

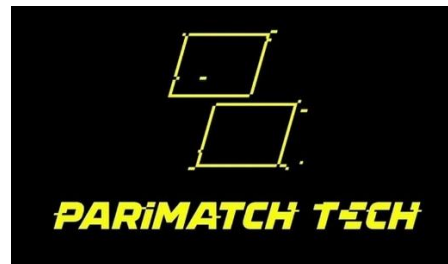
O/0575/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF INTERNATIONAL REGISTRATIONS
DESIGNATING THE UK
UNDER NOS. 1630588, 1572438, 1572953 & 1580872
IN THE NAME OF RILLIUS HOLDING LIMITED:

PARIMATCH



IN CLASS 41

AND

IN THE MATTER OF OPPOSITIONS THERETO
UNDER NOS. 431071, 432215, 432217 & 432249
BY HACHETTE FILIPACCHI PRESSE

Background and pleadings

1. These consolidated proceedings concern the international trade marks shown below, registered by Rillius Holding Limited (“the holder”), and the designation of the UK as a territory in which protection is sought under the terms of the Protocol to the Madrid Agreement.

i) **PARIMATCH**

International registration no. 1630588

International registration date: 17 August 2021

UK designation date: 17 August 2021

(“the holder’s first mark”)

The logo for PARIMATCH TECH, featuring the text "PARIMATCH TECH" in a bold, italicized, yellow font with a black outline, set against a black rectangular background.

ii)

International registration no. 1572438

International registration date: 17 August 2020

UK designation date: 15 September 2021

(“the holder’s second mark”)¹

The logo for PARIMATCH TECH, featuring two yellow-outlined geometric shapes (a parallelogram and a trapezoid) above the text "PARIMATCH TECH" in a bold, italicized, yellow font with a black outline, set against a black rectangular background.

iii)

International registration no. 1572953

International registration date: 17 August 2020

UK designation date: 15 September 2021

(“the holder’s third mark”)²

¹ The holder’s second mark claims the colours yellow, white and black.

² The holder’s third mark claims the colours yellow and black.



iv)

International registration no. 1580872

International registration date: 19 January 2021

UK designation date: 17 July 2021

("the holder's fourth mark")³

2. Protection of all four marks is sought in respect of *providing casino facilities [gambling]; gambling services* in class 41.⁴

3. On 14 February 2022 and 28 March 2022, Hachette Filipacchi Presse ("the opponent") opposed the protection of the marks in the UK. The oppositions are brought under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon its UK trade mark number 900486399, **PARIS-MATCH** ("the opponent's mark").⁵ The opponent's mark was filed on 3 January 1997 and became registered on 23 June 2000. It stands registered for a range of goods and services in classes 9, 16, 35, 38 and 41, as set out in the annex to this decision.

4. The opponent's mark qualifies as an earlier trade mark in accordance with section 6 of the Act. As it had completed its registration process more than five years before the date on which the holder designated the UK for protection, it is subject to the use requirements specified within section 6A of the Act.

5. For the purposes of the oppositions under section 5(2)(b), the opponent relies upon all its goods and services. It claims that the holder's marks are similar to its mark and that the parties' goods and services are similar. On this basis, the opponent submits

³ The holder's fourth mark claims the colours yellow and black.

⁴ Whilst the UK designations originally covered a wider range of goods and services, the specifications were restricted by a Form MM6 filed with WIPO on 6 April 2023.

⁵ The opponent's mark is a comparable trade mark based upon pre-existing EU trade mark number 486399. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the EU, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

that there is a likelihood of confusion. The opponent states that it has used its mark in relation to all its goods and services.

6. As for section 5(3), the opponent claims that its mark has a reputation in respect of *printed matter; printed matter, newspapers and periodicals, illustrated magazines, magazines* in class 16. It submits that this reputation is such that use of the holder's marks would, without due cause, take unfair advantage of, and/or be detrimental to, the repute and distinctive character of its mark. The opponent also contends that the relevant public would believe there is an economic connection between the users of the competing marks.

7. The holder filed counterstatements, denying the grounds of opposition. It denies that the parties' marks are similar, and that the parties' goods and services are similar. The holder disputes that there is a likelihood of confusion. Moreover, it denies that the opponent's mark has a reputation and that use of its marks would take unfair advantage of, or be detrimental to, the repute or distinctive character of the opponent's mark. The holder also indicated that it would require the opponent to provide proof of use.

8. On 16 September 2022, the proceedings were consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008.

9. Both parties filed evidence. A hearing was requested and held before me, by video conference, on 29 November 2023. The opponent was represented by Jerry Bridge-Butler of Barron Warren Redfern. The holder was represented by Niamh Herrett of J A Kemp LLP.

Relevance of EU law

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated

law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

11. The opponent's evidence is given in the witness statement of Céline Coevoet dated 3 October 2022 and 20 exhibits (CC1-CC20). Ms Coevoet is Trademark Legal Manager at the opponent. She gives evidence as to use and reputation of the opponent's mark.

12. The opponent also filed the witness statements of Scott Tatchell and Heather Yesson, dated 15 November 2022 and 16 November 2022, respectively. Mr Tatchell's statement was filed along with two exhibits (ST1-ST2), whilst Ms Yesson's was filed with nine (HY1-HY9). Mr Tatchell and Ms Yesson are both translators who have produced English versions of French-language documents in Ms Coevoet's evidence.

13. The opponent's evidence was accompanied by written submissions dated 16 November 2022.

14. The holder's evidence is given in the witness statement of Thomas Webb dated 16 January 2023 and six exhibits (TAW1-TAW6). Mr Webb is a Trade Mark Attorney with the holder's professional representatives. His evidence broadly goes to use of the parties' marks and the pronunciation of the word 'Paris'.

15. In reply, the opponent filed a second witness statement from Ms Coevoet, dated 14 March 2023, as well as a witness statement from Dominic Watt, dated 15 March 2023. Ms Coevoet's evidence in reply is accompanied by one exhibit (CC21). Professor Watt's statement is accompanied by four (DW1-DW4). He is, *inter alia*, an Honorary Professor in Linguistics at the University of York. Their evidence responds to the point about the pronunciation of the word 'Paris'.

16. The opponent also filed further written submissions dated 15 March 2023.

17. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

Proof of use

18. As noted above, the opponent originally claimed that it had used its mark in relation to all its goods and services. However, within its written submissions dated 16 November 2022, the opponent narrowed this claim to the following goods and services:

Class 16: Printed matter; printed matter, newspapers and periodicals, illustrated magazines, magazines.

Class 35: Advertising; dissemination of advertising matter; subscription to all news, written, audio and/or visual media, among other, subscriptions to newspapers and magazines.

Class 41: Publication of texts, illustrations, magazines, newspapers and periodicals.

19. In her skeleton argument, Ms Herrett conceded on behalf of the holder that use had been proven in respect of these goods and services. As it is not in dispute, I will proceed on the basis that genuine use has been demonstrated by the opponent and adopt these goods and services as a fair specification.

Section 5(2)(b)

Legislation and case law

20. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because -

[...]

(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.”

21. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 be dominated by one or more of its components;

(f) however, it is also 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 great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods and services

22. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary.”

23. Furthermore, the relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity between goods and services also include an assessment as to the respective users and trade channels.

24. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court stated that “complementary” means:

“[...] 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.”

25. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/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.”

26. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J (as he then was) stated that:

"[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. 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 in question."

27. The goods and services to be compared are as follows:

The opponent's goods and services	The holder's services
Class 16: Printed matter; printed matter, newspapers and periodicals, illustrated magazines, magazines.	Class 41: Providing casino facilities [gambling]; gambling services
Class 35: Advertising; dissemination of advertising matter; subscription to all news, written, audio and/or visual media, among other, subscriptions to newspapers and magazines.	
Class 41: Publication of texts, illustrations, magazines, newspapers and periodicals.	

Providing casino facilities [gambling]

28. Clearly, these services differ in nature and method of use when compared with the opponent's goods and services. Whilst I agree with Mr Bridge-Butler to the extent that they share an element of entertainment, in my view that is far too general to conclude that the respective goods and services overlap in intended purpose. The holder's services are for providing facilities within which consumers engage with casino games and gamble. None of the opponent's goods or services is for that purpose. For instance, printed materials are for imparting information to the reader, advertising is for raising awareness of a business or product, and publication services are for bringing materials to market so that they may be read. Mr Bridge-Butler argued that the respective goods and services reach the market through the same, or similar, trade channels, citing Sky as an example of an undertaking which provides some of the opponent's goods and services as well as casino-type facilities. However, I note that the opponent has provided no evidence to demonstrate that this is typical in trade. Moreover, Sky is a very large undertaking that is engaged in many diverse commercial activities. I do not consider this sufficient to establish that the respective goods and services share trade channels. In the absence of any evidence, it is my view that the providers of casino facilities are unlikely to offer any of the goods and services relied upon by the opponent, or vice versa. Mr Bridge-Butler also submitted that there is "an established link" between advertising and casino facilities. Whilst operators of casinos may wish to advertise their services, there is no evidence which establishes that advertisers offer casino facilities, or operators of casinos offer advertising services to third parties. In the absence of such evidence, I am of the view that they are not ordinarily offered by the same undertakings and reach the market through discrete trade channels. At the hearing, Mr Bridge-Butler also highlighted that consumers may access their news and sports coverage through their mobile phones or tablets, where they may also have gambling applications. I do not dispute that consumers may have news and gambling applications on their phones. However, this does not assist the opponent, since it does not have protection for the provision of news or any software applications. Mr Bridge-Butler's submission appeared to be predicated on conflating printed matter such as magazines (and related subscription/publication services) with the news in a more abstract way. There is no competition between the goods and services. Further, they are not important or indispensable to the use of one another

and, as such, are not complementary. I agree with Mr Bridge-Butler insofar as users of the respective goods and services may be the same or overlap. However, this factor alone is not sufficient to engage any overall similarity between them. In light of all this, I find that the respective goods and services are dissimilar.

Gambling services

29. Again, there are fundamental differences in nature between the holder's service and the opponent's goods and services. Mr Bridge-Butler considered there to be an overlap in terms of their interaction with the same real-world events. For instance, he highlighted that gambling relates to sports and news events which are covered by printed publications. However, that cannot be sufficient for determining that there is any material overlap between them. If it was, that would result in printed publications sharing a nature with any event or topic they cover. The respective goods and services also have different methods of use and intended purposes. Again, any shared element of entertainment is, in my view, far too general. As for trade channels, Mr Bridge-Butler submitted that the respective goods and services are provided on the same platforms under the same brands, such as Sky, Virgin and MGM. However, no evidence of this has been filed by the opponent. Even if I were to take judicial notice of the fact, the argument appeared to be based on those undertakings providing the news in addition to gambling services. As outlined above, the opponent does not have protection for the provision of news. Therefore, this argument does little to assist the opponent. In the absence of evidence, it is considered that the respective goods and services will reach the market through different trade channels. It is, in my view, unlikely that the providers of gambling services will offer the opponent's goods and services; it is also unlikely that, for instance, the producer/publisher of a magazine will also offer gambling services. Mr Bridge-Butler also argued that there was a link between gambling and advertising services because offering advertising space in a magazine is comparable to an undertaking offering advertising through a gambling software application. However, this strikes me as a comparison between advertising services through two different mediums, rather than between advertising and gambling services. This argument does little to establish that advertisers offer gambling services, or vice versa. In any event, there is no evidence that providers of gambling services typically offer advertising through their software applications. The respective

goods and services are not in competition. Mr Bridge-Butler submitted that the opponent's goods and services and gambling on sports and news events are complementary, since if you are gambling on the outcome of an event, you will need to know the outcome. In this connection, he also submitted that you would need to follow what is happening to effectively gamble. Again, this argument appears to be predicated on conflating the opponent's goods and services with the news/events in a more abstract sense. Whilst the occurrence of events, sporting occasions and the like are necessary to being able to gamble on their outcomes, that does not mean that producing a magazine about, say, sports is indispensable, or even important, to the provision of gambling services. To my mind, none of the opponent's goods or services is important or indispensable to the holder's services, or vice versa. They can operate entirely separately from one another. As such, I disagree that they are complementary. I agree with Mr Bridge-Butler that users of the respective goods and services may overlap to the extent that they may be used by members of the general public with an interest in the outcome of news and sports events. However, I do not consider that to be sufficient, particularly in the absence of any other material points of overlap, to give rise to any overall similarity between the respective goods and services. Taking all of the above into account, I find that they are dissimilar.

30. I should add that Mr Bridge-Butler's argument that printed publications often contain games and puzzles has not persuaded me otherwise. This was not raised as a point going to any particular factor of similarity. Rather, Mr Bridge-Butler simply argued that this added additional weight to the opponent's claim of similarity. I disagree. Firstly, the holder is not seeking protection of its marks for games and puzzles of this nature. In addition, it is my understanding that games and puzzles which commonly appear in magazines and newspapers (such as crosswords, sudoku and the like) do not tend to be for gambling purposes and could not fairly be described as such. Therefore, I fail to see how the presence of such activities in printed publications would give rise to any material similarity with gambling services.

31. Some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of

confusion to be considered.⁶ My findings above mean that the oppositions under this ground must fail.

Conclusion

32. The opponent's claims under section 5(2)(b) of the Act are dismissed.

Section 5(3)

Legislation and case law

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

“(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”.

34. Section 5(3A) states:

“(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”.

⁶ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

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

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that

this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

36. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its mark is similar to the holder's marks. Secondly, the opponent must show that its mark has 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 mark being brought to mind by the holder's marks. Fourthly, assuming the foregoing conditions have been met, section 5(3) requires that one or more types of damage claimed by the opponent will occur. It is not necessary for the purposes of section 5(3) that the goods or services are similar, although the

relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

37. The relevant dates for the assessment under this ground are the dates upon which the holder designated the UK for protection of its international registrations, those being 17 July 2021 (the holder's fourth mark), 17 August 2021 (the holder's second and third marks), and 15 September 2021 (the holder's first mark).

Reputation

38. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, 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.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

39. At the hearing, there was some disagreement as to how a reputation ought to be assessed following the UK's exit from the EU. Whilst I acknowledge Mr Bridge-Butler

and Ms Herrett's submissions, I wish to clarify the position. Paragraph 10 of Part 1, Schedule 2A of the Act reads as follows:

"10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day [31 December 2020], references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union."

40. The effect of these provisions is that, when considering whether the opponent has established that its comparable mark has a reputation, evidence of use in the EU until IP completion day is to be taken into account. Thereafter, any continuing reputation of the comparable mark is to be based upon use of the mark in the UK.⁷ The fact that the relevant dates fall after IP completion day does mean that I must only consider UK use; use in the EU can still be relied upon for any time up until 31 December 2020.

41. I also note that the opponent has provided three decisions from French courts which state that 'PARIS MATCH' is famous in France.⁸ While I acknowledge the contents of these decisions, it suffices to say that they are not relevant to the present proceedings. It is well established that previous decisions of courts in other jurisdictions are not binding on the Registrar. I must base my assessment of whether the opponent's mark has a reputation upon the evidence before me, not upon conclusions reached by other courts.

⁷ For further information, see article 54 of the Withdrawal agreement and Tribunal Practice Notice 2/2020.

⁸ Exhibit CC20

42. Turning to the evidence, Ms Coevoet states that 'PARIS MATCH' is a news magazine, covering major national and international events, as well as other topics such as culture, celebrities, politics, design, lifestyle, health and games. She says that the magazine was founded in 1949. A copy of the cover page of the first issue of 'PARIS MATCH' is in evidence.⁹ It is dated 25 March 1949. Further copies of magazine cover pages from each decade between the 1950s and the 2010s, and translations thereof, have been provided; I also note the cover page of the 70-year anniversary edition from March 2019, as well as the cover pages of the August 2020 and April 2021 editions.¹⁰ The mark is consistently presented throughout as follows:¹¹



43. According to Ms Coevoet, the opponent's mark is used across France. The magazine is also exported to other countries. She provides circulation figures for the magazine, in numbers of copies, as well as reports from OJD (an independent certifying organisation for publications) and Presstails dated between 2013 and 2019.¹² The documents are in French but can be understood when read in conjunction with the translations.¹³ Based upon the sum of this evidence, I note that the magazine achieved the following circulation figures:

⁹ Exhibits CC3 and HY2

¹⁰ Exhibits CC4, CC5, CC6, CC7, HY2, HY4 and HY6

¹¹ With the exception of the first (March 1949) issue, which is presented in the same format but with the word 'PARIS' in red, the word 'MATCH' in black and a white/grey background.

¹² Exhibits CC8 and CC9

¹³ Exhibits ST1 and HY5

Year	France	Other EU	UK	UK Turnover (€)
2013	30,828,594	-	-	-
2014	30,379,946	-	-	-
2015	29,172,533	438,109	58,184	71,447.47
2016	27,825,441	387,008	43,842	59,905.26
2017	28,400,262	397,368	39,246	44,194.78
2018	27,810,918	341,925	30,803	36,182.20
2019	26,971,057	323,695	36,979	39,341.95
Total	201,388,751	1,888,105	209,054	251,071.66

44. I note that Mr Webb, for the holder, provides evidence that the magazine is available in the UK via Newsstand.¹⁴ In the printouts, the website claims to be the only online outlet in the UK where you can purchase the magazine. However, the printouts are from January 2023 and, therefore, do not show the position at the relevant dates. In any event, Ms Coevoet provides evidence of physical outlets in the UK that were selling 'PARIS MATCH' magazine on 1 April 2020.¹⁵ This shows that the magazine was available to purchase in multiple locations across the UK before the relevant dates, including London, Norwich, Surrey, Chester, Derby, Leeds, Manchester, Newcastle, Cornwall, Cumbria, Cardiff, Newport, Swansea, Edinburgh and Aberdeen.

45. There are media packs 2017, 2018 and 2019,¹⁶ which contain various figures from independent organisations. For example, the magazine had an 85% brand awareness in France in 2016. In addition, it was the number one magazine in terms of circulation and reach in France that year. In 2017 and 2018, 'PARIS MATCH' had a readership of over 3.5million. The 'PARIS MATCH' website (launched in 1996) had over 1.4million unique visitors and over 23million pages viewed in 2016. This rose to over 5.5million and 33million, respectively, in 2017. In 2019, it had around 4million unique visitors and 18million pages viewed. As for social media, the magazine's Facebook and Twitter

¹⁴ Exhibit TAW4

¹⁵ Exhibit CC21

¹⁶ Exhibit CC10

pages both had over 1.2million likes/followers in 2017 and 2020; its Instagram page had over 170,000 followers in 2017 and over 300,000 in 2020.

46. Ms Coevoet says that the magazine has been used as a cultural reference in books, television shows and films. In this connection, she provides extracts from a book entitled *Agatha Raisin and the Dead Ringer*.¹⁷ It was first published in the UK in 2018. One of the characters in the book says, “I heard all the press were here from Japan to *Paris Match*”. The author, MC Beaton, is referred to as an international bestseller. Ms Coevoet says that they have sold more than 20million books, globally, though the source of this information is not clear. Ms Coevoet also says that the magazine featured in an episode of the Netflix series *The Queen’s Gambit*. A still image from the series is provided, in which the subtitles are displayed.¹⁸ ‘PARIS MATCH’ is mentioned by a character along with other press outlets. An online article from *Wondrium Daily*, published on 12 December 2020, says that the series received 62million viewers within the first four weeks of its release.¹⁹ I note that this is a global figure. Further, a scene in the film *Elvis* featured an image of the magazine.²⁰ However, Ms Coevoet says that the film was not released until June 2022. Although filming would have logically occurred prior to that time, this means that any consumer exposure to the opponent’s mark through watching the film would not have occurred until after the relevant dates.

47. Ms Coevoet states that a company called Meilland Richardier has, with the opponent’s authorisation, given the name ‘PARIS MATCH’ to a rose sold in France and other countries. She says that the roses are named after famous people and events. Catalogues of roses from 2004/05, 2008/09 and 2015/16 are in evidence,²¹ as well as English translations.²² A variety of rose named ‘PARIS MATCH’ can clearly be seen in each, alongside other rose varieties such as the ‘Queen Elizabeth’, the ‘ELLE’, and the ‘PARIS D’YVES SAINT LAURENT’.

¹⁷ Exhibit CC12

¹⁸ Exhibit CC13

¹⁹ Exhibit CC13

²⁰ Exhibit CC14

²¹ Exhibit CC15

²² Exhibit HY1

48. According to Ms Coevoet, the magazine is part-financed through advertising. Sample invoices sent to third parties in France and Germany between 2016 and 2020 have been provided.²³ The invoices are in French, but when read in conjunction the English translations,²⁴ they clearly relate to the provision of advertising space within issues of 'PARIS MATCH'. Examples of adverts within the magazine between 2016 and 2020 are also in evidence.²⁵ Brands being advertised in the magazine include Dior, Seat, Schweppes, Mercedes, TUI, Omega, Tissot, Fiat, Lindt, Nutella, Louis Vuitton, Moët & Chandon, Peugeot, iPhone, Lexus and Nespresso.

49. The opponent is said to be active in the entertainment field, having operated a television channel under the name 'MATCH TV' between December 2001 and August 2005. In June 2005, the channel is said to have had an audience in excess of 8million. An extract from an article in the French magazine *Tele Star* and its translation are in evidence.²⁶ Under cable and satellite highlights, 'Match TV' is listed at 7pm on 10 December (no year given). Ms Coevoet says that a weekly radio programme is broadcast on the channel RFM under the name 'La Minute Match +'. I note that reference is made to the programme within an issue of the magazine from 2020.²⁷ Since 2003, the opponent has organised a photography competition for students from French universities.²⁸ An article from Spéos dated 16 July 2019 states that 80,000 candidates entered that year, the 16th edition of the competition.²⁹

50. Finally, I note that 'PARIS MATCH' was awarded Magazine of the Year and Best Investigation by the French Association of Magazine Publishers in 2020.³⁰

51. There is no evidence of the market share held by products sold under the opponent's mark in the EU. Moreover, the opponent has not provided any turnover figures or any information regarding the amounts it has invested in promoting its mark. However, the evidence establishes that a weekly magazine has been published under

²³ Exhibit CC16

²⁴ Exhibit ST2

²⁵ Exhibit CC17

²⁶ Exhibits CC18 and HY9

²⁷ Exhibit CC7

²⁸ Whilst Ms Coevoet says that the competitions are also open to students from foreign universities "if it exists an [sic] agreement with a French one", this has not been explained.

²⁹ Exhibit CC19

³⁰ Exhibit CC11 and HY7

the opponent's mark since 1949. The magazine has been published regularly in every subsequent decade. Therefore, I consider that use of the mark has been intense and longstanding. The opponent's evidence establishes that it had a circulation of more than 200million in France between 2013 and 2019, the lowest annual figure being nearly 30million. Even without any specific market information, these figures are clearly significant. The evidence suggests that the magazine has been successful in France, receiving two awards in 2020 including magazine of the year. The magazine's website had millions of unique visitors prior to the relevant dates, and some of its social media pages had over 1million likes/followers. Whilst these are both global figures, meaning I cannot be certain where the internet users were based, given the overall picture created by the evidence, it is likely that a significant number of them would have been French. Further, although I do not place an undue amount of weight on it because the viewer figures have not been broken down by territory, the opponent's mark featured in a popular Netflix series before the relevant date. A variety of rose has also been named after the opponent's mark by a third party, along with other famous brands. The magazine has been used by some large, reputable brands to advertise their goods/services. As noted previously, the opponent's mark has been used in conjunction with an annual photography competition, in its 16th edition in 2019; the competition that year had 80,000 entries. Taking the evidential picture as a whole into account, particularly the evidence from before IP completion day, I am satisfied that the opponent has demonstrated that its mark had a strong reputation in France at the relevant dates in respect of *magazines*. That reputation does not extend to any of the other goods relied upon by the opponent because there is no evidence of any other kinds of printed matter being produced in connection with the opponent's mark. Rather, the evidence is limited to magazines. For the avoidance of doubt, I consider France to constitute a substantial part of the EU.

52. The evidence of use in respect of the UK is much more limited. Ms Coevoet's evidence shows that the magazine was available in a large number of outlets across the UK. However, the magazine had a circulation of just under 210,000 between 2015 and 2019, with a turnover of around €250,000. The highest annual figure was around 58,000 copies for around €71,000. No details of the magazine market in this territory have been provided by the opponent, and there is no evidence of its share of the same. Whilst the figures are not insignificant, evidence has been provided by the holder that

other UK magazines achieved a circulation of tens/hundreds of thousands per issue in 2021.³¹ This supports my impression that, whilst perhaps reducing since the advent of digital publications, the market for magazines in the UK remains very large. In this context, the annual figures provided by the opponent (which represent the cumulative total of all weekly issues each year, rather than per issue) are modest. In addition, no turnover figures for the UK have been provided, nor any evidence regarding amounts spent on promoting the opponent's mark in the UK. Moreover, the opponent has not provided any information relating to website users or social media followers from the UK. Whilst a book which references 'PARIS MATCH' was published in the UK before the relevant dates, no information about sales of that book in the UK have been provided. The other evidence previously discussed either focuses on the French market or is global in nature, i.e. it is not specific to the UK. Taking all of this into account, I conclude that the opponent's mark does not have a reputation in the UK.

Link

53. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take into account all relevant factors. The factors are identified in *Intel* at paragraph 42. I will take these in turn.

The degree of similarity between the conflicting marks

Overall impressions

54. The opponent's mark consists of the words 'PARIS-MATCH' with no other elements. Although the words are joined through the use of a hyphen, it is my view that they will still both be identified and perceived as separate elements. The word 'MATCH' is more distinctive and plays a greater role in the overall impression, whereas the word 'PARIS' plays a lesser role.

³¹ Exhibit TAW5; Albeit I bear in mind that the figures include sales in the Republic of Ireland as well as the UK.

55. The holder's first mark consists of the word 'PARIMATCH' presented in an ordinary, black font on a white background. The word dominates the overall impression of the mark, whilst the font and colours are likely to go unnoticed.

56. The holder's second mark comprises the words 'PARiMATCH TECH' in a slightly stylised font. The words are presented in yellow and white. The background is black. The word 'PARiMATCH' appears at the beginning of the mark and is more distinctive than the word 'TECH'. As such, it is my view that the former is more dominant in the overall impression, whereas the latter plays a lesser role. The font and colours play a much lesser role as they are likely to be perceived as decorative.

57. The holder's third mark is figurative and consists of the words 'PARiMATCH TECH' below two parallelogram devices. These elements are presented in yellow. The background is black. The word 'PARiMATCH' is the first and most distinctive of the words. Therefore, I am of the view that it is more dominant in the overall impression, whereas the word 'TECH' plays a lesser role. The devices, font and colours play a much lesser role as they are likely to be seen as decorative embellishments.

58. The holder's fourth mark is figurative and comprises the words 'PARI MATCH'. The words are presented in an ordinary font, except for the letters 'P' and 'M' which are elongated. The words dominate the overall impression of the mark, with the word 'PARI' being the most dominant. The stylisation and colours still contribute, though play much lesser roles.

Visual comparisons

59. The holder's first mark and the opponent's mark are visually similar because they share nine letters in the same order, i.e. 'PARI-MATCH'. The respective beginnings and ends of the marks are identical. I do not consider the font used in the holder's mark to constitute a significant point of difference, since the registration of word-only marks (such as the opponent's mark) provides protection for use of the words in any font type (such as that used in the holder's mark). The competing marks are visually different insofar as the opponent's mark contains an additional letter, i.e. 'S', and a hyphen. These characters are not replicated in the holder's mark. However, this

difference appears in the middle of the marks. Bearing in mind my assessment of the overall impressions, I find that there is a high degree of visual similarity between the competing marks.

60. The holder's second mark and the opponent's mark share the same visual similarities and differences as described in paragraph 54. However, these marks have additional differences in the form of the word 'TECH', the stylisation and colours present in the holder's mark. Overall, I find that there is between a medium and high degree of visual similarity between the competing marks.

61. Again, the holder's third mark and the opponent's mark share the same visual similarities and differences as described in paragraph 54. There are, however, additional differences: the holder's mark contains the word 'TECH', stylisation, colours, and parallelogram devices, all of which are absent from the opponent's mark. All in all, I consider there to be a medium degree of visual similarity between the competing marks.

62. The holder's fourth mark and the opponent's mark share the visual similarities and differences outlined at paragraph 54. The stylisation and colours constitute additional points of visual difference. Nevertheless, bearing in mind my assessment of the overall impressions, I find that there is between a medium and high degree of visual similarity between the marks.

Aural comparisons

63. I note that, within his witness statement, Professor Watt comments upon the likely pronunciation of the word 'Paris' amongst members of the public. Given the content of the statement, his qualifications and his experience, it is clearly intended to be expert evidence. However, no permission was sought by the opponent to file such evidence. Moreover, there is usually little need for an expert to give their opinion as to how a word will be pronounced by consumers. Therefore, I would be inclined to attribute very little weight to Professor Watt's evidence.

64. However, even without placing any reliance on Professor's Watt's evidence, the other evidence filed in these proceedings demonstrates that the opponent's goods are French-language magazines. Even those sold in the UK appear to be in French; there is no evidence that they are translated into English for this market. Whilst I agree with the applicant that the average UK consumer will, by and large, pronounce 'Paris' with the 's' sound at the end,³² it is highly likely that purchasers of French-language magazines will be Francophones. They may even be French ex-pats.

65. As such, I consider that a section of the relevant public may articulate the word 'Paris' in the French style, i.e. without the 's' sound. Consequently, I find that there will be a section of the relevant public who pronounce the following verbal elements in the competing marks identically: 'PARIMATCH', 'PARiMATCH', 'PARI MATCH' and 'PARIS-MATCH'.

66. The holder's first and fourth marks, having no other verbal elements, will be pronounced as "PA-REE-MATCH". The opponent's mark may be pronounced as "PA-RIS-MATCH" or "PA-REE-MATCH", resulting in the competing marks being either highly similar or identical from an aural perspective.

67. The holder's second and third marks also contain the word 'TECH' and, in the case of the holder's third mark, parallelogram devices. Consumers will make no attempt to articulate the devices. As such, the holder's marks will be pronounced "PA-REE-MATCH-TEK". Again, the opponent's mark may be pronounced as "PA-RIS-MATCH" or "PA-REE-MATCH". If the former, I find that there is between a medium and high degree of aural similarity between the competing marks. If the latter, the competing marks are highly similar.

Conceptual comparisons

68. The word 'PARIS' in the opponent's mark will be understood as a reference to the capital city of France. The word 'MATCH' has a number of meanings. Of those, the

³² Such as is suggested in the extract from the Cambridge Advanced Learner's Dictionary & Thesaurus in Exhibit TAW6 (the word 'Paris' being pronounced in British English as "/pær.ɪs/").

most likely interpretations, in my view, will be either a sports competition or event in which two people or teams compete against each other, or something that is suitable for or equal to something else.

69. The word 'PARIMATCH' in the holder's first mark is an invented word with no recognised meaning. However, notwithstanding the established principle that consumers normally perceive a trade mark as a whole, consumers will break down the mark into verbal elements which suggest a concrete meaning or resemble words known to them.³³ In this connection, it is my view that, the presence of the sequence 'MATCH' renders the word evocative of either a sports competition or event in which two people or teams compete against each other, or something that is suitable for or equal to something else.

70. The word in the holder's fourth mark is clearly separated, i.e. 'PARI MATCH', but this has no impact; this mark conveys the same concept as the holder's first mark. This is because the word 'PARI' has no recognised meaning and is, therefore, conceptually neutral, whilst the word 'MATCH' will be attributed one of the meanings already mentioned.

71. The word 'PARiMATCH' in the holder's second and third marks conveys the same meaning as the holder's first and second marks, i.e. that associated with the word 'MATCH'. However, these marks also include the word 'TECH', which will be understood as an abbreviation for technical or technology.³⁴

72. The opponent's mark and the holder's first and fourth marks conceptually overlap to the extent that they convey the meaning of the word 'MATCH'. They differ insofar as the opponent's mark also brings to mind the capital of France. Overall, I find that there is a medium degree of conceptual similarity between the competing marks.

73. The opponent's mark and the holder's second and third marks share the same similarities and differences. However, the latter also convey the meaning associated

³³ *Usinor SA v OHIM*, Case T-189/05

³⁴ The parallelogram devices in the holder's third mark have no semantic content over and above their existence as simple geometric shapes.

with the abbreviation 'TECH'. As a result, there is between a low and medium degree of conceptual similarity between the competing marks.

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

74. I have found that the reputed *magazines* are dissimilar to the holder's *providing casino facilities [gambling]; gambling services*. Whilst I accept that dissimilarity is a relative concept, I consider there to be considerable distance between the respective goods and services. They are in entirely different industries and there is no material overlap between them. It is my view that a connection premised upon publications covering events, and individuals gambling on their outcomes, is tenuous and superficial.

75. The goods and services at issue are available to the general public, including individuals in the UK that speak French. The holder's services will only be purchased by those over the age of 18. The goods and services are likely to be purchased at varying degrees of frequency; some individuals may only purchase magazines or gamble occasionally, whilst others may do so often. The purchasing process is unlikely to be merely casual. Consumers are likely to consider factors such as cost, content and editorial stance when purchasing magazines, whereas consumers are likely to consider factors such as odds, ease of use and the range of events/games offered when purchasing gambling services. In my view, consumers are likely to demonstrate a medium level of attention during the purchasing of the goods and services. Magazines are typically purchased from retailers and their online equivalents, after perusing shelves or after viewing information on websites. Gambling services are available through dedicated outlets, establishments such as casinos and arcades, and their online equivalents. They will be purchased after viewing signage on the high street or information on websites. Overall, it is my view that the purchasing process is predominantly visual in nature. However, aural considerations are not excluded entirely, since consumers may receive word-of-mouth recommendations or wish to discuss the goods or services with the provider.

The strength of the earlier mark's reputation

76. I have found that the opponent's mark has a strong reputation in the EU. I have found that the opponent's mark does not have a reputation in the UK.

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

77. The opponent's mark consists of the words 'PARIS-MATCH' with no other elements. Although the words are joined through the use of a hyphen, they will both be readily identified. The word 'PARIS' will be recognised as the capital city of France. It is likely to be perceived as a reference to the geographic location of the magazine, or its editorial focus. The word 'MATCH' is an ordinary dictionary word, the meanings of which have been outlined previously. It is considered that the word 'MATCH', having no unambiguous descriptive or allusive connection with the reputed goods, is more distinctive than the word 'PARIS'. Overall, I find that the opponent's mark possesses no more than a medium level of inherent distinctive character.

78. Although I have found that the opponent's mark has a reputation in the EU through its activities in France, an assessment of enhanced distinctive character is one which focuses on how strongly a mark indicates to consumers in the UK that goods or services originate from a particular undertaking. I have found that the opponent's mark does not have a reputation in this jurisdiction. For the same reasons given at paragraph 47, I conclude that the distinctiveness of the opponent's mark had not been enhanced through use at the relevant dates.

Whether there is a likelihood of confusion

79. As explained previously, some degree of similarity between goods or services is necessary to engage the test for likelihood of confusion. Given that I have found the respective goods and services to be dissimilar, I conclude that there would be no confusion. I acknowledge that the provisions of section 5(3) offer additional protection which takes into account the repute and distinctiveness of earlier trade marks. However, in the circumstances, I do not believe that the relevant public would be

caused to believe that the user of the holder's marks for dissimilar goods is economically connected to the user of the opponent's mark.

Conclusions on link

80. In *China Construction Bank Corporation v Groupement Des Cartes Bancaires*, BL O/281/14, Mr Iain Purvis QC, sitting as the Appointed Person, stated:

“40. [...] I believe that the ultimate decision under s5(3) was nonetheless correct. In order to succeed under s5(3), the opponent has to show either that the distinctive character or repute of its earlier mark would be damaged by reasonable and fair use of the mark applied for, or that such reasonable and fair use would take unfair advantage of the reputation of its earlier mark. The reasonable and fair use of the mark applied for can only be use in the United Kingdom, since this is the entire territorial scope of the application.

41. If the reputation of the earlier mark does not extend to the United Kingdom, it is difficult to see how (at least in the usual case) it could be damaged by use of a mark in the United Kingdom, or that such use could be said to take unfair advantage of the earlier mark. For one thing, the necessary ‘link’ between the marks in the mind of the average consumer which must be established in any case which relies on the extended protection (see *Adidas-Saloman v Fitnessworld* [2004] ETMR 10) would not exist. There is certainly no evidence in the present case which explains how any ‘link’ could be made in the UK absent of a reputation here.”

81. The opponent has demonstrated that its mark has a strong reputation in France. Although there is evidence that goes to the UK market, I have explained that this is not sufficient for establishing a reputation in this territory. The opponent has not provided any (or adequate) explanation as to how a link could be made in the mind of UK consumers, absent such a reputation existing here. Consequently, the opponent's claims under this ground are dismissed.

82. Even if the evidence was sufficient for the purpose of showing a qualifying reputation in the UK, taking all the above factors into account, I do not consider it likely that a link would be made in the mind of the relevant public, notwithstanding the overall levels of similarity between the competing marks. This is because the reputed goods and the services for which protection of the holder's marks is sought are sufficiently distant to avoid a link being made. This is particularly the case, given that the reputation could only be characterised as weak on the basis of the (UK-related) evidence before me.

83. If a link was made, given the disparity between the respective goods and services, it is unlikely to be more than fleeting. It would be unlikely to cause any change in economic behaviour. I cannot see any reason why the holder (offering gambling services) would receive any advantage through use of its marks, let alone an unfair one. Neither would use of the holder's marks for entirely different services have any negative effect on the opponent's mark. Moreover, although gambling as an activity is not immune from certain issues such as addiction, that is hardly exclusive to gambling, and there is nothing inherent in gambling services which is likely to cause a particularly strong negative reaction.

Conclusion

84. The opponent's claims under section 5(3) of the Act are dismissed.

Overall outcome

85. The oppositions under sections 5(2)(b) and 5(3) of the Act have failed. Subject to any appeal against my decision, the holder's marks will become protected in the UK.

Costs

86. As the holder has been successful, it is entitled to a contribution towards its costs. At the hearing, I indicated that this would be awarded by reference to the published scale. As these proceedings commenced after 1 July 2016 but before 1 February 2023, the relevant scale is that published in Tribunal Practice Notice 2/2016.

87. Mr Bridge-Butler submitted that the opponent has “done all the running” in these proceedings and that the holder waited until shortly before the hearing to file its reasoned arguments. Mr Bridge-Butler essentially argued that the opponent has done more work in these proceedings, and this ought to be taken into account regardless of which party is awarded costs.

88. As Ms Herrett submitted, it is for the opponent to prove its case. The evidential burden for proving certain facts which may support its claims falls on the opponent. Therefore, it would be hardly surprising if the opponent had “done all the running”. Moreover, I agree with Ms Herrett that the holder filed counterstatements at the outset of these proceedings in which its position was clearly set out. Parties are not obliged to file written submissions at each stage, and it is not uncommon for arguments to be further developed at the hearing stage. I certainly do not consider the holder’s conduct in these proceedings warrants a punitive reduction in its costs award.

89. In the circumstances, I award the holder the sum of **£2,800** as a contribution towards the cost of the proceedings, which is calculated as follows:

Considering the opponent’s statements and preparing counterstatements	£1,100
Preparing evidence and considering the opponent’s evidence	£900
Preparing for and attending a hearing	£800
Total	£2,800

90. I order Hachette Filipacchi Presse to pay Rillius Holding Limited the sum of **£2,800**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 20th day of June 2024

**James Hopkins
For the Registrar**

Annex

Goods and services of UK trade mark number 900486399

Class 9: Scientific, nautical, surveying, electric, optical, photographic, cinematographic, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment; fire-extinguishing apparatus Sound recording discs of all kinds, optical discs, compact optical discs, disks [magnetic], compact discs with read-only memory, laser discs, audio and video compact discs, digital optical discs, interactive compact discs, pre-recorded or blank magnetic tape cassettes, pre-recorded or blank video cassettes and video discs, audio-visual data carriers, all media for recording, transmission or reproduction of sound and/or images Magnetic tapes, tape recorders, tape unit, video and audio tapes, video and audio cassettes, optical data media, magnetic data media, intercommunication apparatus, loudspeakers, microphones, radios, radiotelegraphy sets, radiotelephony sets, data communication apparatus, aerials, dish aerials, satellite aerials, encoders, decoders, transmitters, emulators, telephones, teleprinters, teleprompters, television apparatus, transformers and transmitters (telecommunication) Computer software, software packages, games software, computer programs [recorded], hard disks, disk drives, diskettes, smart cards; apparatus for games adapted for use with television receivers only encoded cards, magnetic.

Class 16: Paper and cardboard (untreated, semi-finished or for stationery or printing); printed matter; printed matter, newspapers and periodicals, illustrated magazines, magazines, books, printed publications, catalogues, prospectuses, albums; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); playing cards; printers' type; printing blocks fountain pens and pencils; goods made of paper or cardboard, namely calendars; posters; patterns for dressmaking.

Class 35: Advertising; business management; business administration; office functions; outdoor advertising, direct mail advertising; rental of publicity material; business management assistance, business management and organization consultancy, business management consultancy, personnel management consultancy, professional business consultancy; business appraisals; book-keeping; document reproduction; secretarial services; statistical information; shorthand; television commercials; radio commercials; dissemination of advertising matter; opinion polling, market studies; auditing; public relations; subscription to all news, written, audio and/or visual media, among other, subscriptions to newspapers and magazines; data entry and data processing; organization of exhibitions for commercial or advertising purposes; public relations; sponsorship of media events.

Class 38: Telecommunications; news and information agencies, radio broadcasting, communications by telegrams, telephone or data transmission; television broadcasting, radio broadcasting, broadcasting of television programmes; cable television broadcasting; satellite television broadcasting; transmission and broadcasting of images, messages and information by computer terminals, cable, data transmission media and by any other telecommunication media; teleprinting and telex services.

Class 41: Educational, training and entertainment services in general; correspondence courses; lending libraries; publication of texts, illustrations, books, magazines, newspapers and periodicals; tuition and instruction for beginners and advanced students of any discipline of general interest; arranging and conducting of seminars, training courses, conferences, forums, colloquiums and courses; production of radio and/or television programmes; organization of competitions and games of all kinds, broadcast by radio and television; arranging of shows; production and rental of films, cassettes, including video cassettes, discs and compilations of discs; services in relation to recording or reproduction of sound and images; sporting and cultural activities; reservation of seats for shows; organization of sports competitions; providing cinema facilities; discotheque services, entertainment and recreation information; party planning; organization of concerts, musical entertainments and radio shows.