

O/0735/24

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3728174
IN THE NAME OF GOAT MEDIA LIMITED FOR THE MARK**

Goat

**IN CLASSES 9 AND 41
AND THE OPPOSITION THERETO UNDER NO. 432161 BY 1661, INC**

**AND IN THE MATTER OF APPLICATION NO. 3728162
IN THE NAME OF GOAT MEDIA LIMITED FOR THE MARK**



**IN CLASSES 9 AND 41
AND THE OPPOSITION THERETO UNDER NO. 432162 BY 1661, INC**

**AND IN THE MATTER OF REGISTRATION NO. 3623348
IN THE NAME OF 1661, INC FOR THE MARK**


GOAT

**AND THE APPLICATION FOR A DECLARATION OF INVALIDITY THEREOF
UNDER NO. 505027 BY GOAT MEDIA LIMITED**

Background and pleadings

1. On 2 December 2021, Goat Media Limited (“Media”) applied for the trade marks



Goat and  for goods and services in classes 9 and 41. Following publication, the applications were opposed by 1661, Inc (“1661”) under sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In relation to the opposition against the word-only application, 1661 bases its section 5(1), 5(2)(a) and 5(3) grounds on the following earlier mark:

3592499

GOAT

Goods and services in classes 9, 18, 25, 35, 38 and 42.¹

Filing date: 8 February 2021; Canadian priority date: 25 September 2020; status: opposed.

2. 1661 also relies upon a second earlier mark for its section 5(2)(a) ground:

3623348

GOAT

Goods in class 9.²

Filing date: 8 April 2021; US priority date: 11 October 2020; registration date: 22 October 2021.

¹ Only the underlined classes are now relied upon for the section 5(1) and 5(2)(a) grounds (all having been relied upon, originally).

² This earlier mark was originally relied upon for the section 5(3) ground against both applications, but was withdrawn in 1661’s skeleton argument.

3. In relation to its opposition against the stylised application, 1661 relies upon its '499 earlier mark for its section 5(2)(b) and 5(3) grounds. It also relies upon its '348 mark for the section 5(2)(b) ground. The same classes are relied upon as for the opposition against the word-only mark.

4. In summary, 1661 claims:

- sections 5(1), 5(2)(a) and 5(2)(b): that there is a likelihood of confusion because the marks are either identical or highly similar and the goods and services are either identical or similar;
- section 5(3): relying on a reputation in the goods and services in classes 9, 35, 38 and 42 of the '499 mark, 1661 states that the relevant public will believe that the parties are the same or that there is an economic link between them. Further, it claims that the contested applications will 'ride on the coat tails' of the earlier mark, unfairly benefitting from its repute and marketing efforts. 1661 also claims that use of the contested marks will erode the distinctiveness of the earlier mark and damage its reputation if Media's goods and services are inferior.
- section 5(4)(a): on the basis that 1661 has used the sign GOAT since 2015 throughout the UK in relation to a long list of goods and services, reproduced in Annex 1, and has goodwill attached to GOAT. Use of the contested applications could cause a misrepresentation that Media's goods and services are connected to 1661's goodwill, causing damage to 1661 by means of diversion of trade, tarnishing of reputation or erosion of the distinctive character of 1661's sign.

5. Media filed defences and counterstatements, basing some of its denials on the reasons for filing an application for a partial declaration of invalidity against 1661's '348 mark for goods in classes 18, 20 and 28. The grounds for invalidity are, in summary:

- sections 3(1)(b) and (c): the average consumer would not attribute trade mark significance to "Goat" because it indicates that the goods on offer are, e.g.

“products which are made from or contain the skin, hair, or other parts, of a goat, or that the goods represent a goat or apply to a goat.”³ The specific goods attacked are:

Class 18: Bags; belt bags and hip bags; military duffle bags, garment bags for travel, tote bags; shoulder bags; backpacks; book bags; sports bags; bum bags; wallets; credit card holders; business card holders; handbags; travel bags; weekend bags; overnight bags; clutch bags; athletic bags; evening bags; hobo bags; flight bags; drawstring bags; wheeled bags; duffle bags; suit bags; carry-on bags; beach bags; sling bags; hiking bags; waist bags; cross body bags; bracelet bags; bangle bags; leather bags; imitation leather bags; gym bags; carry-all bags; shopping bags; shoe bags for travel; bags for carrying animals; men's clutch bags; bags for carrying baby accessories; sportsman bags; cosmetic bags sold empty; tool bags sold empty; shaving bags sold empty.

Class 20: Furniture parts and accessories; ~~picture frames~~; home décor and accents.

Class 28: Toys; game cards; trading cards for games; collectible toys; collectible toy figures.

- section 3(3)(b): the average consumer will consider that the goods are made from or contain the skin, hair, or other parts, of a goat, or that the goods represent a goat or apply to a goat . If the goods are not made from goat, do not represent a goat or do not apply to a goat, the mark will deceive the public;
- section 5(4)(a) against all the goods of the ‘348 earlier mark on the basis that Media has used the sign Goat since 2001 throughout the UK in relation to *creative industries, digital media, creative arts, crafts, arts projects, media production activities, film production, video production, sales and marketing*

³ The pleadings are identically worded under sections 3(1)(b) and (c).

services, promotional material, documentaries, performance arts, dance services, music services, sports services, choreography, distribution services, DVDs and streaming services. Media claims that it has goodwill in the business attached to the sign Goat. Its pleadings under this ground mirror those of 1661: i.e., misrepresentation, confusion, tarnishing and erosion of its sign's distinctiveness.

6. Media specifically denies any similarity between its class 41 services and the goods of the earlier marks. If the opposed earlier '499 mark proceeds to registration, Media accepts that the parties' goods in class 9 are similar.⁴ In relation to section 5(4)(a), Media denies that 1661 owns goodwill in the UK and states that Media has prior use of its sign. Media claims that 1661 has refused to disclose material which is pertinent to 1661's claims, which Media states are not credible and are an abuse of process.

7. 1661 filed a defence and counterstatement against the invalidation application, denying the grounds. At this point, the proceedings were consolidated.

8. Both parties filed evidence. A hearing was held before me by video conference on 23 November 2023, at which Ms Victoria Jones of counsel, instructed by Fieldfisher LLP, represented 1661. Mr Philip Hannay, of Cloch Solicitors, represented Media. In making this decision, I have borne in mind all of the submissions, both oral and written, and the evidence. I will refer to these as far as they are necessary and relevant to the issues in these proceedings.

Evidence

9. 1661's evidence-in-chief comes from Mr Josh Webman who is Associate Vice President, Brand.⁵ His evidence relates to 1661's use of its marks. Media's evidence in chief comes from Mr Philip Hannay, of Cloch Solicitors.⁶ His evidence is for the purpose of supporting the grounds for invalidation and to show what use Media has made of its marks. 1661's evidence-in-reply comes from Mr Kishen Karia who is a

⁴ 1661's '499 mark is opposed by a third party.

⁵ Witness statement and exhibits dated 22 November 2022.

⁶ Witness statement and exhibits dated 23 November 2022.

trade mark attorney at Fieldfisher LLP.⁷ This goes to rebutting Media's claim to a non-trivial goodwill. Mr Karia also points out that Media's evidence has not come from someone at Media, but from its trade mark attorney, which Mr Karia states affects its weight. Media filed a witness statement from Katherine Pottratz, who is a director of Media, essentially rubber-stamping Mr Hannay's evidence.⁸ Finally, Media filed a second witness statement from Mr Hannay, to reply to Mr Webman's evidence.⁹

Preliminary issues and the case management conference

10. 1661 originally relied upon all the goods and services of its two earlier marks for sections 5(1), 5(2)(a) and 5(2)(b), in classes 9, 18, 25, 35, 38 and 42 for the '499 mark and in classes 9, 14, 18, 20 and 28 for the '348 mark. No attempt was made in the notices of opposition to particularise or give reasons as to why all the goods and services of the earlier marks were said to be identical or similar to those of the two contested applications. Following receipt of the notices of opposition, the Tribunal wrote to 1661, directing it under rule 62(1)(a) of the Trade Marks Rules 2008 (as amended) to explain clearly why it considered there to be similarity of goods and services because aspects of 1661's cases appeared to have no prospect of success under sections 5(2)(a) and (b) of the Act.¹⁰ The Tribunal's letter referred to Tribunal Practice Notice ("TPN") 4/2000, but not to TPN 1/2018 "Examination of pleadings based on earlier marks".

11. 1661 responded on 19 April 2022, referring to TPN 4/2000 and saying:

"[...] the Opponent has provided sufficient information as to the nature and extent of the grounds upon which it relies. Section A of the TM7 deals with the 5(2)(b) basis of opposition. On the first page of Section A, the Opponent has ticked the 5(2)(b) box, entered the trade mark number, entered the type of mark and included a representation of the mark. On the second page of Section A, Q1 asks "Which goods or services covered by the earlier trade mark are relied

⁷ Witness statement and exhibits dated 23 February 2023.

⁸ Witness statement dated 23 February 2023.

⁹ Witness statement and exhibits dated 23 February 2023.

¹⁰ In letters dated 30 March 2022 and 1 April 2022, prior to serving the notices of opposition on Media.

upon for the opposition?". The options are "All goods and services" or "Some goods and services". The Opponent has selected "All goods and services" for both earlier marks relied upon. Q2 has been ticked "No" for both earlier rights. The form then progresses to Q4 as a result. Q4 asks "Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1?". The options are "All goods and services" or "Some goods and services". The Opponent has ticked "All goods and services" in respect of both earlier rights relied upon. Q5 says "Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar". The Opponent has provided an adequate response outlining why there is a likelihood of confusion in respect of both earlier rights relied upon."

12. 1661 said that the Tribunal had misinterpreted TPN 4/2000 which, it said, is for when a Form TM7 has been incompletely or inadequately filed.¹¹ 1661 said: "A detailed comparison of the goods and services will form part of the further analysis during submissions or a Hearing." Further, 1661 said that it should not have to particularise the goods and services when defences had not yet been filed. It reserved the right to a hearing should the Tribunal decide to strike out aspects of its cases under sections 5(2)(a) and (b). The Tribunal replied on 20 and 26 April 2022, admitting and serving the notices of opposition on Media, but also directing under rule 62 that 1661 indicate its best case at the filing of its evidence, clearly particularising which goods and services were similar to the contested goods and services. The letter warned that failure to do so may result in an adverse costs award. This instruction reflects TPN 1/2018; in particular:

"1. The purpose of pleadings is to set out the party's legal case with sufficient clarity so that the other side can make an informed decision about whether to defend their trade mark, and in which respects. The pleadings filed in trade mark oppositions and invalidation proceedings do not always meet this standard.

¹¹ Form TM7 is the statutory notice of opposition.

2. The registrar has a duty to ensure that the system is fair to both parties and that, so far as is reasonably practical, those without legal representation and/or of limited means, are given equal access to justice.

3. From 1 January 2019, where the pleadings in trade mark opposition/invalidation proceedings under s.5(1) -s.5(3) of the Act are not sufficiently clear, the registrar's casework examiners may require further information, particularly if:

(i) The number of earlier marks exceeds 6, and/or

(ii) It is not obvious why the goods/services covered by an earlier mark are claimed to be identical or similar to the opposed goods/services.

[...]

7. Where it is not self-evident why the goods/services covered by an earlier mark are claimed to be identical, or similar, to the opposed goods/services for the purposes of s.5(1) or (2), and this is not explained in the notice of opposition etc. The casework examiner may require the party filing the form TM7/26(I) to provide further information. Specifically, the caseworker may invoke the registrar's power under Rule 62 of the Trade Mark Rules 2008 to require the party to explain which goods/services are claimed to be identical/similar, and why. This requirement will always arise when it is not clear why any of the goods/services covered by the earlier mark are claimed to be similar to the goods/services covered by the grounds under s.5(1) or (2).

8. Where the same explanation applies to multiple comparisons of individual goods/services, the required information should be provided by reference to the relevant goods/services, grouped accordingly.

9. Depending on the degree of ambiguity, and as an alternative to taking this action at the pleadings stage, casework examiners may decide to serve the form TM7/26(I) on the other side and simultaneously direct the party bringing

the case to provide further information about the claimed identity/similarity between the respective goods/services. In these circumstances, the required information will usually be required by the deadline for filing evidence in support of the opposition/application.

10. Either of the above courses of action will permit the other side to properly address the claimed identity, or similarity, of the goods/services in its own evidence of fact and/or written arguments (submissions) in response. This is fairer to the applicant/proprietor than revealing the reasons why the respective goods/services are claimed to be similar for the first time at a hearing, or in final written submissions in lieu of a hearing, i.e. after the other side's opportunity to file evidence or written submissions in response has passed.

Failure to follow directions

11. Failure to comply with directions under Rule 62 may have the following consequences:

(i) an increase in costs awarded against the offending party, if it is unsuccessful, or a reduction in costs to that party, if it is successful;

(ii) the registrar selecting the earlier marks which appear to represent the party's best case and directing under Rule 62 that the evidence and arguments be limited to those marks;

(iii) where the basis of the claimed similarity between the respective goods/services remains non-apparent, and has not been explained, the decision maker is likely to find dissimilarity;

(iv) where there is a serious risk of unfairness to, or oppression of, the other party, directions will be made subject to the condition (per Rule 62(3)) that failure to comply with them will result in the opposition/application being struck out in whole or in part."

13. Whilst the Tribunal had not referred in either of its letters to TPN 1/2018, it seems unlikely to me that 1661's representatives would be unaware of TPN 1/2018. In any event, the Tribunal's letter of 26 April 2022 directed that 1661 clearly particularise the claimed similarity of goods and services when it filed its evidence.

14. 1661 did not do so. It filed its evidence on 23 November 2022, but there were no documents which complied with the Tribunal's direction under rule 62. It finally complied with the Tribunal's directions on 15 December 2022 after a further (third) letter from the Tribunal dated 1 December 2022 directing it to particularise its goods and services claim. I will say more about the matter as part of my decision in relation to costs.

15. I held a case management conference ("CMC") on 22 December 2022 to consider Media's request that 1661 disclose four documents and that 1661 provide security for costs. I refused both requests: one was a publicly available US court judgment; the others were not relevant to the question of whether 1661 had goodwill in the UK at the relevant date; and the request was partly speculative to see if a potential section 3(6) ground could be added to Media's invalidation application. The security for costs application was also speculative, based as it was upon 1661 being a US company without a UK base and that it is not known whether 1661 honours its debts. The reasons for my decisions and directions were given in a letter dated 23 December 2022 and I adopt them as part of this decision.

16. I note that Media's skeleton argument refers to the cancellation application being made against classes 9, 14, 18, 20 and 28 under sections 5(4)(a), 3(1)(b), 3(1)(c) and 3(3)(b). That is incorrect. The section 5(4)(a) ground does attack the whole registration, but the absolute grounds attack only some of the goods in classes 18, 20 and 28, which I have set out above. No application was made to amend the pleadings.

17. Finally, Media's evidence and skeleton arguments make reference to GOAT meaning 'greatest of all time' in the fields of athletics and athleisure and that this supports its arguments under section 3(1)(b) and (c), and goes to the level of distinctiveness of 1661's earlier '499 mark. I will not take that into account because it was not pleaded and no application was made to amend the pleadings.

18. It is convenient to begin with Media's application for invalidation against 1661's '348 mark, after which I will turn to 1661's oppositions.

Sections 3(1) (b) and (c) of the Act

19. Sections 3(1) (b) and (c) state:

“3 (1) The following shall not be registered—

(a) [...],

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) [...]:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

20. The relevant date for determining the above grounds is the date on which the applications for the contested marks were filed: 2 December 2021.

21. The pleadings for both grounds are identical. They are predicated on the basis of the mark describing characteristics of the goods, which is provided for under section 3(1)(c). In *Affinity Leasing Limited v Total Motion Limited*, Mr Daniel Alexander QC, sitting as the Appointed Person, observed:¹²

¹² Case BL O/522/20.

“36. Section 3(1)(b) is in some respects a more general provision than either section 3(1)(c) or section 3(1)(d), precluding registration of marks which have no distinctive character at all. However, the case law, especially from EU tribunals, emphasizes that these are each distinct heads of objection requiring separate analysis – one cannot just go to section 3(1)(b) and use it as a catch-all for marks that have questionable distinctiveness. In my view, it is preferable where a specific objection potentially arises that the sign or trade mark is descriptive of the goods or services (rather than that it is non distinctive for some other reason such as being decorative) that the issue is primarily analysed under section 3(1)(c).

37. If such an analysis points to the mark being registrable on the grounds that it is not descriptive under that provision, it will be harder to show that, despite this, it does not qualify for registration under 3(1)(b). That is partly because the case law relating to section 3(1)(c) is specific to that section as it has developed over recent years and provides a clearer standard for evaluation of marks alleged to be descriptive than the case law specifically directed to section 3(1)(b).

38. Under section 3(1)(c), the case law both from the EU courts and from the Court of Appeal has emphasized that section 3(1)(c) (or its equivalents) only come into play where the average consumer would, at the relevant date, have immediately perceived without thought or explanation that the mark in question designated a characteristic of the goods or services for which the mark was registered (see *JW Spear & Sons v. Zynga Inc.* [2015] EWCA Civ 290 at [73]-[83] and cases there referred to). The cases also show that it is not necessary to demonstrate that the term exactly designates any of the goods or services specifically itself: designation of a characteristic of such services will suffice, including, importantly, ancillary characteristics that the goods or services may reasonably be expected to have (see e.g. *Case C-363/99 Koninklijke KPN Nederland NV v. Benelux Merkenbureau* [2004] ECR I-1619).

39. Second, the case law under both sub-sections and the language of 3(1)(c) itself places some emphasis on avoiding registration not only of marks or signs which are already in use by others to describe the goods or services in issue but also those which may reasonably be adopted by others in future to describe their goods or services having regard to the meaning of those terms.”

22. As in that case, the real issue in this case is descriptiveness, as far as the section 3(1)(b) and (c) objections are concerned. I will, therefore, begin with section 3(1)(c).

23. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:¹³

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph

¹³ 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.

30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland*

[2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the

goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

24. Media has filed evidence purporting to show that 'goat' is meaningful in relation to the specific goods for which it seeks a declaration that the '348 mark is invalid. I do not need to explain what a goat is. In relation to the goods themselves, Exhibit B-12 comprises a print from Wikipedia to show that cashmere wool is derived from the hair of the cashmere goat. Exhibit B-15 includes an undated print showing images from a Google search of bags which have pictures of goats on them. Another undated print in the same exhibit is from a UK website offering bags and wallets made from goat

skin (or goat leather). An undated print from Etsy shows images of leather bags under the heading “Goat Leather Bag”. Exhibit B-16 includes an undated print from a UK furniture website which shows a goat skin stool and a goat skin bench. Pictures of plush toys in the shape of goats are shown in undated prints from the UK websites of Amazon, Etsy and Build A Bear, e.g.:¹⁴



25. Ms Jones referred to the need for evidence in all but the most obvious cases and that in *Burgerista Operations GmbH v Burgista Bros Limited and Ors* [2018] EWHC 35 (IPEC), HHJ Hacon said that there was insufficient evidence to show that ‘burgerista’ was meaningful. The word ‘burgerista’ is not on all fours with ‘goat’, which is an extremely well-known and long-used word for an animal which is familiar to everyone in the UK.

26. 1661 maintains that whilst ‘goat’ is descriptive of an animal, the animal itself will not immediately be perceived as a characteristic of a bag, a piece of furniture or a toy. Further, the evidence shows use of ‘goat’ in conjunction with other words, such as ‘leather’ or ‘skin’ and it is the combination of words which would enable the consumer to perceive a relevant characteristic of the goods. Ms Jones drew my attention to the

¹⁴ Exhibit B-17.

IPO Work Manual with regards to examination practice for animal marks. She said that the examples in the Manual that would be objectionable on a section 3(1)(c) basis are cows or goats for milk or butter; sheep for wool; and images of some animals for leather, skin or hide. Ms Jones submitted that these examples amount to a direct and specific connection: a consumer would see the word and immediately perceive it to be descriptive of the goods. I note that the practice is in relation to images of animals, which has less relevance to the case in hand because I have to assess the word Goat, not the image of a goat. Ms Jones submitted that 'goat' is not descriptive of a toy goat, but at the most would be descriptive of the decorative aspect of the toy.

27. I disagree. The word 'soap' is descriptive of a bar or container of soap. Goat is descriptive of a toy goat/goat toy or a goat figurine, whether that is a plush toy or a faithful representation of a goat for collecting or adding to a toy farmyard. It is not necessary to see evidence to arrive at this conclusion. The connection will be immediate to the average consumer. I find that the section 3(1)(c) objection succeeds in relation to *Toys; collectible toys; collectible toy figures*.

28. In relation to *game cards* and *trading cards for games*, I bear in mind that paragraph 50 of *Technopol* refers to characteristics designating a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. *Game cards* and *trading cards for games* could include cards depicting a goat. It is unnecessary for a characteristic of a product to be a "central or essential" one in order for a description of that characteristic to be caught by section 3(1)(c) of the Act. This is clear from *Koninklijke KPN Nederland NV and Benelux-Merkenbureau*, where the CJEU held:

"... it is irrelevant whether or not.... the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary."

29. I find that Goat is descriptive of a characteristic of *game cards* and *trading cards for games* and the section 3(1)(c) objection succeeds for these goods.

30. I note that model animals which are ornaments fall in class 20.¹⁵ Ornaments would appear to be covered by the terms *home décor* and *accents*. For the same reasons as for the objection against toys and collectible toys and figures, the section 3(1)(c) ground succeeds in relation to *home décor* and *accents*.

31. The other goods in class 20 for which Media claims Goat is descriptive (and non-distinctive on that basis) are *furniture parts and accessories*. The (undated) evidence shows benches and stools covered in goat skin. These are items of furniture, which has not been included in Media's claim. There is no evidence, and it is not obvious, that goat skin is a furniture part or accessory. It seems more likely to me that it would fall in class 18 as animal hide to be shaped according to requirements. The section 3(1)(c) objection fails against *furniture parts and accessories*.

32. I find that use of the word Goat in relation to bags which could be made from goat leather signifies a characteristic which would be recognised as a description by the average consumer for bags. I appreciate 1661's argument that the word 'skin' is missing, i.e. 'goat skin bags'. I nevertheless consider that in the context of the goods, which could be made from goat leather, that the average consumer will immediately perceive Goat as a description of the material from which the goods are made; for example, in a shop selling leather goods, a sign by a selection of leather bags which says 'Goat'. The section 3(1)(c) ground succeeds in relation to all the goods which are attacked in class 18.

33. As the section 3(1)(b) ground is predicated on the same basis as that for section 3(1)(c), it succeeds to the same extent. There is no evidence of use in relation to the offending goods, which means that the proviso to section 3(1) does not apply.

Section 3(3)(b)

34. Section 3(3)(b) of the Act states:

¹⁵ If made of wax, plastic, plaster or wood.

“A trade mark shall not be registered if it is—

(a) [...]

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

35. In *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd*, Case C-259/04, the CJEU stated:

“47 Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (Case C-87/97 *Consorzio per la tutela del formaggio Gorgonzola* [1999] ECR I-1301, paragraph 41).”

36. For this ground to succeed, such deception must be attributable to the nature of the mark itself, as opposed to the way in which it is used. I have already made findings that the mark is descriptive of some of the goods in classes 18, 20 and 28. I find that, at the relevant date, there was a sufficiently serious risk that the consumer would have been deceived into believing that the mark denoted goods which were either toy goats, goat cards, collectible goat figurines or made from goat leather. Such a belief by the average consumer was likely to have influenced the purchasing decision. If the goods were not as described by ‘Goat’, the average consumer would be deceived about the nature of the goods. The opposition under section 3(3)(b) succeeds to the same extent as the section 3(1)(c) ground. However, there is no reason why the average consumer would be deceived about the nature of the other goods attacked under this ground because the mark is not descriptive of them.

Outcome under sections 3(1)(b), (c) and 3(3)(b) of the Act

37. Registration 3623348 is invalid under sections 3(1)(b), (c) and 3(3)(b) in respect of:

Class 18: Bags; belt bags and hip bags; military duffle bags, garment bags for travel, tote bags; shoulder bags; backpacks; book bags; sports bags; bum bags; wallets; credit card holders; business card holders; handbags; travel bags; weekend bags; overnight bags; clutch bags; athletic bags; evening bags; hobo bags; flight bags; drawstring bags; wheeled bags; duffle bags; suit bags; carry-on bags; beach bags; sling bags; hiking bags; waist bags; cross body bags; bracelet bags; bangle bags; leather bags; imitation leather bags; gym bags; carry-all bags; shopping bags; shoe bags for travel; bags for carrying animals; men's clutch bags; bags for carrying baby accessories; sportsman bags; cosmetic bags sold empty; tool bags sold empty; shaving bags sold empty.

Class 20: Home décor and accents.

Class 28: Toys; collectible toys; collectible toy figures; game cards; trading cards for games.

38. The grounds fail in respect of:

Class 18: Furniture parts and accessories.

Section 5(4)(a)

39. Section 47(2)(a) of the Act states as follows:

“47. (2) ... the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(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.”

40. Section 5(4)(a) states:

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

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

(aa) [...]

(b) [...]

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

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

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

42. Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”¹⁶

¹⁶ This section also applies to the grounds raised in 1661’s oppositions.

43. The three elements which Media must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

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

44. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 at 223:

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

45. The *prima facie* relevant date is the date of the application for 1661’s ‘348 mark: 8 April 2021. Media must show that it had sufficient goodwill at this date to bring the claim. This might not be the only relevant date given 1661’s claim in its opposition to

have an earlier right since 2015 and Media's claim to have used its sign since 2001.¹⁷ I will come back to this, if necessary.

46. Mr Hannay, for Media, states that his evidence comes from his own knowledge, from Government sources or from the internet. He provides ten exhibits which are aimed at showing that Media has used the signs GOAT and GOAT MOVING MEDIA.¹⁸ I will take each of these in turn:

- Exhibit B-01 includes prints from a website at www.go-at.co.uk. The prints were downloaded on 21 November 2022. The word Goat appears at the top of the first page with an explanation that Goat is an independent media production company for the arts which was formed in 2001, becoming a limited company in 2005. Mr Hannay states that the domain name was registered on 4 January 2001. A print from the internet archive, the Wayback Machine, is included in the exhibit to show that the website has been continuously hosted and frequently updated since 2002.
- Exhibit B-02 includes a print from a website at www.goat.media. The heading looks like this:



The home page has a post dated 10 November 2020 regarding Media's film festival in Aberdeen scheduled from 11 to 13 March 2021. I note the post says "GO/AT manages and produces the festival with financial support from Creative Scotland and Film Hub Scotland." A post, dated 18 March 2021, says: "It's a wrap. Another successful screen dance festival is finished. Screen.dance 2021 – Scotland's festival of dance on screen brought to you from the heart of Aberdeen in partnership with Citymoves Dance Agency may have finished livestreaming on 13 March but a selection of our works in each of our

¹⁷ *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander QC, sitting as the Appointed Person.

¹⁸ Only GOAT is relied upon for Media's section 5(4)(a) ground against 1661's '348 mark.

programmes are still available to view in our screening room for an extended period of time – until 31 March 2021. What a festival it's been – 100s of you in the audience, 65 films, 62% female directors, 9 Q&As, 5 hosts, 4 workshops, 3 co-curators - packed into 1 screen.dance festival.” Mr Hannay states that at least sixteen films are available to purchase from the 'store' tab. However, the website print is undated and may have been downloaded contemporaneously with the date of Mr Hannay's statement, as for Exhibits B-01 and B-08. It is not clear, therefore, whether the 'store' tab described by Mr Hannay showed the same content on 18 March 2021. A print from the internet archive shows that the website has been updated at intervals since 2017.

- Mr Hannay states that Media is the founder, developer, producer, manager and exhibiter at screen.dance, which is Scotland's only festival of dance. Exhibit B-08 comprises a screenshot from the website www.screen.dance, downloaded on 22 November 2022 which says that the site is maintained by Media. Exhibit B-09 comprises undated screenshots from the screen.dance Instagram page, one of which shows Media's stylised mark (the subject of one of its contested applications, 3728162). What is not clear from Exhibit B-02 or B-08 is whether Goat was used in relation to the film screening festival; i.e. whether or to what extent customers were exposed to the sign in attending the festival or seeing the films, as opposed to the sign screen.dance.
- Exhibit B-03 comprises information about Media from the register of companies. Media was registered as a limited company on 10 May 2005. Exhibit B-04 comprises extracts from Media's accounts from 2005 to 2021. Turnover for the financial years ending 2006 to 2021 was:

2006 - £40,438

2007 - £28,922

2008 - £9,104

2009 - £4,134

2010 - £7,655

2011 - £15,487

2012 - £8,840
2013 - £4,031
2014 - £21,133
2015 - £16,267
2016 - £6,064
2017 - £9,787
2018 - £7,958
2019 - £8,575
2020 – £20,503
2021 - £24,351 (the relevant date falls on 8 April 2021)

The figures from 2006 to 2011 are labelled in the accounts as ‘production fees’ and from 2012 onwards as ‘turnover’. Directors’ reports for the years 2006 to 2011 are included (but not after that period). One of these reports, from 2007, says that Media made a video installation, toured a video booth arts project and had received grants for this and other projects. In 2008, Media toured a video booth arts project, made promotional videos and produced a TV programme. There are no such updates in the directors’ reports for 2009 to 2011.

- Exhibit B-05 comprises an extract from the Scottish Artists Union’s Membership Survey Results 2018 which says that 61% of members had an annual turnover of less than £10,000 in 2016-2017. Mr Hannay submits that the figure of £10,000 annual turnover shows that Media’s trade is above average “for a Scottish arts business.” However, it appears that the Union’s members may be individuals because the report states that 28% of members reported that they, or someone they live with, claim state benefits, and that 81% are registered self-employed. The survey results, based on only 72 responses, is not materially indicative of the level of business generated by businesses in the arts, as opposed to individual artists.
- Exhibit B-06 begins with a single page showing what Mr Hannay states to be film cover images, some of which I note are also shown in Exhibit B-01. The print is undated. Two of the films, “Six Solos” and “Uath Lochans” are the

subject of other prints in the exhibit, on the Vimeo video sharing website. Six Solos, a six minute dance film, is listed as being “from GO/AT” on 23 June 2018, at a rental cost of £4.50 for three days’ streaming, or £15 to stream anytime. Uath Lochans, also a six minute dance film, is listed on Vimeo, “from GO/AT” on 11 May 2016. Rental for three days cost £3.60 and anytime at a cost of £10.79. Uath Lochans was shown at seventeen very small venues in Wales between 1 April 2018 and 31 May 2018.¹⁹ However, the promotional information for the tour does not mention Media: the tour is billed as the work of Simon Fildes and other individuals, on a website called www.fildes.work.²⁰ This does not go to goodwill accrued by Media. There are also no figures as to the take-up of rentals or of purchase of the said videos, or whether customers were in the UK, but I do note that the rental and purchase prices were in pounds sterling, which shows that UK customers were targeted on Vimeo.

- Exhibit B-07 includes prints from the internet archive dated 25 November 2002 and 16 June 2004 from go-at.co.uk which say that Goat is an independent production company, although the majority of the articles refer to the work of its individual directors. I note that by 2004, Goat had produced a handful of films. Awards are mentioned, but it appears to me that the awards were for the two directors, rather than for Goat as a company.
- Exhibit B-10 comprises screenshots from social media. The first is from YouTube and shows Goat and also Media’s stylised mark. There were 92 subscribers at whatever date the screenshot was downloaded. Media joined YouTube on 25 July 2006 and has received about 50,000 views. Goat created its Vimeo account in August 2008, with 306 followers. The stylised mark is shown, and also GO/AT: “GO/AT is an award-winning independent media production company specialising in arts projects, documentaries, documentation, promo videos and dance on screen.” GO/AT also appears on the Twitter print: “GO/AT @ GoatMediaLtd. Media joined Twitter in March 2011 and had 564 followers, including ‘Creative Scotland’. Media had 653 followers on Instagram; its page shows the stylised mark and GO/AT, and 146 posts.

¹⁹ Mr Hannay describes the venues as “intimate”.

²⁰ The late Mr Fildes was a director of Media.

47. Mr Hannay states that various films created by Media have been shown internationally; e.g. the 2013 film “The Time it Takes” has been shown in over 60 international festival screenings; the 2015 film “Uath Lochans” in over 50 international festival screenings; and the 2016 film “Six Solos” has been shown in over 20 international festival screenings. However, what is not shown is how many of these were attended or viewed by customers in the UK. Mr Hannay states that Media has won the following awards, although at least one of these is not a UK award, and there is no territorial information about the others:

- San Francisco Dance Film Festival, “Best Short Film” April 2011;
- UHI Enterprise Award, “Best New Social Enterprise Idea” 2010;
- Dance Camera West, “Best Short film June 2010; and
- Webby nomination 2007 for “Move Me” which was an interactive video installation launched at the ICA in London which toured to 38 arts venues throughout the UK and internationally.

48. As referred to above, Media has also filed a witness statement from Katherine Pottratz, who is a dance and film choreographer, director and shareholder of Media. She was married to Simon Fildes before he passed away in 2021 and now resides in the US. Ms Pottratz states:

“... I had full knowledge of and approved the witness statements filed by Party B’s [Media’s] representative.

[...]

I understand that Philip Hannay, who has given testimony on behalf of Party B, had advised Simon and GOAT in the past. For that reason, and due to my intermittent absence from the UK (I have a co-director, [name], managing any matters which require attendance in my absence), I was content, especially given the pressing deadlines reported to me, for Party B’s representative to file evidence on behalf of Party B. I have reviewed Philip’s witness statement dated 23 November 2022 and the witness statement dated 23 February 2023 and

while Philip does not refer to all Party B [sic] goodwill and reputation in the GOAT mark (I understand that there are limits on what can be filed) I do agree and approve the same.”

49. Some of Mr Hannay’s witness statement contains opinion about what the facts show. I have not taken these opinions as facts; only the evidence insofar as the facts it contains and what I consider the evidence does, or does not, show. Mr Hannay’s evidence is a collection of the results of his internet searches about Media. He does not say in either of his witness statements that he has access to Media’s records. He does not distinguish between facts that he personally knows and those which he has found through searching for internet material which is in the public domain. It appears most of the first witness statement comprises the latter. For this reason, the evidence must rely heavily upon what is contained in the exhibits. There are gaps because the evidence has not been filed by someone with access to Media’s records. For instance, there is no evidence from internal records showing, for example, approaches made by customers for production of films, discussions about filming, or invoices for production and suchlike. It is preferable for parties to file evidence from someone in their business, as opposed to a legal representative who has searched the internet and filed prints of accounts filed at Companies House. Mr Hannay’s evidence is only marginally improved by Ms Pottratz’s statement. If 1661 had wished to cross-examine Media on its evidence, the witness who adduced facts was Mr Hannay, not Ms Pottratz, and the questioning would have been about facts which cannot be explained by someone with more knowledge of the business than someone who has put evidence together from internet searches. Although there is no direct challenge to credibility, the way in which Media’s evidence has been gathered and filed caused 1661’s trade mark attorney, Mr Karia, to file evidence pointing out that Mr Hannay’s witness statement comprises indirect evidence and hearsay evidence. This is what appears to have prompted Ms Pottratz’s witness statement.

50. However, although the evidence is thin, the accounts filed at Companies House show that there was consistent turnover over several years. In relation to what had generated that turnover, it seems to me that it could only have been dance films and videos. The Companies House reports begin by referring to production fees and there is nothing in the evidence which suggests that by the time ‘production fees’ had

changed to 'turnover' that the position was any different. It is clear that some films, including Six Solos and Uath Lochans, were produced. However, there is no evidence of (for example) promotional material, sales and marketing or distribution services which show something more than Media simply promoting its own business (i.e. not for others, as a trade). The thin evidence means that, for example, the claim to goodwill in relation to DVDs and streaming cannot succeed, but it is tolerably clear that films were produced by Media, that there was turnover in relation to this each year, over a relatively long period, and that the websites were updated at reasonably consistent intervals over the years.

51. For some of those years the production fee/turnover figures are borderline trivial, but in other years the figures point to a small but protectable goodwill considering the services are 'arts house' production of dance films and dance videos, cumulatively amounting to £208,989 (to 2020). The sign itself is not low in inherent distinctiveness, so does not face an uphill struggle on that basis to become distinctive of Media's business. At paragraph 3-31, Professor Wadlow, in *Wadlow on the Law of Passing Off 6th Edition*, says that "the action for passing off protects goodwill regardless of the size of the enterprise". He goes on to say that "[the] mere fact that the claimant's business is very small does not prevent it having a goodwill. A fortiori, the scale of the claimants' business in relation to the market as a whole is not determinative." Mr Karia's statement that Media's Companies House returns show that it is a micro company, and that micro companies are "very small companies", is, therefore, far from determinative. In *Lumos Skincare Limited v Sweet Squared Limited and others*, the Court of Appeal held that the claimant's sales were small but that the defendant had passed off its LUMOS nail care products as the claimant's goods.²¹ The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at

²¹ [2013] EWCA Civ 590

first instance put it, “*very limited*”, the claimant’s goodwill was found to be sufficient to entitle it to restrain the defendant’s trade under LUMOS. The court said that if the number of the claimant’s customers was small because of the nature or extent of the claimant’s business, then a substantial number of those who would be misled would also be proportionately small.

52. I find that Media’s business enjoyed a small but protectable level of goodwill at the relevant date for film and video production in relation to dance. Some of the use is GO/AT, which I do not consider would be perceived as the word GOAT but, instead of GO and AT. However, there is also use of Goat, and most of the instances of GO/AT show use of Goat or GOAT alongside, such as on the websites. I find that the sign Goat is distinctive of the goodwill in Media’s business of film and video production in relation to dance.

53. The goodwill goes no wider than film and video production in relation to dance. Media attacks the whole of 1661’s ‘348 registration. There is no basis, particularly given Media’s modest goodwill, on which I can see that there would be misrepresentation for any of the goods for which the ‘348 mark is registered, which are:²²

Class 9: Glasses; sunglasses; optical glasses; sports glasses; ski glasses; protective glasses; corrective glasses; eye glasses; reading glasses; magnifying glasses; smart glasses; anti-glare glasses; virtual reality glasses; hand grips and stands adapted for mobile phones; straps for mobile phones; protective covers and cases for mobile phones, tablet computers, laptop computers and portable media players; armbands specially adapted for personal electronic devices, namely, mobile phones and portable media players.

Class 14: Jewelry; watches; jewelry rolls; jewelry cases; jewelry boxes; jewelry making kits.

²² See, for example, *Teleworks v Telework Group* [2002] R.P.C. 27. The claimant’s turnover was about 0.001% of the market, which was protectable, but the level of goodwill was held to be too small to cause deception when the parties were not in competitive fields of business.

Class 18: Bags; belt bags and hip bags; military duffle bags, garment bags for travel, tote bags; shoulder bags; backpacks; book bags; sports bags; bum bags; wallets; credit card holders; business card holders; handbags; travel bags; weekend bags; overnight bags; clutch bags; athletic bags; evening bags; hobo bags; flight bags; drawstring bags; wheeled bags; duffle bags; suit bags; carry-on bags; beach bags; sling bags; hiking bags; waist bags; cross body bags; bracelet bags; bangle bags; leather bags; imitation leather bags; gym bags; carry-all bags; shopping bags; shoe bags for travel; bags for carrying animals; men's clutch bags; bags for carrying baby accessories; sportsman bags; cosmetic bags sold empty; tool bags sold empty; shaving bags sold empty; suitcases.

Class 20: Furniture; furniture parts and accessories; picture frames; home décor and accents.

Class 28: Toys; game cards; trading cards for games; collectibles; collectible toys; collectible toy figures; sporting goods; athletic sporting goods; storage racks for sporting goods; sporting goods and equipment.

54. Even if Media's goodwill was more substantial, these goods are miles away from the area in which Media's goodwill exists. Although the absence of a common field of goodwill is not fatal, it is important to whether deception will occur. This is not a *Lego*-type case whereby Media is a household name (see *Harrods Limited v Harrodian School Limited* [1996] RPC 697). Even if I am wrong in my findings as to the limits of Media's goodwill and that it extends to all of the goods and services claimed by Media, my conclusion would be the same. Media's section 5(4)(a) claim fails. This means that I do not need to consider whether the position would have been the same or different at any earlier date than the *prima facie* relevant date.

Media's invalidation application: outcome

55. The outcome of the invalidation action is that it succeeds in relation to the following goods:

Class 18: Bags; belt bags and hip bags; military duffle bags, garment bags for travel, tote bags; shoulder bags; backpacks; book bags; sports bags; bum bags; wallets; credit card holders; business card holders; handbags; travel bags; weekend bags; overnight bags; clutch bags; athletic bags; evening bags; hobo bags; flight bags; drawstring bags; wheeled bags; duffle bags; suit bags; carry-on bags; beach bags; sling bags; hiking bags; waist bags; cross body bags; bracelet bags; bangle bags; leather bags; imitation leather bags; gym bags; carry-all bags; shopping bags; shoe bags for travel; bags for carrying animals; men's clutch bags; bags for carrying baby accessories; sportsman bags; cosmetic bags sold empty; tool bags sold empty; shaving bags sold empty.

Class 20: Home décor and accents.

Class 28: Toys; collectible toys; collectible toy figures; game cards; trading cards for games.

56. Under section 47(6), the registration for these goods is deemed never to have been made. The registration remains valid for all goods other than those listed in paragraph 55.

1661's oppositions

Sections 5(1), 5(2)(a) and 5(2)(b) of the Act

57. Sections 5(1), 5(2)(a) and 5(2)(b) state:

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

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

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

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

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

58. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case, *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. They also apply to the consideration under section 5(2)(a), save that the marks under that ground are said to be identical.

The principles

(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.

59. Under section 5(2)(a), 1661 relies upon the class 9 goods of its '348 mark, set out above in paragraph 53, against the contested word mark. 1661 relies upon the '499 mark in relation to its goods and services in classes 9, 38 and 42, as shown below, under sections 5(1) and 5(2)(a) against the contested word mark and under section 5(2)(b) against the contested stylised mark. Some of the goods and services in these classes are the subject of an opposition by a third party, which has not yet been determined. I have underlined the opposed goods and services:

Class 9: Software; e-commerce software; computer software in the field of e-commerce; mobile application software in the field of e-commerce; downloadable and non-downloadable software in the field of e-commerce; computer and mobile application software to allow users to perform electronic business transactions; e-commerce software allowing users to find, research, analyze, compare, sell, and purchase goods and services; computer and mobile application software to allow users to perform electronic business transactions via the Internet, global computer communication networks, and wireless telecommunications networks; computer and mobile application software to allow users to find, research, analyze, compare, sell, and purchase goods and services; computer and mobile application software for advertising, buying and selling new and used clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for use in operating an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for use in the online retail sale for others of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software in

the field of analyzing consumer and marketplace trends; computer and mobile application software for verifying the authenticity of consumer products; computer and mobile application software for verifying the authenticity of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for categorizing and indexing products; computer and mobile application software for analyzing and displaying sales trends, customer demands and buying patterns; computer and mobile application software for test fitting consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets using augmented reality; computer and mobile application software featuring augmented reality; computer and mobile application software for managing user accounts; computer and mobile application software for managing the listing of goods and services available for sale and purchase; electronic publications, articles, magazines, newsletters, catalogues and blogs; Computer application software allowing users to find, research, analyze, compare, sell, and purchase goods and services via the Internet, global computer communication networks, and wireless telecommunications networks.

Class 38: Telecommunication services; data communication services by electronic means; telecommunication services, namely transmission of images, videos, audio recordings, electronic messages, text messages, e-mail notification and push-notification alerts via the Internet, global computer communications networks, and wireless; telecommunication services, namely communications between buyers and sellers by electronic means via the Internet, global computer communications networks, and wireless telecommunications networks; providing access to a website and mobile application to facilitate e-commerce transactions; providing access to an online marketplace via a website and mobile application; providing access to a website and mobile application to connect buyers and sellers of consumer products; providing access to a website and mobile application for advertising, buying and selling new and used consumer products, namely, clothing, footwear,

headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing access to an online retail site and mobile application for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing access to an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing access to an online retailer for others to advertise, sell and purchase consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing access to computer database containing business and commercial information; providing access to computer database featuring reviews of consumer products and sellers; providing access to online publications, articles, magazines, newsletters, catalogues and blogs; Telecommunication services, namely transmission of electronic messages, text messages, and push-notification alerts between consumer product buyers and sellers on the Internet, global computer communications networks, and wireless telecommunications networks.

Class 42: Application service provider (ASP) services; software as a service (SaaS) provider; application service provider (ASP) services in the field of e-commerce; software as a service (SaaS) provider in the field of e-commerce; application service provider (ASP) services in the field of facilitating electronic business transactions via the Internet, global computer communication networks, and wireless telecommunications networks; software as a service (SaaS) provider in the field of facilitating electronic business transactions via the Internet, global computer communication networks, and wireless telecommunications networks; application service provider (ASP) services in the field of facilitating the online purchase and sale of consumer goods via the Internet, global computer communication networks, and wireless telecommunications networks; software as a service (SaaS) provider in the field

of facilitating the online purchase and sale of consumer goods via the Internet, global computer communication networks, and wireless telecommunications networks; application service provider (ASP) services for advertising, buying and selling new and used consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider for advertising, buying and selling new and used consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; application service provider (ASP) services for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; application service provider (ASP) services in the field of an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider in the field of an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; application service provider (ASP) services in the field of online retail sale for others of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider in the field of online retail sale for others of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories; application service provider (ASP) services in the field of analyzing consumer and marketplace trends; software as a service

(SaaS) provider in the field of analyzing consumer and marketplace trends;
application service provider (ASP) services in the field of augmented reality;
software as a service (SaaS) provider in the field of augmented reality;
application service provider (ASP) services featuring software for virtual test fitting of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider featuring software for virtual test fitting of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing use of software for electronic business transactions in online marketplaces via the Internet, global computer communication networks, and wireless telecommunications networks; hosting an e-commerce website on the internet; hosting an e-commerce website on the internet featuring consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; hosting an application for mobile phones and tablet computers in the field of e-commerce; hosting an application for mobile phones and tablet computers featuring consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; hosting an application for mobile phones and tablet computers for the retail sale of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; hosting of digital content, namely, publications, articles, magazines, newsletters, catalogues and blogs; creating and maintaining blogs for others; validating the authenticity of consumer products; authentication of consumer products; authentication of origin of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; Providing temporary use of online non-downloadable software for electronic business transactions in online marketplaces utilizing the Internet, global computer communication networks, and wireless telecommunications networks; authentication services in the field of collectible consumer goods,

namely, the inspection and verification of authenticity of athletic and sporting footwear, apparel, and works of art; Providing use of online non-downloadable software.

60. Media's specifications are largely the same in both of its contested applications. I will begin by comparing the goods in class 9 of the contested applications with 1661's earlier goods and services. Media's class 9 specification is set out below. I have included annotations where the differences lie between its two class 9 specifications:

Digital recorded media; *downloadable digital media*;¹ electronic publications; downloadable electronic publications and documentation; digital video; music, sound, images, text, signals, software, information, data and code provided by telecommunications networks, by online delivery and by way of the Internet and the worldwide web; sound or video recordings or publications in electronic form supplied on-line or from facilities provided on the Internet; digital media provided from the Internet; digital recordings of performing arts provided from the Internet; multi-media recordings; recordings in sound or images; records, compact discs, mini discs, laser discs, digital video discs, digital visual recordings, digital audio recordings, audio cassettes, video cassettes, magnetic tape, computer software and firmware, computer multimedia products; magnetic and optical programme bearing media; floppy discs, CD-ROM, interactive compact discs; computer software; computer programmes; application software; dance software; media streaming software; broadcast software; data analytics software; computer databases; software provided from a computer network; computer software supplied from the Internet; interactive games; interactive software; digital media streaming devices; devices for streaming media content over local wireless networks; computer application software for streaming audio-visual media content via the internet; *parts and fittings for all the aforesaid goods*.²

¹ *Downloadable digital media* is not part of the specification for the stylised mark.

² *Parts and fittings for all the aforesaid goods* is not part of the specification for the word-only mark.

61. The law requires that goods and services be considered identical where one party's description of its goods and services encompasses the specific goods and services covered by the other party's description (and vice versa): *Gérard Meric v OHIM*, General Court of the European Union ("GC").²³

Class 9

62. Media's *digital recorded media; downloadable digital media; electronic publications; downloadable electronic publications and documentation; digital video; music, sound, images, text, signals, information, data and code provided by telecommunications networks, by online delivery and by way of the Internet and the worldwide web; sound or video recordings in electronic form supplied on-line or from facilities provided on the Internet; digital media provided from the Internet; digital recordings of performing arts provided from the Internet; multi-media recordings; recordings in sound or images; records, compact discs, mini discs, laser discs, digital video discs, digital visual recordings, digital audio recordings, audio cassettes, video cassettes; publications in electronic form supplied on-line or from facilities provided on the Internet;* are identical to 1661's electronic publications, articles, magazines, newsletters, catalogues and blogs.

63. Media's *computer software; computer programmes; application software; software provided from a computer network; computer software supplied from the Internet; software [...] provided by telecommunications networks, by online delivery and by way of the Internet and the worldwide web; computer application software for streaming audio-visual media content via the internet; media streaming software; broadcast software magnetic tape, computer software and firmware, computer multimedia products; magnetic and optical programme bearing media; floppy discs, CD-ROM, interactive compact discs;* are *Merici* identical to 1661's software (an opposed term) and all its other software in the specification of the '499 earlier mark (many of which are unopposed terms). Media's *data analytics software* is identical to 1661's computer and mobile application software for analyzing and displaying sales

²³ Case T-33/05.

trends, customer demands and buying patterns. Media's *interactive software* is identical to the opposed software in class 9 of the '499 mark. It is also identical to (for example) 1661's computer and mobile application software to allow users to perform electronic business transactions; e-commerce software allowing users to find, research, analyze, compare, sell, and purchase goods and services; computer and mobile application software to allow users to perform electronic business transactions via the Internet, global computer communication networks, and wireless telecommunications networks because all of these types of software enable the user to interact with it in order to achieve the purpose of using the software.

64. Media's stylised application covers *parts and fittings for all the aforesaid goods*, which are all the goods in its class 9 specification. These include parts and fittings for its *digital media streaming devices; devices for streaming media content over local wireless networks*. Such goods are identical to some of 1661's class 9 goods in its '348 specification; such as hand grips and stands adapted for mobile phones; straps for mobile phones; protective covers and cases for mobile phones, tablet computers, laptop computers and portable media players; armbands specially adapted for personal electronic devices, namely, mobile phones and portable media players.

65. Where not identical, in comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, 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.”

66. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

67. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, the GC stated that complementary means:²⁴

“82 ... there is a close connection between [the goods], 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

68. In *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 Jacob J said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

69. 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.”

²⁴ Case T-325/06, the GC.

²⁵ In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services.

70. At the hearing, Mr Hannay objected to the inclusion in the specification of the '499 mark of the term 'e-commerce'. He asked me to decide whether that term can be allowed from a classification perspective. That is outside of the inter partes nature of these proceedings. I observe that the term 'e-commerce' is listed as an acceptable term in the IPO's classification database, which is searchable on the IPO's website, in classes 9, 35, 36, 38 and 42.

71. Media's *dance software* is *Meric* identical to 1661's opposed software. Dance software does not appear to be similar to any of the other types of software (which are limited as to purpose) in the class 9 specification of the '499 mark, nor to the class 9 specification in 1661's '348 mark. *Dance software* is highly similar to application service provider (ASP) services; software as a service (SaaS) provider; Providing use of online non-downloadable software because the services are the non-downloadable version of computer software (at large). These terms in 1661's '499 class 42 specification are opposed. I cannot see any other of the unopposed terms in the class 42 specification which are similar to *dance software*, nor is it similar to any of 1661's class 38 services.

72. Media's *computer databases* are highly similar, if not identical, to (for example) 1661's computer and mobile application software for categorizing and indexing products; computer and mobile application software for managing user accounts; computer and mobile application software for managing the listing of goods and services available for sale and purchase, in class 9. The purpose of the parties' goods is to store, arrange and access data; the users and method of use will be the same; the trade channels will be the same and, if the goods are not strictly identical, they will be complementary since 1661's goods will be necessary to operate a computer database.

73. Media's *interactive games* is identical to the opposed term software and to the opposed computer and mobile application software featuring augmented reality. It is also highly similar to the class 42 services application service provider (ASP) services; software as a service (SaaS) provider; application service provider (ASP) services in the field of augmented reality; software as a service (SaaS) provider in the field of

augmented reality; providing use of online non-downloadable software because these services are the non-downloadable version of computer software and augmented reality software, used in interactive games. I cannot see any other goods or services in 1661's '499 mark which are similar to *interactive games*.

74. It is in my view common knowledge that providers of certain telecommunication services will provide their own devices and software to access the services and, therefore, one is dependent on the other for their operation. I consider there to be a medium degree of similarity between Media's *digital media streaming devices; devices for streaming media content over local wireless networks* and 1661's class 38 telecommunication services.

Class 41

75. Media's class 41 specification is set out below. The italicised terms are not part of the specification for the stylised mark:

Media production; audio and video production; photography; dubbing; film and video editing services; subtitling; film production; microfilming; production of music; production of documentary films; production of promotional videos; production of dance media; recording studio services; videotape film production; videotape editing; videotaping; cultural services; entertainment services; educational and training services; publication of films, music, books and texts; photographic reporting; photography; film direction and production services; ticket reservation and booking services for cultural, entertainment and educational and events; choreography; choreographic services; writing services; provision of information and tickets to events and festivals and distributing these to customers, other ticket agency activities, including bookings for shows or any festivals; publishing of papers in relation to dance; providing electronic publications; publishing of memorandums, leaflets, newsletters, journals, books and handbooks in the field of videography, dance and performing arts; providing of training; training services;¹ booking of performing artists for events (services of a promoter); instruction in the field of the performing arts; live theatre performances; live performance services; live

performances (presentation of -); organisation, production and presentation of theatrical performances; organising of festivals; organization, production and presentation of theatrical performances; performance of dance, music and drama; performance of films; performances (Presentation of live -); presentation of live dance performances; presentation of live entertainment performances; presentation of live performances; presentation of live show performances; presentation of musical performances; presentation of theatrical performances; production of live performances; production of stage performances; production of theatrical performances; providing performing arts theatre facilities; provision of live musical performances; services providing entertainment in the form of live performances; theatre performances; theatrical floor shows provided at performance venues; theatrical performances; theatrical performances both animated and live action; theatrical shows provided at performance venues; information, advisory and consultancy services relating to all the aforesaid services.

¹ Training services are not part of the specification for the word-only mark.

76. Following the particularisation of its case earlier in the proceedings, reflected in its skeleton argument and the schedule thereto, 1661 claims that all of Media's class 41 services are similar to its (opposed) software (Class 9) and/or application service provider (ASP) services; software as a service (SaaS) provider (Class 42). It claims that Media's *publishing of papers in relation to dance; providing electronic publications; publishing of memorandums, leaflets, newsletters, journals, books and handbooks in the field of videography, dance and performing arts* are similar to its electronic publications, articles, magazines, newsletters, catalogues and blogs. The particularisation is limited to these goods and services. 1661 cites a decision of this tribunal in support, wherein it was found that there was a low level of similarity between software and various entertainment services and coaching for musical artists.²⁶ 1661 recognises that I am not bound by the decision, which is correct: I must make my own assessment.

²⁶ Case BL O/071/22 *Alexey Kryazhev v BRKR.IO, Inc.*

77. *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, concerned a comparison between the applicant for cancellation's goods and services in class 9 and 42, which were 'Computer software for the production of platform-independent internet shops and internet authoring systems chiefly for the reservation, booking and payment of accommodation'; and 'Development and design of computer software, namely for internet shops and internet authoring systems, especially for the reservation, booking and payment of accommodation', and the registered proprietor's services in classes 39 and 42, which were 'Information services relating to transportation services, including information services provided on-line from a computer database or the internet; travel reservation and travel booking services provided by means of the world wide web'; and 'Computerised hotel reservation services'. The Board of Appeal had agreed with the Cancellation Division at OHIM that the parties' goods and services were not similar and, therefore, despite the parties' signs being identical (EASYHOTEL), there was no likelihood of confusion. The applicant for cancellation appealed and the GC stated in its judgment:

"49 In addition, the Board of Appeal examined whether the goods and services concerned may be complementary. According to its findings, complementarity had to be excluded in the present case since the public at large, for which the services covered by the mark at issue are intended, does not purchase the relevant goods and services covered by the earlier mark, which are exclusively intended for businesses which, subsequently, provide services to the public at large.

50 Finally, the Board of Appeal found, in the same context, that users of the internet who purchase travel services on-line are not likely to be aware of who provided the software that allows an internet shop to operate and are, in any event, able to distinguish between a company that provides sophisticated technology and another company that sells travel services via the internet.

51 Those findings must be upheld. They show, to the requisite legal standard, that the goods and services concerned differ in respect of their nature, intended purpose and method of use and are neither in competition with each other nor

complementary. First of all, the relevant goods and services covered by the earlier trade mark are computer-related whereas the information, booking and reservation services covered by the mark at issue are different and use computer technology only to support the transmission of information or to make it possible to reserve hotel accommodation or travel.

52 Further, the relevant goods and services covered by the earlier trade mark are especially intended for businesses in the hotel and travel sector, and the information, booking and reservation services covered by the trade mark at issue are intended for the public at large.

53 In addition, the relevant goods and services covered by the earlier mark are used to enable a software system, and, more specifically, an internet shop, to function, whereas the information, booking and reservation services covered by the trade mark at issue are used to reserve hotel accommodation or travel.

54 The mere fact that the information, booking and reservation services covered by the trade mark at issue are exclusively provided via the internet and therefore require software support such as that provided by the goods and services covered by the earlier trade mark does not suffice to remove the essential differences between the goods and services concerned in terms of their nature, their intended purpose and their method of use.

55 Computer goods and computer services are used in nearly all sectors. Often, the same goods or services – for example, a certain type of software or operating system – may be used for very different purposes, and that does not mean that they become different or distinct goods or services. Conversely, travel agency services do not become something else – in terms of their nature, intended purpose or method of use – solely because they are provided via the internet, particularly since, nowadays, use of computer applications for the provision of such services is almost essential, even where those services are not provided by an internet shop.

56 Moreover, the goods and services concerned are not substitutable, since they are intended for different publics. Therefore, the Board of Appeal was right to find that those goods and services are not in competition with each other.

57 Finally, those same goods and services are also not complementary. It must be recalled in this respect that goods or services which are complementary are those where 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 consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gómez Frías (euroMASTER)*, not published in the ECR, paragraph 35; and Case T-420/03 *El Corte Inglés v OHIM – Abril Sánchez and Ricote Saugar (Boomerang TV)* [2008] ECR I-0000, paragraph 98).

58 That case-law definition implies that complementary goods or services can be used together, which presupposes that they are intended for the same public. It follows that there can be no complementary connection between, on the one hand, the goods and services which are necessary for the running of a commercial undertaking and, on the other, the goods and services produced or supplied by that undertaking. Those two categories of goods or services are not used together since those in the first category are used by the relevant undertaking itself whilst those in the second are used by customers of that undertaking.

59 Although it accepts that the end users of the goods and services concerned are different, the applicant maintains that a likelihood of confusion cannot be ruled out in the present case since the relevant goods and services covered by the earlier mark have the sole purpose of making it possible to provide the information, booking and reservation services covered by the mark at issue. As a general rule, the public concerned by those services does not know who developed the necessary software and likewise cannot distinguish between the

information on the intervener's website which comes from the intervener itself and that which derives from the software or services provided by an undertaking specialised in computing, such as the applicant. In short, on the intervener's website the services covered by the mark at issue are indissociable from the relevant goods and services covered by the earlier mark.

60 That argument cannot be accepted. The commercial origin of the software and the computer services which enable the intervener's website to function is not generally of the slightest interest to the public for which the services covered by the mark at issue, which are supplied via that website, are intended. For that public, the intervener's website is a mere tool for the online reservation of travel and accommodation. What is of importance is that it functions well and not who provided the software and computer services which enable it to function.

61 If, however, some of the intervener's customers wonder about the commercial origin of the software and the software development and design services which are necessary for the functioning of the intervener's website, they are capable, as was correctly pointed out by the Board of Appeal, of making a distinction between the specialised undertaking which supplies those goods and services and the intervener which supplies services relating to the tourism and travel sector over the internet. Since the services covered by the mark at issue are, by definition, supplied exclusively over the internet, it must be assumed that the intervener's customers have at least some basic knowledge of computing. They are thus aware that an online reservation system cannot be set up by merely any computer user and that it requires software and software development and design services which are provided by a specialised undertaking.

62 The applicant's claim that the intervener's customers cannot distinguish information which comes from the intervener itself from that which derives from software and computer services of the kind covered by the earlier mark is likewise incorrect. The information likely to be of interest to the intervener's customers is that relating to travel arrangements, the availability of hotel accommodation and their prices. The provision of that information is precisely

what constitutes the services covered by the mark at issue. The goods and services covered by the earlier mark serve only to convey that information and do not themselves transmit other separate information to the persons concerned.”

78. Computer software is used in every part of modern life. This does not automatically make computer software similar to the services which use computer software to operate. If the average consumer for an undertaking is the general public, that average consumer is not likely to be interested in what software the undertaking uses and would not consider there to be a link between them. Whether there is complementarity depends on the facts of the case and the identity of the relevant public.

79. The relevant date in *Commercy* was 21 September 2000. At that time, mobile ‘apps’ were not prevalent, if in use at all. By the relevant date in these proceedings, apps had become pervasive, but not in relation to all business sectors. For example, takeaway outlets provide apps to enable food orders to be made for collection or delivery. Such apps will be aimed at the same consumers as the takeaway service itself. Consumers use apps to manage their bank accounts and to book tickets to entertainment.

80. Some of Media’s services will be provided to artists, such as film production and recording studio services. As in *Commercy*, Media’s consumers will not be interested in the software used to provide some of Media’s services: they are not the average consumer for the software. I find that there is no similarity between 1661’s software (Class 9) and Media’s class 41 services except for:

entertainment services; educational and training services; providing of training; training services.

81. Entertainment services includes gaming services, and 1661’s software includes gaming software. There will be overlap in users, channels of trade and the goods and services could be complementary or in competition. The same is the case in relation to 1661’s application service provider (ASP) services; software as a service (SaaS)

provider (Class 42) because games can be played as apps or non-downloadable software. In relation to educational and training services; providing of training; training services, educational and training providers may provide software and/or apps for students to access, for example, tutorials, reference materials and practice tests. The services set out above are similar to 1661's software and application service provider (ASP) services; software as a service (SaaS) provider to a medium degree.

82. The following of Media's services are similar to a medium degree to 1661's application service provider (ASP) services; software as a service (SaaS):

Media production; audio and video production; photography; dubbing; film and video editing services; subtitling; film production; film direction and production services; production of music; production of documentary films; production of promotional videos; production of dance media; ticket reservation and booking services for cultural, entertainment and educational and events; provision of information and tickets to events and festivals and distributing these to customers, other ticket agency activities, including bookings for shows or any festivals.

83. The services are similar because consumers can use apps to create, alter and share photographs, videos and films. The purpose is shared, users may be the same and there may be competition between using an app or engaging Media's services.

84. *Information, advisory and consultancy services relating to all the aforesaid services* succeeds to the extent that it relates to services which I have found to be similar, on the basis that there will be shared channels of trade and a degree of complementarity, giving rise to a low to medium degree of similarity.

85. There is no similarity between 1661's application service provider (ASP) services; software as a service (SaaS) provider and the remainder of Media's services:

Microfilming; recording studio services; videotape film production; videotape editing; videotaping; cultural services; publication of films, music; photographic reporting; choreography; choreographic services; writing services; booking of

performing artists for events (services of a promoter); instruction in the field of the performing arts; live theatre performances; live performance services; live performances (presentation of -); organisation, production and presentation of theatrical performances; organising of festivals; organization, production and presentation of theatrical performances; performance of dance, music and drama; performance of films; performances (Presentation of live -); presentation of live dance performances; presentation of live entertainment performances; presentation of live performances; presentation of live show performances; presentation of musical performances; presentation of theatrical performances; production of live performances; production of stage performances; production of theatrical performances; providing performing arts theatre facilities; provision of live musical performances; services providing entertainment in the form of live performances; theatre performances; theatrical floor shows provided at performance venues; theatrical performances; theatrical performances both animated and live action; theatrical shows provided at performance venues; information, advisory and consultancy services relating to all the aforesaid services.

86. These are all services which would not appear to be naturally accessible or deliverable via an app. There is no evidence to the contrary. I find that they are not similar.

87. 1661 claims, in its particularisation of its pleadings earlier in the proceedings and in the schedule to its skeleton arguments, that Media's *publishing of papers in relation to dance; providing electronic publications; publishing of memorandums, leaflets, newsletters, journals, books and handbooks in the field of dance and performing arts* (as set out in its skeleton arguments) are similar to 1661's electronic publications, articles, magazines, newsletters, catalogues and blogs. I agree. There is a degree of complementarity as the published content and the publishing often go hand in hand; a publisher's name is often associated strongly with the content published so that the average consumer will think that the same economic entity is responsible for the publishing service and the publications themselves. The overall purpose is to get end content to the end user. There may be shared trade channels, with the electronic publication being obtained from the publisher. I find these goods and services to be

similar to a medium degree. I note that Media also has the following services in its class 41 specification:

publication of films, music, books and texts; publishing of memorandums, leaflets, newsletters, journals, books and handbooks in the field of videography.

88. However, these have not been included in 1661's particularisation of its claim to similarity under sections 5(1) and 5(2). I will not, therefore, include them in the assessment as the effect of them being left out of 1661's particularisation is that they are not similar. I have already found that they are not similar to 1661's software; application service provider (ASP) services; software as a service (SaaS) provider.

Average consumer and the purchasing process

89. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the parties' goods and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."²⁷ The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer*. I will assess this in relation to the goods and services which I have found have some degree of similarity. 1661 submits that the average consumer for all of its goods and services in classes 9, 8 and 42 and Media's class 9 goods is the general public. It submits that Media's class 41 services are directed more towards a business or professional user but some may also be used by the general public. I broadly agree with this. 1661 submits that, despite the average consumer for some of the services being a business or professional user, that no more than a normal degree of attention will be paid to the purchasing process. I think it is more likely that such a consumer will pay more than an average degree of attention to the purchase as the services will be of some importance financially and reputationally as part of a business purchasing decision.

²⁷ *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).

That purchase is likely to be primarily visual, after consulting a website and marketing information, but I do not discount that some of the services will be discussed aurally during the selection process.

Comparison of marks

90. The parties' word marks are identical.²⁸

91. *Sabel BV v. Puma AG* 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 at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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.”

92. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

93. I will refer to 1661's earlier marks in the singular as they are both GOAT. The comparison is:

1661's mark	Media's stylised mark

²⁸ A word trade mark registration protects the word itself (here BENTLEY) written in any normal font and irrespective of capitalisation and, or highlighting in bold (see e.g. Case T-66/11, *Present-Service Ullrich GmbH & Co. KG v. OHIM*, EU:T:2013:48, para. 57 and the cases referred to therein, BL O/281/14,).”: Professor Ruth Annand, sitting as the Appointed Person, in *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.



94. 1661's marks consists of a single element in which the overall impression of the mark resides. Media's mark consists of three words. GOAT is far larger than MOVING MEDIA, which are positioned below GOAT. The overall impression of Media's mark is dominated by GOAT. The dominance of GOAT means that the parties' marks are visually similar to a high degree, notwithstanding the slightly stylised letters of Media's GOAT element. The marks are aurally similar to a medium degree because GOAT will be heard first, but there are two other words which are not included in 1661's mark. I have considered whether it is likely that MOVING MEDIA will be articulated, but have formed the view that they are more likely than not to be included in oral references to Media's mark (if they are not, the marks are aurally identical). The marks share the concept of a goat, which is obviously an animal, but the additional words MOVING MEDIA create some degree of conceptual difference. I put the conceptual similarity at medium.

Distinctiveness of the earlier marks

95. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier mark has been enhanced (i.e. more distinctiveness has been acquired) through the use made of it. If a mark has an inherently high, or an enhanced, level of distinctiveness, the likelihood of confusion is increased.

96. For the class 9 goods covered by the '348 registration which are now relied upon for sections 5(1) and 5(2), the mark has an average degree of inherent distinctive character. GOAT is a dictionary word, albeit one which does not describe or allude to the goods of the '348 mark or to their characteristics.

97. The goods and services of the '499 mark (not yet registered) which are now relied upon for sections 5(1), 5(2)(a) and 5(2)(b) of the Act are much broader than the class

9 goods relied upon under the '348 mark. The degree of inherent distinctiveness depends upon the specific goods and services. For the majority of goods and services, GOAT has an average degree of inherent distinctiveness. Software at large, application service provider (ASP), software as a service (SaaS) for electronic publications, articles, magazines, newsletters, catalogues and blogs could have goats as their subject matter. If there is any distinctiveness for these goods and services, it must be at a very low level.

98. I turn to 1661's evidence of use of GOAT to decide whether the inherent level of distinctiveness has been enhanced by the use made of GOAT in the UK. Distinctive character is a measure of how strongly the earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identify the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

“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).

99. Mr Webman states that GOAT is a global retail online platform that allows users to buy and sell authenticated apparel, footwear and accessories via the Goat.com website and mobile app. Customers, including those in the UK, can make direct purchases from the website. Exhibit JW2 contains shipping and currency conversion information from the website for purchases made by UK customers, although the date of the print shows that the information was updated on 21 July 2022.

100. Exhibit JW5 comprises press articles about the rise of the GOAT brand. The articles appear to have been published in the US. They refer to the GOAT co-founders entering the 'sneaker marketplace' in July 2015, although at this point in time it is not clear from the evidence whether the retailing service and associated technology was available in the UK. An article on cnbc.com dated 18 October 2018 says that a single pair of sneakers can sell for \$60,000 and that there are over 35,000 unique styles on the GOAT app, all authenticated to prevent counterfeits. An article on a website called SGB Media, dated 21 November 2019, says that GOAT had partnered with the Brooklyn Nets, a sports team in the US. Mr Webman states that the NBA has a large following in the UK. It appears from the end of an article dated 24 January 2020 on the EXPN website, and elsewhere in the exhibits, that the NBA is a US basketball organisation. There are several articles from prior to the relevant date which refer to NBA stars partnering with GOAT.

101. An article dated 23 September 2020 on a website called wsj.com refers to GOAT as being best known for its online marketplace for 'sneakerheads'. According to the article, 1661 was valued at \$1.75 billion, raising nearly \$200 million from investors. Over 350 brands sold their products directly on the GOAT platform, such as Alexander McQueen, as well as the secondary market sales. An article on finance.yahoo.com dated 14 December 2020 says that the secondary sneaker market is booming "with most Americans now working from home".

102. Exhibit JW6 includes screenshots from 1661's GOAT Instagram page, showing 3.9 million followers. The evidence does not show how many followers there were at the relevant date, nor where they were located. Other undated screenshots which show advertisements for GOAT are from the Instagram pages of NBA stars and teams. Mr Webman refers to "increasing visibility" in the UK of the GOAT brand, which he states is demonstrated by the sponsorship deal with the Paris Saint-Germain football club. Mr Webman states that the deal received extensive coverage, including in the UK. Exhibit JW7 carries a Bloomberg report dated 14 April 2022 and Mr Webman confirms that the sponsorship deal was announced after the relevant date. I note that the report states that the US accounts for the majority of GOAT's business, but that management had been pushing GOAT in international markets, and that there were GOAT 'facilities' in the UK and the Netherlands. Another report in The Daily Star,

which is undated, says that the Paris Saint-Germain players will wear the GOAT brand on their sleeves from the start of the 2022-23 season.

103. Mr Webman states that between 2015 and 2021, sales under GOAT in the UK were well in excess of £8 million. Exhibit JW8 comprises analytics figures for the goat.com website which show that at the end of 2021 there had been over 30 million views from the UK. Exhibit JW10 is a screenshot of the GOAT app being available for download from the UK Apple store and that it has a 4.7 out of 5 rating. Mr Webman provides the following table showing the number of times the GOAT app has been downloaded to both Apple and Android devices, in the UK:

	United Kingdom	
	Apple Install	Android Install
2016	4,200	1,055
2017	219,133	41,510
2018	173,861	45,218
2019	146,639	38,969
2020	181,228	36,293
2021	237,400	35,047
Sub Total	962,461	198,092
Total	1,160,553	

104. It is clear from the evidence that the main market for GOAT is in the US. Most of the evidence of use of the mark is in relation to retailing of trainers (sneakers in the US). There is not much which tells me how well-known the mark was in the UK at the relevant date. Whilst the Paris Saint-Germain sponsorship deal shows that 1661's business under the mark GOAT was desirable enough for the football club to enter the sponsorship deal, it was not until after the relevant date that the team displayed the mark on players' sleeves (2022/23 season); and the report of the sponsorship deal is undated, but presumably close to the season. This evidence does not help to establish

the renown of GOAT in the UK prior to the relevant date. Mr Webman states that there were £8 million of sales in the UK between 2015 and 2021. This is over a six-year period: on average, £1.33 million per year. In the context of the UK market for retailing trainers, this is not enough to find an enhanced level of distinctive character.

105. No market figures have been provided in relation to apps. I bear in mind that the GOAT retail app has been downloaded over a million times in the UK. At the relevant date, the app was for the general public, which is the average consumer, to buy or sell trainers. This method of use is analogous to a retailer's website. For instance, one can go to the Marks and Spencer website to order items, or download the Marks and Spencer app to do the same thing. In either case, the consumer is availing themselves of a retailing service. I cannot see that this type of use constitutes a reputation in apps, as opposed to retailing. On that basis, I am not prepared to find that there is enhancement to the distinctive character of GOAT in relation to apps (retail or otherwise).

Likelihood of confusion

106. At the hearing, Mr Hannay urged me to take judicial notice of the general state of the trade mark register and also the Companies House register to demonstrate the number of company names and marks which contain solely the word GOAT. Company name registrations are irrelevant: many companies use entirely different trade marks, not their registered company names. Company names can be registered which are very similar to one another (provided they are not 'too like'). Company names denote businesses whereas trade marks distinguish the goods and services of one undertaking from those of other undertakings. Trade marks are registered for specified goods and services which delineate their protection; company names are not registered in relation to specific goods and services. Mr Hannay referred me to *Lifestyle Equities v Royal County of Berkshire Polo Club* [2023] EWHC 1839 (Ch), at paragraph 70, in which Mellor J considered "Context and the 'crowded' market":

"Instinctively, the long-standing presence of RL Polo, USPA and possibly other third party 'polo' brands must create a different situation. I agree with the Ds that it is necessary to assess the nature of the Cs mark, what it conveys to the

average consumer and its distinctive character in this market which can be characterised as somewhat crowded with 'polo' themed brands. This is not a 'context' issue, and the distinction is clear: context is concerned with an examination of the use complained of, whereas the Ds are saying that it is the Cs mark which brings to that examination the relevance of other 'polo' brands in the market, provided they impinge on the way in which the average consumer views and recalls the Cs' mark."

107. Mr Hannay submitted that the market is crowded with Goat-related brands, such as Media; there is a third party called Goat Solutions Limited which he said operates in classes 9, 35, 38 and 41; and another party called Goat Fashion (which is referred to in Mr Hannay's second witness statement). I am not persuaded by this argument. One of the reasons why is that there is no evidence in this case that 1661 is operating in the same field as Media: I have found that the evidence shows retailing in trainers (1661) and production of (dance) films (Media). The section 5(1) and 5(2) assessment was made on the basis of notional use. Earlier mark '499 is opposed by Goat Solutions Limited. Goat Fashion Limited sold its brand to 1661 in 2021.²⁹ None of this indicates a crowded market which has (i) led to a reduction in distinctiveness of GOAT and (ii) revealed that consumers have become accustomed to differentiating between the marks on account of the number of them.

108. Media has provided a fall-back specification, shown here with additional text in bold and deleted goods and services having been struck through:

3728174 GOAT word-only

Class 9

Digital recorded media; downloadable digital media; electronic publications **in the fields of creative and performing arts**; downloadable electronic publications and documentation **in the fields of creative and performing arts**; digital video; music, sound, images, text, signals, software, information, data and code provided by telecommunications networks, by online delivery and by way of the Internet and the

²⁹ Exhibit B-18.

worldwide web; sound or video recordings or publications in electronic form supplied on-line or from facilities provided on the Internet; digital media provided from the Internet; digital recordings of performing arts provided from the Internet; multi-media recordings; recordings in sound or images; records, compact discs, mini discs, laser discs, digital video discs, digital visual recordings, digital audio recordings, audio cassettes, video cassettes, magnetic tape, ~~computer software and firmware~~, computer multimedia products; magnetic and optical programme bearing media; floppy discs, CD-ROM, interactive compact discs; ~~computer software; computer programmes; application software; dance software; media streaming software; broadcast software; data analytics software; computer databases; software provided from a computer network; computer software supplied from the Internet; interactive games; interactive software; digital media streaming devices; devices for streaming media content over local wireless networks; computer application software for streaming audio-visual media content via the internet.~~

Class 41

Media production; audio and video production; photography; dubbing; film and video editing services; subtitling; film production; microfilming; production of music; production of documentary films; production of promotional videos; production of dance media; recording studio services; videotape film production; videotape editing; videotaping; cultural services; entertainment services; educational and training services; publication of films, music, books and texts; photographic reporting; photography; film direction and production services; ticket reservation and booking services for cultural, entertainment and educational and events; choreography; choreographic services; writing services; provision of information and tickets to events and festivals and distributing these to customers, other ticket agency activities, including bookings for shows or any festivals; publishing of papers in relation to dance; providing electronic publications **in the fields of creative and performing arts**; publishing of memorandums, leaflets, newsletters, journals, books and handbooks in the field of videography, dance and performing arts; providing of training; booking of performing artists for events (services of a promoter); instruction in the field of the performing arts; live theater performances; live performance services; live performances (presentation of -); organisation, production and presentation of

theatrical performances; organising of festivals; organization, production and presentation of theatrical performances; performance of dance, music and drama; performance of films; performances (Presentation of live -); presentation of live dance performances; presentation of live entertainment performances; presentation of live performances; presentation of live show performances; presentation of musical performances; presentation of theatrical performances; production of live performances; production of stage performances; production of theatrical performances; providing performing arts theater facilities; provision of live musical performances; services providing entertainment in the form of live performances; theatre performances; theatrical floor shows provided at performance venues; theatrical performances; theatrical performances both animated and live action; theatrical shows provided at performance venues; information, advisory and consultancy services relating to all the aforesaid services.

3728174 GOAT MOVING MEDIA

Class 9

Digital recorded media; electronic publications **in the fields of creative and performing arts**; downloadable electronic publications and documentation **in the fields of creative and performing arts**; digital video; music, sound, images, text, signals, software, information, data and code provided by telecommunications networks, by online delivery and by way of the Internet and the worldwide web; sound or video recordings or publications in electronic form supplied on-line or from facilities provided on the Internet; digital media provided from the Internet; digital recordings of performing arts provided from the Internet; multi-media recordings; recordings in sound or images; records, compact discs, mini discs, laser discs, digital video discs, digital visual recordings, digital audio recordings, audio cassettes, video cassettes, magnetic tape, computer software and firmware **in the fields of creative and performing arts**; computer multimedia products; magnetic and optical programme bearing media; floppy discs, CD-ROM, interactive compact discs; computer software **in the fields of creative and performing arts**; computer programmes; application software **in the fields of creative and performing arts**; dance software; media streaming software; broadcast software; data analytics software; computer databases; software provided from a computer network **in the fields of creative and performing**

arts; computer software supplied from the Internet **in the fields of creative and performing arts**; interactive games; interactive software **in the fields of creative and performing arts**; digital media streaming devices; devices for streaming media content over local wireless networks; computer application software for streaming audio-visual media content via the internet; parts and fittings for all the aforesaid goods.

Class 41

Audio and video production; photography; dubbing; subtitling; film production; microfilming; production of music; recording studio services; videotape film production; videotape editing; videotaping; cultural services; entertainment services; educational and training services; publication of books and texts, other than publicity texts; photographic reporting; photography; film direction and production services, other than for advertising films; ticket reservation and booking services for cultural, entertainment and educational and events; choreography; choreographic services; writing services; provision of information and tickets to events and festivals and distributing these to customers, other ticket agency activities, including bookings for shows or any festivals; publishing of papers in relation to dance; providing electronic publications **in the fields of creative and performing arts**; publishing of memorandums, leaflets, newsletters, journals, books and handbooks in the field of dance and performing arts; providing of training; training services; booking of performing artists for events (services of a promoter); information, advisory and consultancy services relating to all the aforesaid services.

109. I will take each of these specifications in turn:

- Class 9 of the word-only application: although some goods have been deleted, those that remain are still identical and similar despite the positive limitation to some of the goods. This is because, in relation to the goods which have been limited, 1661's electronic publications are not limited and notionally cover the same goods. The remaining goods were found to be identical or similar earlier in this decision.

- Class 41 of the word-only application: the limitation to *providing electronic publications* does not avoid similarity for the reasons given above. The other services remain either similar or dissimilar for the reasons given earlier in this decision.
- Class 9 of the stylised application: the limitations do not assist because 1661 has cover for software, ASP and SaaS services at large. The remaining goods were found to be identical or similar earlier in this decision.
- Class 41 of the stylised application: the limitation to *providing electronic publications* does not avoid similarity for the reasons given above. The other services remain either similar or dissimilar for the reasons given earlier in this decision.

110. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, the parties' goods and services range from identical to not similar. There is no likelihood of confusion for Media's class 41 services in relation to which I found no similarity.³⁰ In relation to Media's word-only application, which is identical to the earlier marks, the section 5(1) ground succeeds in relation to the goods in class 9 which are identical:

Digital recorded media; downloadable digital media; electronic publications; downloadable electronic publications and documentation; digital video; music, sound, images, text, signals, information, data and code provided by telecommunications networks, by online delivery and by way of the Internet and the worldwide web; sound or video recordings in electronic form supplied on-line or from facilities provided on the Internet; digital media provided from the Internet; digital recordings of performing arts provided from the Internet; multi-media recordings; recordings in sound or images; records, compact discs, mini

³⁰ *Canon*, paragraph 22.

discs, laser discs, digital video discs, digital visual recordings, digital audio recordings, audio cassettes, video cassettes; publications in electronic form supplied on-line or from facilities provided on the Internet; computer software; computer programmes; application software; software provided from a computer network; computer software supplied from the Internet; software [...] provided by telecommunications networks, by online delivery and by way of the Internet and the worldwide web; magnetic tape, computer software and firmware, computer multimedia products; magnetic and optical programme bearing media; floppy discs, CD-ROM, interactive compact discs; data analytics software; interactive software; dance software; interactive games; computer application software for streaming audio-visual media content via the internet; media streaming software; broadcast software; parts and fittings for all the aforesaid goods.

111. The section 5(2)(a) ground also succeeds in relation to goods and services which I have found to have some degree of similarity. The identical marks will cause the average consumer to believe that the goods emanate from the same undertaking and to be directly confused, notwithstanding the above average degree of attention which will be paid to the purchasing process of some of the goods and services. The section 5(2)(a) ground succeeds against:

Class 9: computer databases; digital media streaming devices; devices for streaming media content over local wireless networks.

Class 41: Media production; audio and video production; photography; dubbing; film and video editing services; subtitling; film production; film direction and production services; production of music; production of documentary films; production of promotional videos; production of dance media; ticket reservation and booking services for cultural, entertainment and educational and events; provision of information and tickets to events and festivals and distributing these to customers, other ticket agency activities, including bookings for shows or any festivals; entertainment services; educational and training services; providing of training; publishing of papers in relation to dance; providing electronic publications; publishing of memorandums, leaflets, newsletters, journals, books

and handbooks in the field of videography, dance and performing arts; information, advisory and consultancy services relating to all the aforesaid services.

112. In relation to the stylised mark, I find that there will be direct confusion in relation to all the goods and services for which there is identity or similarity. GOAT is the dominant and distinctive element in both marks and the element which is visually, aurally and conceptually identical. The other words, MOVING MEDIA, will be seen as descriptive or lacking in distinctive character for goods and services related to films and other types of media which is not static. If I am wrong about that, and the difference is noted, it will nevertheless be the instinctive reaction of the average consumer that the marks belong to the same or a linked economic undertaking, signalling brand variants or a variation on what is offered. There will be indirect confusion. The section 5(2)(b) ground succeeds in relation to:

Class 9: Digital recorded media; downloadable digital media; electronic publications; downloadable electronic publications and documentation; digital video; music, sound, images, text, signals, information, data and code provided by telecommunications networks, by online delivery and by way of the Internet and the worldwide web; sound or video recordings in electronic form supplied on-line or from facilities provided on the Internet; digital media provided from the Internet; digital recordings of performing arts provided from the Internet; multi-media recordings; recordings in sound or images; records, compact discs, mini discs, laser discs, digital video discs, digital visual recordings, digital audio recordings, audio cassettes, video cassettes; publications in electronic form supplied on-line or from facilities provided on the Internet; computer software; computer programmes; application software; software provided from a computer network; computer software supplied from the Internet; software [...] provided by telecommunications networks, by online delivery and by way of the Internet and the worldwide web; magnetic tape, computer software and firmware, computer multimedia products; magnetic and optical programme bearing media; floppy discs, CD-ROM, interactive compact discs; data analytics software; interactive software; dance software; interactive games; computer application software for streaming audio-visual media content via the internet;

media streaming software; computer databases; digital media streaming devices; devices for streaming media content over local wireless networks; broadcast software; parts and fittings for all the aforesaid goods

Class 41: Audio and video production; photography; dubbing; subtitling; film production; production of music; training services; entertainment services; educational and training services; providing of training; publishing of papers in relation to dance; providing electronic publications; publishing of memorandums, leaflets, newsletters, journals, books and handbooks in the field of dance and performing arts; production of documentary films; film direction and production services; production of promotional videos; production of dance media; ticket reservation and booking services for cultural, entertainment and educational and events; provision of information and tickets to events and festivals and distributing these to customers, other ticket agency activities, including bookings for shows or any festivals; information, advisory and consultancy services relating to all the aforesaid services.

Section 5(3) of the Act

113. Section 5(3) 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.

(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.”

114. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *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 Saloman*, 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) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L’Oreal v Bellure NV*, paragraph 44.

(g) 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.

(h) 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.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) 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'Oreal v Bellure*).

115. 1661's evidence, as I said earlier in this decision, relates only to retailing of trainers and an app for the same purpose. I found that the scale of use of use was not sufficient for an enhanced distinctive character and I also find that to be the case in relation to the reputation needed for section 5(3). The scale of use, in the context of the market for retail of trainers, is insufficient to find that 1661's mark was known by a significant part of the UK relevant public, which is the general public, at the relevant date. Without the requisite level of reputation, there will be no link. The section 5(3) ground fails.

Section 5(4)(a)

116. Section 5(4)(a) states:

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

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

(aa) [...]

(b) [...]

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

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

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

118. The three elements which the opponent must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

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

119. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 at 223:

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

120. The prima facie relevant date is the date the two contested applications were filed: 2 December 2021. There could be an earlier relevant date given Media’s use of GOAT. At the relevant date, 1661 had a modest level of goodwill in the UK for retailing trainers. The evidence from Media regarding whether 1661 acquired goodwill from an entity called Goat Fashion Limited is irrelevant because 1661 relies upon its own

trading, which I accept from the evidence.³¹ It will be apparent from my earlier comments that I do not see the app as separate from the retailing business: there is no separate goodwill in relation to apps, which are simply the means of accessing the retailing service, as would be the case via a website. The area of 1661's goodwill is far removed from the goods and services of the contested applications. This, together with the level of 1661's use of its sign in the UK, and the average distinctiveness of GOAT, means that there is no likelihood that its customers will be deceived by the use of Media's marks. The use of the contested marks was not liable to be prevented under the law of passing off at the relevant date. I do not, therefore, need to consider the position at an earlier date. The section 5(4)(a) ground fails.

Status of this decision and costs

121. The final outcome of these consolidated proceedings will not be known until the opposition against the '499 mark is finally determined. This is, therefore, a provisional decision. A final decision will be made in respect of the goods and services for which I found a likelihood of confusion once the outcome of the opposition against the '499 mark is known. These proceedings are suspended until such time. Costs will be covered in the final decision.

122. The period for appeal will run from the date of my final decision.

Dated this 5th day of August 2024

**Judi Pike
For the Registrar,
the Comptroller-General**

³¹ Mr Hannay's second witness statement.

Annex 1

Software; e-commerce software; computer software in the field of e-commerce; mobile application software in the field of e-commerce; downloadable and non-downloadable software in the field of e-commerce; computer and mobile application software to allow users to perform electronic business transactions; e-commerce software allowing users to find, research, analyze, compare, sell, and purchase goods and services; computer and mobile application software to allow users to perform electronic business transactions via the Internet, global computer communication networks, and wireless telecommunications networks; computer and mobile application software to allow users to find, research, analyze, compare, sell, and purchase goods and services; computer and mobile application software for advertising, buying and selling new and used clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for use in operating an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for use in the online retail sale for others of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software in the field of analyzing consumer and marketplace trends; computer and mobile application software for verifying the authenticity of consumer products; computer and mobile application software for verifying the authenticity of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; computer and mobile application software for categorizing and indexing products; computer and mobile application software for analyzing and displaying sales trends, customer demands and buying patterns; computer and mobile application software for test fitting consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets using augmented reality; computer and mobile application software featuring augmented reality; computer and mobile application software for managing user accounts; computer and mobile application software for managing the listing of goods and services available for sale and purchase; electronic publications, articles, magazines, newsletters, catalogues and blogs; Computer application software allowing users to find, research, analyze, compare, sell, and purchase goods and services via the Internet, global computer communication networks, and wireless telecommunications networks.

Online retail services; e-commerce services; wholesale services; providing business and commercial information; consignment sale services; online consignment store services; retailing of consumer products; online retail services for consumer products; online retail sale of consumer products; online wholesale services of consumer products; providing an online marketplace for buying and selling new and used goods; providing an online marketplace for connecting potential buyers with potential sellers; providing an online marketplace for buyers and sellers to transact over consumer products; promoting the goods and services of others via a website and mobile application; advertising the goods and services of others; dissemination of advertisements; online advertising on a computer network; sales promotion for others; providing consumer product information via a website and mobile application; wholesale and retail services featuring clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; distribution services, namely, distribution of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; catalogue ordering services featuring clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; operation of an online retail site and mobile application for advertising, buying and selling new and used clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear,

casual wear, clothing accessories, accessories, bags, and wallets; operation of an online retail site and mobile application for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; operation of an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; online retail sale for others of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; operation of a website and provision of a mobile application that allow customers to view and purchase goods and services of others; operation of a website and provision of a mobile application that allow customers to post, advertise for, sell and purchase the goods and services they want; operation of a website and provision of a mobile application that allow third parties to list and offer for sale goods and services; operation of a website and provision of a mobile application for displaying sales trends, customer demands and buying patterns; operation of a sales platform for online users to shop for consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing computerized online ordering services; providing business and commercial information, namely, evaluative feedback in the form of ratings, reviews, recommendations and other consumer information regarding the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and transaction experience via a website and mobile application; the bringing together, for the benefit of others, of a variety of consumer products, namely clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets, to enable sellers to sell and purchasers to purchase those products by electronic means; presentation of goods on communication media for the retailing of consumer products; consultancy, information and advisory services in the field of consumer products; consulting, information and advisory services in the field of consumer and brand protection; rental of advertising space; import and export agency services; operation of a website and provision of a mobile application featuring digital content, namely, publications, articles, magazines, newsletters, catalogues and blogs; Providing an online marketplace for buyers and sellers of collectible consumer goods namely, athletic and sporting footwear; database management services; providing a website featuring evaluative feedback in the form of ratings, reviews, recommendations and other consumer information regarding the value and prices of sellers' goods, buyers' and sellers' performance, delivery, and transaction experience for commercial purposes; providing a searchable advertising guide featuring the goods and services of sellers; advertising and advertising services.

Telecommunication services; data communication services by electronic means; telecommunication services, namely transmission of images, videos, audio recordings, electronic messages, text messages, e-mail notification and push-notification alerts via the Internet, global computer communications networks, and wireless; telecommunication services, namely communications between buyers and sellers by electronic means via the Internet, global computer communications networks, and wireless telecommunications networks; providing access to a website and mobile application to facilitate e-commerce transactions; providing access to an online marketplace via a website and mobile application; providing access to a website and mobile application to connect buyers and sellers of consumer products; providing access to a website and mobile application for advertising, buying and selling new and used consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing access to an online retail site and mobile application for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing access to an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing access to an online retailer for others to advertise, sell and purchase consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing

accessories, accessories, bags, and wallets; providing access to computer database containing business and commercial information; providing access to computer database featuring reviews of consumer products and sellers; providing access to online publications, articles, magazines, newsletters, catalogues and blogs; Telecommunication services, namely transmission of electronic messages, text messages, and push-notification alerts between consumer product buyers and sellers on the Internet, global computer communications networks, and wireless telecommunications networks.

Application service provider (ASP) services; software as a service (SaaS) provider; application service provider (ASP) services in the field of e-commerce; software as a service (SaaS) provider in the field of e-commerce; application service provider (ASP) services in the field of facilitating electronic business transactions via the Internet, global computer communication networks, and wireless telecommunications networks; software as a service (SaaS) provider in the field of facilitating electronic business transactions via the Internet, global computer communication networks, and wireless telecommunications networks; application service provider (ASP) services in the field of facilitating the online purchase and sale of consumer goods via the Internet, global computer communication networks, and wireless telecommunications networks; software as a service (SaaS) provider in the field of facilitating the online purchase and sale of consumer goods via the Internet, global computer communication networks, and wireless telecommunications networks; application service provider (ASP) services for advertising, buying and selling new and used consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider for advertising, buying and selling new and used consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; application service provider (ASP) services for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; application service provider (ASP) services in the field of an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider in the field of an online marketplace for buyers and sellers to transact over consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; application service provider (ASP) services in the field of online retail sale for others of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider in the field of online retail sale for others of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories; application service provider (ASP) services in the field of analyzing consumer and marketplace trends; software as a service (SaaS) provider in the field of analyzing consumer and marketplace trends; application service provider (ASP) services in the field of augmented reality; software as a service (SaaS) provider in the field of augmented reality; application service provider (ASP) services featuring software for virtual test fitting of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; software as a service (SaaS) provider featuring software for virtual test fitting of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; providing use of software for electronic business transactions in online marketplaces via the Internet, global computer communication networks, and wireless telecommunications networks; hosting an e-commerce website on the internet; hosting an e-commerce website on the internet featuring consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; hosting an application for mobile phones and tablet computers in the field of e-commerce; hosting an application for mobile phones and

tablet computers featuring consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; hosting an application for mobile phones and tablet computers for the retail sale of consumer products, namely, clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; hosting of digital content, namely, publications, articles, magazines, newsletters, catalogues and blogs; creating and maintaining blogs for others; validating the authenticity of consumer products; authentication of consumer products; authentication of origin of clothing, footwear, headwear, apparel, intimate wear, swimwear, sports wear, outerwear, formal wear, casual wear, clothing accessories, accessories, bags, and wallets; Providing temporary use of online non-downloadable software for electronic business transactions in online marketplaces utilizing the Internet, global computer communication networks, and wireless telecommunications networks; authentication services in the field of collectible consumer goods, namely, the inspection and verification of authenticity of athletic and sporting footwear, apparel, and works of art; Providing use of online non-downloadable software.