

O/0603/24

TRADE MARKS ACT 1994

IN THE MATTER OF THE CONSOLIDATED PROCEEDINGS

AGAINST TRADE MARK Nos. 3722182 AND 3763024:

REGISTERED IN THE NAME OF GLADNESS JUKIC

“glow up: britain's next make-up star”

IN CLASSES 9 AND 45

AND IN CLASS 41 (RESPECTIVELY)

AND

APPLICATIONS No. 505383 AND 505384 BY WARNER BROS.

ENTERTAINMENT INC.

FOR DECLARATIONS OF INVALIDITY

BACKGROUND AND PLEADINGS

1. This decision deals with one divided part of the cancellation proceedings brought by Warner Bros. Entertainment Inc (“**the Applicant**”) against two UK trade marks - No. 3722182 and 3763024 (“**the Contested Registrations**”) - for the word mark “**glow up: britain's next make-up star**”, registered in the name of Gladness Jukic (“**the Proprietor**”).
2. Contested Registration No. 3722182 was applied for on 16 November 2021, was published for opposition purposes on 3 December 2021 and became registered as a UK trade mark on 18 February 2022 in respect of the following goods and services:

Class 9: *Video recordings, Downloadable videos, video streaming device.*

Class 45: *Licensing of rights relating to video productions, - Licensing of rights to films, television and video productions, - Film, television and video licensing, - Licensing of intellectual property and copyright.*
3. Contested Registration No. 3763024 was applied for on 8 March 2022, was published for opposition purposes on 25 March 2022 and became registered as a UK trade mark on 3 June 2022 in respect of the following goods and services:

Class 41: *Production of television programmes; Production of television or radio programmes; Television programmes (Production of radio and -); Production of entertainment in the form of television programmes; Television and radio programme preparation and production; Production of animated programmes for use on television and cable; Editing of television programmes; Production of shows; Preparation of entertainment programmes for broadcasting; Production of live performances; Production of stage plays; Production of live shows.*
4. The Proprietor’s representative in these proceedings is Thandi Jukic, though the tribunal understands that Thandi Jukic does not act in a professional legal capacity.
5. On 21 September 2023 the Applicant, through its legal representatives,¹ filed a Form TM26(I) in application that the Contested Registrations be declared invalid in

1 Allen & Overy, now known as A&O Shearman, following a recent merger.

accordance with section 47(2)(a) of the Trade Marks Act 1994 (“**the Act**”).

6. The statement of grounds accompanying the Applicant’s Form TM26(I) sets out that “Glow Up: Britain’s Next Make-Up Star” is a reality competition show where aspiring makeup artists navigate through different challenges to win a career-making opportunity in the beauty industry. The Applicant states that the “Glow Up: Britain’s Next Make-Up Star” original format was created in-house and produced on commission for the BBC by a subsidiary company within the group of companies of which the Applicant is a part. It states that the format was in development with the BBC from 15 February 2018 and was commissioned on 14 May 2018. The series was first released on 6 March 2019, since when the Applicant has promoted and distributed 32 one-hour television episodes over four series (as at the date of the application for invalidation).
7. The Applicant claims that the Contested Registration is invalid, based on three grounds under the Act, namely:
 - i. **section 5(2)(b)** – This is a claim that the Proprietor’s mark is similar to a mark under an earlier filed registered trade mark belonging to the Applicant and that the parties’ respective goods and services are identical or similar, such that there is a likelihood that the average consumer will be confused as to the origin of the goods and services.

The registered trade mark on which the Applicant relies for its section 5(2)(b) claim is UK TM No. 3400349 for the word mark

“GLOW UP”

Filing (application) date: 17 May 2019

Published for opposition purposes on 2 August 2019

Registered as a UK trade mark on 11 October 2019 for goods and services in Classes 9, 38 and 41. The full list of those registered goods and services is set out in the **Annex** at the end of this decision.

- ii. **section 5(4)(a)** – This is a claim that the Applicant owns the goodwill in the United Kingdom in the signs (unregistered trade marks) “GLOW UP” and “Glow Up:

Britain's Next Make-Up Star" ("**the Earlier Signs**") as a result of their use in the course of trade in connection with a range of stated goods and services throughout the UK from March 2019, prior to the filing dates of the Contested Registrations. The stated goods and services claimed include, for instance: *production of [...]; reality television series and transmission of downloadable audio-visual media content [...]; [...]* television broadcasting [...]. The Applicant claims the right under the law of passing off to prohibit use of the Contested Registrations. It claims that if the Proprietor were to use the mark under the Contested Registrations, in connection with its registered goods and services, the public would be misled into believing that Proprietor's goods and services are those of the Applicant, that the Proprietor is authorised by or connected to the Applicant and/or that the Applicant has endorsed the Proprietor's goods and services. Because of the goodwill and reputation that the Applicant claims to enjoy in the Earlier Signs, any use by the Proprietor of its Contested Registrations at its filing date would have traded on the notoriety of the Earlier Signs, which would cause damage to the Applicant's goodwill.

- iii. **section 3(6)** - This is a claim that the Proprietor applied in bad faith to register its trade marks because it had full knowledge of the Applicant's earlier trade mark GLOW UP.
8. The Proprietor filed a Form TM8 in notice of defence, including a counterstatement that explains that she grew up watching a television show called "America's Next Top Model". The Proprietor had an interest in the creative use of makeup and states that "the commonly used social media phrase, 'Glow Up'" gave her an idea to write a show 'Glow up: Britain's Next Make-Up Star'. She states that the dictionary meaning of 'Glow Up' refers to a major and impressive transformation in appearance, talent, power etc.
9. Along with the Form TM8, the Proprietor filed documentation setting out in some detail the steps she took in 2018 to bring her idea for the show and its title to the attention of the BBC. This included sending a sealed letter dated 18 January 2018 to herself and to her mother capturing her idea, and copies of emails sent to a contact at the BBC who she states is then credited as a commissioning editor for the show that aired in March 2019.
10. The Proprietor included a statement of defence in respect of each of the three grounds.

I will refer to aspects of the Proprietor's statement relevant to the section 5(2)(b) claim, which is the only ground addressed in this divided decision.

11. Following the evidence rounds, in which both parties filed evidence, and the Applicant filed evidence and submissions in reply, various issues arose. These included an initial objection by the Proprietor to the Applicant's request for an oral hearing; a request by the Proprietor to bring in an expert witness to challenge aspects of the Applicant's evidence; a request by the Applicant to cross-examine the Proprietor, specified as directed, among other things, to her intention and rationale in registering the contested trade marks and her claim to ownership of the BBC Three television show "*Glow Up: Britain's Next Makeup Star*"; and a request by the Proprietor to cross-examine one of the Applicant's witnesses.
12. In view of the mounting potential complexities of the proceedings, the registry wrote to the parties on 5 December 2023, giving the preliminary view of the registrar that the cancellation application proceedings should be considered first on the basis only of the Applicant's claim under section 5(2)(b) of the Act. The letter read:

"[The Applicant] relies for that claim on its earlier registered trade mark - "Glow up", filed in May 2019 and registered for goods and services in classes 9, 38 and 45 (concerning, among other things, video-on-demand transmission services and production, distribution and display of reality television series).

Section 72 of the Act states that "In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it."

The trade mark registration on which [The Applicant] relies for its section 5(2)(b) claim is therefore valid (absent any successful invalidation of that earlier mark).

[The Applicant]'s claim under section 5(2)(b) is that its earlier filed mark "Glow up" is similar to [The Proprietor]'s marks (filed in November 2021 and March 2022) "glow up: britain's next make-up star" and that [The Applicant]'s registered goods and services are similar or identical to the goods and services for which [The

Proprietor]’s trade mark is registered in classes 9, 41 and 45 (concerning videos, licensing tv rights and production of tv programmes) and that there is consequently a likelihood of confusion on the part of the consumer.

ii. It is the registrar’s view that this claim is apt to be assessed on the basis of the papers filed, without the need for an oral hearing at all. This is because [The Applicant] is not required to show use of its earlier mark in order to be able to rely on it for the ground under section 5(2)(b), and the questions of similarity between the respective marks and between the respective goods and services, are assessments which the tribunal is well accustomed to making and are not matters which require consideration of evidence.

iii. The preliminary view of the registrar is therefore to invoke the general powers under rule 62(h) and 62(f) of the Trade Marks Rules 2008 to direct that the claim under section 5(2)(b) be dealt with as separate proceedings and that the grounds under sections 3(6) and 5(4)(a) be stayed pending publication of a decision of the invalidation proceedings based on the section 5(2)(b) claim. The preliminary view is that parties be allowed until 19 December 2023 to confirm whether or not they would wish to file any further submissions in relation to the claims under section 5(2)(b) (only).

Any party wishing to do so, will then have until 8 January 2024² to file those submissions. A decision will then be made from the papers.

The approach set out in this preliminary view has the considerable advantage of avoiding the need for an oral hearing and certainly for any cross-examination. This approach will lessen costs and time to the benefit of both parties and the tribunal.

13. Neither party requested a case management conference to challenge the preliminary view and this decision therefore determines, from the papers, the invalidity application based only on the grounds under section 5(2)(b). It must be noted that the evidence filed has little or no relevance to the ground to be decided, but I have read all the papers filed and refer to their contents where I consider it warranted to do so.

2 An error in the correspondence address of the Proprietor led to an extension of the deadline for written submissions until **15th January 2024**.

RELEVANCE OF EU LAW

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

STATUTORY PROVISIONS

15. Relevant parts of section 47 of the Act reads as follows:

Grounds for invalidity of registration.

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

[...].

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

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

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

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

2ZA) [...]

(2A)... The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b)the registration procedure for the earlier trade mark was not completed before that date, or

(c)the use conditions are met.

(2B)The use conditions are met if—

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

(i)within the period of 5 years ending with the date of application for the declaration, and

(ii)within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b)it has not been so used, but there are proper reasons for non-use.

(2C)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) [...]

...

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

(6)Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.

16. Further to the references at section 47(2)(a) above, the parts of section 5 of the Act relevant to the claim to be considered in this separated decision are:

5. (2) *A trade mark shall not be registered if because –*

(a) [...]

(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.

17. Section 6 of the Act provides the meaning of “earlier trade mark” as referenced in section 5(2).

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

(a) *a registered trade mark which has a date of application for registration earlier than that of the trade mark in question ...*

PRELIMINARY ISSUES ON USE AND OWNERSHIP

18. The electronic case file shows that on 18 December 2023, Thandi Jukic sent an email (copied to the Applicant’s representative) in reply to the Registry’s letter of 5 December 2023. Thandi Jukic’s email disagreed with the statement in the Registry’s letter that the Applicant is not required to show use of its earlier mark in order to be able to rely on it for the ground under section 5(2). It was Ms Jukic’s view that the Registry had reached that conclusion based on the evidence filed by the Applicant, aspects of which the Proprietor strongly contested. Thandi Jukic’s email states that the Applicant has failed to prove the usage of their trade mark, since there is no show called ‘Glow up’: *“The only show that airs is ‘Glow up: Britain’s Next Make-up Star’ which belongs to the proprietor, Gladness Jukic. The Applicant stole the show as well as the trade mark that belongs to Gladness Jukic. ... Assuming that [the Applicant] need not prove the usage of the trade mark, shows that [the Registry is] doing everything that is likely to prejudice the proprietor’s rights to defend her trade mark and her show.”*

19. This accusation is unjustified and is based on a misunderstanding on the part of the Proprietor. The reason why the Applicant is not required to show use of its earlier trade mark is that on the dates that the Proprietor applied to file the Contested Registrations, the Applicant's earlier trade mark had been registered for less than five years. Proof of use is addressed at Question 7 of the Form TM8; the rubric of that pro-forma refers to section 3.4.6 of the Manual of trade marks practice, which expresses the point as follows:

The obligation to demonstrate use of the trade mark is not applicable immediately after registration of the trade mark; instead the registered proprietor has five years following the completion of the registration procedure to put the trade mark into use on the goods and/or services for which the trade mark was registered. Before this period of five years expires the registration is protected for all the goods and/or services for which it is registered.

20. More formally, the relevant provisions of the Act dealing with this question of use are contained in section 47 as set out above.
21. The Proprietor has stated that *"It cannot be assumed that the applicant owns goods and services they claim to own. They have to prove that by showing ownership. So far they have not proven any ownership of goods and services they claim is similar to that of the proprietor."* As referenced in the registry's letter of 5 December 2023, the significance of section 72 of the Act is that if a trade mark is in the register of trade marks it is prima facie valid. In May 2024, the Applicant's legal representatives notified the Registry that the Proprietor has commenced a claim in the High Court pertaining to the same subject matter as these consolidated proceeding, but as far as I am aware the Proprietor has not sought to invalidate the Applicant's earlier mark.³

DECISION

22. Determination of a section 5(2)(b) claim must be made in light of the following principles, gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case

³ See by loose analogy Section 4.6 of the Manual of Trade Marks Practice and the decision of Anna Carboni, sitting as the Appointed Person (appeal tribunal), in *Ion Associates Ltd v Philip Stainton and Another*, BL O/-211/-09.

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. The principles are:

The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

- (a) 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;
- (b) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (c) 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;
- (d) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (e) 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;
- (f) 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;

- (g) 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;
- (h) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (i) 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;
- (j) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the marks

23. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that: “... *it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.*”⁴
24. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

The Proprietor’s Contested Mark: glow up: britain's next make-up star

4 *Bimbo SA v OHIM, Case C-591/12P* (at paragraph 34).

The Applicant's earlier mark: GLOW UP

25. It is first worth noting that a trade mark that is registered as a word mark (as opposed to say a figurative mark) protects the words themselves for normal and fair use. Therefore, it is of no consequence that the Applicant's mark appears in uppercase in the register, and the Proprietor's in lowercase. Each may be used in upper, lower or sentence case or with the first letter of each word capitalised.
26. The Applicant's earlier mark consists of the term GLOW UP. The Contested Mark consists of the identical earlier mark, followed by a colon and the four words "britain's next make-up star." This latter portion of the Contested Mark is certainly not negligible, but it is positioned after the colon and after the opening words Glow Up. The four words "britain's next make-up star" will be understood by the average consumer of the Contested Goods and Services as indicating the underlying subject matter. It is therefore more descriptive, less allusive than the opening words, and I consider the words GLOW UP to be significantly more distinctive. Although the words "britain's next make-up star" occupy more space in the Contested Mark, the positioning of the words "Glow Up" at the beginning of the mark, and their station ahead of the colon also makes them marginally more dominant than the secondary words "britain's next make-up star".
27. The whole of the distinctive mark is reproduced in the Contested Mark, in which it remains distinctive and dominant. **I consider the marks to be visually and aurally similar to more than a medium degree.** Conceptually, the identical message will be conveyed by the shared words "Glow Up" which a significant portion of the average consumer group will understand as carrying the meaning identified by the Proprietor that I gave above, such as an impressive transformation in appearance. The Contested Mark has an explicit reference to a UK competition to become a standout makeup artist, whereas the earlier mark has no such supplementary conceptual message. Taking account of the distinctive and dominant components, **I consider the marks to be conceptually similar to at least a medium degree.**

Comparison of the goods and services

28. In considering this question of similarity of the goods or services, I take account of the factors identified in case law:

*“In assessing the similarity of the goods ... all the relevant factors relating to those goods .. 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”.*⁵

29. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)* the European Court ruled that goods can be considered as identical when the goods designated by the trade mark application the earlier mark are included in a more general category designated by the earlier mark or vice versa.⁶

30. It is settled case law that assessing whether goods and services at issue are similar must be on the basis of all relevant factors. These may include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary.⁷ Goods and services are complementary when “... 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.”⁸

31. In construing the meaning of terms, I keep in mind the guidance from case law that trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise, but that “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

5 The essence of case law points on similarity made in relation to goods applies correspondingly to services.

6 See paragraph 29 of the judgment of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05

7 See *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296].

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

meaning which does not cover the goods in question.”⁹ I also bear in mind that terms used to specify services should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.¹⁰

32. Section 60A of the Act states that goods and services are not to be regarded as being similar to each other simply because they appear in the same class, nor are they to be regarded as being dissimilar from each other on the ground that they appear in different classes.

33. The goods and services to be compared are set out over the following paragraphs.

The Proprietor’s goods in Class 9

Video recordings

34. The earlier trade mark is registered in class 9 for *audio video discs, and digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation*. These goods are **identical**.

Downloadable videos

35. The earlier trade mark is registered in class 9 for *downloadable audio-visual media content in the field of entertainment featuring animated motion pictures, television series, comedies, and dramas*. These goods are **identical**.

video streaming device

36. The earlier trade mark is registered in class 9 for *computer application software for streaming and storing audio-visual media content; computer application software for streaming audio-visual media content via the Internet*. These goods are **similar to at least a medium degree** based on factors such as shared purpose, users and

⁹ See paragraph 12 Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch).
¹⁰ See, for example, Lord Justice Arnold at paragraph 47 of *Sky v Skykick* [2020] EWHC 990 (Ch).

complementarity.

The Proprietor's services in Class 45

Licensing of rights relating to video productions,

Licensing of rights to films, television and video productions,

Film, television and video licensing,

Licensing of intellectual property and copyright.

37. The above services of the Proprietor are concerned with licensing of film, TV and video by managing the intellectual property rights, including copyright, that may attach to any film, television or video production, allowing third parties to use those works in an agreed way. The earlier trade mark is registered in Class 38 for *radio and television broadcasting featuring comedy, drama, action, adventure and/or animation* and in Class 41 for *distribution and display of live-action, comedy, drama and animated motion picture theatrical films; production of live-action, comedy, drama and animated motion picture theatrical films; production of live-action, comedy, drama, animated and reality television series; providing information for and actual entertainment via an electronic global communications network in the nature of live-action, comedy, drama and animated programs and production of live-action, comedy, drama and animated motion picture films for distribution via a global computer network*. The services of one who produces, broadcasts, distributes or displays film and television content are closely connected with the licensing of the rights in those works and are **similar to at least a medium degree** based on factors such as shared purpose, channels of trade and complementarity.

The Proprietor's services in Class 41

Production of television programmes;

Production of television or radio programmes;

Television programmes (Production of radio and -);

Production of entertainment in the form of television programmes;

Television and radio programme preparation and production;

Production of animated programmes for use on television and cable;

Editing of television programmes;

Production of shows;

Preparation of entertainment programmes for broadcasting;

Production of live performances;

Production of stage plays;

Production of live shows.

38. The above services of the Proprietor are concerned with the production of shows, including TV, radio and stage plays. The earlier trade mark is registered in Class 38 for *radio and television broadcasting featuring comedy, drama, action, adventure and/or animation* and in Class 41 for *production of live-action, comedy, drama and animated motion picture theatrical films; production of live-action, comedy, drama, animated and reality television series*. The respective services are largely self-evidently **identical**. There may be a question of whether *Production of stage plays* has an identical counterpart in the Applicant's specification, but in my view a stage play encompasses live-action. Those services are anyway **similar to at least a medium degree** based on factors such as shared nature and purpose (producing live entertainment) and channels of trade.

The average consumer and the purchasing process

39. Trade mark questions must be approached from the point of view of the presumed expectations of the average consumer - a legal construct who is reasonably well informed and reasonably circumspect; "average" denotes that the person is typical.¹¹

¹¹ Per Birss J (as he then was) in *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60.

It is necessary to determine who is the average consumer for the respective goods and services and how the consumer is likely to select them. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.⁸

40. The typical consumer for the goods and services at issue will include businesses, but the end consumer of licensed and broadcast video and television productions will be the general public. The average consumer will purchase the goods or services either by self-selection from a retail outlet (for instance for a video recording on a DVD), or more likely from a website or device where the goods and services are accessed. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase, given the potential for oral recommendations. The goods and services will vary in price. A business consumer seeking to engage the services of one who could provide *Production of television or radio programmes* may expect to pay a considerable sum for such a service. However, the end consumer of what comes from those production services would be the general public who would accept the licensing terms for viewing or downloading the production content. This is likely to entail little or no cost and a low degree of attention.

Distinctiveness of the earlier mark

41. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.¹² In *Lloyd Schuhfabrik*, 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-

¹² *Sabel BV v Puma AG*, Case C-251/95 at [24]

109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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)".

42. GLOW UP will strike the consumer as a phrase combining two ordinary English words and it is my view that a significant slice of the average consumer group would understand the connotation of a notable improvement, for example in self-presentation. There is no inherent connection of that term to the earlier goods and services as they appear in the registered specification; however, dependent on the actual subject matter of the earlier goods and services (for example, what television programme content may be produced or licensed) the phrase may be allusive. In the present proceedings, even without considering the evidence in any depth at all, it is clear that the earlier trade mark is apt to be used in connection with the production and broadcasting of reality television content concerned with impressive transformations arising from skillful and creative application of makeup. There is thus an allusive element to the mark, but it is still a memorable vernacular expression and is **at least distinctive to a medium degree**, and clearly so considering that it has been used as the distinctive and dominant element of the title of a television series that had aired for a couple of years at the relevant dates (the dates on which the Proprietor filed its Contested Registrations).

Conclusion as to likelihood of confusion

43. 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 and services down to the responsible undertakings being the same or related.
44. Determination of the question of a likelihood of confusion requires taking account of all relevant factors. In the present case, the earlier mark has at least a medium degree of distinctive character, and it appears in its entirety as a distinctive and dominant part of the Contested Mark.
45. The parties' marks are visually and aurally similar to more than a medium degree; they also share an identical concept, which concept is not altered by the more descriptive additional words of the Contested Mark such that even with those extra words, the marks remain conceptually similar to at least a medium degree.
46. The parties' goods and services are identical, or similar to at least a medium degree. Given the descriptive message of the words "Britain's Next Makeup Star", it seems to me that if the parties' marks were used in respect of the goods and services, where the underlying subject of those goods and services (such as a television programme) were concerned with a search to identify a standout makeup artist, then the average consumer would see the distinctive and dominant phrase "GLOW UP" as an independent badge of origin and would assume that the same or related undertaking was responsible for the goods and services, whether or not the words "Britain's Next Makeup Star" were present. The identical and similar nature of the goods and services and the nature and level of similarity of the marks will lead to a likelihood of confusion. Even if a medium level of attention were paid, there is a risk of imperfect recollection operating to cause direct confusion. Alternatively, I find there is a certainly a likelihood of indirect confusion. An average consumer who encounters a makeup competition show called "Glow Up: Britain's Next Makeup Star", and then encounters a makeup competition show called simply "Glow Up", will assume that the goods and services

emanate from the same commercial source. The absence of a colon and of the more descriptive words “Britain’s Next Makeup Star” would be put down to a reasonable commercial decision to streamline the title, retaining the memorable and distinctive phrase mark “Glow Up”.

47. **OUTCOME:** The applications for invalidation succeed in full based on the provisions of section 5(2)(b). Trade Mark Nos. 3722182 and 3763024 are declared invalid (as from their dates of application and in line with section 47(6) of the Act, the registrations are deemed never to have been made.

COSTS

48. The Applicant has succeeded in its invalidation applications and is entitled to a contribution towards its costs in these proceedings, in line with the scale set out in Tribunal Practice Notice 1/2023. Taking account of the duplication in the tasks, I award the sum of **£2500**, which is calculated as follows:

Form TM26(l) official fee (x2): **£400**

Preparing statements of grounds and considering the other side’s defence: **£600**

Preparing evidence and considering / commenting on the other side’s evidence (notwithstanding that the Registry separated the grounds reliant on evidence): **£1500**

49. I order Gladness Jukic to pay Warner Bros. Entertainment Inc the sum of £2500. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of June 2024

Matthew Williams
For the Registrar

ANNEX

The Applicant's goods and services registered under its earlier trade mark

"GLOW UP"

Class 9: *Motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; audio video discs, and digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation; stereo headphones; batteries; cordless telephones; CD players; CD ROM computer game discs; telephone and/or radio pagers; compact disc players; radios; mouse pads; eyeglasses, sunglasses and cases therefore; downloadable software for use in playing online computer games, downloadable computer game software; computer game software for use on mobile and cellular phones; video and computer game programs; video game cartridges; computer and video games which are designed for hardware platforms, namely, game consoles and personal computers; computer game software for gaming machines including slot machines; computer software or firmware for games of chance on any computerized platform, including dedicated gaming consoles, video based slot machines, reel based slot machines and video lottery terminals; CD-ROM and digital versatile computer game discs and computer programs, namely, software linking digitized video and audio media to a global computer information network; downloadable audio-visual media content in the field of entertainment featuring animated motion pictures, television series, comedies, and dramas; computer software, namely, computer software for streaming audio-visual media content via the Internet, computer software for streaming and storing audio-visual media content, downloadable audio and video players for media content with multimedia and interactive functions; computer programs for accessing, browsing and searching online databases, software that enables users to play and program entertainment-related audio, video, text and multi-media content; computer application software for streaming and storing audio-visual media content; computer application software for streaming audio-visual media content via the Internet; downloadable computer software for streaming audio-visual media content via the Internet; downloadable computer software for streaming and storing audio-visual media*

content; downloadable publications in the nature of books featuring characters from animated, action adventure, comedy and/or drama features, comic books, children's books, strategy guides, magazines featuring characters from animated, action adventure, comedy and/or drama features, coloring books, children's activity books and magazines in the field of entertainment; cellular telephone accessories, namely hands-free accessories, cellular telephone covers and cellular telephone face covers; encoded magnetic cards, namely, phone cards, credit cards, gift cards, cash cards, debit cards and magnetic key cards; and decorative magnets.

Class 38: *Telecommunications; providing on-line facilities for real-time interaction with other computer users concerning topics of general interest; providing on-line chatrooms and electronic bulletin boards for transmission of messages among users; electronic transmission and streaming of digital media content for others via global and local computer networks and via mobile telephones, smartphones and other mobile communications devices; streaming of audio and video material on the internet and via mobile telephones, smartphones and other mobile communications devices; transmission of downloadable audio-visual media content in the nature of full-length, partial-length, and clips from motion pictures, television programming, and videos; video-on-demand transmission services, enabling users of mobile telephones, smartphones and other mobile communications devices to communicate with each other; telecommunications services; chat room services; portal services; e-mail services; providing user access to the internet; radio and television broadcasting featuring comedy, drama, action, adventure and/or animation.*

Class 41: *Education; providing of training; sporting and cultural activities; entertainment services, namely, providing online video games, providing online computer games, providing temporary use of non-downloadable video games; entertainment services in the nature of live-action, comedy, drama, animated, and reality television series; production of live-action, comedy, drama, animated and reality television series; distribution and display of live-action, comedy, drama and animated motion picture theatrical films; production of live-action, comedy, drama and animated motion picture theatrical films; theatrical performances both animated and live action;*

Internet services providing information via an electronic global computer network in the field of entertainment relating specifically to games, music, movies, and television; providing news about current events and entertainment, and information related to education and cultural events, via a global computer network; providing information for and actual entertainment via an electronic global communications network in the nature of live-action, comedy, drama and animated programs and production of live-action, comedy, drama and animated motion picture films for distribution via a global computer network; providing a computer game that may be accessed by a telecommunications network; electronic publishing services, namely, publication of text and graphic works of others on-line featuring articles, novelizations, scripts, comic books, strategy guides, photographs and visual materials; non-downloadable publications in the nature of books featuring characters from animated, action, adventure, comedy and/or drama features, comic books, children's books, strategy guides, magazines featuring characters from animated, action, adventure, comedy and/or drama features, coloring books, children's activity books and magazines in the field of entertainment; amusement parks services; providing amusement park rides; providing live or pre-recorded shows and/or movies; entertainment and/or recreation information; entertainment club services; electronic games services provided via a global computer network; providing of casino and gaming facilities; entertainment services in the nature of multiplex cinema and theater development, film exhibition, film distribution and marketing services; entertainment services provided by an on-line computer databases and on-line searchable databases; provision of entertainment via on-line computer database and on-line searchable databases.
