BL O/0509/26

TRADE MARKS ACT 1994

IN THE CONSOLIDATED MATTERS OF

UK TRADE MARK APPLICATION Nos. 3714978 AND 3842219:

MINDGYM WELLWORKING

AND Nos. 3714975 AND 3842187:

WELLWORKING

IN CLASSES 9, 16, 35, 41, 42 AND 44

IN THE NAME OF MIND GYM PLC

AND

OPPOSITIONS THERETO BY WELLWORKING LIMITED

(Nos. 431345, 439705, 431346 AND 439704)

BACKGROUND AND PLEADINGS

1. Mind Gym plc ("**the Applicant**") filed the following applications to register the trade marks WELLWORKING and MINDGYM WELLWORKING:

Application No.	Filing Date	Mark	
3714978	27 October **2021**	MINDGYM WELLWORKING	**"Mark 1"**
3714975		WELLWORKING	**"Mark 2"**
3842219	24 October **2022**	MINDGYM WELLWORKING	**"Mark 3"**
3842187		WELLWORKING	**"Mark 4"**

2. All of the Applications are in respect of goods and services in **Classes 9, 16, 35, 41, 42 and 44**. The full specifications are set out later in this Decision where I compare the parties' goods and services under Sections 5(2) and 5(3). For approximate reference, for the purposes of readily indicating the nature of the claims at issue, the applied-for goods and services may loosely be summarised along the following lines:

Class 9 goods: **Software** and **electronic publications** in the fields of psychology, behavioural science, and cognitive science, including training and assessment and business information software for collecting, analysing and processing organizational data, to assist in career, personnel selection and conflict management and administering and scoring personality and leadership attitudes.

Class 42 services: Providing temporary use of **non-downloadable** computer **software** of a sort comparable to the Class 9 software goods.

Class 16 goods: **Printed matter**; teaching material; stationery

Class 41 services: Online journals and blogs and **electronic publishing** services in relation to psychology, behavioural science, and cognitive science, business information, training and education, personality, career, conflict management, education, leadership

attitudes, performance management, team and individual development, sensitivity training, diversity and inclusion, ethics, personal effectiveness, employee engagement and so on.

educational services, namely, providing instruction and training to business managers in the field of enhancing communication, behaviour and cognition skills.

Class 35 services: Business consulting, **human resources consulting**; providing career information; administering and scoring tests in the field of business leadership development; business data analysis;

retail services in relation to psychological and personality test instruments, and materials in the fields of individual and team development; **psychometric testing** for the selection of personnel.

Class 44 services: Psychological testing

3. Wellworking Limited ("**the Opponent**") is the owner of the following UK Trade Mark Registration:

The Opponent's Trade Mark
Trade Mark No. 3201289: WELLWORKING Filing date: 8 December 2016 Registration date: 17 March 2017

4. The Opponent filed oppositions to the Applicant's Marks in February 2022 and March 2023. The opposition grounds include reliance on the Opponent's Trade Mark (as well as claimed unregistered rights in the sign WELLWORKING).

5. At the request of the Applicant, and with the express agreement of the Opponent, on 17 July 2023 the opposition proceedings were suspended pending a substantive decision in

the matter of CA505250 - an application for partial revocation, on grounds of non-use, of the Opponent's Trade Mark. Those non-use proceedings led to Decision O/0138/24, and revocation, with effect from 18 March 2022, of some of the Opponent's goods and services registered under UKTM No. 3201289.

6. The opposition proceedings recommenced, and, on 29 April 2024, the tribunal invited the Opponent to review its pleadings filed in the oppositions in light of the amended specification of the Opponent's Trade Mark. In May 2024, the Opponent filed amended Forms TM7 Notice of Opposition and statement of grounds. I note that the Forms TM7 filed on 30 May 2024 in respect of Marks 1 and 2 contain anomalous elements to which I shall return once I have given my findings in the oppositions to Marks 3 and 4. The Applicant filed amended Forms TM8 and counterstatements and the four sets of Oppositions were consolidated on 27 June 2024.

7. The grounds of opposition are these:

   (i) **Mark 1** (filed 2021) - (Opposition 431345 vs 3714978 MINDGYM WELLWORKING); Sections **5(2)(b)** and **5(4)(a)** of the Trade Marks Act 1994 ("**the Act**");

   (ii) **Mark 2** (filed 2021) - (Opposition 431346 vs 3714975 WELLWORKING) Sections **5(2)(a)** and **5(4)(a)** of the Act;

   (iii) **Mark 3** (filed 2022) - (Opposition 439705 vs 3842219 MINDGYM WELLWORKING) Sections **5(2)(b)**, **5(3)**, **5(4)(a)** and **3(6)** of the Act;

   (iv) **Mark 4** (filed 2022) - (Opposition 439704 vs 3842187 WELLWORKING) Sections **5(2)(a)**, **5(3)**, **5(4)(a)** and **3(6)** of the Act.

8. For the claims based on Sections **5(2)(a)**, **5(2)(b)** and **5(3)** of the Act, the Opponent relies (to different extents) on the Opponent's Trade Mark. The Opponent's Trade Mark is registered for the following goods and services:

Goods and Services of the Opponent's Trade Mark	
Class 20:	*Furniture; benches [furniture]; chairs [seats]; stools; desks; tables; credenzas [furniture]; pedestals; filing cabinets; shelving units; coatstands; cushions; sofas; footrests; storage furniture, storage units [furniture]; parts, fittings and accessories for all of the aforesaid goods.*
Class 35:	*Retail services relating to … furniture, benches [furniture], chairs [seats], stools, desks, tables, credenzas [furniture], pedestals, filing cabinets, shelving units, coatstands, cushions, sofas, footrests, storage furniture, storage units [furniture], electric lights, light-emitting diodes [LED], desk lights, ceiling lights, wall lights, clocks, document holders [stationery], computer peripheral devices, computer keyboards, mice [computer peripherals], mouse pads, mounting brackets adapted for computers; advice, information and consultancy services relating to all of the aforesaid services.*
Class 37:	*Installation services; installation, maintenance and repair of computer hardware and computer peripherals; furniture installation, maintenance and repair; office machines and equipment installation, maintenance and repair; advice, information and consultancy services relating to all of the aforesaid services.*[1]
Class 42:	*Display Screen Equipment (DSE) assessments and ergonomic workplace assessments, including provision of supporting software and related advice, information and consultancy services.*

1 These underlined terms are not – at time of writing - recorded in the Register. However, for the reasons explained at paragraph 14 below, I find that they have been removed in error and that they may be considered as part of the Opponent's stated claims in these opposition proceedings.

9. For its **Sections 5(2)(a)** and **5(2)(b)** grounds, the Opponent claims the parties' respective marks are identical or similar to one another, that some of the applied-for goods and services (in Classes 16, 35 and 42) are similar to the goods and services of the Opponent's Trade Mark, and that these factors give rise to a likelihood of confusion on the part of the consumer as to the source of the goods or services, including a likelihood of association.

10. Under the **Section 5(3)** ground, it is claimed that, at the filing dates of the Applicant's marks (24 October 2022 - "**the Relevant Date**"), the Opponent's trade mark had a reputation in the UK in respect of goods and services registered in Classes 20, 35 and 37, and that use of the applied-for trade marks (Marks 3 and 4 filed in 2022), without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the Opponent's trade mark.

11. **Section 5(4)(a)** is based on the Opponent's claim that the use of the applied-for trade marks in the United Kingdom was liable to be prevented by virtue of the law of passing off protecting unregistered marks used in the course of trade. The sign relied on is "Wellworking" – identical to the Opponent's registered mark, and is claimed to have been used since 20 February 2008, in respect of precisely the same goods and services as those registered in Classes 20, 35 and 37.

12. Under the **Section 3(6)** ground, it is claimed that the applications for Marks 3 and 4 were filed in bad faith. The bases of that allegation are the claims that:
    i. the Opponent has been using the sign WELLWORKING for 15 years;
    ii. that the Applicant is aware of the Opponent, having purchased goods from it;
    iii. that the Applicant is evergreening because the applications for Marks 3 and 4 are identical to Marks 1 and 2.

13. The Opponent's Trade Mark had been registered for more than five years when the Applicant applied for the opposed trade marks, and is therefore subject to the use requirements stipulated in the Act. The Opponent stated in the Forms TM7 stated that its

Trade Mark had been used in the five-year period up to the Applicant's filing dates in respect of all of the goods and services relied on by the Opponent.

The Opponent's services in Class 35 and consequences for its claims

14. Revocation application No. CA505250 challenged for non-use only some of the goods and services registered under the Opponent's Trade Mark. In Class 35, the contested services did not include those I have underlined in the table above at paragraph 8. Implementation of the outcome of the revocation Decision O/0138/24 should therefore have retained the registration in respect of "*retail and wholesale services relating to …furniture, benches [furniture], chairs [seats], stools, desks, tables, credenzas [furniture], pedestals, filing cabinets, shelving units, coatstands, cushions, sofas, footrests, storage furniture, storage units [furniture], electric lights, light-emitting diodes [LED], desk lights, ceiling lights, wall lights, clocks, document holders [stationery]*".

15. The Forms TM7 filed by the Opponent rely on *all registered goods and services* for the section 5(2) claims, as is clear from the ticked box at Question 5. Elsewhere in the amended Form TM7 – for instance, in the table at paragraph 10 of the Opponent's statement of grounds setting out the parties' goods and services for comparison – the services presented for Class 35 show only those *not* underlined in the table at paragraph 8 above, namely: *Retail services relating to … computer peripheral devices, computer keyboards, mice [computer peripherals], mouse pads, mounting brackets adapted for computers; advice, information and consultancy services relating to all of the aforesaid services.* While those services reflect the record of the register, it seems clear to me that the register wrongly omits the additional underlined services.

16. I also note that the claims of similarity in the Opponent's statement of grounds expressly refer to "*furniture, benches [furniture], chairs [seats], stools, desks, tables, credenzas [furniture], pedestals, filing cabinets, shelving units, coatstands, cushions, sofas, footrests, storage furniture, storage units [furniture]*"".

17. Moreover, it is accepted by the Applicant in its submissions in lieu that the evidence demonstrates that the Opponent is an online retailer of third-party goods in Class 20. The Applicant submits that its own evidence at Exhibit LN1 shows that the Opponent is an

"online supplier of contemporary home and office furniture". I therefore conduct my consideration of the opposition claims based on the inclusion of the due specification of services in Class 35. I will also direct the registry to amend the register to correct the error that removed the references to the parts of Class 35 that are underlined at paragraph 8 above.

The Applicant's defence

18. The Applicant filed Forms TM8 (amended), denying the grounds in all cases and, in the oppositions against Marks 3 and 4, requested proof of use of the Opponent's Trade Mark in respect of the goods and services relied on. The Applicant admitted that Mark 2 and Mark 4 ("WELLWORKING") are identical to the Opponent's mark, but denied that the applied-for goods and services are similar to those registered under the Opponent's Trade Mark and denied a likelihood of confusion. It put the Opponent to proof of its claimed reputation and goodwill. It denied the bad faith claim. The Applicant's defence position is summarised as follows:

"The Opponent is a retailer of furniture and provides training sessions to clients on how to assess their posture and use the ergonomic products to improve healthy homeworking. The Applicant provides leadership coaching and training sessions to multinational companies through an online platform and a network of accredited coaches. The respective parties operate in very different commercial fields and there is no risk of consumer confusion or unfair advantage or detriment, particularly taking into account that the expression "wellworking" is made up of two dictionary words and is commonly used in commerce."

Representation and papers filed

19. The Opponent's legal representative is Briffa; the Applicant's is Lewis Silkin LLP. During the evidence rounds, the Opponent filed evidence in support of its opposition claims, both before and after the separate determination of the revocation proceedings. The Applicant also filed evidence. Neither party requested an oral hearing, but the Applicant filed submissions in lieu. I have read all the papers filed and will refer to the evidence and points raised to the extent I consider necessary for the purposes of this Decision.

RELEVANCE OF EU LAW

20. 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.

DECISION

THE SECTION 5 GROUNDS

21. Section 5 of the Act provides as follows with regard to sections 5(2)(a), 5(2)(b), 5(3) and 5(4)(a):

> **(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, or
>
> **(b)** it is similar to an earlier trade mark and is to be registered for goods or services identical with or 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 of association with the earlier trade mark".
>
> **(3)** A trade mark which—
>
> (a) is identical with or similar to an earlier trade mark, and
>
> (b). . . . .
>
> shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom ... and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.

(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 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.

(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.

PROOF OF USE AND MY APPROACH TO THE OPPOSITIONS

22. The applications in respect of Marks 3 and 4 exactly duplicate those in respect of Marks 1 and 2, made one year earlier. To the extent that the more extensive opposition claims directed against Marks 3 and 4 fail, Marks 3 and 4 may naturally proceed to registration. The Applicant has requested proof of use of the Opponent's Trade Mark only for the purposes of the oppositions against Marks 3 and 4.[2] I shall therefore focus this Decision on the five grounds directed against Marks 3 and 4, beginning with the claims under section 5. Once I have dealt with the oppositions claims against Marks 3 and 4, I shall return to consider the position in respect of Marks 1 and 2, taking account of the anomalies I alluded to above (and the submissions and claims of the parties).

23. Section 6 of the Act defines what is meant by an "earlier trade mark" for the purposes of Section 5(2)(a), 5(2)(b) and 5(3); by virtue of its earlier filing date, the Opponent's trade mark qualifies as such. As it had been registered for more than five years at the filing

2 This is clear from the responses to Question 7 in the amended Forms TM8 for Marks 1 and 2, although I note that the Applicant's submissions in lieu refer to two different relevant periods for establishing genuine use, based on the year's separation between the filing dates of Marks 1 & 2 and Marks 3 & 4.

dates of the Applications, it is subject to the use conditions pursuant to section 6A of the Act. Relevant provisions are set out below.

Section 6A

(1) This section applies where—

(a) an application for registration of a trade mark has been published,

(b) […]

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) […]

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if—

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes—

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[...]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

24. In line with section 6A(2), the Opponent can rely on its earlier trade mark as the basis of its claims under Sections 5(2)(a), 5(2)(b) and 5(3) only to the extent that the evidence filed establishes that it had been put to genuine use in respect of the registered goods and services relied on, within the five years ending on the date on which the Applications were filed. The relevant period in which the Opponent must establish use of the Earlier Trade Mark is therefore 25 October 2017 to 24 October 2022 ("**the Relevant Period**").

Evidence of Use

25. This part of the Decision considers the evidence filed of use of the Opponent's earlier mark. That registered trade mark relied on for the section 5(2) and 5(3) is identical to the sign (unregistered trade mark) relied on by the Opponent for its section 5(4)(a) claims, and the list of registered goods and services relied on cover the same goods and services as those in respect of which goodwill is claimed. Whereas genuine use of the Earlier Mark is framed by the dates of the five-year Relevant Period, evidence of goodwill is not so strictly defined by a timeframe (though goodwill is required to be shown to have existed at the application dates). In my consideration of the evidence of use, I keep in mind not only the question of genuine use, but also that there may later be comment to be made on its potential contribution to the evidence of goodwill for the purposes of the section 5(4)(a) claim (and, indeed, the claimed reputation).

Evidence filed

The Opponent's evidence and submissions

- **First** Witness statement of **Luke Munro**, dated 9 August 2022 and **Exhibit LM1**;
- Written submissions, dated 10 August 2022;
- **Second** Witness statement of Luke Munro, dated 30 December 2022 and **Exhibit LM2**;
- Witness statement of **Paul Simon**, dated 29 July 2024 and **Exhibit PS1**.

26. Luke Munro is a director of the Opponent. Parts of the Opponent's written submissions related to goods and services originally relied on, but which were revoked for non-use by the findings in the revocation decision. Mr Simon is also a director of the Opponent, and his evidence addresses the oppositions, as resumed after the revocation Decision.

The Applicant's evidence and submissions

- Witness statement of **Laura Nend**, dated 29 August 2024 and **Exhibits LN1 - LN4**.

27. Ms Nend is an attorney at Lewis Silkin. Her evidence includes, inter alia, extracts from the Opponent's website demonstrating the nature of its business as a supplier of various third-party branded office furniture and ergonomic solutions for the workplace and home.

28. The Applicant's legal representative also filed lengthy written submissions in lieu of an oral hearing, which I have found helpful in this Decision.

Proof of use

29. The Applicant requested proof of use in respect of the Opponent's Trade Mark in Classes 20, 35, 37 and 42. Mr Simon notes that evidence of use of the Opponent's Trade Mark registration has already been assessed in respect of the Applicant's revocation proceedings, in which it was concluded that the registered trade mark should remain protected for services in Classes 35, 37 and 42. Mr Simon submitted that having to provide proof of use of the same again, only increased costs unnecessarily.

30. Although the Opponent's Trade Mark had been put to proof of use in CA505250 mentioned above, I note that those proceedings had not sought to revoke the Opponent's goods in Class 20, nor its services registered in Class 37, nor all of the services in Class 35. That the Applicant requested proof of use in respect of the goods and services in those classes is therefore quite reasonable. Moreover, since the Opponent claims goodwill and reputation in respect of the goods and services in Classes 20, 35 and 37, it is anyway necessary for the evidence to demonstrate use sufficient for those claims.

31. The evidence of use in the revocation proceedings related to periods spanning 18 March 2017 to 24 July 2022. My consideration of that evidence resulted in the specification for services in Classes 35 and 42 in the form now relied on in these related opposition proceedings. The Applicant did not appeal the findings on genuine use in respect of those services in Classes 35 and 42. In view of the closely overlapping relevant periods in the revocation proceedings and these oppositions, I am content that genuine use has been established in respect of the services in Classes 35 and 42 as settled by the revocation proceedings, such that they may be relied on for the section 5(2) and 5(3) opposition

claims. In taking this approach, I bear in mind that the evidence in the present oppositions very largely duplicates that in the settled revocation proceedings. (The Applicant notes in its submissions in lieu that the latterly filed Exhibit PS1 to the Witness Statement of Paul Simon consists of 96 pages, the first 86 of which are identical to pages 1 – 86 of Exhibit LM2 of the Witness Statement of Luke Munro.)

32. Proof of use therefore remains to be established in respect of the goods in Class 20 and the services in Class 37. Proof of use also remains to be established in respect of the underlined parts of the services in Class 35, since they were not within scope of the revocation Decision.

Proof of use - general case law

33. The applicable legal principles relating to genuine use of a registered trade mark, derived from a series of EU decisions, were summarised in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247 by Arnold LJ as follows (where I have emphasised certain points in bold):

““106. […]:

> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
>
> (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].
>
> (3) The use must be consistent with the essential function of a trade mark, which is **to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin**: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].
>
> (4) Use of the mark **must relate to goods** or services which are already marketed or which are about to be marketed and for which preparations to secure

customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial **exploitation of the mark on the market for the relevant goods** or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is **to create or preserve an outlet for the goods** or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such **use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods** and services in question; (b) the **nature of the goods** or services; (c) the characteristics of the market concerned; (d) the **scale and frequency** of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or **just some of them**; (f) **the evidence that the proprietor is able to provide**; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark **need not always be quantitatively significant** for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, **use of the mark by a single client which imports the relevant goods can be sufficient** to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

107. […] The General Court of the European Union has repeatedly held that **genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned**: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office [EU:C:2020:166*] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. Lidl at [33]. In *Awareness Ltd v Plymouth City Council [2013] RPC 24* Daniel Alexander QC, sitting as the Appointed Person said:

19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, **it should be provided with clear, precise, detailed and well-supported evidence** as to the nature of that use during the period in question from a person properly qualified to know. …

22. … **it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid.** That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. **A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive.** By the time the tribunal … comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaking, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

34. The genuine use provision is not there to assess economic success or large-scale commercial use.[3] An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[4]

Does the evidence filed establish genuine use?

35. The Opponent originally filed the Witness Statement of Luke Munro dated 9 August 2022 and a further Witness Statement of Luke Munro dated 30 December 2022, which were both addressed in the Applicant's submissions of 6 April 2023. In summary, the Applicant at that stage submitted that the Opponent evidenced use of the Opponent's Trade Mark in relation to:
    (i) "office furniture" in **Class 20**;
    (ii) "the design of ergonomic workspaces, the provision of health and safety assessments and retail services of furniture etc" in **Class 35**; and
    (iii) "professional consultancy relating to the science of ergonomics" and "design of layouts for office furniture, design of office space, space planning [design of interiors]" in **Class 42**.

    The Applicant did not consider there to be any evidence of use in relation to the **Class 37** services.

36. The specification of the Opponent's Trade Mark was revised in Decision O/0138/24 to a fair specification on the basis of the evidence of genuine use filed by the Opponent. I agree with the Applicant that some of its previous admissions are redundant in view of the revised specification.

The Goods in Class 20

Furniture; benches [furniture]; chairs [seats]; stools; desks; tables; credenzas [furniture]; pedestals; filing cabinets; shelving units; coatstands; cushions; sofas; footrests; storage furniture, storage units [furniture]; parts, fittings and accessories for all of the aforesaid goods.

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3 *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

4 *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

37. The Applicant's submissions in lieu resile from the earlier admission in respect of the Class 20 furniture goods, arguing the evidence does not show use of the Opponent's Trade Mark as an indication of origin in respect of those goods. While the Opponent's evidence includes copies of invoices showing the sales of relevant goods – armchairs, desks and so on - none of the goods in the invoices is labelled as WELLWORKING, but instead show another trade mark.[5] This is further apparent in evidence from the Applicant, where an extract from the Opponent's website under the "browse by brand shows only offered third-party branded furniture".[6] There is no evidence that the Opponent manufactures or providing the goods under its own WELLWORKING mark. For these reasons, **I find that the evidence does not satisfy genuine use** of the Opponent's Trade Mark in respect of the goods in Class 20.

Services in Class 35

Retail services relating to … <u>furniture, benches [furniture], chairs [seats], stools, desks, tables, credenzas [furniture], pedestals, filing cabinets, shelving units, coatstands, cushions, sofas, footrests, storage furniture, storage units [furniture], electric lights, light-emitting diodes [LED], desk lights, ceiling lights, wall lights, clocks, document holders [stationery],</u> computer peripheral devices, computer keyboards, mice [computer peripherals], mouse pads, mounting brackets adapted for computers; advice, information and consultancy services relating to all of the aforesaid services.

38. I have explained that I have already found proof of use to be satisfied (by Decision O/0138/24) in respect of the terms *not* underlined above, but have made no findings on the evidence of use with regard to the underlined parts of the services. The Applicant's evidence shows extracts from the Opponent's website, on which it describes itself as follows: "*We are an award-winning UK supplier of office and home furniture that specialises in workplace wellbeing. We have an online retail store and carry out commercial office projects and workplace assessments*." In its submissions in lieu the Applicant submits that the Opponent "has not provided evidence showing the provision

5 Witness Statement of Paul Simon and Exhibit PS1 – for example. Herman Miller Sayl Task Armchair and Holmris Electrical Sit-Stand Desk. See too Exhibit LM1 where at least some of the invoices from page 24 – 32 fall within the Relevant Period and show sales of chairs and pedestals for instance. More third-party branded office furniture is shown at Exhibit LM2 from page 122.

6 Exhibit LN1 to the Witness Statement of Laura Nend. The website evidence shows brands sold by the Opponent as including, for example, artek, boss design and buzzi space.

of retail services in relation to all the items of furniture listed under Class 20." In support of that contention, the Applicant summarises the evidence from Mr Simon.

39. Mr Simon states that the redacted invoices to customers of Wellworking at pages 1 to 45 of Exhibit PS1, show evidence of use of the WELLWORKING mark in relation to the Class 35 and Class 37 services, inasmuch as he claims that the invoices show sales of "computer peripheral devices including computer keyboards, computer mice, mouse pads and mounting brackets, as well as supporting software, and providing the installation, maintenance and update of computer software for consumers." The invoice evidence does include some references to the supply of (third-party-branded) items of furniture including a task armchair, sit-stand desk and wedge cushion.[7] These invoice references to items of office furniture are very few, but taken in the context of the evidence as a whole, of the Opponent operating by reference to the Mark since 2008 and the evidence of its website content, and despite the evidential weaknesses with regard to particular items of the listed underlined goods in the Class 35 specification, I am content that there has been genuine use of the Opponent's Trade Mark in respect of the retail of office furniture, as well as (the previously determined) computer peripherals.[8] I will conduct the comparison of the parties' goods and services based on a fair specification along those lines.[9] (The express inclusion or exclusion of a particular term, such as *sofas* or *light-emitting diodes [LED]* can anyway have no material effect on the assessment of the claims.)

Services in Class 37

Installation services; installation, maintenance and repair of computer hardware and computer peripherals; furniture installation, maintenance and repair; office machines

7 I have previously noted too the few additional invoices in Exhibit LM1.

8 Exhibit PS1 includes screenshots from the Wayback machine at pages 86 – 89. The evidence also includes screenshots from Trustpilot.co.uk, which shows a total of 2759 reviews, 96% five stars. That evidence is from July 2024, but I consider it a reasonable inference that a good deal of those reviews would relate to the Relevant Period, and page 66 shows a five star overall rating on Trustpilot in June 2021.

9 I bear in mind the principles on fair specifications, outlined in *Property Renaissance Ltd (t/a Titanic Spa) v. Stanley Dock Hotel Ltd (t/a Titanic Hotel) [2016] EWHC 3103 (Ch); [2017] E.T.M.R. 12* at §47, which I referred to at paragraph 22 of Decision O/0138/24 in the related non-use revocation case against the Opponent's Trade Mark.

and equipment installation, maintenance and repair; advice, information and consultancy services relating to all of the aforesaid services.[10]

40. The evidence in respect of these services is limited, though as the Applicant notes, the invoice evidence in Exhibit PS1 refers to installation services in relation to computer peripheral devices and office furniture (setting-up of a desk and chair). Taken in the context of the evidence as a whole, including the Opponent's website content and some of the Trustpilot reviews, I am content to find genuine use of the Opponent's Trade Mark in Class 37 based on the following fair specification, which in my view reflects how the average consumer would fairly describe the services, according to the evidence filed: *installation of computer peripherals; furniture installation, office equipment installation; advice, information and consultancy services relating to all of the aforesaid services.* (In framing that fair specification, a lack or insufficiency of evidence has led to my exclusion of certain terms from the registered specification, but those exclusions do not appear likely to change my assessment of the claims.)

THE SECTION 5(2)(A) and 5(2)(B) CLAIMS

41. The specifications applied for under the Applicant's marks are identical to one another. The applied-for Mark 4 WELLWORKING is admitted to be clearly identical to the Opponent's Earlier Mark. Since the Opponent's case is strongest against the identical Mark 4, I will focus on that application, but will return to comment on the non-identical Mark 3.

Case law principles

42. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2025] UKSC 25:

10 These underlined terms are not – at time of writing - recorded in the Register. However, for the reasons explained at paragraph 14, I find that they have been removed in error and that they may be considered as part of the Opponent's stated claims in these opposition proceedings.

(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;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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; and

(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

Comparison of the goods and services

43. Section 60A(1) of the Act provides that for the purpose of the Act goods and services are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, nor are they to be regarded as being dissimilar from each other on the ground that they appear in different classes.

44. When considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. Those factors include, inter alia:[11]

i. the physical nature of the goods;

ii. their intended purpose;

iii. their method of use / uses;

iv. who the users of the goods and services are;

v. the trade channels through which the goods reach the market;

vi. in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

11 See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the *"Treat"* case

vii. whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);

viii. whether they are complementary to each other. Complementary has been described as meaning that *"there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking"*.[12] Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[13] Complementarity should be distinguished from 'use in combination', where goods are merely used together, whether by choice or convenience (e.g. bread and butter; or wine and wine glasses[14]) but are not essential or important to one another's use such that they would be assumed to share source.

45. I bear in mind too that when interpreting terms in a specification that it is *"necessary to focus on the core of what is described* [... and that] *trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise",* although *"where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods* [and services] *in question"*.[15]

The Opponent's Goods and Services (in light of proven use/fair specification)	
Class 20:	NONE
Class 35:	*Retail services relating to … office furniture, computer peripheral devices, computer keyboards, mice [computer peripherals], mouse pads, mounting brackets adapted for computers; advice, information and consultancy services relating to all of the aforesaid services.*

12 *Boston Scientific Ltd v OHIM,* Case T-325/06, paragraph 82

13 *Kurt Hesse v OHIM, Case C-50/15 P*

14 As Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL-0-255-13 - *"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."*

15 *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

Class 37:	*Installation of computer peripherals; furniture installation, office equipment installation; advice, information and consultancy services relating to all of the aforesaid services.*
Class 42:	*Display Screen Equipment (DSE) assessments and ergonomic workplace assessments, including provision of supporting software and related advice, information and consultancy services.*

46. With regard to the services in Class 35 under the Earlier Mark, I note that the table at paragraph 10 of the Opponent's statement of grounds (which compares the goods and services) lists only: *Retail services relating to … computer peripheral devices, computer keyboards, mice [computer peripherals], mouse pads, mounting brackets adapted for computers; advice, information and consultancy services relating to all of the aforesaid services* – which is to say, it omits reference to the furniture goods. However, under Q1 of Section A of the Form TM7, it is stated that "<u>all</u> goods and services covered by the earlier trade mark are relied on for the opposition" (my emphasis). I therefore include retail of office furniture for the comparison of goods and services for the claims under Section 5(2).

Applied-for Goods and Services - Those opposed under Section 5(2)(a) & (b)
The opposition based on section 5(2)(a) and section 5(2)(b) target only some of the applied-for goods and services, as set out below.
Class 16: *Printed matter; publications; books; journals; magazines; brochures and leaflets; manuals; instructional and teaching material; stationery.*
In its statement of grounds, the Opponent claims the above applied-for goods in Class 16 "are a clear crossover with the whole of the Earlier Mark. The goods and services provided by the Opponent will carry an inherent element of marketing and advertising

to promote their goods to their targeted consumer, especially in respect of "*furniture, benches [furniture], chairs [seats], stools, desks, tables, credenzas [furniture], pedestals, filing cabinets, shelving units, coatstands, cushions, sofas, footrests, storage furniture, storage units [furniture]; parts, fittings and accessories for all of the aforesaid goods*."

I have previously found that the Opponent has not established genuine use in respect of those furniture goods, but *has* shown use for retail services for those goods. I have also found genuine use in respect of *advice and information* relating to the Opponent's office furniture retail services, furniture installation and Display Screen Equipment (DSE) assessments. **I find no similarity** between such services and ***stationery; books; journals; magazines***.

I acknowledge that marketing of goods and information and advice on services may very likely involve making use of *Printed matter; publications; brochures and leaflets; manuals; instructional and teaching material*, but such printed matter is auxiliary to those services, and the core of those services is different in nature. There is no evidence that providers of the Opponent's services also seek to create a market for any of the printed materials, though there is overlap in purpose between, say, the applied-for *manuals; instructional and teaching material* and the Opponent's *advice and information relating to the furniture installation or DSE assessments*, and possibly overlapping method of use. Likewise, there may be some complementarity between the applied-for *brochures and leaflets* and the Opponent's *office furniture retail services.*

The Opponent has made no submission arguing that there is any element of competition between the respective goods and services, though it is possible that a customer could choose *manuals* and *instructional and teaching material* instead of seeking advice and information services by other (non-print) means, and to the extent that the informational content of those goods overlaps with the purpose of the services, there is also an overlap in potential users.

Standing back and comparing ***Printed matter; publications; brochures and leaflets; manuals; instructional and teaching material*** with *advice and information relating to the furniture installation or DSE assessments,* I find that on the narrow possibility that the content of the printed or instructional materials may be specifically concerned with

furniture assembly or DSE assessments, there is perhaps **a medium degree of similarity** (at most). (Basing a comparison on the Opponent's *office furniture retail services,* I find that on the narrow possibility that the content of printed material such as ***brochures and leaflets*** is specifically concerned with offering for sale office furniture, there is only **a low degree of similarity**, since such printed materials can amount only to a part of any retail service).
Class 35: *Retail and online retail store services in relation to psychological and personality test instruments, and downloadable and printed materials in the fields of personality type, personality assessment, personality testing, personality test scoring and assessment, psychology, business, careers, leadership, organizational behaviour and growth, group dynamics, interpersonal relationships, interpersonal communication, conflict management, relationship skills, self development, personal development, performance management, talent management, management development, team and individual development, sensitivity training, diversity and inclusion, ethics, personal effectiveness, employee engagement, employee onboarding, customer service, reorganization management, and cognitive assessments, cognitive training, cognitive fitness services; retail and online retail store services in relation to psychological and personality test instruments, and downloadable and printed materials in the fields of individual and team development, individual and team performance, team management, personnel selection, employee productivity and human resources; psychometric testing for the selection of personnel.*
In its statement of grounds, the Opponent claims the above applied-for services in Class 35 are "a direct crossover" with the retail services offered by the Opponent. I bear in mind that services should be confined to their core focus. It is not appropriate to lump together all retail services; clearly what is important is what goods are offered through the respective retail services. I find the goods retailed under the Earlier Mark (*office furniture and computer peripherals devices)* are different from the goods in the applied-for Class 35 services (*psychological and personality test instruments, and materials in the fields of individual and team development*). They differ in nature, purpose and method of use. They are not in competition or complementary and the

services do not share trade channels. I again acknowledge that there is a degree of overlap in user, inasmuch as the average consumer will particularly include businesses (as well as the general public at large), but this arguable factor alone is too general and here not enough to be able to consider the services to be similar. I find no similarity on the basis as claimed by the Opponent in its statement of grounds. I find **no similarity** between the above applied-for services in Class 35 and any of the Opponent's services.

Class 42: *Providing temporary use of non-downloadable computer software for administering and scoring personality, psychology, career, conflict management, education, leadership attitudes; providing temporary use of non-downloadable computer software for providing feedback on and generating reports regarding personality, psychology, career, conflict management, education, leadership attitudes; providing temporary use of non-downloadable computer software for identifying personality type; providing temporary use of non-downloadable computer software for collecting, analysing and processing psychological, personality, career, leadership, personnel selection, and organizational data.*

In its statement of grounds, the Opponent claims that "the provision of services such as providing non-downloadable software is a clear cross over with the services offered by the Opponent, such as Display Screen Equipment (DSE) assessments and ergonomic workplace assessments, <u>including provision of supporting software and related advice, information and consultancy services</u>" (underlining as included by the Opponent)

Again I bear in mind that consideration of services should be confined to their core focus. In assessing services *Providing temporary use of non-downloadable computer software,* clearly what is important is the purpose of the software.

I find the purpose of the applied-for software, focused on psychological and personality analysis, is wholly different from the Opponent's provision of supporting software for ergonomic workplace assessments. The services are not complementary and do not compete or share channels of trade. I acknowledge that there are overlaps in nature

(non-downloadable software), method of use (engagement with a computer) and user (business consumers), but these factors are too general in the present comparison to give rise to similarity. I find **no similarity** between the above applied-for services in Class 42 and any of the Opponent's services.

47. **Conclusion on similarity of goods and services**: Since some similarity of goods and services is a required component under Section 5(2), the claims under Sections 5(2)(a) and 5(2)(b) inevitably fail in respect of the applied-for goods and services that I have above found not to be similar to the protected services under the Opponent's Earlier Trade Mark. The grounds therefore fail in respect of the applied-for *stationery; books; journals; magazines* in **Class 16** and in respect of the services in **Classes 35** and **42**.

48. I have found similarity in respect of *Printed matter; publications; brochures and leaflets; manuals; instructional and teaching material* based only on the narrow possibility that the content of the printed materials is specifically concerned with furniture assembly or DSE assessments. Having found some similarity, I proceed to consider the remaining aspects of the Section 5(2) grounds.

The average consumer and the nature of the purchasing act

49. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

50. According the Opponent's statement of grounds, the goods and services primarily target the general public who will pay "no more than an average degree of attention". The Applicant disputes that the average consumer is the general public and instead considers that the services covered by the respective marks primarily target specialised consumers. The Applicant submits that the Opponent's services primarily target specialised consumers, and its services are expensive purchases (based on the invoices contained in Exhibit PS1 totalling hundreds, if not thousands of pounds), such that the consumers will exercise a higher degree of care and will make a purchase only after careful consideration.

51. I agree with the Applicant that both parties' goods and services seem likely to target a business consumer, though I accept that the general public may also buy *Printed matter; publications; brochures and leaflets; manuals; instructional and teaching material*, which are the only similar goods. I accept the Opponent's suggestion that the average consumer for those goods may pay no more than a medium degree of attention.

Distinctive Character of the Earlier Trade Mark

52. Registered trade marks possess varying degrees of inherent distinctive character. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, since (generally) the more distinctive the earlier mark, the greater the likelihood of confusion.

53. The Applicant submits the word element WELLWORKING is an invented word, but alludes to something "working well" in relation to the goods and services covered by the Opponent's Trade Marks. The Opponent's use of the phrase "working well" is evidenced in Exhibit LN1 which shows that the Opponent describes its business as "Wellworking is everything about working well, wherever work is" … "we offer a range of assessment services across the UK including virtual ones via video call to ensure you are working well". The Applicant submits that the word element WELLWORKING is of minimal inherent distinctive character and the evidence has not sufficiently shown that the distinctive character of the mark has been enhanced through use.

54. I agree with the Applicant that, on an inherent basis, the Earlier Mark WELLWORKING has a low level of distinctive character in relation to the Opponent's goods and services, since it is clearly a composite of two ordinary English words. Although the "well" precedes "working", the composite remains a combination low in distinctive character for services concerned with desk and office work.

Enhancement through use?

55. I must take into account the evidence of use of the Earlier Trade Mark and determine whether it is sufficient to support a finding that the distinctive character of the Earlier Trade Mark benefits from an enhancement gained through that use. Since this sort of evidence

will also be relevant under other grounds (inasmuch as it informs the claimed reputation and goodwill), I set out below relevant case law principles and points from the evidence in some detail. While distinctiveness and reputation are different, the nature, factors, and evidence used to prove enhanced distinctiveness are the same as for reputation.

56. In *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, 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)."

57. The First Witness Statement of Luke Munro includes the following statements:
    (i) Wellworking has been trading under its name since 2008;
    (ii) He describes it as one of the UK's fastest growing online suppliers of contemporary home and office furniture, with three office showrooms in London, Galashiels and Worcestershire;

(iii) To evidence the substantial growth of well working over the 13 years from 2008 – 2021 Mr Munro provides **turnover figures** for each of those years, which range from. The turnover figures range from around £1.5 million to £3.6 million in the first six years, rising to £10.3 million in 2021. Some of the supporting invoices in evidence are in respect of sales totalling thousands of pounds for seating and other goods.

(iv) **Awards**: As a result of its innovative approach to customer services, in 2015, Wellworking was awarded Best Business Awards for Best Customer Focus, where Wellworking was described as "a company that clearly listens to its customers and is now a leading light within the online retail industry. Wellworking has created a unique delivery system called "Precision" and teamed up with Herman Miller, one of the world's leading furniture manufacturers. This has resulted in more than 650 positive independent reviews from customers with an overview score of 9.8 out of 10". The chairman of the judges described the Best Business Awards as "one of the UK's highest profile awards and winning this accolade speaks volumes about the quality of the organisation." The Press release is shown at Exhibit LM1.

In 2016 Well working 1 the Morrison Utility Services Satisfaction Awards, again a Press release is shown at Exhibit LM1.

Wellworking won The UK Workplace Well-being Programme of the Year at the UK Active Awards 2018.

A Press release in Exhibit LM1, dated 23 September 2021 refers to "Local Company scoops "Furniture provider of the year" award at Mixology21. It states that the "Mixology21 Awards from Mix Interiors celebrate the best projects, projects and people in commercial interior design and widely regarded as the most prestigious award for the interior design community." It states that well working has an office in Acton and was one of 21 winners judged to have "led the way within the dynamic and innovative interior design community." It notes that well working was shortlisted for the same award in 2017 and won Best Marketing Campaign at Mixology 2007. The Press release also states that Wellworking has been rated the UK's favourite office furniture supplier for six years in a row by customers on the independent review platform Trustpilot.

58. The Applicant made various submissions in critique of the Opponent's evidence. The turnover figures given are reasonably substantial, single figure millions of pounds for each

year, increasing to over ten million by 2021. I have not been given sector comparators, so cannot reliably gauge how the figures compare with other providers of the same goods or services. The Applicant's written submissions dated 6 April 2023 noted that the Opponent has not particularised the turnover figures by the different areas of business and so it is not possible to say to what goods or services they relate (for example, sale of office furniture, installation services or ergonomic assessments – all also in evidence). A similar point was made by Professor Phillip Johnson, sitting as the Appointed Person in *W Sternoff LLC v Peter Kertels*, BL O/0984/25:

> 26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or a split between the two. This is why particularisation is so important as without it the figures provide no evidence of use for either good A or good B. The same applies where the same good is sold under trade mark A and trade mark B.
>
> 27. Evidence of sales is only useful for establishing genuine use where it sets out the sales revenue for a particular and identified good (or service) and it is clear that that good or service is sold under the trade mark. Only where there is only one good being sold and it is sold under only one trade mark can global figures be sufficient."

59. This is a legitimate flaw to highlight, and it weakens the evidential clarity of the turnover figures, since I cannot accurately ascertain how significant use of the Earlier Mark was for any of the particular goods and services relied upon.

60. The Applicant's submissions dated 6 April 2023 acknowledge that the various awards do show that the Opponent has some recognition amongst its peers in the categories of Best Customer Focus, Customer Satisfaction and Workplace Wellbeing Programme of the Year. The Applicant submits that peer recognition does not necessarily translate to a reputation and goodwill to the average consumer of the goods and services covered in the Opponent's Trade Mark. This point by the Applicant was not made in direct reference to enhanced distinctiveness (though I accept it has some read across), but in any event, I do not consider the objection especially potent in the present case, since the natures of

the particular awards given to the Opponent are concerned with the customer experience. Moreover, the evidence also refers to the Trustpilot reviews,[16] which are strongly positive and of course come from customers (buying office furniture).

61. The Trustpilot reviews totalled 2759 as of July 2024 (well after the relevant date in October 2022 when the Applicant filed Marks 3 and 4). The Applicant made the following submission:

"Notwithstanding that the reviews from https://uk.trustpilot.com/ set out on Pages 90 – 95 of Exhibit PS1 fall outside the relevant period and the Applicant claiming the Opponent has no reputation in relation to furniture goods, the Applicant notes that the Opponent falls under the "Business Services > Office Space & Supplies > Office Furniture Shop" categories on TrustPilot. Exhibit LN3 shows a copy of the list of companies displayed under the "Office Furniture Shop" category sorted by "highest number of reviews". Exhibit LN3 shows that the Opponent is not listed as one of the companies with the highest number of reviews. Therefore, it shows that consumers use and are more familiar with other companies for office furniture and the like."

This is not an entirely fair point, since of course some companies are larger (and possibly older) and will consequently have attracted more reviews. Moreover, some of the companies may be listed on Trustpilot in multiple categories. For instance, the top result (as of 23 August 2024) is "Oak Furnitureland" with over 178k reviews (4.6 overall rating) and "Staples" has nearly 12k reviews (4.4 overall rating). Fourth on the list is "Office Furniture Online" with over 19k reviews (4.1 overall rating). Lower on the list is "Office Outlet" with 4636. The fact that there are other companies with more reviews does not mean that the Opponent cannot rely on evidence of its own review ratings to support a claim of enhancement of distinctive character, reputation or goodwill. The Applicant's evidence does, however, call into question the statement in the 2021 Press Release that "Wellworking has been rated *the UK's favourite* office furniture supplier for six years in a row by customers on the independent review platform Trustpilot", since Exhibit LN1 shows that by 2024 the Opponent was not listed in the top 17 results shown and that the

16 Pages 90 -94 of Exhibit PS1.

17th result (Belliani.co.uk, listed in at least five categories) had 3282 reviews, 4.0 overall rating (versus 2759 reviews for Wellworking in the previous month).

62. The Applicant also submits (correctly in my view) that there is limited information to show the geographical extent of use of the Opponent's Trade Mark in relation to the services. The Applicant notes that the copies of the invoices provided by the Opponent show that the Opponent's services are primarily provided to businesses in London (though I accept that the evidence refers also to the Opponent having a showroom in Galashiels and Worcestershire).

63. Despite the reference to a 2007 marketing award, there is also little evidence related to marketing – no promotional expenditure, no social media. As the Applicant notes, the Opponent submitted one advertisement (Page 66 of Exhibit PS1), but provides no indication of the number of consumers who viewed the advertisement or where the consumers were based. I agree with the Applicant that it is not possible to determine the intensity of the use and the size of the investment made promoting the Earlier Mark in relation to the services because no such evidence has been provided by the Opponent.

64. Standing back and looking at the evidence as a whole, I find that, despite several millions of pounds of annual sales for well over a decade, and despite award recognition as a fast-growing office furniture supplier, it is difficult to conclude that the use has been of a scale to increase the distinctive character from its inherently low base. This doubt arises from the lack of evidence on customer base/reach, geographic spread or market share. The turnover figures must include its DSE services as well as office furniture services, and attribution of income cannot therefore be reliably made to a particular service registered under the Earlier Mak on which the Opponent relies.

65. The Applicant has submitted that the average consumer for its goods and services is the general public.[17] The evidence does not show how many customers it has served. I have noted that the sums indicated by the invoices in evidence are in the hundreds or thousands of pounds, but even given the annual turnover totals (between 1.5 –8 million pounds in the years 2008 – 2020, and around 10.3 million in 2021), the number of

17 Paragraph 19 of its Statement of Grounds.

separate or returning customers is not calculable. Even on the basis that the average consumer is not the general public at large, btu a smaller pool made up predominantly of a business user, wishing to furnish its offices and suitable desk and computer arrangements (which is more in line with my finding on the evidence), it is not possible to contextualise the turnover sums – are they substantial in the sector or not?

66. Moreover, as I have previously noted, has the Opponent explained the division of its turnover between services, making it difficult to assess where any increased distinctiveness should in any event be attributed.

67. In the circumstances, my primary finding is that the evidence is not sufficiently robust or clear to establish that the Earlier Trade Mark benefits from enhanced distinctiveness character acquired through use. Alternatively, taking the evidence at its highest - the award evidence, respectable sales figures since 2008, and that a good part of the 2759 Trustpilot reviews will be from before the filing dates of the contested marks - I find that the distinctive character of the Earlier Mark may be considered to have been enhanced by a modest degree in respect of office furniture retail services, though it remains fairly low and certainly no more than medium distinctive character.

Conclusion as to likelihood of confusion

68. I turn now to make a global assessment of likelihood of confusion if the parties' marks were used concurrently in respect of their similar respective goods and services. This assessment takes account of my findings set out in the foregoing sections of this decision and of all of the various principles from case law outlined in my paragraph 42 above.

69. An assessment of likelihood of confusion requires a realistic appraisal of the net effect of the similarities and differences between the marks and the goods in issue, giving the similarities and differences as much or as little significance as the relevant average consumer would attach to them, noting that such a consumer is taken to be reasonably well-informed and reasonably observant and circumspect. The average consumer is a hypothetical person - a legal construct - created to strike the right balance between the

various competing interests including, on the one hand, the need to protect consumers and, on the other hand, the promotion of free trade in an openly competitive market.[18]

70. Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.

71. The assessment of likelihood of confusion involves factoring in the potential for a greater degree of similarity (or identity) between the marks the goods or services to offset a lesser degree of similarity between the goods or services. The Applicant admits the (self-evident) fact that the Opponent's Mark (Wellworking) is visually, aurally and conceptually identical to Mark 4.

72. Of the applied-for goods and services, I have found that only ***Printed matter; publications; brochures and leaflets; manuals; instructional and teaching material*** in Class 16 have any similarity with the Opponent's services. The basis for that conclusion on similarity is the narrow possibility that the content of the printed materials may be specifically concerned with furniture assembly or DSE assessments, such that there may be perhaps a medium degree of similarity with the Opponent's *advice and information services related to installation of computer peripherals; furniture or office equipment* (Class 37), or to *Display Screen Equipment (DSE) assessments and ergonomic workplace assessments* (Class 42). (The comparison based on the Opponent's retail services leads to a lower degree of similarity.)

73. The Opponent has various factors weighing in its favour – identical marks, maybe medium similar services, and that the average consumer could include the general public who may exercise no more than a medium level of attention in the process of purchasing, for instance, the applied-for publications, manuals etc.

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18 *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ, particularly paragraph 34.

74. Weighing against a likelihood of confusion is the lowish distinctive character of the Earlier Mark and my primary position that the evidence of use is not compelling enough to have enhanced the distinctive character. My secondary position is that if the use has improved the distinctive character of the Earlier Mark, it has enhanced it by a modest degree in respect of office furniture retail services, and it remains fairly low and certainly no more than medium distinctive character.

75. The purpose of the relative grounds opposition framework is to protect the proper scope of earlier registered rights, including avoiding a likelihood of confusion on the part of the purchasing public. In circumstances where the content of the Applicant's goods in Class 16 are *not* concerned with the advice and information services related to the Opponent's services in Classes 35, 37 or 42, there is no similarity (and therefore no possible likelihood of confusion under Section 5(2) of the Act). It seems to me that in the present case, the narrow possibility of conflict or confusion is readily averted by this Tribunal requiring a simple overlaying qualification to the Applicant's specification for its goods in Class 16 under its Mark 4, as set out below, ruling out the narrow circumstance where a likelihood of confusion may otherwise arise.

OUTCOME OF SECTION 5(2)(a) CLAIM:

76. I have already found that the grounds under Section 5(2) fail in respect of the applied-for services in **Classes 35** and **42**.

77. With regard to the goods in **Class 16**, I have already found that the grounds under Section 5(2) fail in respect of respect of the applied-for *stationery; books; journals; magazines*. In the absence of any qualification to the remainder of the specified goods in Class 16, the preponderance of factors would lead to a likelihood of confusion. The opposition based on Section 5(2)(a) against Mark 4 would succeed to that extent, based on direct confusion.

78. However, all of the goods would withstand the objection under Section 5(2)(a) subject to the addition of the underlined qualification as follows:

Class 16: *Printed matter; publications; books; journals; magazines; brochures and leaflets; manuals; instructional and teaching material; stationery; <u>none of these goods concerning or in the field of retail or assembly of furniture or computer peripherals, or in the field of ergonomic workplace or Display Screen Equipment (DSE) assessments.</u>*

Conclusion in respect of Mark 3

79. The relevant factors and findings in respect of Mark 4 above largely apply to Mark 3. The only difference is that Mark 3 is for "MINDGYM WELLWORKING". Whereas Mark 3 was identical, Mark 4 is similar only to a medium degree. In my view, "MINDGYM" is a more distinctive concept and coinage than "WELLWORKING". While "MINDGYM" is a little shorter than WELLWORKING, it is also the first word in the mark and that begins the mark and plays at least an equal role in the overall impression of Mark3. The difference of the additional first word is enough to rule out rule out direct confusion – the marks will not be mistaken one for the other.

80. Is there a proper basis for a finding of indirect confusion?[19] Mark 4 contains the whole of the Earlier Mark, notwithstanding that the common element is less distinctive than "MINDGYM". "MINDGYM" is the opening word and arguably plays a greater role in the overall impression of the mark, but the longer word WELLWORKING is far from negligible, is itself a neologism and contributes significantly to the overall impression. I bear in mind the case law principle that "the overall impression created by a mark depends heavily on the dominant features of the mark, and that it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark." In my view, "MINDGYM WELLWORKING" does not read as cohesive unitary phrase, and despite the lowish distinctive character of the coinage "WELLWORKING", it *could* be considered to carry independent distinctive character. The goods and services may, on one construction, be considered to have a medium degree of similarity (at best). Given the medium similarity of marks and goods/services, and the identical common element, which is a made-up word (if not especially creative), it seems to me that in the narrow circumstance I have postulated

19 See the Court of Appeal's comments in *Liverpool Gin Distillery*, paragraph 13

for my finding of similarity of goods and services, there could be indirect confusion. However, that limited risk is again obviated by the addition of the qualification I have introduced previously, reliably separating the parties’ business areas and avoiding similarity and eliminating a likelihood of confusion.

81. **The opposition based on section 5(2)(b) against Mark 3 fails (subject to the added qualification for the applied-for goods in Class 16).**

THE SECTION 5(3) CLAIM

82. Section 5(3) of the Act provides as follows:

(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 and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.]

83. The relevant case law can be found in the following judgments of the CJEU: *General Motors*, Case C-375/97, *Intel*, Case 252/07, *Adidas-Salomon*, Case C-408/01, *L’Oréal v Bellure*, Case C-487/07, *Marks and Spencer v Interflora*, Case C-323/09, and *Environmental Manufacturing LLP v OHIM*, Case C-383/12P*.* 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'Oréal 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 proprietor 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'Oréal v Bellure).*

84. The conditions of section 5(3) are cumulative. Firstly, the Earlier Mark must be (at least) similar to the applied-for marks - this factor has been established in the present case. Secondly, the Opponent must show that its Earlier Mark had, by the Relevant Date, achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, the Opponent must establish that the public will make a link between the marks, in the sense of its marks being brought to mind by the Earlier Mark. Finally, assuming the foregoing conditions have been met, Section 5(3) requires that one or more types of damage claimed by the Opponent will occur.

85. The opposition claim under Section 5(3) is directed against all of the applied-for goods and services. Although some of the contested goods and services were set out under the Section 5(2) claim considered above, the complete list of applied-for goods and services is as follows:

Class 9: *Computer software for use in education, assessment, training, performance, and instruction, in the fields of psychology, behavioural science, and cognitive science; computer software for use in cognitive assessment and cognitive training; business information software, none being goods in relation to real estate services, construction*

*and building services, property maintenance and development services and building project management services; downloadable electronic publications in the fields of psychology, behavioural science, and cognitive science; electronic publications; all the aforesaid goods for the purposes of providing business information, training and education; materials and data in digital form for providing business information none being goods in relation to real estate services, construction and building services, property maintenance and development services and building project management services; computer software for administering and scoring personality, psychology, career, conflict management, education, leadership attitudes; downloadable or recorded computer software for providing feedback on and generating reports regarding personality, psychology, career, conflict management, education, leadership attitudes; computer software for identifying personality type; computer software for collecting, analysing and processing psychological, personality, career, leadership, personnel selection, and organizational data; software for the analysis of business information; data processing software none being goods in relation to real estate services, construction and building services, property maintenance and development services and building project management service*s.

Class 16: *Printed matter; publications; books; journals; magazines; brochures and leaflets; manuals; instructional and teaching material; stationery.*

Class 35: *Business consulting, none being services in relation to real estate services, construction and building services, property maintenance and development services and building project management services; human resources consulting; providing career information; providing advice concerning career selection and placement; psychological and personality testing and test-scoring for the selection of personnel and managers; administering and scoring tests in the field of business leadership development; provision of information in the fields of psychological and personality testing for business purposes, all via a website; preparing, administering, and scoring tests for business skills and competency; business data analysis; analysis of business data in the fields of careers, leadership and personnel; retail and online retail store services in relation to psychological and personality test instruments, and downloadable and printed materials in the fields of personality type, personality assessment,*

personality testing, personality test scoring and assessment, psychology, business, careers, leadership, organizational behaviour and growth, group dynamics, interpersonal relationships, interpersonal communication, conflict management, relationship skills, self-development, personal development, performance management, talent management, management development, team and individual development, sensitivity training, diversity and inclusion, ethics, personal effectiveness, employee engagement, employee onboarding, customer service, reorganization management, and cognitive assessments, cognitive training, cognitive fitness services; retail and online retail store services in relation to psychological and personality test instruments, and downloadable and printed materials in the fields of individual and team development, individual and team performance, team management, personnel selection, employee productivity and human resources; psychometric testing for the selection of personnel.

Class 41*: Online journals and blogs in relation to psychology, behavioural science, and cognitive science, business information, training and education, personality, career, conflict management, education, leadership attitudes; educational services, namely, providing instruction and training to business managers in the field of enhancing human thought, communication, behaviour and cognition skills; providing educational examinations in the field of enhancing human thought, human communication, behaviour and cognition skills; electronic publishing services, namely, publication of text and graphic works of others on-line for the purpose of enhancing human thought, communication, behaviour and cognition skills; provision of business training, in the fields of performance management, talent management, management development, team and individual development, sensitivity training, diversity and inclusion, ethics, personal effectiveness, employee engagement, employee onboarding, customer service, and reorganization management, cognitive assessments, cognitive training, cognitive fitness services, all via a website; editing, publishing and distribution of printed educational materials of others in the field of performance management, talent management, management development, team and individual development, sensitivity training, diversity and inclusion, ethics, personal effectiveness, employee engagement, employee onboarding, customer service, and reorganization management, cognitive assessments, cognitive training, cognitive fitness services; business training in the field*

of performance management, talent management, management development, team and individual development, sensitivity training, diversity and inclusion, ethics, personal effectiveness, employee engagement, employee onboarding, customer service, reorganization management, and cognitive assessments, cognitive training, cognitive fitness services.

Class 42: *Providing temporary use of non-downloadable computer software for administering and scoring personality, psychology, career, conflict management, education, leadership attitudes; providing temporary use of non-downloadable computer software for providing feedback on and generating reports regarding personality, psychology, career, conflict management, education, leadership attitudes; providing temporary use of non-downloadable computer software for identifying personality type; providing temporary use of non-downloadable computer software for collecting, analysing and processing psychological, personality, career, leadership, personnel selection, and organizational data.*

Class 44: *Psychological testing; providing psychological and personality testing services; administering and scoring psychological and personality tests; administering and scoring psychological and personality tests in the fields of conflict management and leadership development; providing information regarding personality type, personality assessment, personality testing, personality test scoring, personality test assessment, and psychology; psychological data analysis.*

Similarity:

86. I have already considered whether certain of the applied-for goods and services in Classes 16, 35 and 42 are similar to the services of the Opponent's Earlier Trade Mark. Similarity of goods and services is not a requirement for success under Section 5(3), but the relative distance between the respective goods and services or a lack of similarity, will be a relevant factor in determining whether a mental link arises and whether the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. Other factors will include the strength and scope of any reputation evidenced and the distinctive character of the Earlier Mark.

Reputation:

87. The Opponent claims that at the Relevant Date, the Earlier Mark had a reputation in relation to the goods and services for which it is registered in Classes 20, 35 and 37, inasmuch as it specifies in it Form TM7, the following:

Furniture; benches [furniture]; chairs [seats]; stools; desks; tables; credenzas [furniture]; pedestals; filing cabinets; shelving units; coatstands; cushions; sofas; footrests; storage furniture, storage units [furniture]; parts, fittings and accessories for all of the aforesaid goods.

Retail services relating to … computer peripheral devices, computer keyboards, mice [computer peripherals], mouse pads, mounting brackets adapted for computers; advice, information and consultancy services relating to all of the aforesaid services.

Installation services; installation, maintenance and repair of computer hardware and computer peripherals; furniture installation, maintenance and repair; office machines and equipment installation, maintenance and repair; advice,

88. I note that the goods and services stated to be relied on do not include retail of office furniture goods. As I noted at paragraph 17 above, I will direct the registry to amend the register to correct the error that removed the references to the parts of Class 35 that are underlined at paragraph 8. Since the Opponent clearly intended to invoke office furniture as part of its claimed reputation (in Class 20), I do not consider it unduly generous to the Opponent to conduct my consideration of the Section 5(3) claim on the assumption that the claimed reputation extends also to the retail of office furniture.

89. In the present case, a prerequisite to reliance on a reputation claimed for the Earlier Mark, is that it must satisfy the use conditions set out in section 6A of the Act, proof of which was requested by the Applicant. The Opponent's evidence fails, for the reasons I have previously explored, to demonstrate the required genuine use of its Earlier Mark in respect of the goods in Class 20. It is therefore unable to rely on Class 20 for the

purposes of section 5(3) of the Act, but may rely on the fair specifications for the services in Classes 35 and 37.

90. A trade mark has a reputation within the meaning of Section 5(3) if it was known to a significant part of the relevant public at the relevant date; the relevant public are those concerned by the products or services covered by the trade mark. There is no fixed percentage threshold which can be used to assess what constitutes a significant part of the public;[20] it is proportion rather than absolute numbers that matters. Reputation constitutes a knowledge threshold, to be assessed according to a combination of geographical and economic criteria. All relevant facts are to be taken into consideration when making the assessment, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.[21]

91. I will consider first the reputation claimed in respect of **Class 35:** *Retail services relating to … office furniture, computer peripheral devices, computer keyboards, mice [computer peripherals], mouse pads, mounting brackets adapted for computers; advice, information and consultancy services relating to all of the aforesaid services.*

92. The evidence does not state how any turnover from retail services divides between furniture goods and the computer peripheral goods. There are some invoices relating to both types of goods,[22] but without clearer and fuller evidence it is not possible to conclude that the Earlier Mark has any reputation for *Retail services relating to … computer peripheral devices, computer keyboards, mice [computer peripherals], mouse pads, mounting brackets adapted for computers.*

93. The evidential picture in relation to *Retail services relating to … office furniture* is a little fuller – with the positive Trustpilot reviews, more visible relevant content of the Opponent's website, and a reference in the awards evidence to "Furniture provider of the

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20 General Motors, C-375/97, EU:C:1999:408; paragraph 26

21 See, for instance, ruling of Judge Hacon in *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC (IPEC),

22 The invoices also refer to DSE assessments. While no reputation is claimed for DSE assessments in Class 42, those services presumably are part of the turnover figures, thereby further diluting the evidential contribution of the turnover figures in assessing reputation.

year" award at Mixology21. However, again, since there is no clear disaggregation of the turnover, the volume of sales of furniture under the Earlier Mark is not known, nor is the number of UK customers. I have been given no evidence on market size or of the Opponent's market share, so I cannot assess if the raw figures in the table - which range from 1.5 up to 10 million pounds in annual revenue – may be considered as total sums of a scale capable of indicating of a reputation in respect of *Retail services relating to … office furniture.* Statements referring to the Opponent as "rated *the UK's favourite* office furniture supplier" or as "one of the UK's fastest growing online suppliers of contemporary home and office furniture" are not sufficient to establish the claimed reputation and need to be substantiated by clearer evidence. It is not clear how many of the 2759 reviews were achieved by the Relevant Date and over what period of time. Based on the Opponent's submission that its retail services are directed to the general public, I do not consider the review numbers to be compelling evidence that the Earlier Mark was known to a significant part of the relevant public at the Relevant Date. In my view, the relevant public is more likely a business user, but even on that premise, given that there are large numbers of businesses in the UK, I find that it has not been robustly established that the Earlier Mark had become known to a significant part of that UK business public. The Opponent does not have a large number of outlets – just three showrooms across England and Scotland – and though it is clear that it has an online retail offering, there is no evidence of visitor numbers to the website.

94. Page 66 of Exhibit PS1 shows a copy of an advert by the Opponent with a publication date of June 2021. The Applicant makes the following legitimate criticisms: this is the only example of advertising material submitted by the Opponent. The evidence includes no advertising or promotional expenditure figures to show that how the Earlier Mark has been exploited to create or maintain a share of the market. There is also no information associated with the advert in Exhibit PS1 to show which areas of the UK the advertisement targeted, how it was distributed and how many consumers engaged with it. The copy of the advert is therefore of little probative value in relation to the Opponent's exploitation of the mark in relation to the goods and services in the UK. Pages 67 – 70 show a Wellworking Home Working Solutions brochure dated June 2020, but there is no evidence as to how the brochure was distributed or how many consumers were aware of it. The copy of the brochure again is of limited probative value in relation to the Opponent's exploitation of the mark in relation to the goods and services in the UK.

95. Taking the evidence in the round, and factoring in the notable shortcomings I have identified, I find that it is not possible to conclude that the Earlier Mark had a reputation for *Retail services relating to office furniture,* since it is not clear that the Earlier Mark was known by a significant part of the relevant public. The evidence in relation to *advice, information and consultancy services relating to all of the aforesaid retail services* is too thin to serve as a basis for a finding of reputation.

96. Turning to consider the claimed reputation in respect of **Class 37:** *Installation of computer peripherals; furniture installation, office equipment installation; advice, information and consultancy services relating to all of the aforesaid services,* I likewise find the aggregated turnover figures, very limited invoice evidence and lack of evidence of advertising do not permit a conclusion that the Earlier Mark benefits from a reputation in respect of these services.

97. Since I have found that the Opponent's evidence has failed to establish a reputation for any of its claimed goods or services, **the opposition must fail based on the Section 5(3) ground**.

98. For sake of completeness, and in case I am wrong to find no reputation, I will set out below my analysis in respect of the other components of the Section 5(3) ground. If my primary finding of no reputation is wrong, then my secondary position would be - based on the evidence of receipt of awards, invoiced sales of office furniture contributing to annual turnover figures of millions of pounds, and the Press Release evidence statement that "Wellworking has been rated the UK's favourite office furniture supplier for six years in a row by customers on the independent review platform Trustpilot"[23] - that I find that the most that could be sustained on the evidence is a modest reputation in respect of retail of office furniture among a proportion of the UK business public.

99. Proceeding on my fallback finding of a modest, limited reputation, I next consider the question of mental link. Even without a reputation, **Mark 4, may bring to mind the identical Earlier Mark to the extent that there is also similarity of goods or services**.

23 (Notwithstanding the evidence casting doubt on that statement.)

The average consumer may, in other words, make the mental link, between identical marks for similar goods or services. This simply aligns with my finding of a potential limited likelihood of confusion under the Section 5(2) claim. However, as with the Section 5(2) claim, the potential conflict would anyway be resolved by the simple addition of the qualification I set out at paragraph 78 above. (**Mark 3** – MINDGYM WELLWORKING - is not identical, though its second word is identical. I am doubtful that the relevant public would even call to mind the Earlier Mark, but this is a moot point since the Section 5(3) objection would fail for the reason I give below.)

100. Under the Section 5(2) ground, I have previously found that between the goods and services that the Opponent claimed were similar, there is no similarity, save only in respect of a limited number of the applied-for goods in Class 16 (resolved by the added qualification). **Where there is no similarity of goods or services, I find it unlikely that the applied-for Marks 3 or 4 would call to mind the Earlier Mark**. I reach this conclusion - notwithstanding that Mark 4 is identical to the Earlier Mark – taking account of (i) the distance between the Earlier Mark's reputed services (retail of office furniture) and the applied-for goods and services, (ii) the modest strength of reputation and (iii) the limited inherent distinctiveness of the Earlier Mark. The range of goods and services challenged under the Section 5(3) is wider than those challenged under Section 5(2), extending to all of the goods and services applied for. Looking across the full range of goods and services applied for, I find that none of them is similar to any of the office furniture retail services on which my reputation analysis is here premised. **My overall conclusion on mental link is therefore that the Earlier Mark may only be brought to mind by Mark 4 and only in respect of the few similar applied-for goods in Class 16**.

101. Success under Section 5(3) requires not only a reputed similar mark and a mental link, but further that the use of the contested application without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark. The statement of grounds does not elaborate how the prohibited consequences would arise in the present case, rather it essentially reiterates the wording of the statute.

102. The Applicant's submissions in lieu included the following points: "*The 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 later mark than they would otherwise have been if they had not been reminded of the earlier mark. … The Opponent is an online office supplies retailer and the Applicant operates in an entirely different sector. The Applicant's goods and services are not logical trade extensions for the Opponent's Trade Mark, so its mark will not be negatively affected, i.e. consumers will not be less likely to buy them*." I agree.

103. Mark 4 is identical to the Earlier Mark, which (in my secondary position) I am notionally affording a modest reputation for office furniture retail services, and where Mark 4 will bring to mind the Earlier Mark insofar as Mark 4 may be used for goods in Class 16 that, on one construction, I have found (absent a qualifying exclusion) may be considered to be similar in some (low) degree, based on the narrow possibility that the content of printed material such as *brochures and leaflets* is specifically concerned with offering for sale office furniture. Section 5(3) only covers detriment to the distinctiveness of the mark in relation to the categories of goods/services for which the mark is registered and has a reputation.[24] In respect of that small proportion of similar goods, I have found that there is the possibility of confusion, which may be considered a detriment to the distinctive character and a species of unfair advantage. However, the addition of the qualification set out at paragraph 78, to avert the conflict arising under Section 5(2), serves equally well to overcome this objection under Section 5(3). Beyond those similar goods, I find not only that no mental link arises, but even if the identity of the marks were enough to prompt a link, there will be no unfair advantage or detriment to the distinctive character or the repute of the Earlier Mark. This is because the distinctive character is inherently low, the reputation is modest, there will be no confusion, the goods and services are not similar and there is no plausible transfer of image likely to flow to the applied-for marks for their specified goods or services nor is any change in economic behaviour likely to arise.

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24 See R*oger Maier and Another v ASOS,* [2015] EWCA Civ 220, Kitchin L.J. (with whom Underhill L.J. agreed) at paragraphs 122 and 140.

104. **Overall conclusion on Section 5(3):** My overall finding on the Section 5(3) claim is firstly that it fails entirely for want of established reputation. Secondly, in the alternative, it can succeed only in respect of **Mark 4** and the few similar applied-for goods in Class 16. However, that potential conflict is overcome by the wording of the qualification that I have found needs to be added to the Class 16 specification for Mark 4. With respect to **Mark 3**, the Section 5(3) claim fails for lack of reputation, lack of mental link provoked by the non-identical mark, and no detriment or advantage.

THE SECTION 5(4)(a) CLAIM

105. Section 5(4)(a) of the Act provides 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 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.
>
> (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.
>
> 5A Grounds for refusal relating to only some of the goods or services
>
> 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.

Applicable principles

106. 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)."

107. **Goodwill:** The first element described in *Reckitt & Colman* refers to "goodwill or reputation", although case law has developed so as to distinguish between goodwill and "mere reputation" – the latter being insufficient alone to sustain a claim of passing off. To satisfy the first element of the tort, the Opponent is required to show that it has goodwill among UK consumers.

108. The best-known case as to the meaning of 'goodwill' is given in *IRC v Muller and Co's Margarine Limited* [1901] AC 217. At 223, Lord MacNaghten said:

"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."

109. In *Hart v Relentless Records*, Jacob J. (as he then was) stated his view that "the law of passing off does not protect a goodwill of trivial extent. …. one is looking for more than a minimal reputation."[25] This does not mean that a small business is incapable of establishing goodwill - even though its goodwill may be modest, a business can protect signs which are distinctive of that business under the law of passing off. Thus, in *Lumos Skincare Ltd v Sweet Squared Ltd*,[26] the Court of Appeal upheld a claim for passing off based on the claimant's use of the mark "LUMOS" for around three years before the defendant's use of the same mark, even though sales volumes and turnover were modest.

110. Halsbury's Laws of England Vol. 97A (2021 reissue) contains guidance on establishing the likelihood of **misrepresentation** or deception, in particular, paragraph 636, in which 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 reputation among a relevant class of persons; and
>
> (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.
>
> While it is helpful to think of these two factual elements as 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:

25 *Hart & Anor v Relentless Records* [2002] EWHC 1984 (Ch) [62]
26 [2013] EWCA Civ 590

(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."

111. The Opponent claims to have goodwill associated with the unregistered sign WELLWORKING ("**the Sign**"), which it claims have used since 2008 throughout the UK in relation to the following goods and services:

Furniture; benches [furniture]; chairs [seats]; stools; desks; tables; credenzas [furniture]; pedestals; filing cabinets; shelving units; coatstands; cushions; sofas; footrests; storage furniture, storage units [furniture]; parts, fittings and accessories for all of the aforesaid goods.
Retail services relating to … computer peripheral devices, computer keyboards, mice [computer peripherals], mouse pads, mounting brackets adapted for computers; advice, information and consultancy services relating to all of the aforesaid services.

Installation services; installation, maintenance and repair of computer hardware and computer peripherals; furniture installation, maintenance and repair; office machines and equipment installation, maintenance and repair; advice, information and consultancy services relating to all of the aforesaid services.

112. The Statement of Grounds puts the Opponent's case under Section 5(4)(a) as use of the applied-for Marks would give the Applicant "an unfair advantage by misappropriating and

misrepresenting the Opponent's goodwill and reputation which, in turn, would lead to damage and a decrease in sales and custom for the Opponent."

113. These goods and services listed above exactly reflect goods and services registered under the Earlier Mark in Classes 20, 35 and 37. The Earlier Mark is identical to the Sign and I have already considered and made findings on what the evidence of its use establishes for trade mark purposes, including reputation, goodwill, genuine use and likelihood of confusion. I see no reason at all why the Section 5(4)(a) claim would lead to increased oppositional success in the present case. It is unlikely that the difference between the legal test for likelihood of confusion under trade mark law and the test for misrepresentation under the law of passing off (deception of "a substantial number of the Claimant's customers or potential customers") will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.[27] I have rejected genuine use in respect of the furniture goods, finding genuine use only for retail services in respect of those goods. It is my view that the goodwill likewise extends only to the same retail services, rather than to the goods themselves, but even if it were the case that the goodwill attached to the Sign were in respect of the goods themselves, it would not strengthen the Opponent's position.

114. **Outcome of the Section 5(4)(a) claim**: I find that the Opposition based on Section 5(4)(a) succeeds to no greater extent than the Section 5(2) grounds, which is to say that the Applications may proceed to registration subject to the addition of the qualification set out previously.

THE SECTION 3(6) CLAIM

115. 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."

27 See Kitchin LJ in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41. See too *Soulcycle Inc v Matalan Ltd,* [2017] EWHC 496 (Ch)

116. The relevant case law on bad faith is well known. 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 Ankenaevnet 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 Mağazacilik 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)."

117. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(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?

118. It is also 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).

119. The Relevant Date is again 24 October 2022.

120. The Opponent claims that the Applications the later filed Marks 3 and 4 should be refused under Section 3(6) on the following bases:

    i. "The Opponent has been using the sign while working for 15 years and the applicant is well aware of the opponent having purchased goods from it".

    ii. "The applicant is evergreening" because the Applications for Marks 3 and 4 are identical to Marks 1 and 2 and cover identical classes.

121. As set out in its counterstatement position at paragraph 18 above, the Applicant denied the bad faith claims, referring to the parties' different fields of activity and the low distinctiveness of the Earlier Mark. A bad faith allegation is a serious allegation and the onus is on the Opponent to distinctly prove that the Applicant's Trade Marks were filed in bad faith. In its submissions in lieu, the Applicant notes that the evidence that the Applicant was aware of the Opponent prior to filing the Applications is based on an electronic contact from the Applicant's HR department exhibited to the first Witness Statement of Luke Munro,[28] and on three invoices connected to the Applicant.

122. The email is an enquiry to the Opponent's website, from October 2015, where the correspondent states that they work in the HR department (of the Applicant) and asks for

28 Page 42 Exhibit LM1

a quote for what an ergonomic assessment would cost, to assess solutions for an employee (of the Applicant) with back pain. An invoice from the Opponent, to the Applicant, in respect of a 1-1 ergonomic assessment is dated 27 October 2015.[29] A further invoice from the Opponent, to the Applicant, for an ergonomic assessment and half day DSE assessor training is dated 22 November 2019, and another invoice from the Opponent, to the Applicant, in respect of 3 mesh-back chairs with lumbar support is dated 20 December 2019.[30]

123. In its submissions in lieu, the Applicant states as follows:

"*the average number of employees employed by the Applicant has been above 200 at least since 2019. Evidence of this is exhibited in Exhibit 4 of the Witness Statement of Laura Nend. The average number of employees employed by the Applicant has increased each year and 331 were employed as of 31 March 2024. Given the size of the Opponent's business it is highly unlikely that those in the HR department would have also had an input in the brand development of the MINDGYM WELLWORKING and WELLWORKING marks. It is therefore highly unlikely that the brand development team had knowledge of the use of the Opponent's Trade Mark. The Applicant's three orders, one for office furniture and two for ergonomic assessments is not sufficient evidence to demonstrate and support a bad faith filing. The Opponent failed to prove that the two people within the HR team, who placed the orders had any involvement in the selection of the marks subject to the Applications which are selected by the marketing/legal team.*

The possibility that the Applicant could have known about the Opponent's use of the WELLWORKING mark is not sufficient for a finding of bad faith given that the Applicant had no dishonest intentions or other sinister motives at the time of filing the Applicant's Trade Marks. Its conduct did not depart from accepted standards of ethical behaviour or honest commercial and business practices. The Applicant is using its WELLWORKING mark in commerce and had no other intentions to obtain the mark for purposes other than those falling within the functions of a trade mark."

29 Page 31 of Exhibit LM1 (redacted) Invoice No. 114543.
30 Pages 32 and 33 of Exhibit LM1 (Nos 164383 and 133041 - redacted).

124. I note that the contacts between the Applicant and the Opponent took place in 2015 and at the end of 2019. The later of the dates is nearly three years before the Relevant Date. There is nothing in the timing that suggests bad faith and the applications do not appear to have been made with any suspicious haste based on those previous interactions as customers of the Opponent. Nor do I find the fact that a company with hundreds of employees had twice interacted with the Applicant (for DSE assessments and to purchase 3 lumbar-supportive chairs) to be convincing evidence that the decision within the Applicant company to apply for the contested trade marks was one taken with knowledge of the Earlier Mark, motivated by bad faith or dishonesty, or inconsistent with honest practices. That said, the Applicant will have known about the Opponent's Earlier Mark at the Relevant Date (in applying for Marks 3 and 4), since the Opponent had brought it to bear in the opposition proceedings taken against Marks 1 and 2. However, mere knowledge of another party's use or ownership of a trade mark is anyway not sufficient to establish bad faith.[31]

125. The proposed adoption of a trade mark with an inherently lowish distinctive character to use as a mark of origin in respect of the goods and services applied-for is not bad faith; the applied-for goods and services are essentially different from those under the Earlier Mark, and the level of reputation that may accrue to the Earlier Mark in respect of retail of office furniture, would not in the present case be sufficient to prevent registration of Marks 3 and 4. The claims under Section 5(2), (3) and (4)(a) have been considered. A claim of bad faith does not here overcome the lack of success under those relative grounds.

126. The second limb of the Opponent's allegation of bad faith is that the filing of Marks 3 and 4 (identical to Marks 1 and 2) constitutes evergreening.

127. In its submissions in lieu, the Applicant submits that "*evergreening is the term used to describe a trade mark proprietor refiling trade marks that are identical to previously registered marks of the same owner to circumvent the obligation after five years to provide evidence of genuine use in opposition and invalidation proceedings. The Opponent claims that the Applicant's UK Trade Mark Application Nos. 3842187*

31 *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker Case* C-320/12 and *Lindt, Koton* (paragraph 55).

WELLWORKING and 3842219 MINDGYM WELLWORKING are identical to UK Trade Mark Application Nos. 3714975 WELLWORKING and 3714978 for the mark MINDGYM WELLWORKING which amounts to evergreening, however, the Applicant submits that this cannot be the case given that the Applicant's Trade Marks are all applications. The Applicant's later applications have not been filed in bad faith on the basis of evergreening because the earlier applications were not subject to proof of use."

128. I find that the filing of Marks 3 and 4, despite their being identical in substance to applications Marks 1 and 2 a year earlier, does not amount to bad faith. While it is not ideal to have overlapping, duplicative registrations, I do not find that the Applicant's refiling the same Marks was driven by a bad intention. To the extent that Marks 1 and 2 and Marks 3 and 4 survive the opposition attacks, all four will likely become registered on the same date. Since registration is the date from which the five-year grace period begins for the purposes of demonstrating genuine use, the Applicant gains no advantage akin to evergreening as claimed by the Opponent. The Applicant likely filed the second applications (for Marks 3 and 4) in order that their registrability should be assessed in light of evidence the Opponent can provide of genuine use of its Earlier Mark. The applications for Marks 3 and 4 are in a stronger position than Marks 1 and 2 in defence of these opposition proceedings since, in the challenge to Marks 1 and 2, the Earlier Mark relied on by the Opponent is not subject to proof of use, so wields a broader base for similarity of goods and services, as I identify below. The Applicant has two pending applications, interrupted (with the Opponent's agreement) by a non-use revocation challenge by the Applicant against the Earlier Mark. I do not consider this to be evergreening, illegitimate or abusive of the trade mark system. I find no bad faith, so the opposition under Section 3(6) fails.

Oppositions against Marks 1 and 2

129. As noted at paragraph 6 above, following the Decision in respect of the Applicant's revocation action against the Opponent's Earlier Mark,[32] the tribunal invited the Opponent to review its opposition pleadings in light of the amended specification of its Earlier Mark.

32 O/0138/24 in Revocation application No. CA505250.

The Opponent filed amended Forms TM7 on 30 May 2024. Those Forms TM7 in respect of Marks 1 and 2 appear to contain possible anomalies.

130. For instance, in respect of the opposition against Mark 2 – No. 3714975 "WELLWORKING – the amended Form TM7 states the following, under the Section 5(2)(a) ground:
    - In response to Question 5, it states that **all** goods and services covered by the earlier trade mark are relied on for the opposition;
    - Question 6, asks "*Was the registration process for the earlier trade mark completed five years or more before the application date of the application you wish to oppose?*" To that question, the Opponent states "*Yes*", and then in response to Question 7 it states that the trade mark had been used in the five-year period ending on the date of application of the opposed mark for *all* of the goods and services listed at Question 5.

131. However, the filing date of Marks 1 and 2 is 27 October 2021, and the registration date of the Earlier Mark was 17 March 2017. The Earlier Mark had therefore *not* completed its registration process five years or more before the application date of the opposed applications for Marks 1 and 2. Following Decision O/0138/24, the effective date for revocation for non-use of some of the Opponent's goods and services registered under UKTM No. 3201289 was 18 March 2022. None of the goods and services registered under the Earlier Mark was therefore subject to the use provisions under Section 6A, and the Opponent could indeed rely on all of its registered goods and services as it indicated at Question 5. (I note that the Applicant's amended Form TM8 stated that it did not request proof of use of the Earlier Mark relied on for the oppositions to Marks 1 and 2, acknowledging that as a consequence the Earlier Mark may be relied upon for all the goods/services identified in the statement of use.)

132. At Question 8, the Opponent refers to Schedule 1, attached to its Form TM7, as listing which of the applied-for goods and services it claimed to be identical or similar to those covered by the Earlier Mark listed at Question 5. Schedule 1 lists precisely those applied-for goods in Class 16 and services in Classes 35 and 42 as listed in the table at paragraph 46 above, in the Section 5(2) oppositions against Marks 3 and 4.

133. At paragraph 8 of its Statement of Grounds, the Opponent presents a table of the parties' respective goods and services to be compared for similarity. For ease of reference, this is that table:

The Applications (Marks 1 and 2)	The Earlier Mark
Class 16 *Printed matter; publications; books; journals; magazines; brochures and leaflets; manuals; instructional and teaching material; stationery*. **Class 35** *retail and online retail store services in relation to psychological and personality test instruments, and downloadable and printed materials in the fields of personality type, personality assessment, personality testing, personality test scoring and assessment, psychology, business, careers, leadership, organizational behaviour and growth, group dynamics, interpersonal relationships, interpersonal communication, conflict management, relationship skills, self development, personal development, performance management, talent management, management development, team and individual development, sensitivity training, diversity and inclusion, ethics, personal effectiveness, employee engagement,*	**Class 20** *Furniture; benches [furniture]; chairs [seats]; stools; desks; tables; credenzas [furniture]; pedestals; filing cabinets; shelving units; coatstands; cushions; sofas; footrests; storage furniture, storage units [furniture]; parts, fittings and accessories for all of the aforesaid goods.* **Class 35** *Retail services relating to … computer peripheral devices, computer keyboards, mice [computer peripherals], mouse pads, mounting brackets adapted for computers; advice, information and consultancy services relating to all of the aforesaid services.* **Class 37** *Installation services; installation, maintenance and repair of computer hardware and computer peripherals;*

employee onboarding, customer service, reorganization management, and cognitive assessments, cognitive training, cognitive fitness services; retail and online retail store services in relation to psychological and personality test instruments, and downloadable and printed materials in the fields of individual and team development, individual and team performance, team management, personnel selection, employee productivity and human resources; psychometric testing for the selection of personnel. **Class 42** *Providing temporary use of non-downloadable computer software for administering and scoring personality, psychology, career, conflict management, education, leadership attitudes; providing temporary use of non downloadable computer software for providing feedback on and generating reports regarding personality, psychology, career, conflict management, education, leadership attitudes; providing temporary use of non-downloadable computer software for identifying personality type; providing temporary use of non downloadable computer software for collecting, analysing and processing psychological, personality,*	*furniture installation, maintenance and repair; office machines and equipment installation, maintenance and repair; advice, information and consultancy services relating to all of the aforesaid services.* **Class 42** *Display Screen Equipment (DSE) assessments and ergonomic workplace assessments, including provision of supporting software and related advice, information and consultancy services*.

career, leadership, personnel selection, and organizational data	

134. The Statement of Grounds reiterates that it opposes only some of the applied-for goods and services under the Section 5(2) grounds. I also note that the Applicant's counterstatements respond on the basis of the above goods and services.

135. For sake of completeness, I note that the Section 5(4)(a) ground against Marks1 and 2, based on claimed use generating goodwill and unregistered rights, is exactly as claimed against Marks 3 and 4. It opposes all applied-for goods and services and relies on claimed use of the sign in respect of (essentially) furniture, retail of computer peripherals and installation and repair services (and related consultancy).

136. **Conclusion**: While I note that the Opponent's Earlier Mark at the filing date of Marks 1 and 2 included all of the goods and services as registered pre-revocation, the preponderance of elements of Form TM7 (and taken with the evidence filed) leads me to conclude that the opposition against Marks 1 and 2 should be understood as mirroring the claims under Section 5(2) and 5(4)(a) against Marks 3 and 4. The outcomes are the same for all four opposition proceedings.

137. **OVERALL OUTCOME**: The oppositions against Marks 1, 2, 3 and 4 all fail, subject only to the addition of the underlined limitation in respect of the applied-for goods in Class 16:

Class 16: *Printed matter; publications; books; journals; magazines; brochures and leaflets; manuals; instructional and teaching material; stationery; <u>none of these goods concerning or in the field of retail or assembly of furniture or computer peripherals, or in the field of ergonomic workplace or Display Screen Equipment (DSE) assessments.</u>*

COSTS

138. The oppositions have been unsuccessful and the Applicant is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016.

The costs awarded reflect small change to the application specifications and the considerable overlap in the four oppositions.

Considering the Notices of opposition and preparing counterstatements: £400
Considering Opponent's evidence and preparing own response: £800
Submissions in lieu of hearing : £550

TOTAL £1750

43 I order WELLWORKING LIMITED to pay MIND GYM PLC the sum of £1750, to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 2 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 15th day of June 2026

Matthew Williams
For the Registrar