 October 2025, by video conference. NYT was represented by Mr Guy Tritton of Hogarth Chambers, as instructed by Taylor Wessing, who have represented NYT throughout these proceedings. Mr Heine was represented by Ms Alison Wilson of Murgitroyd & Company, who has represented Mr Heine in these proceedings since 12 January 2024.

14. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

NYT's evidence

15. NYT's evidence in chief across both sets of proceedings came in the form of the witness statements of Jonathan Gary Knight, Joshua Wardle and Roland Mallinson dated 5 January, 7 January and 15 April 2024, respectively. In addition, Brandon Hunter Calvert filed two witness statements, dated 4 January and 15 April 2024, respectively.

16. Mr Knight is the Senior Vice President and Head of Games at NYT and his statement is accompanied by 11 exhibits (being JGK1 to JGK11). Mr Wardle is the original owner and creator of the Wordle game at issue in these proceedings and his statement is accompanied by one exhibit, being JW1. Mr Mallinson is a solicitor and partner at NYT's representative firm and his statement is accompanied by six exhibits, being RAS1 to RAS6. Lastly, Mr Hunter Calvert is the Director of Data and Insight, Games at NYT and his statements are unaccompanied.

17. In respect of evidence in reply, I note that NYT filed the witness statements of Al-Amyr Sumar and Jordan LaVine, both dated 3 September 2024. In addition, further statements came from some of the witnesses that filed evidence in chief, namely the second witness statements of Mr Knight and Mr Wardle dated 3 and 4 September 2024, respectively, as well as the third witness statement of Mr Hunter Calvert dated 4 September 2024. Lastly, it is noted that NYT was permitted to file additional evidence in the form of the second witness statement of Mr Mallinson dated 4 November 2024.

18. Mr Sumar is Senior Counsel at NYT and his statement is accompanied by two exhibits, being AS1 and AS2. Mr LaVine is an attorney at the firm of Akin Gump Strauss Hauer & Feld and he is the manager of NYT's global portfolio of trade marks. His statement is accompanied by four exhibits, being JVL1 to JVL4. Mr Knight's second statement is accompanied by two exhibits, being JGK12 and JGK13. Mr Wardle's second statement is also accompanied by two exhibits, being JW2 and JW3. Mr Hunter Calvert's third statement is unaccompanied. Mr Mallinson's second statement is accompanied by one exhibit, being RASM7.

19. I do not intend to discuss the purpose of each statement here, save to say that they were all filed in support of the various grounds relied upon for the application for invalidity or in defence of Mr Heine's opposition.

Mr Heine's evidence

20. Evidence in support of Mr Heine's opposition and in defence of the invalidity application came in the form of three witness statements in his own name as well as two additional statements from translators, Mr James McGill and Alexandrina McLeod Kerr. Mr Heine's first statement was filed as evidence in chief and is dated 12 April 2024. It is accompanied by 18 exhibits being SH1 to SH18. Alongside this evidence comes the statement of Mr McGill dated 3 June 2024. As above, he is a translator and is qualified professionally and can speak both German and English. His statement is accompanied by three translated exhibits, being JM1 to JM3 (which translate Exhibits SH1, SH8 and SH13). Mr Heine's second statement was filed in reply, is dated 27 August 2024 and is accompanied by one exhibit, being SH19. Mr Heine's second statement was accompanied by the witness statement of Alexandrina McLeod Kerr dated 27 August 2024. Ms McLeod Kerr is a publicly appointed court translator and can speak German and English. Her statement confirms that she translated the judgment found at Exhibit SH19. Lastly, it is noted that Mr Heine was afforded the opportunity to respond to Mr Mallinson's second statement and this came via his own third statement dated 27 December 2024, which was unaccompanied.

21. I do not intend to discuss the purpose of each statement here, save to say that they were all filed in support of Mr Heine's opposition and in defence of the various grounds relied upon for the application for invalidity.

22. I do not intend to summarise the parties' evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

MY APPROACH

23. I will begin my decision by assessing NYT's invalidation application. I do so because any success of the same would have a direct impact on Mr Heine's opposition. On this point, if NYT's application succeeds in full then Mr Heine's IR will be declared invalid and deemed to have never been protected in the UK. This would mean that it would not qualify as an earlier mark for the purpose of Mr Heine's opposition resulting in said opposition falling away. Further, if the application is only partially successful then the opposition will proceed but only in respect of those goods and/or services that remain. Lastly, in the event that the application fails outright, then Mr Heine's opposition will proceed in full. If necessary, I will discuss the position with Mr Heine's opposition at the conclusion of NYT's application.

DECISION

NYT's application

24. As set out above, NYT's application for invalidity is based on section 5(4)(a) and 3(6) of the Act. In addition, it includes a claim that NYT enjoys protection for an earlier mark under section 6(1)(c) of the Act, which is a well-known trade mark as defined in section 56 of the Act. The section 5(4)(a) and 3(6) grounds of the application have express application to invalidation proceedings by virtue of section 47 of the Act.

25. As for the claim under section 56, this is not expressly referred to in section 47 of the Act. However, a claim under section 56 of the Act is reliant upon an earlier mark in which the conditions set out in sections 5(1), 5(2) and 5(3) apply. In addition, it is noted that the use provisions set out in section 47 for earlier marks are expressly confirmed as not being applicable where the earlier mark is one under section 6(1)(c). As such, the section 56 ground also has application in invalidation proceedings because of the provisions of section 47 of the Act.

26. Section 47 of the Act states as follows:

“47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 5(4)(a)

27. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(a) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

28. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

29. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

30. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant Date

31. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

32. The IR enjoys a priority date of 1 February 2022. There is no evidence before me of Mr Heine using the IR prior to that date. The priority date is, therefore, the relevant date for the purpose of the present ground.

Goodwill

33. The first hurdle for NYT is that it needs to show that it had the necessary goodwill in the sign relied upon at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

34. In *South Cone* (cited above), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground

of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

35. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

36. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge’s finding). Again that shows one is looking for more than a minimal reputation.”

37. Goodwill arises as a result of trading activities. I remind myself that NYT claims to have accrued goodwill in its unregistered sign of ‘WORDLE’ in respect of” puzzles and guessing/memory games and publications and software relating thereto”.

38. It was argued on behalf of Mr Heine that NYT does not benefit from any goodwill in the sign relied upon. The reasons given for this were numerous but can be summarised as being:

- a. The game was offered for free so there was no intention by Mr Wardle to commercially exploit the mark;
- b. Any use associated with Mr Wardle’s ‘WORDLE’ game was not longstanding as it was only offered to the public in October 2021;
- c. NYT only began using the mark after the relevant date;
- d. There are no sales, turnover or advertising figures to show use of the sign in the course of the trade;
- e. Mr Hunter Calvert’s data evidence is unreliable; and
- f. The game already existed under other names and the name ‘WORDLE’ had already been used previously by Mr Steven Cravotta.

39. I consider that points (b) and (d) can be directly addressed in my summary and assessment of the evidence below. However, I deem it necessary to discuss points (a), (c), (e) and (f) at this stage. My comments in respect of the same are set out below.

a) The fact that the WORDLE game was offered for free

40. It was argued on behalf of Mr Heine that Mr Wardle did not seek to commercially exploit the WORDLE sign so, therefore, it cannot be said that he generated any goodwill in the same. The basis for this argument is twofold and I will deal with these arguments in turn.

41. First, it is argued that because Mr Wardle only sent his game to friends and family in June 2021, he did not intend for it to be played by the wider general public. While this was the case, he did eventually make the game available to the public at large in October 2021.² In my view, offering the game to the public at large is a clear indication that he intended for the game to be played by a broader user base. At that point, if the game became successful it would naturally begin accruing goodwill whether Mr Wardle wished for it to or not. On this point, it is the consumers who would be the ones to associate the goodwill and it is unlikely that they would have been aware, or even had regard to, Mr Wardle's initial intentions.

42. Second, it is noted that Ms Wilson relied on the fact that the game was free. On this point, she referred to evidence of an interview wherein Mr Wardle, in discussing his WORDLE game, set out that he did not intend to profit from it.³ It is claimed that this means that it cannot be a trading activity capable of generating goodwill. Having considered the interview, I appreciate that it shows that Mr Wardle was fine with the game not making him a profit. However, he does discuss whether he should at least discuss opportunities with potential investors.⁴ While Mr Wardle may not have initially intended to profit from the WORDLE game, this is not a

² See page 4 of JGK1

³ See the interview with TIME Magazine at SH2 and the interview with TechCrunch at SH3

⁴ On this point, when asked about the point in the TechCrunch interview, Mr Wardle stated that it would be good to meet these people and at least have a discussion.

prohibitor to goodwill accruing. On the point of the game being free, I refer to the cases mentioned by Mr Tritton at the hearing which directly support a proposition that goodwill can accrue where services are free. For example, I refer to paragraph 37 of *Plentyoffish Media Inc v Plenty More LLP* [2011] EWHC 2568 wherein HHJ Birss Q.C. set out that:

“I accept that the concept of “customers” required by the English cases must include the people to whom the relevant services are actually provided even if, in a case like this, they receive the services for free. If the Appellant had been able to show that it had indeed provided dating services to people in the UK, the fact that the people had not been charged for that service seems to me to be irrelevant.”

43. In addition, I also refer to paragraph 147 of *Starbucks (HK) Ltd v British Sky Broadcasting Group PLC* [2013] F.S.R. 29 wherein Mummery LJ stated the following:

“Accordingly, the key question is whether the viewers of PCCM’s programmes in the United Kingdom were customers for its service so as to give rise to a protectable goodwill in the United Kingdom. I agree with H.H.J. Birss QC that it is not necessarily a bar to such a claim that the service is provided free.”

44. In light of this and the reasoning set out above, I see no merit in the argument that Mr Wardle (and by extension, NYT) cannot have generated goodwill because the game at issue was only initially offered to Mr Wardle’s friends and family and provided for free. Therefore, I am satisfied that so long as the use before me is sufficient, it is capable of generating goodwill despite being free.

(c) NYT began using the mark after the relevant date

45. The evidence in respect of NYT’s own use of WORDLE sets out that the game was not transferred to NYT’s own website until around 10 February 2022.⁵ It is argued

⁵ See paragraph 6 of the first witness statement of Mr Hunter Calvert.

that this means that NYT only began using the mark after the relevant date so is of no assistance here. In short, I see no merit in this argument. This is because NYT is, clearly, relying on the fact that it was assigned Mr Wardle's goodwill via an assignment dated 31 January 2022. On this point, said assignment is included in evidence⁶ and while it contains a significant number of redactions, it is noted that clause 2 of the agreement states:⁷

“Upon the terms and subject to the conditions of this Agreement, Purchaser hereby purchases from Seller and Seller hereby irrevocably, sells, assigns, conveys and delivers to Purchaser, all of Seller's right, title and interest in, to and under the following assets, rights and properties, free and clear of all Encumbrances (collectively, the “Purchased Assets”):

(i) the Game, the Game Technology, and the Documentation;

(ii) the Game Brands;

(iii) the Game Domain Names and the Game Social Media Account, including all of Seller's rights to operate and use the accounts, the Game and other content associated therewith.

(iv) all designs, layouts, content, text, fonts and materials used or otherwise displayed on the Game Domain Names and Game Social Media Account;

[...]

(viii) any and all Intellectual Property associated with or embodied in any of the foregoing;”

46. In addition, the term ‘Intellectual Property’ is expressly defined in the agreement as covering “all rights in or affecting intellectual or industrial property or other

⁶ JGK2

⁷ For the avoidance of doubt, ‘Purchaser’ is defined as NYT and ‘Seller’ is Mr Wardle.

proprietary rights, existing now or in the future, in the United States or anywhere in the world". Further, it expressly states that this covers "all trademarks, service marks, logos, trade names, fictitious business names and brands [...], as well as domain names, together with the goodwill of the business associated therewith."

47. At the hearing, it was argued by Ms Wilson that this agreement should not be taken into account on the basis that it actually does not provide anything. Various reasons were put forward for this argument and they include reference to the fact that the agreement is heavily redacted so it is not clear what rights were assigned to it. Further, it was argued that it refers to use in the USA and other countries, but that it does not list the other countries. In addition, it was argued that there is no mention as to what date the goodwill dates back to. At the hearing, there was some discussion on this point between Ms Wilson and me. In short, I asked Ms Wilson as to what was actually unclear about the agreement as while there were redactions within it, it includes numerous definitions and descriptions of the WORDLE game as well as reference to the technology behind the game, the game's IP, social media accounts, domain names and the intellectual property surrounding the game. In response, Ms Wilson argued that the agreement does not actually mention the sign WORDLE within it and that Mr Wardle could have had many games on the go at the time and that the agreement was just 'so hazy' as to the rights that were transferred to NYT. I pointed out that the word 'WORDLE' appears several times throughout the document to which Ms Wilson argued that there is a difference between the sign WORDLE and the game WORDLE. On this point, Ms Wilson referred to a game previously published called 'Wordle!' by a Steven Cravotta (which I will discuss further below).

48. Having considered the documents and Ms Wilson's arguments, I am unclear as to what points she is actually raising. In my view, the agreement offers certainty in that it clearly covers Mr Wardle's WORDLE game and it is obvious from the evidence what this is in reference to. While the evidence surrounding the presence of a previous released game under the name 'Wordle!' by Steven Cravotta is noted (again, more on this below), I fail to understand how it can be said that the agreement provided has anything to do with that. In respect of the fact that there is no starting date to the goodwill, this is not something that is necessary in an

agreement wherein goodwill is assigned. The agreement offers certainty in that it covers the fact that any and all goodwill that accrued in Mr Wardle's game prior to the agreement, regardless of when it began accruing, would vest in NYT. Lastly, the agreement clearly covers the UK as it makes reference to the USA and 'other countries' which, plainly, covers the UK.

49. Despite the claims on behalf of Mr Heine, I am satisfied that the agreement validly and expressly assigns any UK-based goodwill that Mr Wardle accrued in respect of the WORDLE game to NYT.

(e) the reliability of Mr Hunter Calvert's data

50. The data provided by Mr Hunter Calvert is, as I will come to discuss below, related to the daily users that accessed Mr Wardle's website when it hosted the WORDLE game. Firstly, it is noted that Mr Hunter Calvert was required to file a second witness statement in order to clarify the accuracy of the EU figures he provided. This is as a result of what he confirms to be a human error in inputting data into the tables in his first statement. At the hearing, Ms Wilson argued that Mr Hunter Calvert was executing a witness statement so he should have made sure that the first figures provided were correct. Ms Wilson also placed some blame on NYT's representatives who she claims should have noticed the issue. I appreciate that it was not ideal for the figures to be incorrect first time around. However, this does not mean that the statement clarifying the issue should be treated with any degree of caution. In addition, I note that Ms Wilson claims that Mr Hunter Calvert appears to have been confused by his own dissection of the figures and, as a result, his interpretation could be incorrect so I should exercise caution when considering the same. In short, I see no merit in this claim. Mr Hunter Calvert is the head of data and analytics for games at NYT who had access to all the relevant information and analytics so as to be able to provide the figures. On this point, the figures provided are simple visitor figures which, as far as I understand it, are easily accessible to those with the relevant access. Lastly in respect of this point, I note that I have nothing before me to directly contradict the figures provided so I see no reason why I should treat them with any degree of caution.

51. In respect of the issue regarding the data, Mr Heine's evidence seeks to argue that the data is from Mr Wardle's homepage, being powerlanguage.co.uk and not powerlandguage.co.uk/wordle, being the sub-domain that actually hosts the game. As such, Mr Heine has argued that the data is unreliable because it does not point to actual visits to the game page of Mr Wardle's website. In response to this, Mr Wardle provided evidence as to the content of his website.⁸ He confirms that the home page of his website merely acts as a landing page to get to the game and he states that he is unaware as to why the influx in visitors to his website would be so that people could view his homepage when all the alleged hype and interest was clearly about the WORDLE game. Further, he confirms that the Google analytics code was never added to his homepage but existed only on the subdomain for the game. As such, the traffic figures provided by Mr Hunter Calvert directly relate to visits to his WORDLE game. In light of this explanation, I am content to conclude that the above figures cover visits from those playing the game, as opposed to hits to the homepage of Mr Wardle's website.

(f) the existence of other games similar to WORDLE and the claim that the name WORDLE existed prior to Mr Wardle's iteration.

52. Mr Heine relies on a series of games that are claimed to be closely related to WORDLE. These include Jotto, Mastermind and Lingo. The evidence on this point is discussed between 46 and 59 of Mr Heine's first statement. While this is noted, I see no need to discuss it in any great detail. This is because the existence of similar games prior to Mr Wardle's game has no real impact on whether Mr Wardle's game could have generated its own goodwill. On this point, it is necessary to set out that the question I have to consider is whether 'WORDLE' accrued goodwill prior to the relevant date amongst UK consumers. So even if it could be said that a majority of UK consumers were aware of the closely similar games (there is no evidence to suggest that they were), this does not prevent them from associating goodwill with Mr Wardle and his WORDLE game. For the avoidance of doubt, my assessment is based on the use of the sign 'WORDLE' and I am not

⁸ Images of the landing page of Mr Wardle's website taken from 1 January 2021 to 1 February 2022 are provided in evidence at JW2. They contain very little information and include a link to the WORDLE game.

required to assess the mechanics or technology/code behind the game itself in order to determine whether the game itself is a 'copy' of another game.

53. In respect of the other earlier WORDLE game, I note that the evidence of Mr Heine refers to a game app called 'Wordle!' which is claimed to have been put online in 2016.⁹ Screenshots of the game are provided by Mr Heine and I note that one of them appears to show a game similar to Mr Wardle's WORDLE game, whereas the others show different types of word based games. In respect of this point, NYT responded with evidence from Mr LaVine which discusses how the 'Wordle!' game of Mr Cravotta appeared on the Apple App Store prior to the success of Mr Wardle's game.¹⁰ On this point, I note that Mr Cravotta's game was, in the screenshots provided prior to the relevant date, described as a time based word game in which the user is given letters to create a word as fast as they can. Further, the screenshots covered by these earlier screenshots clearly show a game different to Mr Wardle's. In addition, Mr Lavine has provided images of reviews for the 'Wordle!' game, one of which is dated 11 January 2022 which sets out that it was not the 'much talked about Wordle game' and another dated 14 January 2022 states that it was 'NOT the popular game, but still fun'.¹¹ The screenshots provided for 10 January 2023 are the first ones that show a game in the same vein as Mr Wardle's game.

54. In respect of this game, the evidence also sets out that prior to the success of Mr Wardle's game, Mr Cravotta's app only had one or two downloads per day in the six years prior. Clearly, the evidence falls far short of demonstrating that Mr Cravotta's app was well known to consumers when Mr Wardle created his own game. Further, in his second witness statement when discussing Mr Heine's evidence in respect of Mr Cravotta's app, Mr Wardle expressly confirms that he had never heard of Mr Cravotta or his 'Wordle!' app prior to being contacted by him in January 2022 via Twitter. This interaction is discussed further elsewhere in the evidence as Mr Wardle discussed it in an interview with TechCrunch Magazine on 12 January 2022. It is explained that this interaction was merely Mr Cravotta

⁹ See paragraph 61 of Mr Heine's first statement

¹⁰ This is done via screenshots taken from the internet archive facility, the Wayback Machine, at JLV2 which are taken from various dates between 31 December 2021 and 11 October 2023.

¹¹ See paragraph 21 of Mr LaVine's statement

contacting Mr Wardle to let him know of his increase in downloads and that, because he liked how Mr Wardle was approaching the game, he would donate the money he made from people downloading his app.¹²

55. Despite Mr Heine's claims and Ms Wilson's submissions to the contrary, the evidence filed is clearly insufficient to demonstrate that Mr Cravotta's app was well known as, prior to the rise of Mr Wardle's game, it only attracted a very low level of use and there is nothing before me to suggest that this would have been known to the relevant public in the UK as at the relevant date. In addition, NYT has adequately refuted any of the claims that Mr Wardle was aware of this app and, further, it proves that prior to the success of Mr Wardle's game, Mr Cravotta's app did not offer a game that was the same or similar to Mr Wardle's. As a result, I fail to see how this app has any impact on the public's perception of Mr Wardle's WORDLE game and neither can it be said to be something that dilutes any claim by NYT that it has goodwill in the 'WORDLE' sign.

Evidence of use

56. It is set out in evidence that the game that eventually became NYT's WORDLE game was initially created as a prototype in 2013. However, nothing further came of the game until 2020 when, during the COVID-19 pandemic, Mr Wardle and his partner were playing various word games which led to him deciding to start work again on his prototype game. Mr Wardle confirms that he and his partner began playing it for a few months. In around January 2021, Mr Wardle came up with the name for this game, being WORDLE, which he describes as a pun based on his surname. He completed the code for an early but playable version of this game in January 2021 and uploaded a refined version to his website on 19 June 2021. He confirms that he shared the game with a few friends and family members. He also confirms that, as far as he was aware, this was the first game called WORDLE. The game was made available to the public in October 2021.¹³

¹² SH3 and paragraph 63 of Mr Heine's first witness statement

¹³ See page 4 of JGK1

57. In respect of the growth of the game, Mr Wardle sets out that it was featured in a newsletter article published by NYT on 24 November 2021. After NYT published the article, the number of daily players began to increase and, by late November 2021, roughly three thousand people were playing the game each day. This increased to a couple of hundred thousand by December 2021 and, further, to millions per day by the middle of January 2022. The increase in popularity led to WORDLE being featured in a number of different publications or on various TV or Radio shows in the UK. A list of these is included in the narrative evidence and I note that they include BBC Radio 5 Live, BBC Radio 4, ITV London, various local BBC stations/channels, Sky News, The Sunday Times and The Daily Telegraph, amongst others. While none of this coverage is actually shown in Mr Wardle's evidence (as I will come to discuss below, it is covered elsewhere), he does confirm that the shows/articles all ran between 4 January and 31 January 2022.

58. Mr Wardle confirms that he was approached by NYT to buy his rights in the game and the mark WORDLE in early January 2022. During this time, Mr Wardle received interest from the publication DER SPIEGEL regarding a German version of the game as well as several emails provided from users in Germany who sought to offer a German version of the game.¹⁴ Despite the interest from third parties, Mr Wardle ultimately sold his rights and mark to NYT on 31 January 2022. I note that press coverage covering this sale is provided elsewhere in evidence.¹⁵

59. Above, I set out that Mr Wardle's evidence goes into brief detail with regard to WORDLE's player base. Further, more detailed evidence on this point was provided by Mr Hunter Calvert who provided information regarding the global player base of WORDLE prior to the relevant date. Mr Hunter Calvert is the director of Data and Insight, Games at NYT and he confirms that he has undertaken a review of the data from Google Analytics of Mr Wardle's website, which hosted the WORDLE game leading up to the relevant date. The information shows how many players visited Mr Wardle's website on various dates. It is noted that Mr Hunter Calvert's evidence covers a range of jurisdictions and while all are noted, I will reproduce only the worldwide and UK data. This is as follows:

¹⁴ JW1

¹⁵ See page 12 of JGK1

Date	Number of global players that day	Number of UK players that day
1 December 2021	3,048	174
15 December 2021	No information provided	389
1 January 2022	234,233	55,535
15 January 2022	5,684,603	866,519
31 January 2022	19,377,187	2,700,402
1 February 2022	21,424,106	3,229,514

60. As I have discussed above, I am content to conclude that the above figures relate to people who actually played the game. On this point, I note that in Mr Hunter Calvert's third statement, he does provide additional information as to how many people in the UK actually completed the game that day. I do not intend to reproduce this in full but note that on 1 December 2021, 131 UK users finished the game and, by 1 February 2022, this increased to 2,770,713 UK users.

61. In respect of media coverage for the WORDLE game, I note that this is covered mostly in the evidence of Mr Knight. He discusses the viral nature of WORDLE's popularity at the end of 2021 and into the beginning of 2022. It is confirmed that in January 2022, WORDLE appeared in well-known UK based publications such as The Sun, the Times, The Guardian, the Daily Mail and the Telegraph, amongst others. In addition, it is confirmed that WORDLE also appeared on UK TV shows such as Good Morning Britain, The One Show and BBC Breakfast. Examples of these articles and transcripts from the television shows are provided in evidence.¹⁶ I do not intend to discuss these in full as they cover 115 pages of evidence. However, in order to illustrate the nature of WORDLE's popularity, I consider it necessary to provide a brief range of quotes taken from the articles provided. These are as follows:

¹⁶ JGK4

“If you’re wondering why your Twitter is covered in green and yellow squares, - we’ve got the answers. Online word game Wordle is taking the internet by storm” (The Sun – 2 January 2022);¹⁷

“By now almost everyone has heard of Wordle. [...] Wordle is the quick but challenging new word game that exploded in popularity just over the Christmas holiday period and early in the New Year.” (Daily Stay – 4 January 2022);¹⁸

“[I]n all likelihood, you’ve started 2022 with a Wordle addiction too (The Telegraph – 5 January 2022);¹⁹

“Everyone seems to be playing Wordle” (The Mirror - 6 January 2022);²⁰

“Not since Words With Friends, not since Draw Something, has an online game spread with such vigour. Wordle [...] is everywhere, leaving green-and-yellow-spotted grids in its wake.” (The Observer – 8 January 2022);²¹ and

“Not since the Sudoku boom hit the UK some 15 years ago has there been a craze like the new online puzzle Wordle” (Mail Online – 13 January 2022).²²

62. These quotes are merely examples of how WORDLE was talked about in the press just prior to the relevant date. Clearly, the nature of the press coverage is such that it supports the position that, as at the relevant date in the UK, WORDLE had become a very popular and talked about viral sensation. In addition, it is noted that the press coverage generally makes repeated reference to the game’s use of yellow and green squares.²³

¹⁷ See page 54 of JGK4

¹⁸ See page 62 of JGK4

¹⁹ See page 67 of JGK4

²⁰ See page 69 of JGK4

²¹ See page 73 of JGK4

²² See page 86 of JGK4

²³ See not only the quotes reproduced above but also pages 60, 62 to 63, 65, 70, 84, 97, 107, 140 and 150 (amongst many others) which make clear reference to the use of green and yellow squares as part of the game.

Assessment of the evidence

63. In considering the evidence before me, it is noted that NYT has not provided any evidence of turnover, sales or advertising spend. As set out above, Ms Wilson raised this as an issue at the hearing. I do appreciate that evidence of turnover and advertising spend is commonly adduced in proceedings which require a finding of a goodwill. However, the lack of the same is not fatal to a party's claim. On this point, I consider that the evidence of use before me is somewhat unique as it pertains to a rapidly growing game that grew without paid advertisements and was offered for free online. Therefore, it is to be expected that the evidence relating to the use would not include any turnover or advertising spend. In addition, I appreciate that the level of use is not particularly longstanding. Again, this is something that Ms Wilson picked up on at the hearing. While I do accept that longstanding use is often of great assistance to an assessment of the existence of goodwill, as was the case with the aforementioned issue, it does not mean that there cannot be any goodwill simply because the use was over a short period of time. I say this because a high and intensive level of use over a short period of time can overcome such an issue. In the present case, that is exactly what the evidence shows because, plainly, the WORDLE game offered by Mr Wardle went from being relatively unknown in December 2021 to a global phenomenon by the relevant date. On this point, I remind myself that the UK daily player base during that time went from 174 users to over 3 million. In addition, I note that NYT has provided a significant amount of evidence of press coverage from during that same timeframe which clearly shows that WORDLE had an intense presence in the media. Not only that but the nature of the coverage spoke directly to its rapid ascension and viral nature. On this point, I note that readership or viewership figures for the publications or radio/TV stations covered have not been provided but the evidence stems from what are well-known UK-based publications/channels which, as above, cover BBC, the Sun, the Telegraph, the Mirror and Sky News, amongst others.

64. Taking all of NYT's evidence into account, I am satisfied that, as at 31 January 2022, Mr Wardle enjoyed a significant level of protectable goodwill which vested in

his WORDLE sign.²⁴ On that date, the goodwill was appropriately assigned to NYT meaning that, by the relevant date (which was the very next day), that goodwill vested in NYT. While that may be the case, I do not consider that the goodwill extends to all of the goods and services relied upon. I say this because the use stems solely from the provision of one online game. On this point, I remind myself that NYT relies on the following:

“Puzzles and guessing/memory games and publications and software relating thereto”

65. The evidence summarised above clearly only covers the provision of a puzzle online. As such, I consider that the goodwill is associated with “provision of online puzzles”.

Misrepresentation

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

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] *R.P.C.* 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville*

²⁴ In reaching this finding, I appreciate that 'WORDLE' may have some allusive qualities in that it will allude to the fact that the game offered is a word game. However, the scale of the use and the prevalence of press coverage sufficiently overcomes this issue.

Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

67. And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

68. In considering the issue of misrepresentation, I remind myself that NYT enjoys a protectable level of goodwill for the sign ‘WORDLE’. The IR is for the word only mark ‘Wordle’. Despite the different use in case, the sign and the IR are plainly identical. I say this because word only marks such as the IR are protected in any case, be that upper, lower or any customary combination of the two.

69. I turn now to consider the goods and services at issue. The field of activity within which NYT operates under the ‘WORDLE’ sign clearly relates to puzzles. I consider that this is the same field of activity for Mr Heine’s business but only insofar as it relates to the following goods and services:

Class 16: Children's activity books; books; books for children; magazines in the field of games; books in the field of games; crossword puzzles [printed matter];

Class 28: Memory games; guessing games.

Class 41: Organization of quiz programs, games and competitions.

70. I reach this finding because, plainly, all of the above goods and services cover those that can be said to also relate to puzzles, be that expressly or on the basis that they are sufficiently broad that they may cover the same. In respect of the latter point, I note that “books for children” and “children’s activity books”, for example, can cover books that contain puzzles. As a result, I am of the view that the relevant public would believe that the goods and services of Mr Heine originate from, or are associated with NYT’s business. For such goods and services, there exists a misrepresentation between NYT’s sign and the IR.

71. In respect of the remaining terms in the IR, being “calendars” and “non-fiction books”, these cannot be said to cover puzzles of any sort. That being said, this does not render the present assessment unsuccessful because there is case law that sets out that there may be passing off where there is no common field of activity. On this point, I refer to the case of *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA) wherein Millet L.J. stated the following:

“In the *Lego case Falconer J.* likewise held that the proximity of the defendant’s field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant’s conduct would cause the necessary confusion.

Where the plaintiff’s business name is a household name the degree of overlap between the fields of activity of the parties’ respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.”

72. I remind myself that by the relevant date, the goodwill associated with ‘WORDLE’ was strong. In my view, even though the use was over a short timeframe, it was at a level that rendered it a household name in the UK. So while the distance in fields of activity is still relevant, it is a less important consideration given the size of the goodwill of ‘WORDLE’. In considering the present goods of Mr Heine, I see no reason why a significant proportion of the relevant public would not, upon viewing the IR, believe that it was associated with, authorised by or at least connected to

NYT on the basis that it is identical to the same. For the avoidance of doubt, this applies even in spite of the relative distance between the fields of activity because, as above, WORDLE is a household name.

73. In addition to the above, I note that under section 5(4)(a) grounds, it may be a relevant factor to consider the intent of the parties. On this point, I refer to the case of *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] RPC 39 (HOL), wherein Lord Simonds stated that:

“Confusion innocently caused will yet be restrained. But, if the intention to deceive is found, it will be readily inferred that deception will result. Who knows better than the trader the mysteries of his trade.”

74. In the present case, I note that there is evidence of Mr Heine using the IR on a calendar.²⁵ This is shown via a screenshot taken from Mr Heine’s website which shows the following:²⁶



Wordle 2023 The Official Calendar

The Internet hype - now as a calendar This simple game has achieved Internet fame in a very short time. Originally developed by software developer Josh Wardle for his partner and later sold to the New York Times for a sum of millions. play it every day today.

²⁵ Pages 218 and 223 of JGK7

²⁶ I note that an affidavit is provided at page 226 of JGK7 from translator Anthony Gething who attests to the true translation of Mr Heine’s website. While not provided as its own standalone witness statement, Mr Heine has not contested the translation of this document.

75. While the evidence is taken from a screenshot of Mr Heine's website dated 11 August 2023, it is a calendar product for 2023 so was likely available towards the end of 2022. Regardless, it is from after the relevant date but, in my view, shows a clear intent to deceive the relevant public into believing there was a connection between Mr Wardle's WORDLE and Mr Heine's goods. On this point, I note that the packaging not only says 'Wordle' but includes the yellow and green squares. While the use of yellow and green squares is not relied upon in NYT's sign, the press coverage I have discussed at paragraph 62 above clearly makes some association with this colour scheme and the game. As such, it is clear to me that the intentional colour choice of the above packaging and the accompanying wording indicates an intended association with NYT, thereby reinforcing the finding of a misrepresentation even in respect of goods that are in different fields of activity.

Damage

76. Having found the existence of goodwill and misrepresentation, I consider that damage through diversion of sales is easily foreseeable. As a result, the present ground succeeds in full.

Section 56

77. I will now proceed to consider NYT's application by considering the section 56 claim. Section 56 of the Act states as follows:

"56 Protection of well-known trade marks: Article 6bis.

(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who—

(a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to the well known trade mark—

(a) in relation to identical or similar goods or services, where the use is likely to cause confusion, or

(b) where the well known trade mark has a reputation in the United Kingdom and the use of the other trade mark—

(i) is without due cause, and

(ii) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the well known trade mark.

This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(2A) Subsection (2)(b) applies irrespective of whether the goods or services in relation to which the other trade mark is used are identical with, similar to or not similar to those for which the well known trade mark is entitled to protection.

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.

78. Section 6(1)(c) of the Act states as follows:

Meaning of “earlier trade mark”.

(1) In this Act an “earlier trade mark” means—

[...]

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.

79. In *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Ltd & Ors* [2008] EWHC 3032 (Ch), Arnold J (as he then was) concluded at [237] that the following factors are relevant to determining whether a mark is well known:

- 1) the degree of knowledge or recognition of the mark in the relevant sector of the public;
- 2) the duration, extent and geographical area of any use of the mark;
- 3) the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- 4) the duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;

5) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;

6) the value associated with the mark.

80. Under this ground, NYT claims to be the owner of a well-known trade mark, being the word 'WORDLE' ("NYT's mark"). It is claimed that by the relevant date (being the priority date of the IR, being 1 February 2022), NYT's mark became well known pursuant to Article 6bis of the Paris Convention and section 56 of the Act. It is claimed that NYT's mark is protected for "puzzles and guessing/memory games and publications and software relating there". Under the present ground, the opponent relies on sections 5(1), 5(2)(a) and 5(3) of the Act.

81. While the evidence shows use of NYT's mark by Mr Wardle, I remind myself that all intellectual property rights in 'WORDLE' were duly assigned to NYT on 31 January 2022. Therefore, I consider that NYT is permitted to bring a claim under the present ground as the owner the earlier mark.

82. In respect of the present ground, I note that NYT's pleading sets out that it is a company that is domiciled in, or has a real and effective industrial or commercial establishment in the USA. NYT's address in these proceedings is registered as being in New York City, USA. I, therefore, accept that NYT is domiciled in the USA and as the USA is a country that is subject to the Paris Convention, NYT satisfies the first requirement of having the necessary standing under section 56(1)(b) of the Act to bring a claim under this ground. The next step I must consider is whether NYT's mark is a well-known mark. On this point, I remind myself that for the purposes of section 56(1) of the Act, it is the UK in which the mark must be well-known.

83. The evidence relevant to the present ground is the same as that relied upon when considering the issue of goodwill above. I do not intend to reproduce that evidence here but remind myself that the global use went from around 3,000 daily users on

1 December 2021 to over 21 million on the relevant date. In respect of the UK use, this went from just 174 users on 1 December 2021 to over 3 million on the relevant date, which included 2.7 million UK-users actually finishing the game. In addition, the evidence in respect of press coverage further supports the conclusion that NYT's mark was well known in the UK as at the relevant date.

84. In considering NYT's evidence in light of the factors set out in *Hotel Cipriani* (cited above), I note that the high global and UK-specific player count and press coverage demonstrates that NYT's mark had a high degree of knowledge or recognition amongst the relevant sector of the public. While the duration of the use may not have been long standing, it was intensive and the press coverage came from popular UK-wide publications that would have been viewed by members of the relevant public all across the country. Again, I appreciate that the level of use was short lived prior to the relevant date, however, it is clear that there was a high value associated with the mark as in the month leading up to the relevant date, the press coverage confirmed that it was a viral sensation that was ultimately purchased for a seven-figure sum. As a result, I am content to conclude that NYT's mark was a well-known mark in accordance with section 56 of the Act. On this point, I am of the view that NYT's mark was only well known for the term of "provision of online puzzles".

85. As I have concluded that NYT's mark is well-known, the section 56 ground may proceed. I will first consider the section 5(1) and 5(2)(a) aspects of this ground together.

86. Sections 5(1) of the Act reads as follows:

"(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

87. Section 5(2)(a) of the Act reads as follows:

“(2) A trade mark shall not be registered if because-

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, [...]

there exists a likelihood of confusion on the part of the public, which includes the likelihood or association with the earlier trade mark.”

88. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

89. By virtue of section 6(1)(c) of the Act (which I have reproduced above), NYT’s mark constitutes an earlier trade mark for the purposes of these grounds.

90. The below principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (“OHIM”), Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P. While I reproduce them here, I remind myself that they are only applicable to the assessment under section 5(2)(a) on the basis that section 5(1) does not require a likelihood of confusion. The principles are as follows:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

[...]

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Identity of the marks

91. It is a pre-requisite of both sections 5(1) and 5(2)(a) of the Act that the trade marks are identical. The IR is 'Wordle' and NYT's mark is 'WORDLE'. While the IR is presented in title case and NYT's mark is in upper case, they are identical for the

purposes of the present assessment. This is because fair and notional use of word only marks covers their use in any standard typeface and in any case, be that upper, lower or any customary combination of the two. Both grounds may, therefore, proceed.

Comparison of goods and services

92. The competing goods and services are as follows:

NYT's services	Mr Heine's goods and services
Provision of online puzzles.	<p data-bbox="831 750 1390 1059"><u>Class 16</u> Calendars; children's activity books; books; books for children; magazines in the field of games; books in the field of games; crossword puzzles [printed matter]; non-fiction books.</p> <p data-bbox="831 1133 1318 1223"><u>Class 28</u> Memory games; guessing games.</p> <p data-bbox="831 1355 1390 1496"><u>Class 41</u> Organization of quiz programs, games and competitions.</p>

93. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

94. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

Class 16

Children's activity books; books; books for children; magazines in the field of games; books in the field of games; crossword puzzles [printed matter].

95. All of the above goods are either expressly reserved for puzzles or are sufficiently broad so as to cover puzzles. As such, I find that while the nature and method of use differ from NYT's term of "provision of online puzzles", there is a degree of overlap in purpose on the basis that both the goods and services will aim to provide

a puzzle to the end user. Further, I consider that the provider of online puzzles is likely to also seek to produce physical puzzle books meaning that there is an overlap in trade channels. In respect of user, I am of the view that someone who buys the above goods will also likely play puzzles online, and vice versa. On this point, I am of the view that there is also a degree of competition between them as a user looking to complete a puzzle may choose to do so in a physical book as opposed to doing it online, or vice versa. Taking all of this into account, I find that the goods and services are similar to a medium degree.

Non-fiction books; calendars.

96. The above goods cannot be said to cover those that include puzzles. As such, I find that they differ in nature, method of use and purpose with NYT's service. In terms of trade channels, I do not consider that there is any overlap on the basis that I see no reason why an undertaking that provides online puzzles would also produce and sell non-fiction books or calendars. I accept that there is a degree of overlap in user as members of the general public at large will buy the above goods and also use NYT's service to complete puzzles. However, this alone is insufficient to warrant a finding of similarity. These goods are, therefore, dissimilar.

Class 28

Memory games; guessing games.

97. The above goods are, in my view, types of puzzles. I consider that the findings I have made at paragraph 95 above are applicable here on the basis that while the above goods differ in nature and method of use when compared to NYT's online puzzles, there is an overlap in purpose, trade channels and user. Further, the goods and services may share a degree of competition. As such, I find that these goods and services are similar to a medium degree.

Class 41

Organization of quiz programs, games and competitions.

98. On the basis that a quiz can include puzzles, I find that the above service can be said to cover programs, games and competitions that include puzzles. Plainly, such a service differs in nature, method of use and purpose with NYT's service. The plain reading of the above term does not, in my view, mean that the services are related solely to the organisation of television programmes or services that only business users will select. On this point, I am of the view that the above service can cover offerings made to members of the general public where games and competitions are provided on smaller scales, such as in the home or small venues. As above, these games and competitions can include puzzles. As a result, I am of the view that the above service may also be selected by the same user who plays online puzzles. In terms of trade channels, I consider that there is an overlap in on the basis that the provider of the above service is also likely to offer the same puzzles that are included in their games and competitions via an online platform. The services are not complementary and neither are they in competition. Taking all of this into account, I find that these services are similar to a low degree.

Conclusion of the goods and services comparison

99. It is a requirement of section 5(1) of the Act that the goods and services be identical. Given the findings I have made above, the section 5(1) aspect of the present ground must fail. That being said, the section 5(2)(a) aspect of this ground may proceed in respect of the goods and services I have found similar. As for the dissimilar goods, I remind myself that a likelihood of confusion under section 5(2) of the Act may only succeed where there is a degree of similarity between goods and services.²⁷ The section 5(2)(a) aspect of the present ground, therefore, fails against the dissimilar goods.

²⁷ *esure Insurance Ltd v Direct Line Insurance Plc*, [2008] EWCA Civ 842

The average consumer and the nature of the purchasing act

100. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

101. For the most part, the average consumer for the goods and services at issue will be members of the general public at large. However, some services will be sought by business users looking to run quizzes and competitions. The goods at issue will be available via general retailers or book stores and their online equivalents. In physical stores, the goods will be placed on shelves where they will be self-selected by the consumer. Online, the goods will be selected after viewing an image of the same on a webpage. As for the services, these will be available online or via the provider directly. The services will be selected after viewing them on lists on websites or as a result of internet searches. I find that both the goods and services will be selected via predominantly visual means, though I do not discount an aural component playing a role via word of mouth recommendations.

102. The goods and services will be selected on a somewhat frequent basis but I do appreciate that Mr Heine's services will, for some, be selected less frequently. In terms of costs, the goods at issue will be relatively cheap. NYT's service is also likely to be cheap or even free. Mr Heine's services may come at a more

considerable cost but I do not consider it will extend to being an expensive selection. In terms of the level of attention paid, this will vary. I say this because some goods such as children's activity books will likely attract a lower degree of attention as they will be casual selections, picked to occupy a child for a brief period of time. Some goods (such as those in class 28) will attract a medium degree of attention as they will be relatively ordinary selections with consideration given to factors such as the type of game offered and how many players can participate. In respect of Mr Heine's services, I do not consider that the attention paid will extend beyond medium as while business users may indeed select them, they will not pay attention to any particularly complex factors outside of the types of games offered, whether a host is provided and testimonials from previous customers, for example.

Distinctive character of NYT's mark

103. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

104. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that NYT has filed evidence of use. I will, therefore, consider whether the evidence is sufficient to give rise to a finding that the distinctiveness of NYT’s mark has been enhanced through use. Before doing so, I will consider the inherent position.

105. NYT’s mark is a word only mark for ‘WORDLE’. On online puzzles, this will be seen as an indication that the puzzle relates to ‘words’. As such, the mark has somewhat allusive qualities. That being said, it is not outright descriptive as even with the reference to ‘word’, it does not convey a clear meaning as to what the game actually is. Further, the mark as a whole is a somewhat novel word which, in my view, is another factor that elevates it from being outright low in distinctive character. Overall, I find that NYT’s mark enjoys between a low and medium degree of distinctive character.

106. In respect of the enhanced distinctiveness of this mark, I remind myself that I have assessed NYT’s evidence of use above. Following the same conclusions I have reached in those assessments, I am of the view that while the use may have been over a short period of time, the rapid ascension of ‘WORDLE’ from being a relatively unknown game in December 2021 to being a household name by the relevant date is such that it points to an enhancing of its distinctive character. I say this not only due to the significant daily player base in the UK as at the relevant date but the repeat and consistent press coverage provided in evidence. While the mark may possess an inherent level of distinctiveness that sits on the lower end of the scale, the use is such that it has increased the distinctiveness of the mark to a high degree.

Likelihood of confusion

107. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of NYT's mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

108. The marks at issue are identical. I have found the goods and services at issue to be similar to either a medium or low degree. The average consumer base is formed of members of the general public and business users who will select the goods and services via primarily visual means (though not discounting an aural component). The level of attention paid will either be at a lower or a medium degree. Lastly, while I found NYT's mark to be inherently distinctive to between a low and medium degree, the evidence is sufficient to enhance this to a high degree.

109. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that the identity of the marks at issue leads to a conclusion that consumers would incorrectly recall or misremember the parties' marks for one another. I consider that the identical nature of the marks together with the high distinctive character associated with NYT's mark are such that this finding applies regardless of whether the marks are viewed on services that are similar to a low degree. Consequently, I find that there exists a likelihood

of direct confusion between the marks at issue in respect of all similar goods and services.

110. The section 5(2)(a) aspect of the present ground succeeds against all goods and services, bar “calendars” and “non-fiction books”. I will now proceed to consider the section 5(3) aspect of the present ground.

Section 5(3)

111. Section 5(3) of the Act states:

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

112. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors*, *Case 252/07, Intel*, *Case C-408/01, Adidas-Salomon*, *Case C-487/07, L’Oreal v Bellure*, *Case C-323/09, Marks and Spencer v Interflora*, *Case C383/12P, Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

113. The conditions of section 5(3) are cumulative. Firstly, NYT must show that the marks at issue are similar. Secondly, NYT must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

114. I have assessed NYT's evidence above at paragraphs 56 to 62. Repeating what I have said a number of times already, I am satisfied that the evidence is sufficient to demonstrate that by the relevant date, 'WORDLE' was a well-known mark amongst the relevant public in the UK. This, in my view, equates to a finding that NYT's mark enjoyed a strong reputation in its "provision of online puzzles" service.

Link

115. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

116. The marks are identical.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

117. Above, I found the reputed service of NYT to be similar to a medium degree with "children's activity books", "books", "books for children", "magazines in the field of games", "books in the field of games", "crossword puzzles [printed matter]", "memory games" and "guessing games", similar to a low degree with "organization of quiz programs" and "games and competitions" and dissimilar to "calendars" and "non-fiction books". Despite there being dissimilar goods, I am of the view that there remains a degree of closeness between them and the reputed service of NYT on the basis that they share users.

The strength of the earlier mark's reputation.

118. NYT's mark has a strong reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

119. While inherently distinctive to only between a low and medium degree, NYT's evidence is sufficient to give rise to a finding that its mark enjoys a high degree of enhanced distinctive character.

Whether there is a likelihood of confusion

120. There is a likelihood of direct confusion in respect of the similar goods and services of Mr Heine. However, I found there to be no confusion in respect of the dissimilar goods on the basis that, as I have set out above, confusion may only be found under section 5(2) if the goods and/or services share a degree of similarity. This does not automatically apply here as the provisions under section 5(3) offer additional protection which take into account the repute and distinctiveness of the earlier marks. I am, therefore, required to decide whether, in this particular case, the average consumer would be caused to believe that the user of the IR for dissimilar goods is connected to the user of NYT's mark. In my view, they would. This finding is made on the basis that 'WORDLE' was well known in the UK as at the relevant date together with the fact that the IR and NYT's mark are identical and because, while dissimilar, Mr Heine's goods share a degree of closeness with NYT's reputed service in that they share users. In respect of the latter point, I am of the view that the consumer who is aware of 'WORDLE' for online games (which makes up a significant part of the relevant public), would, upon seeing 'Wordle' on a non-fiction book or a calendar, believe it to have originated from NYT. For example, the repute of 'WORDLE' is strong enough to lead the consumer to believe that the non-fiction book was a factual account telling of the origin and rise of the 'WORDLE' game. In addition, it would be believed that the calendar was a merchandising product stemming from NYT whereby a 'word of the month' was offered for each month in that calendar year. Therefore, given the distinctiveness and repute of NYT's mark, I find that there exists a likelihood of confusion in respect of all goods and services covered by the IR.

Conclusion on link

121. Even if it is not right that there would be confusion where dissimilar goods are concerned, when all of the above is taken into account I have no hesitation in finding that NYT's mark would be brought to mind by the consumer upon viewing the IR. The strong reputation of NYT's mark, the identity of the IR and NYT's mark and the fact that the respective goods and services, even where not similar, are

selected by the same consumer, will create the necessary link across the contested specification.

Damage

122. NYT has pleaded that use of the applicant's mark would, without due cause, lead to an unfair advantage in favour of Mr Heine and cause a detriment to the distinctive character and/or reputation of NYT's mark.

Unfair Advantage

123. I bear in mind that unfair advantage has no effect on the consumers of NYT's services. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to select the goods and services of the IR than they would otherwise have been if they had not been reminded of NYT's mark.

124. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

125. In the present case, I have found that there would be a link between the marks given their identity and the level of reputation that vests in NYT's mark. In such circumstances, I consider it inevitable that use of the IR in respect of the goods and services for which it is registered would give rise to an unfair advantage. This is on the basis that the consumers may engage the goods or services of Mr Heine based on the strength of the reputation and association of NYT's mark, without Mr Heine needing to go to the effort and expense of promoting and marketing his goods or services itself.

126. Mr Heine would have a defence if he could establish that he had a due cause in filing for his mark. However, no arguments have been put forward to this effect. I do not, therefore, need to consider due cause.

127. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider NYT's other heads of damage. The section 5(3) aspect of the present ground, therefore, succeeds in full.

128. I will now consider the section 3(6) ground.

Section 3(6)

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

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

130. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

“(i) [...]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*[Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemaerker (C-320/12) EU:C:2013:435 (“Malaysia Dairy”)]*, para 29; *[Sky plc v SkyKick UK Ltd (C-371/18) EU:C:2020:45 (“Sky CJEU”)]*, para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; *[Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO) (C-104/18) EU:C:2019:724 (“Koton”)]*, para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial

authorities having regard to the objective circumstances of the case (*[Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

131. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

132. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

133. I note that in the case of *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12, the CJEU set out that although it may be a relevant factor, the mere fact that an applicant knew that another party was using the trade mark in another territory does not establish bad faith. In addition, I note the case of *HOGS AND HEFFERS*, BL O/580/16, wherein Professor Ruth Annand, sitting as the Appointed Person, set out that given the territorial nature of IP rights, the mere appropriation of a name registered/used was not enough under UK law: there must be something else involved before this can justify a finding of bad faith.

134. In respect of the relevant date for the present ground, I note that NYT's position is that this is 1 August 2022 on the basis that this is the date on which Mr Heine sought to apply for his mark in the UK. In my view, this is an uncontroversial point. I say this because while the priority date will be relevant to other assessments that are based on the existence of an earlier right, the relevant date for determining whether a trade mark is subject to refusal on section 3(6) grounds is the date on which it was applied for in the UK.²⁸ In the present case, Mr Heine sought protection in the UK for the IR on 1 August 2022 and this is, plainly, the date on which the IR was technically applied for in the UK.²⁹

135. When it comes to determining a claim of bad faith, I remind myself of the key questions set out in the case of *Alexander Trade Mark*, BL O/036/18. These are as follows:

²⁸ In addition, I note that at the hearing, Ms Wilson also referred to 1 August 2022 as the relevant date (see page 32 of the transcript of the hearing).

²⁹ On this point, see the cases of *FSS Trade Mark* [2001] RPC 40 and *HYBRID* (BL O/308/20)

- (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
- (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
- (c) Was it established that the contested application was filed in pursuit of that objective?

136. I will now deal with these questions in turn.

What, in concrete terms, was the objective that the applicant has been accused of pursuing?

137. I have set out the detail of NYT's section 3(6) claim at paragraph 6 above. Essentially, that claim can be broken down to an allegation that Mr Heine was aware of the popularity surrounding the 'WORDLE' game and its use by Mr Wardle and subsequent transfer to NYT. As such, it is claimed that Mr Heine, in applying for an identical mark, intended to undermine the system of undistorted competition and indications of origin by preventing the average consumer from distinguishing, without any possibility of confusion, the origin of his IR. In addition, Mr Heine is alleged to have intended to use the IR to create a copycat game. Further, it is claimed that by applying to designate the IR in the UK, Mr Heine indicated an intention to use the mark in the UK, to acquire a registered monopoly in a trade mark that was created and owned by someone else and to use it to detriment and/or exclusion of that party (such as by using it as a legal impediment to the applicant).

Was that an objective for the purposes of which the contested application could not be properly filed?

138. The basis of NYT's claim is directly in line with the provisions of bad faith as set out in the case of *SkyKick*, namely 240(iv) and 240(v) (both of which are reproduced above). As such, if it is proven that Mr Heine sought to (1) undermine

the system of undistorted competition and indications of origin by preventing the average consumer from distinguishing, without any possibility of confusion, the origin of his IR or (2) use the mark in the UK, to acquire a registered monopoly in a trade mark that was created and owned by someone else and to use it to detriment and/or exclusion of that party, then he will be found to have acted in bad faith.

Was it established that the contested application was filed in pursuit of that objective?

139. In these proceedings, there is a vast array of evidence (stemming from a total of 16 individual witness statements) and it is simply not possible for me to discuss it all in detail here. While this may be the case, I can confirm that I have taken all of the parties' evidence and submissions into account. However, I will only discuss the same insofar as I consider it necessary to do so.

140. Having considered the evidence filed, I find that there are a number of facts that I am satisfied are borne out in the evidence before me. It is clear that Mr Heine was aware of (1) Mr Wardle's use of 'WORDLE' prior to 1 February 2022,³⁰ (2) the fact that it was 'well-received'³¹ and (3) that NYT had bought the game from him.³² The evidence is equally as clear in that Mr Heine believed that NYT was not interested in Germany and other European countries as a distribution area for the game.³³ In offering his explanation of the latter point, Mr Heine sets out that because NYT did not reply to any of his enquiries, their intentions were passive regarding Europe.³⁴ On this point, there is an email from Mr Heine to a Mr Sulzberger of NYT³⁵ which confirms that Mr Heine had made several enquiries as to a non-commercial working relationship with NYT but that he had been ignored. Further, there is an email from Mr Heine to Will Shortz (who is confirmed as being an NYT puzzle editor) regarding a request for someone at NYT to get in touch with a Spanish

³⁰ This is confirmed at paragraph 84 of his first statement wherein he states that one of his motivating factors was that Mr Wardle's game was 'obviously well received'.

³¹ This is confirmed in the first bullet point under paragraph 84 of his first statement.

³² At paragraph 89 of his first statement, Mr Heine says that he aimed to register the IR "at the moment" when he realised that Mr Wardle sold his game to NYT.

³³ Also set out in paragraph 89 of Mr Heine's first statement.

³⁴ See paragraphs 94 to 97 of Mr Heine's first statement.

³⁵ Page 231 at JGK8

publisher regarding the permission for said publisher to use 'WORDLE' in Spain.³⁶ This email is confirmed as making its way to Mr Knight at NYT, who confirmed in an affidavit filed in German proceedings that he had sight of the email but did not reply to the same.³⁷ Mr Heine sets out that it was his belief that this behaviour could not have been a more clear indicator that the European market for puzzle games was not relevant to NYT.³⁸

141. Before proceeding, I consider it necessary to discuss Mr Heine's assumptions regarding NYT's intentions. In short, I do not consider the reasons given by Mr Heine to be logical conclusions that a reasonable person acting with honest intentions would have believed. I say this because his claim to have any sort of insight as to either Mr Wardle's or NYT's intentions with regards to the WORDLE game in Europe is, to put it frankly, entirely unreasonable.³⁹ Further, to suggest that NYT was obliged to reply to Mr Heine or else it would be deemed to lack the necessary intention to expand into Europe is misguided. Therefore, I do not consider that NYT's lack of response to Mr Heine is in any way an indication that NYT did not intend to use WORDLE in Europe or that it acted as a green light for Mr Heine to proceed with registering the IR and subsequently seeking to protect the same in Europe when he knew full well that NYT has just acquired the rights to the game from Mr Wardle. Such an approach is not logical and, in my view, it is not a suitable excuse that demonstrates Mr Heine was acting in good faith.

142. In further reference to the email exchange regarding the Spanish publisher, it is clear to me that this email acts as an indicator that Mr Heine was aware of NYT's rights in 'WORDLE'. If he did not consider that it had any rights in the name/game, it begs the question as to why he sought to put the Spanish publisher into contact with someone at NYT by utilising his contact with Mr Shartz who he believe to be responsible for NYT's crossword puzzles.⁴⁰

³⁶ JGK10

³⁷ SH18

³⁸ See paragraph 97 of Mr Heine's first statement.

³⁹ It is noted that NYT did seek to provide evidence as to its international strategy via the statement of Al-Amyn Sumar. However, I do not consider this evidence to be necessary as, clearly, the claims of Mr Heine have no bearing whatsoever.

⁴⁰ This belief is confirmed at the sixth bullet point found at paragraph 84 of Mr Heine's first statement.

143. Having reached the above conclusions, I will now look at how Mr Heine was representing himself and the IR to the public not only prior to the relevant date but after it.⁴¹ On this point, evidence has been provided the form of a screenshot from Mr Heine’s Facebook post of 4 March 2022 and a screenshot taken from Mr Heine’s website on 12 December 2023⁴² which, while in German, have been translated to read as follows:⁴³

“In January, the New York Times paid Josh Wardle – the inventor of this small but addictive online puzzle – a seven-figure sum. The handful of players who happened upon the website over the summer, suddenly became million. So the newspaper, known for its engaging puzzles, had to pounce before anyone else did. In Germany, we and the New York Times have bought the name rights to WORDLE and now offer our own version for many customers.”; and

“Wordle is the new puzzle trend! We have the official German version: online and offline.”

144. In respect of the first translation, Mr Heine attempts to provide a detailed breakdown of what was meant by his comments.⁴⁴ He argues that it should read as being a reference to “our own versions” (as opposed to the above translation which refers to “our own version”), implying that he and NYT operate separately. It is claimed that this is meant to be read as a statement that acts as a notification to co-exist and that it should not be read as an assertion of an action supported by a common will. Mr Heine’s position is that the statement is clear that each party provides their own versions of the puzzles. In addition, Mr Heine argues that the statement should read “we have the naming rights to WORDLE together with the NYTimes” and not “we and New York Times have bought the name rights to WORDLE”. Even if I were to accept Mr Heine’s translations, I cannot help but read the statement as a whole as implying some form of relationship between Mr Heine

⁴¹ As above, even if evidence covers events after the relevant date, it may be of assistance if it casts light backwards on the position as at the relevant date.

⁴² See pages 219 at JGK7 and page 236 at JGK9, respectively.

⁴³ See pages 236 and 237 of JGK9. In addition, I note that an affidavit is provided at page 238 of JGK9 from translator Anthony Gething who attests to the true translation of Mr Heine’s Facebook post. I note that the affidavit was not provided under the cover of a witness statement from the translator himself.

⁴⁴ See paragraphs 115 to 119 and 129 to 132 of Mr Heine’s first statement.

and NYT as being co-owners of the 'WORDLE' brand in Germany, thereby indicating some sort of joint right to offer the game there which, in turn, implies some form of association between them.

145. In respect of the second translation, Mr Heine argues that by virtue of being the owner of the IR, he is allowed to advertise himself as having the official German version.⁴⁵ While he may have owned the IR at the time of making this statement, I am of the view that the reference to the official German version of WORDLE can only be read as implying that Mr Heine has the rights to use the name upon some agreement with the owner of the original game which, at that time was a well-known game that attracted a high global player rate (over 21 million as at 1 February 2022). Alternatively, the use of 'official' applies some form of connection with the rightful owner of the game.

146. Based on the above, I am satisfied that Mr Heine was presenting himself as being someone with the necessary rights to offer 'WORDLE' despite being well aware that this was not the case, especially given his knowledge of Mr Wardle's use of the same and his sale to NYT, and the fact that, by the time the second quote was posted, NYT had not engaged with him regarding any permission to use WORDLE.

147. Another point I consider necessary to discuss here is that Mr Heine offered a game that was an exact copy of NYT's WORDLE game, albeit using German words. While Mr Heine refers to a range of other similar games to that of WORDLE that existed prior to Mr Wardle's use, it strikes me as no coincidence that he offered the exact same game under an identical name and colour scheme to that popularised by Mr Wardle.⁴⁶ In respect of this point, I note that first statement of Mr Knight includes an article dated 31 January 2022 regarding the sale of WORDLE to NYT and, in it, there is an image of how the game appeared on Mr Wardle's website prior to that date.⁴⁷ This is as follows:

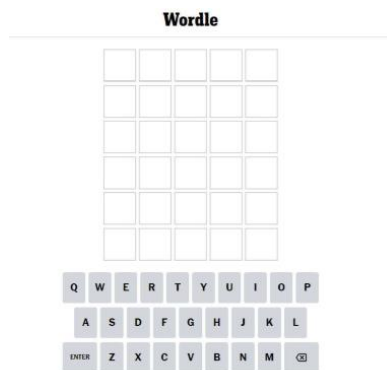
⁴⁵ See paragraph 120 to 121 of Mr Heine's first statement.

⁴⁶ Again, I refer to the press coverage discussed at paragraph 62 which demonstrates the associated between WORDLE and the green and yellow colour scheme.

⁴⁷ Page 12 at JGK1



148. In addition, a screenshot taken from the internet archive facility, the Wayback Machine, of how the game appeared on NYT's own website from 10 February 2022 is provided.⁴⁸ This is as follows:



149. In terms of Mr Heine's game, I note that his evidence includes a screenshot of a post dated 4 March 2022 from his Facebook account which shows the following image of his game:⁴⁹



⁴⁸ JGK3

⁴⁹ Page 236 at JGK9

150. Whilst the game features German words, this is clearly an attempt to offer the exact same game in Germany to that of NYT's well-known mark, even to the point that the options shown either side of the heading of 'Wordle' are the same as those offered under the screenshot shown at paragraph 147 above.

151. Mr Heine attempts to give reasons for seeking to expand the IR for protection in other countries, including the UK. The reasons given are that the extension occurred two and a half months after NYT ignored his email dated 17 May 2022 (being the email to Mr Shortz discussed above). It is claimed that the absolute silence from NYT meant that it had no interest in Europe. I have disregarded this point above. He then refers to an article from Bloomberg News (dated 4 May 2022) and quotes the fact that NYT had an unprecedented number of millions of new users and 387,000 new digital subscribers in the first quarter of 2022. Mr Heine states that this was more than a sufficient level of users for NYT. By saying this, I take it that Mr Heine argues that the influx in new subscribers was sufficient for NYT so that they saw no additional benefit in expanding into Europe. Much like the assumptions made above, it is not for Mr Heine to determine what was sufficient for NYT in terms of its international strategy. In further defence of his position, Mr Heine sets out that he has used the IR since the beginning of 2022 and in a commercial comprehensible manner for his self-developed German-language puzzles online and in paper print. This is noted but the fact that Mr Heine offered an exact copy of Mr Wardle's game under the cover of the IR does not mean that he cannot have acted in bad faith by applying for it.

152. Further to the reasons given in the preceding paragraph, I note that much is made in the evidence of Mr Heine's knowledge of puzzles generally and his experience in establishing the game of 'Sudoku' as a popular game in Germany in 2005.⁵⁰ In addition, he makes reference to a game called 'Ken Ken'. He explains that while 'Sudoku' was successful in Europe, 'Ken Ken' was not. It is claimed that this was because the name 'Sudoku' was available to all users because it was not registered as a trade mark by a 'license troll' whereas 'Ken Ken' was registered as

⁵⁰ See paragraphs 87 to 89 of Mr Heine's first statement.

a trade mark and the owner sought to commercialise the puzzle by selling licences as opposed to letting it be used for free. Mr Heine explains that to avoid this same thing happening to WORDLE, he decided to register it once he realised NYT was not interested in Europe. This explanation is noted but, firstly, his understanding of what NYT wanted to do with 'WORDLE' in Europe is, as above, not relevant. Secondly, Mr Heine was not the owner of the WORDLE game (a point he was well aware of) and the commercial success or failure of the game had absolutely nothing to do with him. In short, I fail to see how him seeking to ensure what happened with 'Ken Ken' would not happen to 'WORDLE' is a valid defence to the present ground, especially given his awareness of NYT's rights in the name after buying it from Mr Wardle.

153. In my view, the present case represents a clear example of where bad faith has been established on the balance of probabilities. Taking all of the evidence into account, the only logical conclusion I can draw from the circumstances put before me was that Mr Heine was not acting in a manner consistent with honest practices, regardless of whether the goods and services under the IR are similar to NYT's game or not.⁵¹ Put simply, Mr Heine was aware of the successful and well received game WORDLE, that it was created by Mr Wardle and that NYT became the holder of the rights to the game on 31 January 2022. As set out in the cases of *Malaysia Dairy* and *HOGS AND HEFFERS* (both cited above), these facts alone are not indicative of bad faith. Whilst that may be the case, the subsequent actions of Mr Heine were that he sought to create an identical game to that of NYT's game and under an identical name simply on the misguided assumption that he *thought* NYT had no interest in Europe.⁵² He also clearly made an attempt to insinuate that his game was an 'official' version of WORDLE and was associated with NYT who had bought WORDLE from Mr Wardle. As set out above, I am of the view that Mr Heine was aware these claims were untrue. It is my view that these actions satisfy the requirement of there being "something else" beyond mere knowledge of someone else using the mark, as referred to in the case of *HOGS AND HEFFERS*.

⁵¹ I say this because the goods and services under the IR relate mostly to puzzles but, even where they do not, they can realistically be said to be types of merchandising goods that consumers would readily associate with NYT's well-known (and identical) mark.

⁵² To repeat what I have above, NYT was not obliged to reveal its strategy to Mr Heine.

154. Frankly, I struggle to equate how taking the steps described above and then applying for the IR to be protected in the UK can realistically be seen as anything other than an attempt to prevent the average consumer from distinguishing, without any possibility of confusion, the origin of the IR. It is on this basis that NYT's bad faith claim is borne out and, as such, I find that seeking to designate the UK for protection of his IR was in bad faith. The IR is, therefore, objectionable under section 3(6) of the Act and is to be declared invalid.

Mr Heine's opposition

155. Given that NYT's application for invalidation has succeeded in its entirety, the IR is declared invalid and deemed as if it had never been granted protection in the UK. As such, it is not a valid earlier mark for the purposes of Mr Heine's own opposition and as the only grounds (sections 5(1), 5(2)(a) and 5(2)(b)) in that opposition were reliant upon the IR as an earlier mark, it follows that Mr Heine's opposition falls away. Therefore, NYT's contested mark may proceed to registration for all goods and services applied for.

CONCLUSION

156. NYT's application for invalidation has succeeded in full and, subject to any successful appeal of my decision, the IR is declared invalid and deemed as though it had never been granted protection in the UK. As for Mr Heine's opposition, this has failed in its entirety and, again subject to any successful appeal of my decision, NYT's contested mark may proceed to registration for all goods and services applied for.

COSTS

157. NYT has succeeded in invalidating the IR and in defending Mr Heine's opposition. Therefore, I find that NYT is entitled to a contribution towards its costs. At the hearing, there was discussion as to whether I should grant off-scale costs in the event that I disbelieved Mr Heine. While I have found that Mr Heine acted in bad faith, this does not speak to his conduct throughout these proceedings, which

I deem to have been entirely reasonable. As such, any costs should be awarded based upon the scale published in Tribunal Practice Notice 1/2023. Another issue in respect of costs relates to the fact that the parties participated in a case management conference (“CMC”) regarding the fact that NYT made a request to cross-examine Mr Heine. The request was initially refused as a preliminary view and NYT requested the CMC to oppose this. While I ultimately refused the request for cross-examination, I do not consider that NYT was unreasonable in its request to have a CMC on the matter. As such, I do not consider that any adverse costs award should be made against NYT.

158. In the circumstances, I award NYT the sum of £4,200 as a contribution towards its costs. The sum is calculated as follows:

Preparing invalidation application and considering Mr Heine’s response to the same:	£600
Considering Mr Heine’s notice of opposition and responding to the same:	£400
Filing evidence:	£2,000
Preparation for and attendance at a hearing:	£1,000
Official fees:	£200
Total:	£4,200

159. I hereby order Mr Stefan Heine to pay The New York Times Company the sum of £4,200. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 28th day of January 2026

A COOPER
For the Registrar