

O/0913/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3851546
IN THE NAME OF BEREAL WEAR LIMITED
IN RESPECT OF THE TRADE MARK**

BeReal

SKIN AND BEYOND

IN CLASSES 3 & 10

AND

**THE OPPOSITION THERETO UNDER NO. 439390
BY BEREAL**

Background and pleadings

1. BeReal Wear Limited (“the applicant”) applied to register the trade mark no. 3851546 for the mark shown on the cover page of this decision in the UK on 21 November 2022. It was accepted and published in the Trade Marks Journal on 9 December 2022 in respect of goods in classes 3 & 10, including cosmetics and massage apparatus, set out at Annex A to this decision.

2. On 27 February 2023, BeReal (“the opponent”) opposed the trade mark on the basis of Section 5(3) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its UK designation of International Registration no. 1647102, for the mark BeReal. The opponent claims it holds a reputation for this mark in the UK in respect of all of its registered goods and services, which are spread across classes 9, 18, 25, 35, 38, 41, 42 and 45. These are set out at Annex B of this decision. The opponent argues that the applicant will benefit from an unfair advantage and/or cause damage to its reputation or detriment to the distinctive character of its mark on the basis that consumers will believe the applicant’s mark shares an economic connection with the opponent.

3. By virtue of its earlier priority date of 18 June 2021, the opponent’s International Registration will, if it is granted protection in the UK, be deemed an earlier mark in accordance with section 6 of the Act. However, the UK designation of the opponent’s International Registration relied upon is currently subject to separate opposition proceedings, and as such it has not yet been granted protection in the UK. The consequence of this on the final outcome of this decision will be discussed at its conclusion.

4. The applicant filed a counterstatement putting the opponent to proof of its reputation and denying that there is any “confusing similarity” between the marks, and denying there is a relationship between the goods. The applicant requests the opposition is refused on this basis.

5. Both parties filed evidence in these proceedings and the applicant filed written submissions during the evidence rounds. This will be referred to within this decision to the extent considered necessary.

6. Both parties are represented in these proceedings. The applicant is represented by Digip AB. The opponent is represented by Barker Brettell LLP.

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

Evidence

8. The opponent filed its evidence in the form of a witness statement in the name of Damien Kieran, General Counsel for the opponent. The witness statement is dated 7 August 2023. It introduces 7 exhibits, namely Exhibit DK1 to Exhibit DK7. The statement and exhibits go to the use and claimed reputation of the opponent's earlier mark. This will be considered in more detail later in this decision.

9. The applicant also filed evidence in these proceedings. This is in the form of a witness statement in the name of Batool Zaidi, the Director of the applicant. The statement is dated 6 October 2023, introduces 6 exhibits, namely Exhibit BZ1 to Exhibit BZ6. The statement and exhibits filed go to the use of the applicant's own mark in the UK since June 2020, and its expansion into a wellness range from February 2022. This evidence has been reviewed but will only be considered in more detail should it become necessary to do so.

Legislation

10. 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”.

11. Section 5(3A) states:

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

12. Section 5A of the Act is as follows:

“5A 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.”

13. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-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-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

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

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

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

14. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements, the cumulation of which must satisfy all elements of the claim. To be successful on this ground, the opponent must prove it holds a reputation for the earlier mark relied upon amongst a significant portion of the public. It must also be established that the marks are similar. If it is found both that the marks are similar and that the earlier mark holds a qualifying reputation it must then be shown that this reputation, combined with the similarity between the marks, will result in the relevant public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage.

15. The relevant date for consideration under section 5(3) of the Act is the application date of the opposed mark, that being 21 November 2022. The relevant territory for consideration is the UK.

Reputation

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

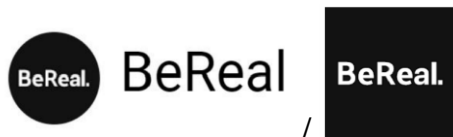
“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

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

17. Exhibit DK1 provides several webpages from web archiving site the Wayback Machine. These show an application available to install under the marks below:



The applications under these marks are shown as available to install via the Google Play and Apple app stores between 2021 and 2022. I note at this stage that the opponent’s mark relied upon is the mark BeReal, presented in an ordinary typeface without additional stylisation. A word mark protects the words contained in the mark, whatever form, colour or typeface are used: see *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39. I find that the use of the opponent’s mark in an alternative

typeface will constitute use of the mark as filed. It also is my view that the opponent's mark continues to act as an indication of origin in all of variations of the marks shown in the evidence, whether it is used in conjunction with a black box, circle, or used with a full stop. I therefore find the use shown in the evidence to either be use of the mark as filed, or use of an acceptable variant of the mark for the purpose of establishing a reputation under the same.¹

18. In his witness statement filed on behalf of the opponent, Mr Kieran explains that 'BeReal' is a social media application that was released in 2020.² He explains that the most well-known feature of the application is that at a different time every day, the application requires users to capture a photo within 2 minutes.³ One archived webpage from the Google Play app store dated 21 September 2021,⁴ describes the app as "[...] the simplest photo sharing app to share once a day your real life in photo with friends."

19. Mr Kieran explains that the opponent does not engage with traditional advertising methods for its application,⁵ nor does it make any money from the application itself, and instead it relies on private investments in order to hire employees and keep the technology working.⁶ The application is free and does not display any advertisements to consumers.⁷ Mr Kieran states the application has caught on entirely through word of mouth.⁸ However, I do note the information provided on archived webpage www.businessofapps.com dating from 16 November 2022, which states:

In 2022, BeReal stepped up the marketing drive in the US and UK, specifically targeting college students with cash for referrals and billboards on campus. It appears to have worked, with BeReal's usage increasing by 315 percent in a year and its downloads increasing by over 1000 percent.

¹ See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 which explains that for genuine use purposes, a registered trade mark used as part of a composite mark must continue to be perceived as indicative of origin in order to be covered by the term 'genuine use'. I find this will also be required in order for that use to contribute towards a finding of reputation under an earlier mark.

² See paragraph 4 of the witness statement of Damien Kieran

³ As above.

⁴ See Exhibit DK1

⁵ See paragraph 5 of the witness statement of Damien Kieran

⁶ See paragraph 7 of the witness statement of Damien Kieran

⁷ See paragraph 6 of the witness statement of Damien Kieran

⁸ See paragraph 5 of the witness statement of Damien Kieran

20. This same archived webpage explains that the BeReal application had, as of August 2022, 73.5 million monthly active users had been downloaded 67 million times since its launch. This page confirms that whilst the app is most popular in the US, the second most popular territory for the application is the UK. This page also details that as of July 2022 there had been 7.9 million UK downloads. A further page provided at Exhibit DK3 from the website wearesocial.com/uk states that in 2022, BeReal was the fourth most downloaded app in the UK. A page provided from www.statista.com also at Exhibit DK3 shows the number of worldwide downloads of the application steadily increasing monthly throughout 2022 from 760,000 in January to 14.7 million in September the same year. Mr Kieran explains that the application won “iPhone App of the Year” in 2022.⁹

21. Mr Kieran explains that the UK continues to be one of the biggest markets for the social media application.¹⁰ A large portion of the opponent’s evidence comprises news articles referring to the application in UK media. A spreadsheet of UK articles referring to the application is provided at Exhibit DK4. This lists over 200 articles between 7 April 2022 and 18 November 2022. A selection of these is provided at Exhibit DK5. Mr Kieran helpfully sets out some of the comments from these articles within his witness statement as below. I note I do not appear to be able to completely cross reference all of the statements from the witness statement with the extracts of the articles provided at Exhibit DK5, although most of these are clearly present:

⁹ See paragraph 5 of the witness statement of Damien Kieran in addition to Exhibit DK1

¹⁰ See paragraph 9 of the witness statement of Damien Kieran

- "Founded in France in 2020, BeReal has been quietly growing and now has more downloads on the AppStore than Facebook, despite having no filters, no ads or like buttons" (Daily Mail article dated 28 April 2022);
- "The success of BeReal – the most-downloaded free app in the UK, the US and Australia in August – is testament to a yearning for life online that is about connection rather than confection" (The Guardian article dated 3 September 2022);
- "Last year, Perreau and Barreyat reportedly raised over \$36 million from US venture capital firms including Andreessen Horowitz, Accel Partners and DST Global Partners" (Daily Mail article dated 28 April 2022);
- "Some reports say BeReal has had more than 27 million downloads worldwide" (BBC News article dated 7 September 2022);
- "From The Russell Howard Hour, in this uncut footage from a live recording of the show, I take my first BeReal..." (Russell Howard's YouTube Channel dated 10 October 2022).
- "In videos of the moment shared on social media, Styles paused to repeat the woman's request into the microphone: "Can you do my BeReal?" (Independent UK article dated 16 September 2022)
- "At the time of writing this article, BeReal is at the number one spot among free Social Networking apps on the App Store, ahead of WhatsApp and Facebook" (Digital Camera World UK Edition article dated 15 August 2022);
- "In a viral TikTok posted by user @LadBible, the musician was filmed taking a selfie on the fans phone.... Lewis said at the beginning of the video: "Oh it's a, oh yes! Right this is Kerry's phone, it's a Bereal, it's a Bereal." The fans cheers excitedly as they realise that Lewis will be posing for a selfie on the lucky fans phone" (Glasgow Live article dated 15 August 2022);
- "According to data shared by Fast Company, BeReal has now been downloaded over 20 million times, and is worth an estimated \$600 million" (Digital Camera World UK Edition article dated 15 August 2022).

22. I also note here the further articles included in this exhibit with headlines such as "What is BeReal and why is everyone suddenly using it?" (from www.thetab.com/UK dating from April 2022) and "What is BeReal – and why is it exploding in popularity" (from www.tomsguide.com also from April 2022). Additional articles are also provided by Mr Kieran at Exhibit DK2, with statements from these articles also helpfully set out in his witness statement as below:

- *"The app has grown from 10,000 daily active users just over a year ago to more than 15mn today, surpassing internal targets. Insiders expect it to reach tens of millions of people by the end of the year"* (Financial Times UK article dated 17 September 2022);
- *"The company raised \$30mn in a series A funding in June, led by Andreessen Horowitz and Accel. Its valuation was not disclosed but several sources told the Financial Times it was around \$600mn"* (Financial Times UK article dated 17 September 2022).
- *"Currently ranked number one on the iOS App store in the social networking category, BeReal describes itself as the "simplest photo sharing app to share once a day your real life in photo with friends""* (Independent article dated 5 September 2022);
- *"BeReal is a free photo sharing app that aims to offer a more authentic image sharing experience, with over 3.5 million daily active users"* (Welsh Government article first published on 8 September 2022).
- *"As of May, it had 10.7 million global downloads, and saw a 157 per cent uptick in downloads from March to April this year"* (Independent article dated 5 September 2022);
- *"It was started in 2020 by French cofounders Kevin Perreau and Alexis Barreyat and it was reportedly valued at £499m in May this year"* (Independent UK article dated 5 September 2022);
- *"The #BeReal hashtag on TikTok has had over 524 million views, with videos showing everything from people trying to BeReal at a Harry Styles concert to jokes about making a BeReal while getting dumped"* (Independent article dated 5 September 2022);

23. I also note the headline "What is BeReal? The 'anti-instagram' app Gen Z is obsessed with" (from the article on www.independent.co.uk dated 5 September 2022).

24. Whilst the evidence provided by the opponent in this matter does not follow a typical structure, that is to show, for example, turnover and advertising spend in relation to the earlier mark, it is my view that this is not detrimental to the opponent's case in this instance. Despite the lack of (or seemingly low) financial investment in the advertising of the opponent's application, I note it has nonetheless received significant UK press coverage, particularly in the months prior to the relevant date. Further, it is clear that whilst the opponent has chosen to allow (at least in part) the product to market itself and has opted not to gain any revenue from the application, it is clear that the application has nonetheless infiltrated the UK market in a significant way, and I note particularly, amongst other figures and statistics provided in articles in the evidence, the reference in the Guardian article from 7 September 2022, shortly prior to the relevant date, that the application was the most downloaded free application in the UK at that time. I also note the reference to the application being the fourth most downloaded app in the UK overall in 2022. Whilst I note the application had not been

around for much more than a couple of years prior to the relevant date, with many of the articles provided seeking still to explain to the reader what the app is, it is clear that it gained traction and popularity in the UK fairly quickly during that time and prior to the relevant date amongst a significant group of users. As set out above, there are references in the articles provided to an explosion in popularity of the app, to ‘everyone’ suddenly using the app, and the headline claiming ‘Gen Z’ are ‘obsessed’ with it. Considering the evidence as a whole, it is my view this shows that the opponent’s application under the mark BeReal will have been known by a significant part of the relevant UK public at the relevant date, and therefore holds the qualifying reputation required for bringing an opposition under section 5(3) of the Act.

25. I note in this case that the opponent claims to hold a reputation for a huge range of goods and services. However, it is my view that at the relevant date, the opponent held a reasonably strong reputation in relation to a narrow set of its goods relied upon in the UK, those being:

Class 9: Downloadable software applications for sending and sharing text, photographs and images; application software for social networking services via the Internet.

Link

26. As I found the opponent to hold a qualifying reputation in relation to some of its goods relied upon, I will move on to consider if I find there will be a link made between the marks, with consideration to the relevant factors set out in *Intel*.

The degree of similarity between the conflicting marks

27. The marks for comparison in this instance are as set out below:

Earlier mark	Contested mark
BeReal	<p style="text-align: center;">BeReal</p> <p style="text-align: center;">SKIN AND BEYOND</p>

28. The earlier mark comprises the two words Be Real. The space between the words is omitted so that these are set out as one element, although they remain clearly distinguishable as two words. The overall impression resides in the combination of the two words, that being the mark as a whole.

29. The contested mark contains the identical element BeReal, in addition to the wording SKIN AND BEYOND in smaller text beneath. Due in part to its smaller size, and to its lack of, or at least low level of distinctiveness for the goods, many of which concern the skin or body, SKIN AND BEYOND plays a lesser role in the overall impression of the mark. The most dominant and distinctive element of the mark is therefore BeReal.

30. Visually, by virtue of their identical dominant and distinctive elements, the marks are similar to a relatively high degree.

31. Aurally, it is my view that due to its smaller size and lack of distinctiveness in relation to the goods, SKIN AND BEYOND in the contested mark is unlikely to be pronounced by the consumer. If this is the case, the marks will be aurally identical. If it is not the case, by virtue of the initial identical verbal element BeReal, I find the marks aurally similar to a medium degree.

32. Conceptually, both marks coincide on the basis that they include the element 'BeReal', which in my view will be construed by the consumer as an instructive expression telling them to be their authentic self. The inclusion of SKIN AND BEYOND in the contested mark conveys the concept of SKIN, that being the layer of tissue covering a person's (or animal's) body, 'and beyond', which in my view will likely convey the concept of something beyond the skin, be it the mind or internal elements of the body, such as the muscles or internal organs. In conjunction with the BeReal element, it may also convey to some the idea that they should be their authentic self from their skin and beyond. Overall, due to the shared concept conveyed by the 'BeReal' element of the marks, I find them to be conceptually similar to a high degree.

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

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

“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”.

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

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

35. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) there is complementarity 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 customers may think that the responsibility for those goods lies with the same undertaking”.

36. The goods covered by the contested mark include a range of cosmetic and massage products. These are dissimilar to the goods for which the opponent holds a reputation, and they are not in a similar field. The nature, method of use and intended purpose of the goods will differ, and they will not be in competition or be complementary. I find it very unlikely channels of trade would frequently be shared. Users will overlap to the extent that all the goods are aimed at the general public, but this is not enough to create any meaningful similarity between the goods overall.

The strength of the earlier mark’s reputation

37. I found the opponent to hold a reasonably strong reputation for its earlier mark.

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

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings

(see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

39. Whilst not directly descriptive of the goods, I note the earlier mark BeReal is somewhat allusive of the goods for which the opponent holds a reputation, namely of a social media and photo sharing application for the purpose of sharing elements of your life with others. I find it holds an inherently low to medium degree of distinctive character in relation to the goods. However, I note the evidence provided (as summarised above), and it is my view that to the UK consumer at the relevant date, the distinctiveness of the earlier mark will have been increased to a medium level by virtue of the use made of the same, in respect of the services for which the opponent holds a reputation only.

Whether there is a likelihood of confusion

40. A likelihood of confusion as assessed under section 5(2)(b) of the Act is reliant on finding some similarity between the goods. I have found these to be dissimilar in this instance, and I would not find a likelihood of confusion between the marks on this basis under 5(2)(b). I note at this stage, it is possible under section 5(3) for the reputation of an earlier mark to be such that the relevant consumer is still likely to believe that the use of a contested mark in relation to dissimilar goods or services will be use of the same or a similar mark deriving from the same or a connected economic entity. A

finding of this nature would result in a conclusion that there is a likelihood that the consumer will be confused as to the origin of the marks either directly or indirectly under this ground. However, having considered the factors in this case, I do not find a likelihood of confusion to be present.

41. I remind myself at this stage that finding similarity between the goods, or indeed a likelihood of confusion, is not required in order to find a link would be made between the marks. However, the closeness of the goods is one factor to take into account when considering if the use of the later mark would bring the earlier mark to mind. Whilst I note the marks themselves are highly similar, it is my view that considering the disparity between the goods, the consumer would not make a link between the marks when used in relation to the goods as filed. If a link were to be made, it is my view that it would be so fleeting that it could not result in an unfair advantage for the applicant or damage to the opponent. Therefore, the opposition based on section 5(3) of the Act must fail.

42. However, in case I am wrong in this respect, I will go on to consider the damage as pleaded.

Damage

43. The opponent's pleadings in respect of damage are very sparse. Question 3 on the TM7 form was completed as follows:

Q3. Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?



Yes



No

Use this space to supply any further information

44. Question 4 goes on to ask if there are any other basis for the opponent's claim of unfair advantage. This box was left blank. Question 5 asks if there are any other basis for a claim of detriment to the reputation of the earlier mark. This was left blank. Question 6 asks if there are any other basis for a claim of detriment to distinctive character. This was also left blank. No additional statement of grounds was filed with the form itself.

45. Considering the significant differences between the goods applied for and those for which the opponent holds a reputation in this case, it is my view that even if a link between the marks were made on the basis that the use of the later mark for the goods filed brought the earlier mark to mind, the factors in this case would not be such that the consumer would assume the goods provided under the contested mark were economically linked to the opponent in some way. I find it very unlikely that in the present case the consumer would assume a party responsible for and with a reputation for a software application would diversify into cosmetic and massage goods under the contested mark, even considering the closeness of the marks and the level of reputation in this particular case. They are in completely different fields and require a very different set up in terms of manufacture and expertise, and I do not find the reputation or distinctiveness of the earlier mark in this case to be so strong that it overcomes these factors. The opponent has not provided me with any additional reasoning to consider, outlining why this might be the case. It is my view that the type of damage pleaded by the opponent has not been made out.

46. Based on my findings above, the opposition based on section 5(3) of the Act must fail.

Final remarks

47. As the opposition has failed in its entirety, it is not necessary to make this decision provisional awaiting the grant of the opponent's earlier International Registration in the UK. Therefore, subject to any successful appeal, this application may now proceed to registration in respect of all of the goods applied for.

48. The applicant is the successful party in this instance, it has not become necessary for me to consider the evidence filed by the applicant concerning the use of its own mark any further in these proceedings.

COSTS

49. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances, and in accordance with Tribunal Practice Notice 1/2023, I award the applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the TM7 filed and preparing and filing the TM8:	£300
Considering the evidence filed and preparing and filing submissions within the evidence rounds:	£700
Total	£1000

50. I therefore order BeReal to pay BeReal Wear Limited the sum of £1000. The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of September 2024

Rosie Le Breton

For the Registrar

Annex A

Class 3: Skincare cosmetics; Beauty serums; Facial moisturizers; Skin moisturizers; Anti-aging moisturizers; Suncare lotions; Skin moisturizer; Skin moisturizers used as cosmetics; Anti-ageing moisturiser; Anti-aging moisturizers used as cosmetics; Beauty lotions; Skin moisturizer masks; Moisturisers [cosmetics]; Skin moisturiser; Skin moisturisers; Facial cleansers; Moisturisers; Skin cleansers; Facial lotions; Anti-aging skincare preparations; Non-medicated skin serums; Skin hydrators; Suncare lotions [for cosmetic use]; Skin cleansers [non-medicated]; Facial lotion; Facial concealer; Exfoliants; Facial moisturisers [cosmetic]; Exfoliant creams; Skin lotions; Exfoliants for the cleansing of the skin; Cosmetic moisturisers; Moisturising skin lotions [cosmetic]; Hair moisturizers; Skin lotion; Anti-ageing serum; Moisturizers; Acne cleansers, cosmetic; Beauty serums with anti-ageing properties; Skin cleansing lotion; Aromatherapy lotions; Cleansing lotions; Facial creams [cosmetics]; Hairstyling serums; Facial cleansers [cosmetic]; Skin balms (Non-medicated -); Exfoliating creams; Non-medicated skin lotions; Beauty creams; Skin cleansers [cosmetic]; Anti-ageing creams; Facial makeup; Non-medicated moisturisers; Skincare preparations; Facial lotions [cosmetic]; Hair serums; Moisturizing creams; Hair moisturisers; Hydrating masks; Moisturising skin creams [cosmetic]; Lotions for the skin; Skin masks [cosmetics]; Beauty soap; Non-medicated skincare preparations; Anti-ageing serums for cosmetic purposes; Sunscreen lotions; Facial gels [cosmetics]; Beauty balm creams; Skin emollients; Cosmetic facial lotions; Pre-shave creams; Moisturiser; Skin make-up; Cosmetic products in the form of aerosols for skincare; Skin emollients [non-medicated]; Non-medicated skin balms; Facial creams; Depilatory lotions; Beauty masks; Moisturising creams; Anti-wrinkle creams; Facial beauty masks; Aromatherapy creams; Cosmetic creams for the skin; Anti-ageing creams [for cosmetic use]; Cosmetics for use on the skin; Masks (Beauty -); Non-medicated skin creams; Skin creams [non-medicated]; Anti-aging creams; Skin texturizers; Exfoliants for the care of the skin; Non-medicated skin clarifying lotions; Facial soaps; Cosmetics; Organic makeup; Cosmetic creams and lotions; Cosmetics in the form of lotions; Skin creams; Moisturising creams, lotions and gels; Cosmetic nourishing creams; Cosmetic hair lotions; Facial toners [cosmetic]; Aftershave lotions; Skin balms [cosmetic]; Hair lotions; Moisturising body lotion [cosmetic]; Skin cleansing cream [non-medicated]; Creams for the skin; Body moisturisers; Skin toners; Hair lotion; Facial oils; Cosmetic

suntan lotions; Facial creams [for cosmetic use]; Facial creams [cosmetic]; Cleansing creams; Body and facial creams [cosmetics]; Non-medicated cosmetics; Beauty gels; Anti-wrinkle creams [for cosmetic use]; Skin hydrators for cosmetic purposes ; Cosmetics for suntanning; Styling lotions; Moisturizing preparations for the skin; Skin soap; Skin toners [cosmetic]; Non-medicated hair lotions; Cleansing creams [cosmetic]; Anti-aging creams [for cosmetic use]; Creams for tanning the skin; Facial toner; Non-medicated cleansing creams; Facial massage oils; Cosmetic massage creams; Facial scrubs; Facial cream; Facial emulsions; Massage oils; Facial butters; Massage oils and lotions; Facial masks; Facial wash; Body massage oils; Facial oil; Massage waxes; Facial scrubs [cosmetic]; Facial cream [for cosmetic use]; Facial packs; Massage oil; Facial washes; Scalp treatments (Non-medicated -); Facial masks [cosmetic]; Facial cleansing milk; Body and facial oils; Non-medicated massage preparations; Creams (Non-medicated -) for the body; Cosmetic facial masks; Facial packs [cosmetic]; Facial serum for cosmetic use; Facial cleansing grains; Facial washes [cosmetic]; Non-medicated scalp treatment cream; Body and facial butters; Cream cleaners (Non-medicated -); Massage creams, not medicated; Blusher; Cosmetics for eye-brows; Face glitter; Cosmetics for eye-lashes; Eyeshadow; Creamy face powder; Eyeliner; Cuticle cream; Multifunctional makeup; Skin cream; Make-up for the face; Beauty masks for hands; Foundation make-up; Nail-polish removers; Cleaning masks for the face; Make-up for the face and body; Cosmetics for the treatment of dry skin; Face and body creams; Sun-tanning creams; Face creams for cosmetic use; Cosmetic face powders; Face blusher; Non-medicated hair shampoos; Hair shampoos; Dry shampoos; Hair balm; Oil baths for hair care; Pores tightening mask packs used as cosmetics; Cleansing balm; Natural cosmetics; Liners [cosmetics] for the eyes; Hair cosmetics; Nail cosmetics; Cosmetic products for the shower; Cleansing products for the eyes; Organic cosmetics; Hair lighteners; Bath powders (Non-medicated -); Eyeshadows; Cosmetic oils; Skin fresheners [cosmetics]; Hair creams; Serums for cosmetic purposes; Beauty care cosmetics; Concealers; Eyeliner pencils; Hair mascara; Bubble bath [for cosmetic use]; Bubble bath preparations; Nail polish; Body polish; Makeup; Make-up primers; Eye makeup; Eyebrow mascara; Deodorants for body care; Preparations for the care of the body; Beauty creams for body care; Body care cosmetics; Body cleaning and beauty care preparations; Essences for skin care; Hand masks for skin care; Foot masks for skin care; Hair care lotions; Skin care oils [non-medicated]; Cosmetic preparations for skin care; Essential

oils for the care of the skin; Hair and body wash; Cosmetic body scrubs; Skin care mousse; Cosmetic creams for skin care; Hair care serum; Sparkling fluid for the body; Hand and body butter; Exfoliating body scrub; Natural makeup; Natural oils for cosmetic purposes.

Class 10: Foam massage rollers; Massage appliances; Massage apparatus; Instruments for massage; Manual massage instruments; Esthetic massage apparatus; Massage mitts; Massage balls; Massage apparatus for eyes; Foot massage apparatus; Back massage apparatus; Electric massage rollers.

Annex B

Class 9: Downloadable software applications for collecting, editing, organizing, modifying, transmitting, storing, sending and sharing data, information, text, audio, photographs, videos, images and other multimedia content; computer platforms in the nature of recorded or downloadable software for collecting, editing, organizing, modifying, transmitting, storing, sending and sharing data, information, text, audio, photographs, videos, images and other multimedia content; applications for mobile devices and web-based application software for collecting, editing, organizing, modifying, transmitting, storing, sending and sharing data, information, text, audio, photographs, videos, images and other multimedia content; communication software for connecting computer network users; software for providing multiple-user access to a global computer information network; communication, networking and social networking software; application software for social networking services via the Internet; content management software; software for organizing and displaying digital images and photographs; downloadable software for instant messaging and electronic mail services; databases (electronic); data processing systems; data storage devices; electronic publications [downloadable] provided from databases or the Internet; downloadable multimedia content.

Class 18: Bags; trunks and suitcases; umbrellas; luggage; travel sets [leatherware]; card wallets [leatherware]; banknote holders [leatherware]; credit card cases and holders [leatherware]; document cases; purses.

Class 25: Clothing; footwear; headwear.

Class 35: On-line advertising on a computer network; on-line advertising services on computer networks; providing advertising space on a global computer network; promotion of the goods and services of others via computer and communication networks; dissemination of advertisements for others by means of online electronic communication networks; publication of advertising texts; rental of advertising space on-line; online dissemination of advertising matter; commercial business management; commercial administration; conducting business research and surveys; collection of data; data processing; commercial data analysis; commercial data analysis services; compilation of data in computer databases; database management;

all the aforementioned services relating to a software solution for collecting, editing, organizing, modifying, transmitting, storing, sending and sharing data, information, text, audio, photographs, videos, images and other multimedia content; subscription services, namely, provision of subscriptions to textual content, data, images, audio, video and multimedia content, via the Internet and other electronic and communications networks.

Class 38: Telecommunications services, namely, electronic transmission of media, data, messages, graphics, images, audio content, audiovisual and video content, photographs, videos, texts, advertisements, information and advertising communications in the media; peer-to-peer computer network services, namely electronic transmission of images, audiovisual and video content, photographs, videos, data, texts, messages, advertisements, media advertising and information communications; transmission of videos, films, visual media, images, texts, photographs, games, user-generated content, audio content and information via the Internet; provision of discussion forums on the Internet and online forums; photo sharing and video content sharing services, namely electronic transmission of digital photo files, videos and audiovisual content between Internet users; dissemination of audiovisual and multimedia content via the Internet; broadcasting audio, text and video content via computer networks or other communications networks, in particular, uploading to a server, posting, displaying, modifying, tagging and electronically transmitting data, information, video content, audio content; provision of access to computer databases in the fields of social networking, dating and social meetings; providing access to online, electronic and computer databases; provision of email and instant messaging services; providing online forums for the transmission of messages, comments and multimedia content among users; electronic transmission of digital photo files between Internet users; provision of access to Internet platforms for the purpose of exchanging digital photographs; online transmission of electronic publications; data transmission; dissemination of data; data transfer services; provision of access to computer databases; providing online computer databases in the field of social networking and social introductions.

Class 41: Entertainment relating to a software solution for collecting, editing, organizing, modifying, transmitting, storing, sending and sharing data, information,

texts, audio, photographs, videos, images and other multimedia content; organization of games and competitions; on-line game services; editing of electronic publications; provision of non-downloadable electronic publications from a global computer network or the Internet; providing non-downloadable videos online; on-line library services, namely provision of an electronic library containing newspapers, magazines, photographs and images via an on-line computer network.

Class 42: Platform as a service (PaaS) offering software platforms for transmission of images, audiovisual content, video content and messages; hosting multimedia content for others; Interactive hosting services that allow users to publish and share their own content and images online; electronic storage services for data and archiving databases, images and other electronic data; hosting, for others, of online web facilities for online content sharing; provision of temporary use of non-downloadable software to enable content providers to track multimedia content; providing temporary use of non-downloadable software enabling sharing of multimedia comments and content among users; electronic storage of entertainment media content; providing temporary use of non-downloadable software applications for social networking, creation of a virtual community and transmission of audio content, video content, photographic images, texts, graphic illustrations and data; application service provider (ASP) proposing software enabling or helping in creating, editing, uploading, downloading, accessing, viewing, publishing, displaying, identifying, blogging, streaming, linking, annotating, sharing impressions of, commenting, integrating, transmitting and sharing or otherwise providing multimedia content or electronic information via computer and communication networks; development of software for processing and distribution of multimedia content; programming of software for Internet portals, chat rooms, chat lines and Internet forums.

Class 45: Online social networking services; meeting, presentation and social networking service on the Internet; online social networking services accessible by means of downloadable mobile applications; provision of information in the field of social networking and social introductions from online computer databases; licensing of software and industrial property rights; database licensing.