O/0936/26

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. UK00003953377 & UK00003953266 BY JONATHAN MARK KENDRICK TO REGISTER:

OKay

AS A TRADE MARK IN CLASS 9

AND

AS A TRADE MARK IN CLASSES 3, 9, 10, 11, 12, 14, 16, 25, 28, 30, 32, 33, 36, 38, 29, 41, 42 & 44

AND

IN THE MATTER OF THE OPPOSITIONS THERETO UNDER NOS. 444999 & 445000 BY REACH MAGAZINES WORLDWIDE LIMITED

BACKGROUND AND PLEADINGS

1. On 5 September 2023, Jonathan Mark Kendrick ("the applicant") applied to register the two trade marks shown on the cover page of this decision in the UK. Both were published on 29 September 2023. In respect of the applicant's first mark (being the word only mark under no. 3953377), the applicant seeks registration for the goods set out in **Annex 1** of this decision. As for his second mark (being the figurative mark under no. 3953266), he seeks registration for the goods and services set out in **Annex 2** of this decision.

2. The applicant's marks were both opposed on 29 December 2023 by Reach Magazines Worldwide Limited ("the opponent"). The opposition against the first mark is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and is aimed only at some of the goods applied for, being those I will set out at the relevant points below.[1]

3. The opposition against the second mark is based on sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act.[2] The section 5 grounds are aimed at only some goods and services of the applicant's specification, being those I will set out at the relevant points below. However, the section 3(6) ground is aimed at all goods and services for which registration is sought.

4. Under both oppositions, the section 5(2)(b) and 5(3) grounds are reliant on the following trade marks:

[1] The scope of goods against which the opposition against the first mark was aimed was expanded by way of a request from the opponent on 23 December 2024. This requested was granted by way of a preliminary view on 17 March 2025 and despite being provided with an opportunity to object to this, the applicant made no such objection. The preliminary view was confirmed on 31 March 2025 (being the deadline set by the Tribunal for parties to object to it).

[2] It is noted that the section 3(6) ground was added to these proceedings by way of a request made by the opponent on 8 April 2025. Following a similar pattern to that above, a preliminary view to include this ground was given on 24 April 2025 and despite being provided with the opportunity to object to this, the applicant made no such objection. The preliminary view was, therefore, confirmed on 8 May 2025 (being the deadline set by the Tribunal to raise an objection).

OK!

UK registration no. 903158251[3]

Filing date 8 May 2003; registration date 8 August 2006

Relying on all goods, namely:

Class 16: Printed matter, including magazine, periodicals and weeklies.

("the opponent's first mark"); and



UK registration no. 2538568

Filing date 9 February 2010; registration date 21 May 2010

Relying on some goods and services,[4] namely:

Class 9: Publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); electronic magazines; multimedia recordings and publications; audio and visual recordings; music, sounds, videos, images and information provided by a telecommunications network, by on-line delivery and by way of the Internet and/or the world-wide web or other communications network; interactive sound and/or audio recordings; games and puzzles, all supplied in the form of pre-recorded cartridges, tapes, cassettes, records, discs, CDs and DVDs, or other electromagnetic, magnetic or optical media.

[3] The opponent's first mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

[4] The goods and services referred to below have been extracted from the various tables in the opponent's statement of grounds as well as the annexes attached thereto.

Class 16: Publications; newspapers; magazines; comics; books; posters.[5]

Class 28: Electronic games and playthings, other than those adapted for use with television receivers; hand held electronic games; hand held computer games.

Class 38: Television and radio broadcasting services; radio broadcasting services.

Class 41: Electronic publishing; education and entertainment services by means of radio, television, telephony, the Internet, global computer network or on-line databases; production presentation and distribution of radio and television programmes, interactive television, interactive games, interactive entertainment and interactive competitions; publication of material provided by means of the Internet, or via a global computer network, or on-line from a computer network database; entertainment services.

5. In relying on the above marks, the opponent gave a statement of use confirming that it has used them in respect of the goods and services relied upon.

6. By virtue of relying on section 5(2)(b) grounds, the opponent's position is that the marks at issue are similar and that the goods and services at issue are identical and/or similar. As such, it is claimed that there exists a likelihood of confusion between the marks.

7. Under the section 5(3) grounds, the opponent's position is that it enjoys a very substantial reputation in the UK for the goods and services relied upon. It claims that the similarity of the marks at issue together with identity/similarity of the goods

[5] The term 'posters' is relied upon under section 5(3) but does not appear in the table of goods relied upon under the section 5(2)(b) ground, being that at paragraph 12 of the opponent's statement of grounds.

and services at issue will mean that, when used, the applicant's marks will create a link in the mind of the relevant public between those marks and the marks of the opponent. As such, it is claimed that the applicant's marks will take unfair advantage of the opponent's marks and that their use will be detrimental to the distinctive character and/or reputation of the opponent's marks.

8. Under the section 5(4)(a) ground, the opponent relies on two unregistered signs, being identical to its first and second marks. It claims to have used those signs throughout the UK since at least 2021 in respect of the following:

> "Beauty box containing a variety of beauty products; Provision of a subscription beauty box containing cosmetics, skincare, haircare and make-up products; Provision of information relating to cosmetics, skincare, haircare and make-up products; Entertainment and entertainment news programme; Website and app featuring videos; Virtual bingo game."

9. Under this ground, the opponent claims that its use of its signs in respect of the above goods and services has given rise to a substantial and valuable goodwill. Such goodwill means that use of the applicant's marks would cause a misrepresentation to the relevant public in that the goods and services at issue are those of the opponent or are authorised or approved by it. It is claimed that this misrepresentation is likely to cause damage to the opponent.

10. Lastly, under the section 3(6) ground (which is applicable to the opposition against the applicant's second mark only), it is claimed that the applicant has no intention to use his mark and, as such, his application for the same was in bad faith. The basis for this argument is that the overall length and breadth of the goods and services applied for are such that it can be reasonably inferred that the applicant has no intention to use the mark in relation to any and all of the same.

11. The applicant filed counterstatements wherein he denied all of the claims made and, further, requested that the opponent provide proof of use for the marks relied upon.

12. Upon the filing of the counterstatement in defence of the applicant's second mark, these proceedings were consolidated in accordance with the power granted to the Registrar under Rule 62(1)(g) of the Trade Marks Rules 2008. This was communicated to the parties via written correspondence on 7 May 2024.

13. The opponent is represented by Hansel Henson Limited and the applicant is represented by Nicholas Faieta. Only the opponent filed evidence. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

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

PRELIMINARY ISSUE

15. As set out above, the opponent amended its opposition against the applicant's second mark by introducing the section 3(6) ground. As is ordinarily the case when grounds are amended, the applicant was permitted to file an amended counterstatement in defence of the section 3(6) ground of the second opposition. An amended counterstatement was subsequently received on 24 June 2025.[6]

[6] For the avoidance of doubt, he was also permitted to file an amended counterstatement in respect of the expanded scope of opposition against his first mark. This was received on the same date set out here.

Further, the applicant was also given an opportunity to file evidence speaking directly to the section 3(6) ground. However, he did not take this opportunity.

EVIDENCE

16. The opponent's evidence came in the form of the witness statement of Rowan Olivia Erlam dated 8 July 2025. Ms Erlam is the Assistant Group Editor in Chief of the opponent. She has been employed by the opponent in various roles since approximately 2007. Her evidence is accompanied by 21 exhibits, being ROE1 to ROE21, and was adduced in order to demonstrate genuine use of the marks relied upon, that they enjoy a reputation and that the opponent's business enjoys the benefit of a protectable goodwill which is associated with the earlier signs.

17. I do not intend to discuss the opponent's evidence in full at this point (or its submissions, for that matter) but will, where necessary, discuss it below.

DECISION

My approach

18. I will begin my assessment with the section 3(6) ground of the opposition against the applicant's second mark. I do so because it is aimed at the entirety of the specification for which registration is sought and, if successful, the applicant's second mark will be refused registration in its entirety. It will, therefore, not be necessary to consider the remaining grounds. However, if it fails then I will proceed to consider the remaining grounds. Further, in the event that it is only partially successful, then so long as the remaining goods or services are targeted under the remaining grounds, I will proceed to consider those grounds accordingly.

Section 3(6): legislation and case law

19. Section 3(6) of the Act states:

> "(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith"

20. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

> "(i) […]
>
> (ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).
>
> (iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*"), para 73).
>
> (iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which

enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

21. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

22. The opponent's claim under the present ground is that the applicant does not have a *bona fide* intention to use its mark for all of the goods and services covered by its specification. The argument is made on the basis that the specification is long and broad so it can be reasonably inferred that the applicant has no intention to use its mark in respect of the same. In making such an argument in reliance upon the section 3(6) ground, it follows that the opponent's position is that the applicant, in applying for such a broad specification, acted with a dishonest state of mind or intention because, in filing for his second mark, he provided a false declaration that he would use the mark on all of the goods and services at issue. In the context of

trade mark law, this means that the mark could not have been filed with the aim of engaging fairly in competition but that it was filed either with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties or with the intention of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark.

23. In assessing this claim in accordance with the correct approach to assessing bad faith claims as set out in *Alexander Trade Mark*, BL O/036/18, I am satisfied that the objectives set out in the preceding paragraph are ones for which the contested application could not have been properly filed (i.e. if proven, it would lead to a conclusion that it was made in bad faith). As such, it is now necessary for me to proceed to consider whether the opponent has established that the application was filed in pursuit of that objective.

24. In its submissions, the opponent referred to the *ENERJO* decision of this Tribunal (BL O/0439/24) and its subsequent appeal (BL O/1191/25). Coincidentally, this was a decision issued by myself wherein I found that an applicant had applied for a mark in bad faith on the basis that it had no intention to use its mark due to the size of its specification. In that case, the applicant offered no reasonable rationale for applying for such a wide specification and, in the absence of such, I found that the entirety of the specification was objectionable under section 3(6) of the Act. As above, this was appealed and my approach to the bad faith ground was upheld by Mr Thomas Mitcheson KC, in his capacity as an Appointed Person. Of course, I am not bound to take the same approach I did in that decision because the present case is not necessarily on all fours with *ENERJO*. I say this because the specification in *ENERJO* was, by my count, 120 pages whereas in the present case it is only seven pages in length.[7] That being said, I am of the view that I can take a

[7] Whilst seven pages of specification is not the same as 120 pages (in relative terms), it is still an unusually long specification (in absolute terms).

similar approach due to the disparate nature of the specification before me and the lack of any reasonable rationale put forward by the applicant. My reasons follow.

25. I will deal with the disparate specification point because when it comes to claims of broad specifications, it is necessary to first assess the nature of the applied for specification. The applicant's specification includes 18 different classes and, having considered the terms within it, I do not consider it controversial to suggest that it covers a very wide range of disparate goods and services. While I do not intend to reproduce an exhaustive list showing the disparate nature of the goods and services, I note the following examples:

- "Perfume" and "hair lotions" in Class 3;
- "Downloadable software to enable investments and crypto-currency transactions", "wearable audio equipment", "animated cartoons" and "helmets for motorcyclists" in Class 9;
- "Hearing aids" and "ear plugs" in Class 10;
- "Apparatus for […] ventilating water supply and sanitary purposes" and "coffee machines" in Class 11;
- "Vehicles" in Class 12;
- "Comic books" and "post cards" in Class 16;
- "Clothing" in Class 25;
- "Interactive gaming chairs" in Class 28;
- A range of various beverage goods, such as "coffee", "beers" and "alcoholic beverages, except beers" across classes 30, 32 and 33;
- "Insurance services" and "child sponsorship services" in Class 36;
- "Photographic and image processing, namely providing online access to digital images via a global computer network" and "data communications by radio, telecommunications and satellite" in Class 38;
- "Recovery of vehicles" in Class 39;

- “Sporting and cultural services”, “providing information, reviews, and recommendations regarding movies and television shows via a website and video-on-demand transmission services”, “online gaming services” and “film directing” in Class 41;
- “Design of games” in Class 42; and
- “Telemedicine Services”, “therapy services” and “healthcare services” in Class 44.

26. In addition to the above, the opponent’s submissions make reference to the broad nature of some of the terms in the applicant’s specification. Having considered this point, I accept that some of the applicant’s specifications are incredibly broad, such as “computer software” at large in class 9 and “clothing” in class 25, for example. Such goods can cover any type of software for any purpose and any of the vast array of items that fall within the category of clothing.

27. It is difficult to imagine that one business would use its trade mark to indicate to customers that it is responsible for providing goods and services as varied as those in the specification at issue. The sheer breadth of the specification is sufficient to call into question whether the applicant had an intention to use the trade mark in accordance with its essential function in relation to all of the goods and services in the application.

28. The above being said, in proceedings such as this it is open for the applicant to at least offer some explanation as to why he applied for such a disparate specification. However, as I have set out above, the applicant did not file any evidence in defence of this ground and neither did he file any written submissions at any point during these proceedings. Instead, he relied solely on the following comments in his amended counterstatement:

> “14. The Applicant denies that given the overall length and breadth of the goods and services applied for in the Application, it can be reasonably inferred that

the Applicant has no intention to use the Application mark in relation to any, or alternatively, all of the goods and services applied for.

15. The Applicant denies that it can be reasonably inferred that the Application was made in bad faith."

29. While the above comments are noted, I am of the view that they offer nothing to assist the applicant in proving that he has a genuine intention to use his mark for the disparate range of goods and services he applied for. At this stage, the applicant could have at least offered some insight as to his intended business operation. Instead, he has simply made a blanket denial of the claim against him. Put simply, such a defence does not suffice. On this point, I repeat what I have said above in that I find it difficult to imagine that one business would use a trade mark on such a wide range of goods and services as those set out at paragraph 25 above.

30. On the topic of an overly broad specification, I refer again to the Supreme Court's decision in *SkyKick*, namely paragraphs 252 to 254, wherein Lord Kitchen sets out the following (emphasis added):

"252. I recognise that such an applicant, when given an appropriate opportunity, may provide a reasonable explanation and justification for its actions and in that way answer and dispel any inference that it made the application in bad faith. If, however, it fails to do so, it is in my view open to the tribunal to find that the application was indeed made in bad faith in respect of those goods and services.

253. This proposition may be tested by taking an example provided by counsel for the Comptroller-General, namely a person who applies to register a mark in respect of everything in all 45 classes of goods and services. **Here the width and size of the specification would, absent a satisfactory explanation,**

justify a finding of abuse on the basis that the applicant had intentionally taken advantage of the rules by creating artificially the conditions laid down for obtaining a registration with unduly wide protection: see also *Hasbro*, para 72; and, in a different context, *Eichsfelder Schlachtbetrieb GmbH v Hauptzollamt Hamburg-Jonas* (C-515/03) EU:C:2005:491; [2005] ECR I-7355, para 39 and the case-law cited there.

254. **Once that proposition is established, as I think it is, then it must be a matter of degree whether the objective circumstances, that is to say, the width and size of the specification of goods and services and their nature, as compared to the size and nature of the applicant's business (or lack of it) are such as to rebut the presumption of good faith and so justify the conclusion that the application was filed, at least in part, for a purpose other than in connection with the proper functions of a trade mark, that is to say to denote the origin of the goods or services to which it is applied**."

31. In the present case, and in light of the case law cited above, I am of the view that the applicant has intentionally sought to take advantage of the trade mark registration system by seeking to obtain a registration with unduly wide protection. I appreciate that the applicant has not sought to register goods and services in every class or for a specification that is overwhelming in length. However, this does not mean that the specification cannot be considered unjustifiably broad, especially in light of the fact that the applicant seeks registration for goods and services across 18 classes and, lastly, the arbitrary and disparate nature of the specification (which I have highlighted at both paragraphs 25 and 26 above). While it may be the case that the specification is unduly wide, the case law referenced above sets out that while such a proposition may have been established, it is necessary for me to consider the size and disparate nature of the applicant's specification against the nature of the applicant's business. In doing so, I must consider whether the degree to which the goods and services applied for, and the applicant's business intentions, are such as to rebut the presumption of good faith and justify the

conclusion that the application was filed for purposes other than in connection with the proper functions of a trade mark.

32. In assessing the consideration set out in the preceding paragraph, I do not consider that the applicant has adequately indicated the actual scope of his business. I have set out the sole basis of his defence above and as I mentioned at that point, it offers absolutely no rationale for the nature of the applied-for specification. In light of this, I cannot see any real justification for the applicant applying for a trade mark that covers such a broad scope of goods and services so as to cover 18 classes and seven pages worth of disparate terms. Without any assistance as to any specific (and narrower) business intentions, I am left to wonder what else the applicant could be doing other than seeking to use its mark to undermine the interest of third parties by seeking to register a trade mark for such a wide and disparate range of goods and services. As a result, I consider that there is a *prima facie* case that the application was indeed made with a dishonest intention, that is, to use the mark in order to undermine the objectives of third parties who may reasonably wish to use similar marks for some of the disparate goods and services applied for (which, as above, the applicant has no intention to use).

33. When a *prima facie* case of bad faith is raised, it does not automatically follow that a finding of bad faith must ultimately be found. That being said, it does shift the burden of proof to the applicant in that it is required to rebut a *prima facie* case. If the claim is successfully rebutted, the claim will fail. However, if the applicant fails to rebut the claim, I am entitled to find that the application was made in bad faith. In the present case, and as discussed a number of times throughout this decision, the applicant has failed to provide any sufficient reasoning to explain why he applied for such a broad specification. Therefore, I am of the view that he has failed to dispel the *prima facie* case against him.

34. As a result of the above, I hereby find that the applicant's mark was applied for in bad faith. Given the broad and disparate nature of the applied for goods and

services, and the lack of any clarity from the applicant in respect of *any* reasonable business intention, I am of the view that this finding applies to all of the goods and services applied for. As such, I find that the present ground succeeds in full.

Final remarks in respect of the applicant's second mark

35. The consequence of the complete success under the section 3(6) ground is that the applicant's second mark is refused registration for all goods and services applied for. In light of this, this decision now only proceeds in respect of the opposition against the applicant's first mark only which, for ease of reference going forward, I will refer to as simply "the applicant's mark".

36. I will begin my assessment of the remaining opposition with the proof of use assessment, which is applicable to both the section 5(2)(b) and 5(3) grounds of opposition.

Proof of use

37. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> (aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected

international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[…]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

38. Section 6A is also relevant. It reads:

"(1) This section applies where:

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

39. Section 100 of the Act is also relevant. It reads:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

40. Given their filing dates, the opponent's marks qualify as earlier trade marks under the above provisions. Both marks completed their registration processes more than five years prior to the filing date of the applicant's mark. As above, the applicant requested proof of use meaning that the opponent's marks are subject to the use provisions.

41. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v*

Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional

items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the

proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

42. As the opponent's first mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union".

43. Section 6A of the Act (cited above) sets out that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant's mark, being 5 September 2023. The relevant period is, therefore, 6 September 2018 to 5 September 2023. In respect of the opponent's first mark, the relevant territory is the EU at large prior to 31 December 2020 (which, at that time, included the UK) and, thereafter, the UK only. The relevant territory for the opponent's second mark is the UK only.

44. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[8] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

Evidence of use

45. The opponent's evidence sets out that it first published its 'OK!' magazine in the UK in 1993. It was originally published as a monthly magazine, before being published weekly in March 1996. An online version of the magazine became available at 'ok.co.uk', where content was provided through video, pictures and text. A screenshot of the website from 2005 is shown in evidence.[9]

46. In terms of use during the relevant period, the opponent has provided a number of images of the cover pages of its magazine throughout this time.[10] It is noted that these covers are from the editions published between 11 September 2018 and 4 September 2023. Each cover shows the words 'OK!' as its title and this appears identical to the opponent's second mark.

[8] *Jumpman* BL O/222/16
[9] ROE1
[10] ROE2

47. In respect of sales and readership of the magazine, the opponent's evidence is sprawling and covers a range of metrics that I do not consider all that necessary to discuss at this stage. I say this because it not only includes circulation of its physical magazines but also figures for its online readerships and then, ultimately, the culminative total for both. Having been through the evidence, I will endeavour to discuss only that which I consider necessary.

48. The evidence confirms that the opponent's magazine is sold across the whole of the UK via supermarkets, newsagents and bookshops. On this point, it is confirmed that the opponent has wholesale distribution agreements with Smiths and Menzies to sell the magazines throughout the UK. The evidence discusses the variety of ways in which the magazines are sold, in that they are either sold on a stand-alone basis, combined with another edition of a magazine owned by the opponent, on a subscription basis and via special sales. On the latter point, it is noted that the evidence refers specifically to special editions of the magazine, two of which relating to Queen Elizabeth II (one being published in 2021 and the other in 2022) and one relating to the coronation of King Charles III (which was published in April 2023). Respectively, these editions sold 30,000 copies, 40,000 copies and 25,000 copies. In terms of overall magazine sales, I note that individual figures for each year are provided but, as above, the evidence includes total readership figures for both physical and online editions of the magazine, which I will discuss below. However, when it comes to physical sales, I note that the opponent's turnover in respect of sales during the relevant period amounts to approximately £38 or £39 million. In support of this point, the opponent has provided invoices covering sales to distributors.[11] Whilst these are noted, I do not consider that they add much beyond the sales figures discussed above.

[11] ROE3

49. The average monthly readership figures are provided for both the physical and online versions of the OK! Magazine. These cover October 2018 to June 2023 and are as follows:

Period:	**Average monthly readership**
October to December 2018	6,000,600
2019	4,801,750
2020	6,016,500
2021	7,135,000
2022	6,603,750
January to June 2023	6,292,000

50. It is confirmed that the online readership comes from the online news portals of Apple News, Readly (being an online subscription service) and MSN.

51. In terms of its readership, the opponent spends some time on clarifying where its readership figures are drawn from and how these are verified. Whilst this is noted, I note that in the present case the accuracy or authenticity of the figures provided have not been challenged by the applicant and I, therefore, see no reason to discuss them any further.

52. In addition to its sales revenue and readership figures, the opponent confirms that it offers advertising space to third parties for its magazines, websites and social media platforms. During the relevant period, it is confirmed that the opponent generated a turnover of between £10 and £15 million from advertising.

53. In respect of its online presence, screenshots taken from its '.co.uk' website are provided.[12] These come from screenshots dated between April 2006 and June

[12] ROE5

2022 and each page shows the words OK! (presented identical to the opponent's second mark) at the top or somewhere within the article.

54. The evidence also confirms that 'OK!' magazine was ranked, by 'pressgazette.co.uk', as the third most popular lifestyle magazine in the UK in 2023. In addition, 'themagazineclub.co.uk' ranked 'OK!' magazine as one of the top 10 magazines for women in 2020.[13]

55. The evidence discusses the provision of two downloadable applications, one being the paid for reader version of the magazine and the other being an app version of the opponent's '.co.uk' website. The paid for version was launched in 2016 whereas the magazine app was launched in 2010.[14] Landing pages for these apps available on both Apple's App Store and Google's Play Store are provided in evidence.[15] These printouts are shown as being from within the relevant period.

56. In respect of the paid-for app, the evidence confirms that between 1 January 2018 and 1 January 2023, it generated a revenue of over £60,000 from sales via Google Play and the Apple Store. As for the free app, there are no figures regarding how many times it was downloaded in the UK but the opponent has provided two articles promoting the app.[16] One being in relation to the update and relaunch of the app in 2019 and another being a general promotional article which is from 2017, but was updated in 2020.

57. In addition to its magazine related goods (be that physical or digital), the opponent offers a bingo game under the name 'OK! Bingo'. This is confirmed as being launched in July 2020. Screenshots taken from the Wayback Machine from within the relevant period are provided in evidence that show use of the 'OK! Bingo'

[13] Both articles are provided at ROE18
[14] A printout from 'www.pressgazette.co.uk' is provided at ROE7 confirming its launch in November of 2010.
[15] ROE6
[16] ROE8

branding.[17] The evidence confirms that from 2021 to 2023, 'OK! Bingo' has made in excess of £75,000 in revenue. In addition, it is confirmed that between 14 July 2020 and 4 September 2023, the bingo game attracted over 800,000 users with over 1 million sessions. Lastly, it is claimed that this game is promoted via its magazines and digital publications.

58. In respect of advertising, the opponent confirms that in promoting the issue relating to the Queen's year in 2021, it ran approximately 600 adverts. Further, it ran approximately 970 adverts in respect of the Queen's jubilee special issue in 2022 and, lastly, in respect of King Charles III's coronation special issue from 2023, it ran approximately 1,035 adverts. A selective example of these adverts is provided in evidence.[18] It is also noted that the estimated worth of these campaigns is around £200,000 in media value.

59. While on the topic of advertising, it is also confirmed that the opponent spends a considerable amount of money in relation to advertising, though I note the total advertising spend is not provided. That being said, the evidence does attempt to demonstrate some of its spend for different types of advertising. Firstly, invoices are provided for advertising spend in respect of Facebook adverts provided by CARAT, which show a total spend of £2,323.20.[19] Secondly, figures are provided for business to business spend for 'OK!' branded dinner events for a total sum of £35,000.[20] Lastly, it is noted that between May 2020 and May 2023, the opponent spent around £63,000 on various advertising activities such as a campaign to drive sales during the COVID-19 pandemic, inserting copies of its magazine into Daily Record and Daily Mirror newspapers, promoting the 2021 Queen's special issue and its special for King Charles III's coronation in 2023. In respect of the latter

[17] ROE10
[18] ROE15
[19] ROE19
[20] ROE20

effort, evidence is provided confirming the opponent's attempt to promote the special via a radio advertising campaign.[21]

60. The opponent confirms that it sponsors and partners with various events. These include the National Television Awards between 2018 and 2023, the Together For Short Lives charity ball between 2021 and 2023 and the Tric Awards between 2021 and 2023. Invoices for the sponsorship of these events are provided in evidence.[22] No breakdown of the invoices is provided but I note that each of them show that the opponent spends thousands of pounds on these events, with the sponsorship of the National Television Awards costing £20,000 in 2023. While this is noted, the popularity of these events and how well known they are across the consumer base in the UK is not confirmed.

61. The opponent refers to some competitions that it ran on its website during the relevant period. While evidence is provided confirming this,[23] there is nothing to suggest the level of use for such services.

Form of the mark

62. In the present case, the opponent relies on two earlier marks, the first is a word only mark, being 'OK!' and the second is as follows:



63. Both marks are featured consistently throughout the evidence. Even so, I will say that where the second mark is used, I consider that this is in line with the notional

[21] ROE21
[22] ROE16
[23] ROE17

and fair use of the first mark on the basis that the first mark is word only and is suitably protected for use in any standard typeface and in any colour. Further, where the word only mark is used, this is an acceptable variant of the second mark. I say this because the second mark, whilst figurative, is a simple reproduction of 'OK!' in a standard typeface on a grey background. The slight alteration of that typeface or the change of colour are not sufficient to alter the distinctive character of the mark (which lies in the 'OK!' element). Therefore, in accordance with *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, use simply as 'OK!' is acceptable use of the second mark.

64. In addition to the above, it is noted that the opponent has also used the mark 'OK! Bingo' in respect of its online bingo game. While the addition of 'Bingo' is noted, 'OK!' still appears within the mark. As per *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, use of a mark generally encompasses its use as part of a composite mark and so long as the mark relied upon continues to be perceived as indicative of the origin of the goods/services at issue, then it is acceptable use of the registered mark. I consider this to be the case here on the basis that 'Bingo' simply describes the game at issue and 'OK!' clearly remains the indicator of origin. As such, and bearing in mind what I have said in the preceding paragraph, use of 'OK! Bingo' is use of the opponent's marks as registered.

Assessment of the evidence

65. I do not intend to labour my assessment of the evidence because, plainly, the opponent has made attempts to create and/or preserve a market share for the goods and services both of its marks during the relevant period. However, the issue before me is in respect of which goods or services the opponent has genuinely used it marks. Rather than go over each and every term in the opponent's specifications, I will simply discuss what goods or services for which use has been shown. For the most part, I will refrain from discussing certain goods or services

where no attempt has been made to demonstrate use for such goods or services. Where necessary though, I will discuss some goods or services in further detail.

66. For the avoidance of doubt, this assessment is made whilst bearing in mind the principles set out in *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 and *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

Class 16

67. As class 16 is the only class that appears in both marks' specification, I will begin here. In short, it is clear that the evidence is sufficient in respect of the opponent's physical magazines. Whilst both marks are registered for broader goods (essentially being printed matter at large in the first mark and any form of publication in the second), I am of the view that the appropriate approach is to limit the terms to "magazines".

Class 9

68. I turn now to the class 9 goods of the second mark's specification. Of these, I accept that the opponent has genuinely used its mark for terms that suitably cover its online magazine and its downloadable app. In my view, the terms "publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites)" and "electronic magazines" cover both publications of articles and magazines via the opponent's website and via its downloadable app.

69. As for the remaining goods under this class, I do not consider that the opponent has genuinely used its mark for any of them. For example, I appreciate that the evidence does show use for games, the relevant term for gaming goods in class 9 relates to games on pre-recorded cartridges, which is plainly not the case for the opponent's online bingo game. In addition, I note that the opponent's second mark

is registered for “music, sounds, videos, images and information provided by a telecommunications network, by on-line delivery and by way of the Internet and/or the world-wide web or other communications network”. I note that the opponent’s evidence sets out that its website includes photos and videos. However, this is not, in my view, the provision of videos or pictures with an intention to create or preserve a market share for such goods. Instead, the images and videos are ancillary goods that are part and parcel of the opponent’s provision of news.[24] I consider that to find use of the above term on such a basis would be unreasonable and, as such, I do not consider that the provision of an online magazine suitably covers such use.

Classes 28 and 38

70. While registered for class 28 goods and class 38 services, the evidence makes no attempt to demonstrate genuine use for the same. Therefore, I find that there is no genuine use for such goods and services.

Class 41

71. While the use is at a much lower level than that associated with the opponent’s magazine, I accept that the use of opponent’s second mark in respect of its online bingo game constitutes genuine use of “interactive games”. That being said, given that the use stems from only one specific type of game, I am not willing to grant genuine use for the term as a whole. Instead, I consider that a fair specification which reflects the opponent’s actual use to be “interactive games, namely online bingo.” On this point, while evidence was provided to attempt to show use for a competition (which would fall within the term “interactive competitions”), the opponent has made no attempt to quantify such evidence. As such, I find that it falls far short of the threshold for proving genuine use. Further, while broader

[24] It is noted that the earlier screenshots from ROE5 include reference to something called ‘OK! PARTY PHOTOS’. Firstly, it appears that this is only present on screenshots from prior to the relevant period. Secondly, it is not clear what the ‘PARTY PHOTOS’ are a reference to and I am of the view that if there was anything in such evidence, it was for the opponent to specifically argue as such.

entertainment services are covered, insofar as a bingo game can be deemed entertainment, the use for such a service is clearly covered by the specific term listed above. Further, there is no other evidence pointing to any type of entertainment services.

72. Staying on the topic of class 41 services, I note that the second mark stands registered for a range of publishing services. I appreciate that the opponent is a popular publication that seemingly publishes its own magazines. However, this is not the same as offering any sort of publication service to third parties under the 'OK!' branding and, therefore, does not constitute a genuine attempt to create or preserve a market share for such services.

73. As a result of the above, the opponent can rely on the following goods and services:

The opponent's first mark

Class 16: Magazines.

The opponent's second mark

Class 9: Publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); electronic magazines

Class 16: Magazines.

Class 41: Interactive games, namely online bingo.

Section 5(2)(b): legislation and case law

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

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

(a) […]

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

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

75. Section 5A of the Act states as follows:

"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."

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

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

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

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

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

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

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

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

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

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

Comparison of goods and services

77. The opposed goods of the applicant's mark are as follows:

"Computer software; mobile apps; computer software for uploading, sending, manipulating and enlarging media objects and other digital content, including texts, documents, photographs, images, video and audio; computer software for transmission of audio and video by means of a communications network; software for streaming audiovisual and multimedia content via the internet and global communications networks; software for streaming audiovisual and multimedia content to mobile digital electronic devices; downloadable motion pictures and television shows provided via a video-on-demand service; downloadable graphics featuring sets of digital images and icons for use on computers, tablets, and mobile phones; downloadable motion pictures and television shows; downloadable sound recordings; audio and visual recordings; downloadable electronic publications; animated cartoons; cinematographic films; digital music; downloadable electronic games; electronic game programs; electronic game software; downloadable electronic game programs; electronic game software for handheld electronic devices; electronic game software for wireless devices; electronic game software for mobile phones; downloadable electronic game software for wireless devices; downloadable electronic game software for handheld electronic devices; downloadable electronic game software for mobile phones; computer games; gaming software; games

software; game software; downloadable computer games; interactive game software; computer game programs; computer game programmes; downloadable game software; video game software; computer gaming software; video films; recorded films; downloadable films; animated films; pre-recorded films; motion picture films; downloadable mobile applications for use with wearable computer devices; computer application software for use with wearable computer devices."

78. The goods and services the opponent may rely upon are set out at paragraph 73 above.

79. Under the present ground of opposition, the opponent's position is that the goods and services at issue are identical or similar. In responding to the present ground in its counterstatement, the applicant failed to make any comment as to the goods and services comparison. Instead, the applicant simply stated the following:

"SECTION A - Section 5(2)(b)

1. The Applicant denies that registering the Applicant's mark would be contrary to the provisions of Section 5(2)(b) of the Trade Marks Act ("TMA"). The Applicant denies that the Applicant's mark is similar to the Opponent's earlier marks or that there exists a likelihood of confusion on the part of the public.

2.The Applicant's mark and the Opponent's earlier marks are clearly dissimilar. The Applicant's mark comprises the four letters "OKay" whereas the Opponent's earlier marks are comprised of the two letters "OK" with an exclamation mark at the end and in the case of UK00002538568 in stylised form."

80. To me, the substance of this defence relies solely on an alleged lack of similarity between the marks. It makes no mention of the goods and services at issue. On

this point, I remind myself of paragraphs 26 and 27 of *SkyClub* (Case BL O/44/21) wherein Professor Phillip Johnson (sitting as the Appointed Person) set out that there is a positive duty on a defendant to admit or deny matters and that the purpose of pleadings is to define the issues and give the other party fair notice of the case which it is required to meet. Given that the applicant has made no comment as to the opponent's claim in respect of the goods and services, the opponent has not been put on fair notice of what case it is required to meet. It is also noted that the applicant has not filed any submissions or evidence which may give any further indication of its position in respect of the goods and services. Therefore, I consider it appropriate to conclude that the applicant's lack of comment on this point acts as a concession of the opponent's position that the goods and services at issue are identical or similar.

81. The above being said, the opponent's claim is that the goods are identical or similar and it did not plead as to what level of similarity existed. Therefore, it remains incumbent on me to conduct a comparison in order to determine the actual level of similarity. I will do this in the ordinary way whilst, of course, bearing the deemed concession of there being at least some degree of similarity in mind.

82. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. 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 that:

> "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".

83. 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.

84. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

Downloadable electronic publications.

85. The opponent's second mark's specification includes the term "publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites)". There is no limitation preventing the opponent's goods as being downloadable meaning that they can be said to fall within the broader term of the applicant. As such, I find that these goods are identical under the principle outlined in *Meric*.

Computer software; mobile apps.

86. Whilst I appreciate that the opponent's evidence shows use of an app, it does not have any actual terms in its specifications for downloadable applications. Instead, it has 'electronic magazines' in its second mark's specification. The above goods can both cover software used for accessing electronic magazines and, as such, I find that whilst the natures of the goods differ (one being an app, the other being a digital publication), there is an overlap in method of use and purpose. I say this because the goods will be sought in the same way by accessing software on a computer and, in the present context, will be used to access magazines. As for trade channels and user, I consider that an undertaking that offers a downloadable magazine app will also offer an electronic magazine in the form of a publication. Such goods will be accessed by the same users. In addition, there is a competitive relationship between the goods in that a user may wish to access an electronic magazine via a downloadable app or an electronic publication (being the opponent's term) or vice versa. As a result, I find that these goods are similar to a high degree.

Computer software for uploading, sending, manipulating and enlarging media objects and other digital content, including texts, documents, photographs, images, video and audio; computer software for transmission of audio and video by means of a communications network; software for streaming audiovisual and multimedia content

via the internet and global communications networks; software for streaming audiovisual and multimedia content to mobile digital electronic devices.

87. As above, I do not consider that the opponent's class 9 goods cover a type of software but are, instead, publications. Even though I accept that the opponent's electronic magazines and publications may include images and videos, there is nothing before me to suggest that the opponent's goods can be used for uploading, sending, manipulating or enlarging media or other digital content, transmitting anything via a communications network or streaming content. Instead, the purpose of the opponent's goods is to read a magazine or other document covered by the electronic publication. The purpose of these goods is not, therefore, the same as the purpose of the above goods of the applicant. The natures and methods of use for these goods differ. Further, I have nothing to suggest that the goods would be offered by the same undertakings or sought through the same distribution channels. I appreciate that the user may overlap but this is relatively broad given the wide user base for both parties' goods. Lastly, the goods are not complementary or in competition. Taking all of this into account and bearing in mind my comments at paragraph 80 above, I find that these goods are similar to a very low degree.

Downloadable motion pictures and television shows provided via a video-on-demand service; downloadable graphics featuring sets of digital images and icons for use on computers, tablets, and mobile phones; downloadable motion pictures and television shows; downloadable sound recordings; audio and visual recordings; animated cartoons; cinematographic films; digital music; video films; recorded films; downloadable films; animated films; pre-recorded films; motion picture films.

88. I accept that the user base for the above goods is so broad that it would overlap with the opponent's class 9 goods in its second mark's specification. Even acknowledging that electronic magazines and publications may feature videos and images, I am of the view that all other factors differ. I have nothing to suggest any

overlap in nature or method of use. Further, while some large entertainment providers may produce downloadable publications or electronic magazines, I do not consider it common in the trade to suggest that this equates to any meaningful overlap in trade channels between these goods. As for purpose, I do accept that there is a vague connection in that the above goods aim to entertain the user and that it can be said that the opponent's class 9 goods may also be read for entertainment purposes. That being said, this is a very general overlap. The goods are not complementary and neither are they competitive to any meaningful degree. Overall, I am of the view that in light of the applicant's lack of denial, these goods are similar to a very low degree.

Downloadable electronic games; electronic game programs; electronic game software; downloadable electronic game programs; electronic game software for handheld electronic devices; electronic game software for wireless devices; electronic game software for mobile phones; downloadable electronic game software for wireless devices; downloadable electronic game software for handheld electronic devices; downloadable electronic game software for mobile phones; computer games; gaming software; games software; game software; downloadable computer games; interactive game software; computer game programs; computer game programmes; downloadable game software; video game software; computer gaming software.

89. The above terms essentially cover the same product, being computer games. The opponent's second mark is protected for "interactive games, namely online bingo". While the opponent's term covers a very specific type of electronic game, the above terms are broad and can, therefore, all duly cover bingo games. Further, the opponent's term, while a service, can still be played on a console, computer, mobile phone or any other sort of wireless device. Given that the applicant's terms are goods and the opponent's is a service, they differ in nature and method of use. That being said, I find that they share overlaps in purpose, trade channels and user. Further, there is a degree of competition between them as a user could elect to play a game via an online service (such as the opponent's term) or buy the game

outright as a good (being the applicant's terms). Taking all of this into account, I find that the opponent's term is similar to a medium degree with the above goods of the applicant.

Downloadable mobile applications for use with wearable computer devices; Computer application software for use with wearable computer devices.

90. I consider that the best comparators to the above terms are "publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites)" and "electronic magazines" in the opponent's second mark's specification. This is on the basis that, as far as I am aware, it is possible to access articles from news publications or magazines on an app via a smart watch. In this context, I see no reason why the comparison made at paragraph 86 above cannot apply to these terms in that they are similar to a high degree. Even if this is incorrect, the fact that an app for a smartwatch may be used to access news means that, at the very least, there is an overlap in trade channels and user. This is on the basis that an undertaking that offers electronic publications or electronic magazines may wish to provide an app that can be used to allow users to quickly access articles via their wearable device. Those users will be the same as those who access the publication/magazine goods. These factors are, in my view, sufficient to give rise to a finding that if the goods are not highly similar, then they are similar to a low degree.

The average consumer and the nature of the purchasing act

91. 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 or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

92. In *Iconix* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
>
> (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
>
> (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
>
> (e) The average consumer's level of attention varies according to the category of goods or services in question; and
>
> (f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

93. The goods and services at issue are ordinary consumer offerings so will, therefore, be selected by the general public at large. The goods at issue will be available from a range of retailers (such as general retailers or more specialised retailers such as video game retailers or online newsagents) as well as from the providers directly. The goods are such that they will either be found in physical retailers where they will be placed on shelves and self-selected by the consumer or will be available online via websites or online app stores. As for the services, these will be obtained from the producer directly or general gaming retailers and, like the goods, will be selected visually after the consumer sees them on a webpage. Regardless of whether the consumer is selecting goods or services, the visual component will dominate the selection process, though I do accept that the aural component will play a role through discussions with sales assistants or word of mouth recommendations.

94. The selection process for the goods and services at issue will vary in frequency and in cost. I say this because some terms (such as downloadable publications or online bingo games, for example)[25] are broad enough to cover free offerings that will be selected at a high frequency. However, some computer game related goods can be moderately expensive and selected on a less frequent basis. In light of this, I find that the level of attention will vary. For example, the free app/publication related goods and the opponent's gaming service can cover casual selections so I find that, in some instances, a lower degree of attention will be paid. However, for the computer game goods, these will attract various considerations such as the type of game offered, reviews, the availability of online play and whether the game includes microtransactions to unlock additional features, for example. Such factors are, in my view, sufficient to warrant a medium degree of attention from the consumer. To conclude, I find that the goods and services at issue will attract either a lower (but not outright low) or a medium degree of attention.

[25] Whilst I appreciate that bingo may often include the user offering monetary stakes in order to play, they may also be free games simply played for entertainment.

Comparison of the marks

95. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

96. 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."

97. It would be wrong, therefore, to artificially dissect the trade marks, although 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.

98. In light of the fact that the comparison above covered only goods and services from the opponent's second mark, the opponent's first mark is no longer at issue. I take this approach because even despite the lack of deniability as to the goods and services at issue, it is clear to me that goods and services covered by the second mark offered the opponent its best case. As such, the present ground proceeds in respect of the opponent's second mark only, which for the remainder of this ground, I will refer to simply as 'the opponent's mark'.

99. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
 ("the opponent's mark")	OKay ("the applicant's mark")

100. I have reproduced the entirety of the applicant's comments on the marks at issue when discussing the goods and services comparison above. In short, the applicant's position is that the marks at issue are not similar. I have detailed submissions from the opponent as to the similarity of the marks and while I can confirm I have taken these into account, I will not repeat them here.

Overall impression

101. The applicant's mark is a word only mark consisting solely of the word 'OKay'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself. The opponent's mark is a figurative mark that consists of the element 'OK!' in a white, standard typeface on a greyscale background. 'OK' will dominate the overall impression of the mark with the exclamation point playing a lesser role, serving only to imply that the word 'OK' is being shouted. As for the background and stylisation used, I consider both of these are banal and, as such, they will have a negligible impact on the mark.

Visual comparison

102. As suggested above, the stylisation in the opponent's mark is banal. Given that the applicant's mark is a word only mark, it is capable of being presented in any standard typeface and in any colour. In the present case, I consider that this includes the typeface and colour used in the opponent's mark, meaning that these points in the opponent's mark are not points of visual difference between the marks.

103. Visually, the marks share the letters 'OK' and differ in the presence of the letters 'ay' in the applicant's mark and the exclamation point in the opponent's mark. The marks at issue are short marks and whilst there is no special test for short marks,[26] the shortness of the marks means that the average consumer is more likely to notice the differences. That being said, the shared letters form the dominant element of the opponent's mark and the first two letters of the applicant's mark.[27] They will, therefore, not be ignored. Taking all of this into account, I find that the marks at issue are visually similar to a medium degree.

Aural comparison

104. While the exclamation point in the opponent's mark may indicate that the word 'OK' is to be shouted, I do not consider that it actually has any impact on the aural comparison. The opponent's mark will, therefore, simply be pronounced as 'OH-KAY'. While the additional letters in the applicant's mark are noted, it will also be pronounced as 'OH-KAY'. As such, I find that the marks are aurally identical.

[26] See paragraph 44 of *BOSCO*, BL O/301/20
[27] As per *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, beginnings of words tend to have more visual and aural impact than their ends.

Conceptual comparison

105. The concept of the opponent's marks lies in the 'OK!' element. 'OK' will be readily understood as an abbreviation of the word 'okay', which is to mean that *something is satisfactory or acceptable*, an *expression of agreement*, or a statement that *someone is safe and well*.[28] The use of the exclamation point will insinuate that 'OK' is to be shouted. While noted, this does not alter the concept of the mark. As for the applicant's mark, whilst it is spelt as 'OKay', the same concept as that discussed above will be attributed to it. As such, I find that the marks are conceptually identical.

Distinctive character of the opponent's mark

106. 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

[28] https://www.collinsdictionary.com/dictionary/english/okay

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)."

107. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use. Given that the opponent has filed evidence of use, I will consider whether the said use is sufficient to enhance the distinctiveness of its mark. Before doing so, however, I will consider the inherent position.

108. The opponent's mark is a figurative mark consisting of the element 'OK!' in a white standard typeface on a grey background. As mentioned above, the stylisation and background in the mark are banal and, as such, I find that the distinctive character resides in the 'OK!' element. 'OK' is a very common English language word that carries a well-known meaning. The exclamation point simply conveys the message that 'OK' is to be shouted. While the mark has no descriptive or allusive meaning in respect of the goods and services relied upon, it is dominated by such a common (and short) word and I, therefore, find that its distinctiveness sits towards the lower end of the scale. In my view, its distinctiveness resides somewhere between a low and medium degree.

109. I turn now to consider the position regarding an enhanced distinctive character. I have summarised the opponent's evidence at paragraphs 45 to 61 above. The evidence relevant to the present assessment relates to the digital aspect of the

opponent's magazine and the bingo game it offers. I say this because only those goods and services remain at issue further to my goods and services comparison.

110. While I coupled the online and physical magazine evidence together in my assessment of the evidence above, the opponent did distinguish between the two in its evidence. Of the digital magazine, I note that it attracted the following views across different platforms (Readly, Apple News and MSN):[29]

Year	**Views**
5 September to 31 December 2018	Over 10.3 million
2019	Over 33.6 million
2020	Over 34.9 million
2021	Over 36 million
2022	Over 33.6 million
1 January to 4 September 2023	Over 20.9 million
Total	**Over 169.3 million**

111. Clearly, the digital magazine/publication attracted a significant amount of views. In my view, the volume of views is at a level that warrants a finding that the distinctiveness of the opponent's mark has been enhanced through use. That being said, given that the inherent position is relatively low, I do not consider that this extends to outright high. Instead, I find that the use is only sufficient to take the distinctiveness to between a medium and high degree in respect of the opponent's class 9 goods.

[29] There is nothing before me to expressly confirm that these views come from UK consumers. However, on balance, I am satisfied that given the fact that the opponent's evidence as a whole is directed at the UK is sufficient to lead me to conclude that these figures relate to UK views.

112. As for the opponent's bingo game, this attracted over 800,000 users between July 2020 and September 2023 with a revenue in excess of £75,000. While no evidence as to the size of the online bingo market is provided, I am of the view that it is likely to be a very large market. Therefore, I consider that the evidence provided reflects a relatively low level of use. While I was satisfied that this level of use was sufficient for genuine use, the bar for proving an enhanced distinctive character is far more onerous. Therefore, I consider that, in respect of these services, the inherent position applies.

Likelihood of confusion

113. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or economically linked. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

114. I found the goods and services to be either identical or similar to varying degrees, including very low. On this point, I appreciate that if some goods in the applicant's specification are not highly similar then I have found that they are similar to a low degree. The average consumer base for the goods and services at issue

will be members of the general public who will select them via primarily visual means (though I do not discount an aural component) whilst paying mostly a medium degree of attention. On this point, I remind myself that some goods will attract a lower (but not outright low) degree of attention. I have found the marks at issue to be visually similar to a medium degree and aurally and conceptually identical. Lastly, I have found that the opponent's mark possesses between a low and medium degree of inherent distinctive character, though I have found that this has been enhanced to a medium to high degree in respect of its class 9 goods. On this point, I remind myself that a weaker degree of distinctive character for the class 41 services (i.e. low to medium) does not preclude a finding of a likelihood of confusion.[30]

115. Taking all of the above into account, I consider that when consumers are confronted by the marks on goods and services that are identical or sufficiently similar,[31] they would misremember or inaccurately recall the parties' marks for one another. I consider that the shared conceptual hook and aural identity are such that consumers will overlook the fact that one mark is spelt as 'OKay' and the other is spelt as 'OK!', especially when factoring in the principle of imperfect recollection, the principle of interdependence and, again, bearing in mind that in these circumstances, the marks are viewed on sufficiently similar goods and services. Consequently, I consider that there is a likelihood of direct confusion between the marks at issue for such goods and services.

116. Despite the above finding of direct confusion for identical or sufficiently similar goods and services, I do not consider that there will be a likelihood of direct confusion when it comes to those goods that are similar to a very low degree. I say this even whilst bearing in mind the enhanced degree of distinctive character of the opponent's mark for some of the opponent's goods. In reaching this finding, I also remind myself of the principle of interdependence which sets out that a lesser

[30] *L'Oréal SA v OHIM*, Case C-235/05 P
[31] Which, in the present case, covers those goods and services similar to a low degree and above.

degree of similarity between goods and services may offset a greater degree of similarity between the respective marks. On this point, I accept that there is conceptual and aural identity between the marks. However, the visual similarity is not at a high level and given the impact of the visual component during the selection process, this is a significant factor,[32] especially when factoring in the distance between the very lowly similar goods. I appreciate that the sufficiently similar (or identical) goods and services overcame this issue.[33] However, I do not consider that this applies to those goods that are similar to a very low degree because, put simply, the distance between them is just too far to allow me to conclude that consumers would be directly confused by the marks when viewed on these goods. As a mere example, I see no reason why consumers would directly confuse 'OK!' on electronic magazines/publications and 'OKay' on cinematographic films or a type of streaming software.

117. I will now proceed to consider a likelihood of indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

[32] *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03
[33] Even though the principle of interdependence was triggered above, it covered lowly similar goods only.

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

118. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances whereby indirect confusion occurs.

119. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to

establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

120. In the event that the differences between the marks are noticed, I consider that consumers (when viewing the marks on sufficiently similar goods and services) will believe that the marks originate from the same undertaking. I say this because the only point of difference between the marks is the spelling of the word 'OK' and the exclamation point and those differences are such that consumers will likely believe the marks to be alternative or re-branded marks used by the same undertaking. Therefore, I consider that there exists a likelihood of indirect confusion in respect of those goods of the applicant that are similar to a low degree and above.

121. The above being said, I do not consider that the finding applies to those goods that are only similar to a very low degree. My reasons for this finding mirror those I have given at paragraph 116 above. Additionally, there was no direct confusion for those goods and, on this point, I remind myself of the comments of Arnold LJ and Mr Mellor Q.C. (that I have reproduced in the preceding paragraph) in that where there is a lack of direct confusion, there needs to be a proper basis for a finding on indirect, which I do not consider there to be such a basis here.

122. In light of the above, I find that the present ground succeeds in respect of those goods and services that I have found to either be identical or similar to a medium degree or above. For ease of reference, this means that the present ground succeeds against the following goods:

Class 9: Downloadable electronic publications; computer software; mobile apps; downloadable electronic games; electronic game programs; electronic game software; downloadable electronic game programs; electronic game software for handheld electronic devices; electronic game software for wireless devices; electronic

game software for mobile phones; downloadable electronic game software for wireless devices; downloadable electronic game software for handheld electronic devices; downloadable electronic game software for mobile phones; computer games; gaming software; games software; game software; downloadable computer games; interactive game software; computer game programs; computer game programmes; downloadable game software; video game software; computer gaming software; downloadable mobile applications for use with wearable computer devices; computer application software for use with wearable computer devices.

123. However, it fails in respect of the following:

Class 9: Computer software for uploading, sending, manipulating and enlarging media objects and other digital content, including texts, documents, photographs, images, video and audio; computer software for transmission of audio and video by means of a communications network; software for streaming audiovisual and multimedia content via the internet and global communications networks; software for streaming audiovisual and multimedia content to mobile digital electronic devices; downloadable motion pictures and television shows provided via a video-on-demand service; downloadable graphics featuring sets of digital images and icons for use on computers, tablets, and mobile phones; downloadable motion pictures and television shows; downloadable sound recordings; audio and visual recordings; animated cartoons; cinematographic films; digital music; video films; recorded films; downloadable films; animated films; pre-recorded films; motion picture films.

Section 5(3)

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

> "5(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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

125. 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,* Case C-323/09, *Marks and Spencer v Interflora,* Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder 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*).

126. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks at issue are similar. Secondly, the opponent must show that its marks have achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the pleaded types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

127. Under the present ground, the opponent relies on the same marks as it did under the section 5(2)(b) ground. As for the goods and services, those relied upon here are slightly broader than those relied upon above. Having said that, the issue of genuine use is as equally relevant to the present ground as it was to the section 5(2)(b) ground. Therefore, the present ground may only proceed in respect of those goods and services for which I found genuine use. For ease of reference, those goods and services are as follows:

The opponent's first mark

Class 16: Magazines.

The opponent's second mark

Class 9: Publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); electronic magazines

Class 16: Magazines.

Class 41: Interactive games, namely online bingo.

Reputation

128. I have summarised the opponent's evidence throughout this decision, namely at paragraphs 45 to 61 and 110 above. I do not intend to repeat that evidence here but remind myself that the opponent's business operation in respect of its magazines, both physical and digital is significant. Such use is at a level to demonstrate that the opponent's marks enjoy a strong reputation for the class 9 and 16 goods listed above. As for the class 41 services, I repeat my findings when considering an enhanced distinctive character at paragraph 112 above. In short, the evidence in respect of such services is not at a level that would indicate that the opponent's marks have become known by a significant part of the relevant public in respect of such services. As a result, the present ground proceeds in respect of the class 16 goods of the opponent's first mark and the class 9 and 16 goods of the opponent's second mark.

Link

129. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

130. Under the section 5(2)(b) ground, I found that the applicant's mark was visually similar to a medium degree and aurally and conceptually identical with the opponent's second mark. Whilst the opponent's first mark is a word only mark, I remind myself that I considered the stylisation elements of the second mark so banal that I can simply apply those same findings to a comparison between the applicant's mark and the first mark of the opponent.

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.

131. Much like the pleadings in respect of the section 5(2)(b) ground, the applicant made no comment as to the goods and services at issue. As such, I will take the same approach here as I did above in that I am compelled to find at least some similarity between the goods and services at issue. Insofar as my comparison of the goods and services under section 5(2)(b) above was reliant upon the reputed goods of the opponent, my findings are equally applicable here. On this point, I remind myself that:

a. The applicant's term of "downloadable electronic publications" is identical to the opponent's term of "publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites)";

b. The applicant's terms of "computer software" and "mobile apps" are similar to a high degree to the opponent's "electronic magazines";
c. The applicant's terms of "downloadable mobile applications for use with wearable computer devices" and "computer application software for use with wearable computer devices" are similar to a high degree with "publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites)" and "electronic magazines". Failing that, they are similar to a low degree; and
d. The applicant's terms of "computer software for uploading, sending, manipulating and enlarging media objects and other digital content, including texts, documents, photographs, images, video and audio", "computer software for transmission of audio and video by means of a communications network", "software for streaming audiovisual and multimedia content via the internet and global communications networks", "software for streaming audiovisual and multimedia content to mobile digital electronic devices", "downloadable motion pictures and television shows provided via a video-on-demand service", "downloadable graphics featuring sets of digital images and icons for use on computers, tablets, and mobile phones", "downloadable motion pictures and television shows", "downloadable sound recordings", "audio and visual recordings", "animated cartoons", "cinematographic films", "digital music", "video films", "recorded films", "downloadable films", "animated films", "pre-recorded films" and "motion picture films" are all similar to a very low degree with the opponent's "publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites)" and "electronic magazines".

132. I turn now to the applicant's video game related goods, being:

"Downloadable electronic games; electronic game programs; electronic game software; downloadable electronic game programs; electronic game software for handheld electronic devices; electronic game software for wireless devices;

electronic game software for mobile phones; downloadable electronic game software for wireless devices; downloadable electronic game software for handheld electronic devices; downloadable electronic game software for mobile phones; computer games; gaming software; games software; game software; downloadable computer games; interactive game software; computer game programs; computer game programmes; downloadable game software; video game software; computer gaming software."

133. I remind myself that I found these goods similar to a medium degree with the opponent's "interactive games, namely online bingo". This service is not at issue here (on the basis that the opponent does not enjoy a reputation for such a term) and in light of the lack of any deniability of similarity from the applicant in respect of this point, I consider that they are similar to a very low degree with the opponent's reputed goods of "publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites)" and "electronic magazines".

The strength of the earlier mark's reputation

134. The opponent's mark enjoys a strong reputation.

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

135. The opponent's mark is inherently distinctive to between a low and medium degree. I found that it has been enhanced to between a medium and high degree in respect of the class 9 goods. While I see no reason why that same finding cannot apply to the class 16 goods, I am of the view that the opponent's class 9 goods (which are present in its second mark only) are the best comparator for the present ground.

Whether there is a likelihood of confusion

136. Where the goods are identical or similar to any degree above very low, I find that there is a likelihood of direct confusion under the present ground. I say this for similar reasons to those provided under the section 5(2)(b) ground above whilst also bearing in mind the strength of the repute of the opponent's mark's and its level of enhanced distinctiveness.

137. As for the goods that are only similar to a very low degree, I remind myself that under the present ground, the provisions of section 5(3) offer additional protection which take into account the repute and distinctiveness of the earlier marks. Therefore, it can be said that some marks are so distinctive and well known that there is likely to be some confusion almost irrespective of the goods and the marks that are used. While the reputation in the opponent's mark is strong and its distinctiveness sits at a higher level, I do not consider they are at a significant enough level to overcome the distance between the very lowly similar goods. As such, there is no confusion for such goods.

Conclusion on link

138. Taking all of the above factors into account, I consider that when it comes to the goods that are similar to more than a very low degree, a link exists between the marks at issue. That being said, I do not consider that the same can be said to apply for those goods that are similar to only a very low degree. While the strength of reputation and enhanced distinctiveness of the opponent's mark is noted, I fail to see how this can overcome the distance between the goods that are similar to only a very low degree. I am of the view that when a member of the relevant public (who is aware of the OK! brand for the reputed goods) is confronted by the 'OKay' mark on a range of goods such as "software for streaming audiovisual and multimedia content via the internet and global communications networks" and "animated films", for example, they would not be caused to wonder if the marks

were linked. This is simply down to the sheer distance between such goods and the reputed goods of the opponent. Lastly, I appreciate that the reputation of some marks may be so strong that a link would be caused regardless of what goods or services the later mark was viewed on. However, I do not consider that to be the case here.

139. As a result of the above, I do not consider that any link exists for the following goods:

Class 9: Computer software for uploading, sending, manipulating and enlarging media objects and other digital content, including texts, documents, photographs, images, video and audio; computer software for transmission of audio and video by means of a communications network; software for streaming audiovisual and multimedia content via the internet and global communications networks; software for streaming audiovisual and multimedia content to mobile digital electronic devices; downloadable motion pictures and television shows provided via a video-on-demand service; downloadable graphics featuring sets of digital images and icons for use on computers, tablets, and mobile phones; downloadable motion pictures and television shows; downloadable sound recordings; audio and visual recordings; animated cartoons; cinematographic films; digital music; video films; recorded films; downloadable films; animated films; pre-recorded films; motion picture films; Downloadable electronic games; electronic game programs; electronic game software; downloadable electronic game programs; electronic game software for handheld electronic devices; electronic game software for wireless devices; electronic game software for mobile phones; downloadable electronic game software for wireless devices; downloadable electronic game software for handheld

electronic devices; downloadable electronic game software for mobile phones; computer games; gaming software; games software; game software; downloadable computer games; interactive game software; computer game programs; computer game programmes; downloadable game software; video game software; computer gaming software; downloadable mobile applications for use with wearable computer devices; computer application software for use with wearable computer devices.

140. The present ground, therefore, fails in respect of the above. That being said, a link does exist for the remaining goods. Therefore, I will proceed to consider whether damage exists in respect of the following goods:

Class 9: Downloadable electronic publications; computer software; mobile apps.

Damage

141. The opponent has pleaded that use of the applicant's mark would take unfair advantage of the reputation of its marks, that it would, without due cause, prove to be detrimental to the reputation of the opponent and the distinctive character of the opponent's marks. I will deal with each head of damage in turn below.

Unfair Advantage

142. I bear in mind that unfair advantage has no effect on the consumers of the opponent's marks' goods and services. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

"80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

143. I have found above that the opponent has demonstrated that its mark has obtained a strong reputation for its class 9 goods. This is, in my view, the sort of reputation that would result in the applicant benefiting from an enhanced level of recognition due to the link between the marks in the minds of the relevant public. In my view, the shared reference to the word 'Okay' is sufficient to result in an unfair advantage being taken of the opponent's marks' reputation. The applicant, by using the word 'OKay' on identical goods or goods with a sufficient degree of similarity to the reputed goods of the opponent, would achieve instant familiarity in the eyes of average consumers, thereby securing a commercial advantage and benefitting from the opponent's reputation without paying financial compensation. Such commercial advantage would not exist but for the strong reputation of the opponent's mark. Therefore, I find it likely that the applicant's mark would take unfair advantage of the opponent's mark in relation to the goods set out at paragraph 140 and the opposition under Section 5(3) succeeds in relation to these goods.

144. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage.

Section 5(4)(a)

145. Section 5(4)(a) of the Act states as follows:

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met.
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark".

146. Subsection (4A) of section 5 of the Act 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."

147. Under the present ground, the opponent claims to enjoy goodwill in its business and that its two signs (being those identical to the two marks relied upon under section 5(2)(b) and 5(3) grounds above) are distinctive of and/or associated with that business. The opponent claims to have used its signs in respect of the following goods and services:

"Beauty box containing a variety of beauty products; provision of a subscription beauty box containing cosmetics, skincare, haircare and make-up products; provision of information relating to cosmetics, skincare, haircare and make-up products; entertainment and entertainment news programme; website and app featuring videos; virtual bingo game."

148. I consider that I can deal with this ground in three separate points. These are set out below.

149. Firstly, I appreciate that evidence has been provided in respect of the beauty related goods and services. However, I fail to see how this can be said to place the opponent in a better position than the goods relied upon under the section 5(2)(b) and 5(3) grounds above. In short, I consider that such goods and services are even further removed from the applicant's goods than those subject to the above grounds. For example, I see no logical reason why enjoying goodwill (regardless of its level) in the term "beauty box containing a variety of beauty products" would result in any misrepresentation when compared with the opponent's class 9 goods.

150. Secondly, I appreciate that the opponent's reliance on the terms "entertainment and entertainment news programme" and "website and app featuring videos" may, on the face of it, offer better prospects for the opponent due to the broad reference to 'entertainment' at large and 'videos'. However, the evidence before me in respect of such terms (being the provision of an online magazine via a website and a downloadable app for said magazine) specifically relates to the provision of a celebrity news magazine. As such, I see no reason why this would attract goodwill in 'entertainment' at large and, further, any terms the opponent would be permitted to rely upon would be limited accordingly (i.e. "the provision of a news website" or "a downloadable application for the provision of news").[34] Goodwill in these (or

[34] I see no rationale as to why the opponent would be afforded protection for an 'app featuring videos'. Such a level of protection would extend far beyond the actual nature of the opponent's business operation. On this point, such a term would cover the opponent for goods akin to apps used by Instagram, YouTube or a range of streaming platforms, to name just a few primary examples. Such protection is, plainly, unjustifiable.

similar) terms is insufficient to lead to a misrepresentation with the applicant's goods that survived the section 5(2)(b) claim. On this point, I remind myself that this includes terms such as "software for streaming audiovisual and multimedia content via the internet and global communications networks" and "animated cartoons" for example. At no point does the opponent's evidence indicate the offering of any type of streaming product and the provision of videos in news articles is, clearly, not a form of streaming and neither does a downloadable news app share any connection with animated cartoons. Therefore, I find that when it comes to such terms, the parties can be said to operate in different fields of activity and I remind myself that, as per *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), there is a heavy burden on the opponent in order to prove a misrepresentation across different fields of activity. In the present case, the opponent has not attempted to discharge said burden.

151. Lastly, any goods with sufficient similarity to "virtual bingo game" have already fallen foul of the section 5(2)(b) ground so I see no merit in considering them again here, save to say that the present ground would also succeed in respect of such goods.

152. In light of the above, I do not consider that the present ground offers anything beyond the level of success achieved by the section 5(2)(b) ground.

CONCLUSION

153. The opposition against the applicant's second mark succeeded in full, meaning that, subject to any successful appeal against my decision, it is refused registration in its entirety. The opposition against the applicant's first mark was partially successful and, again, subject to any successful appeal of my decision, it is refused registration for the following goods:

Class 9: Downloadable electronic publications; computer software; mobile apps; downloadable electronic games; electronic game programs; electronic game software; downloadable electronic game programs; electronic game software for handheld electronic devices; electronic game software for wireless devices; electronic game software for mobile phones; downloadable electronic game software for wireless devices; downloadable electronic game software for handheld electronic devices; downloadable electronic game software for mobile phones; computer games; gaming software; games software; game software; downloadable computer games; interactive game software; computer game programs; computer game programmes; downloadable game software; video game software; computer gaming software; downloadable mobile applications for use with wearable computer devices; computer application software for use with wearable computer devices.

154. It may proceed to registration for both the unopposed goods and those which (again, subject to any successful appeal against my decision) survived the opposition. Those goods are as follows:

Class 9: Computer hardware; PC mice; keyboards; computer mice; keyboard terminals; multifunction keyboards; Computer controllers; USB cables; HDMI cables; Ethernet cables; Network cables; USB adapters; HDMI adapters; Ethernet adapters; communications and telecommunications apparatus and instruments; Mobile phones; smart phones; computer software for uploading, sending, manipulating and enlarging media objects and other digital content, including texts, documents, photographs, images, video and audio; computer software for transmission of audio and video by means of a communications

network; software for streaming audiovisual and multimedia content via the internet and global communications networks; software for streaming audiovisual and multimedia content to mobile digital electronic devices; downloadable motion pictures and television shows provided via a video-on-demand service; downloadable graphics featuring sets of digital images and icons for use on computers, tablets, and mobile phones; downloadable motion pictures and television shows; downloadable sound recordings; audio and visual recordings; musical recordings computer software for metadata tagging and website tagging; apparatus for recording, transmission or reproduction of sound or images; data processing apparatus and computers, namely computers and computer software for transmission and synchronisation of data between portable communication apparatus; electronic hand-held apparatus intended for the wireless transmission of data and/or voice signals; computer communication software for the synchronisation, transmission and sharing of data, including data related to the keeping of an electronic diary, the contents of messages between one of more electronic hand-held devices and data stored on or linked to a computer; none of the aforesaid goods having the primary function of data acceleration or data transportation, including the acceleration of data storage or acceleration across transmissions lines; animated cartoons; cinematographic films and compact discs; digital music; computer hardware for games and gaming; headphones; headphone consoles; wireless headphones; video films; recorded films; downloadable films; animated films; pre-recorded films; motion picture films; film reproducing apparatus; film recording apparatus; film production apparatus; exposed cinematographic film; cinematographic film, exposed; film processing apparatus; pre-recorded cinematographic films;

movie film developing machines; smart glasses; wearable speakers; wearable computers; Wearable smart phones; Wearable displays; Wearable monitors; Smart bracelets; Smart rings; Smart watches; Smart glasses; Wearable computer peripherals; Wearable audio equipment; Wearable computer hardware; Wearable activity trackers; Wearable telecommunication apparatus; Wearable communications apparatus; Wearable portable media players; Wearable computer peripheral devices; Wearable video display monitors; Wearable digital electronic communication devices; Smart phones in the form of eyewear; Wearable communications devices in the form of wristwatches; Wearable digital electronic devices capable of providing access to the Internet; Protective helmets; Drivers helmets; Sports helmets; Helmets for motorcyclists; Helmets for bicycles; Helmet communications systems; downloadable software to enable payment for prepaid wireless phone and data plan services; downloadable software for enabling the transfer of money between users via electronic transactions; downloadable software to enable investments and crypto-currency transactions; downloadable software for facilitating financial transactions via global computer networks and mobile devices via terrestrial and wireless networks and via near field communications; downloadable software for facilitating and verifying authenticated financial transactions between users; downloadable software for enabling payment transactions between users via gift cards, prepaid cards, credit, debit and ACH; downloadable software for providing access to and management of stored financial transaction information.

COSTS

155. While the applicant's mark may proceed to registration for some goods, the opponent enjoyed the greater degree of success. The opponent is, therefore, entitled to a contribution towards its costs based on the scale set out in Tribunal Practice Notice 1/2023. In the circumstances, I consider it appropriate to reduce the costs award to some degree to reflect the applicant's partial success in defending its first mark. I award the opponent the sum of £1,600 as a contribution towards its costs. The sum is calculated as follows:

Preparing two notices of opposition and considering the applicant's counterstatements:	£500
Preparing evidence:	£600
Preparing written submissions:	£400
Sub-total:	£1,500
Reduction:	*-£300*
Official fees (not subject to reduction):	£400
Total:	**£1,600**

156. I hereby order Jonathan Mark Kendrick to pay Reach Magazines Worldwide Limited the sum of £1,600. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of October 2026

A COOPER
For the Registrar

ANNEX 1

Class 9

Computer hardware and computer software; PC mice; keyboards; computer mice; keyboard terminals; multifunction keyboards; Computer controllers; USB cables; HDMI cables; Ethernet cables; Network cables; USB adapters; HDMI adapters; Ethernet adapters; communications and telecommunications apparatus and instruments; Mobile phones; smart phones; Mobile apps; computer software for uploading, sending, manipulating and enlarging media objects and other digital content, including texts, documents, photographs, images, video and audio; computer software for transmission of audio and video by means of a communications network; software for streaming audiovisual and multimedia content via the internet and global communications networks; software for streaming audiovisual and multimedia content to mobile digital electronic devices; downloadable motion pictures and television shows provided via a video-on-demand service; downloadable graphics featuring sets of digital images and icons for use on computers, tablets, and mobile phones; downloadable motion pictures and television shows; downloadable sound recordings; audio and visual recordings; musical recordings computer software for metadata tagging and website tagging; apparatus for recording, transmission or reproduction of sound or images; data processing apparatus and computers, namely computers and computer software for transmission and synchronisation of data between portable communication apparatus; electronic hand-held apparatus intended for the wireless transmission of data and/or voice signals; computer communication software for the synchronisation, transmission and sharing of data, including data related to the keeping of an electronic diary, the contents of messages between one of more electronic hand-held devices and data stored on or linked to a computer; none of the aforesaid goods having the primary function of data acceleration or data transportation, including the acceleration of data storage or acceleration across transmissions lines; downloadable electronic publications; animated cartoons; cinematographic films and compact discs; digital music; downloadable electronic games; electronic game programs; electronic game software; downloadable electronic

game programs; electronic game software for handheld electronic devices; electronic game software for wireless devices; electronic game software for mobile phones; downloadable electronic game software for wireless devices; downloadable electronic game software for handheld electronic devices; downloadable electronic game software for mobile phones; computer games; gaming software; games software; game software; computer hardware for games and gaming; downloadable computer games; interactive game software; computer game programs; computer game programmes; downloadable game software; video game software; computer gaming software; headphones; headphone consoles; wireless headphones; video films; recorded films; downloadable films; animated films; pre-recorded films; motion picture films; film reproducing apparatus; film recording apparatus; film production apparatus; exposed cinematographic film; cinematographic film, exposed; film processing apparatus; pre-recorded cinematographic films; movie film developing machines; smart glasses; wearable speakers; wearable computers; Wearable smart phones; Wearable displays; Wearable monitors; Smart bracelets; Smart rings; Smart watches; Smart glasses; Wearable computer peripherals; Wearable audio equipment; Wearable computer hardware; Wearable activity trackers; Wearable telecommunication apparatus; Wearable communications apparatus; Wearable portable media players; Wearable computer peripheral devices; Wearable video display monitors; Wearable digital electronic communication devices; Smart phones in the form of eyewear; Wearable communications devices in the form of wristwatches; Downloadable mobile applications for use with wearable computer devices; Computer application software for use with wearable computer devices; Wearable digital electronic devices capable of providing access to the Internet; Protective helmets; Drivers helmets; Sports helmets; Helmets for motorcyclists; Helmets for bicycles; Helmet communications systems; downloadable software to enable payment for prepaid wireless phone and data plan services; downloadable software for enabling the transfer of money between users via electronic transactions; downloadable software to enable investments and crypto-currency transactions; downloadable software for facilitating financial transactions via global computer networks and mobile devices via terrestrial and wireless networks and via near field communications;

downloadable software for facilitating and verifying authenticated financial transactions between users; downloadable software for enabling payment transactions between users via gift cards, prepaid cards, credit, debit and ACH; downloadable software for providing access to and management of stored financial transaction information.

ANNEX 2

Class 3

Perfume; Fragrances; Hair shampoos; Hair conditioners; Hair lotions.

Class 9

Computer hardware and computer software; PC mice; keyboards; computer mice; keyboard terminals; multifunction keyboards; Computer controllers; USB cables; HDMI cables; Ethernet cables; Network cables; USB adapters; HDMI adapters; Ethernet adapters; communications and telecommunications apparatus and instruments; Mobile phones; smart phones; Mobile apps; computer software for uploading, sending, manipulating and enlarging media objects and other digital content, including texts, documents, photographs, images, video and audio; computer software for transmission of audio and video by means of a communications network; software for streaming audiovisual and multimedia content via the internet and global communications networks; software for streaming audiovisual and multimedia content to mobile digital electronic devices; downloadable motion pictures and television shows provided via a video-on-demand service; downloadable graphics featuring sets of digital images and icons for use on computers, tablets, and mobile phones; downloadable motion pictures and television shows; downloadable sound recordings; audio and visual recordings; musical recordings computer software for metadata tagging and website tagging; apparatus for recording, transmission or reproduction of sound or images; data processing apparatus and computers, namely computers and computer software for transmission and synchronisation of data between portable communication apparatus; electronic hand-held apparatus intended for the wireless transmission of data and/or voice signals; computer communication software for the synchronisation, transmission and sharing of data, including data related to the keeping of an electronic diary, the contents of messages between one of more electronic hand-held devices and data stored on or linked to a computer; none of the aforesaid goods having the primary function of data acceleration or data transportation, including the acceleration of data storage or acceleration across transmissions lines; downloadable electronic publications; animated cartoons;

cinematographic films and compact discs; digital music; downloadable electronic games; electronic game programs; electronic game software; downloadable electronic game programs; electronic game software for handheld electronic devices; electronic game software for wireless devices; electronic game software for mobile phones; downloadable electronic game software for wireless devices; downloadable electronic game software for handheld electronic devices; downloadable electronic game software for mobile phones; computer games; gaming software; games software; game software; computer hardware for games and gaming; downloadable computer games; interactive game software; computer game programs; computer game programmes; downloadable game software; video game software; computer gaming software; headphones; headphone consoles; wireless headphones; video films; recorded films; downloadable films; animated films; pre-recorded films; motion picture films; film reproducing apparatus; film recording apparatus; film production apparatus; exposed cinematographic film; cinematographic film, exposed; film processing apparatus; pre-recorded cinematographic films; movie film developing machines; smart glasses; wearable speakers; wearable computers; Wearable smart phones; Wearable displays; Wearable monitors; Smart bracelets; Smart rings; Smart watches; Smart glasses; Wearable computer peripherals; Wearable audio equipment; Wearable computer hardware; Wearable activity trackers; Wearable telecommunication apparatus; Wearable communications apparatus; Wearable portable media players; Wearable computer peripheral devices; Wearable video display monitors; Wearable digital electronic communication devices; Smart phones in the form of eyewear; Wearable communications devices in the form of wristwatches; Downloadable mobile applications for use with wearable computer devices; Computer application software for use with wearable computer devices; Wearable digital electronic devices capable of providing access to the Internet; Protective helmets; Drivers helmets; Sports helmets; Helmets for motorcyclists; Helmets for bicycles; Helmet communications systems; downloadable software to enable payment for prepaid wireless phone and data plan services; downloadable software for enabling the transfer of money between users via electronic transactions; downloadable software to enable investments and crypto-currency transactions; downloadable

software for facilitating financial transactions via global computer networks and mobile devices via terrestrial and wireless networks and via near field communications; downloadable software for facilitating and verifying authenticated financial transactions between users; downloadable software for enabling payment transactions between users via gift cards, prepaid cards, credit, debit and ACH; downloadable software for providing access to and management of stored financial transaction information; downloadable software, namely, electronic financial platform that facilitates payment and debt transactions.

Class 10

Hearing protectors; Hearing aids; Electric hearing aids; Medical hearing instruments; Hearing protection devices; Electronic hearing aids; Analog hearing aids; Programmable hearing aids; Electrical hearing aids; Digital hearing aids; Electrically operated hearing aids; Ear plugs; Ear adaptors for hearing aids; Earmoulds being parts of hearing aids; Apparatus for use in alleviating hearing disorders; Apparatus for use in treating hearing disorders; Acoustic amplifiers for partially deaf persons.

Class 11

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating water supply and sanitary purposes; coffee machines; electric coffee machines; electric coffee makers and percolators; parts and components for all the aforementioned goods.

Class 12

Vehicles; apparatus for locomotion by land, air or water; motorcycles; bicycles; electric bicycles; parts, fittings and spare parts for motorcycles, bicycles and electric bicycles.

Class 14

Watches containing an electronic game function.

Class 16

Periodical publications, comic books, comic magazines and stories in illustrated form; posters, lithographs, calendars, diaries, memo pads, scrap books, address books, greeting cards, post cards .

Class 25

Headgear; Clothing; Footwear; and parts and fittings of all the aforesaid goods, included in the class.

Class 28

Electronic games; Handheld electronic games; Electronic games apparatus; Games consoles; Interactive gaming chairs; Gaming chairs; Gaming keypads; Gaming mice.

Class 30

Coffee; tea; coffee substitutes; coffee based drinks; Coffee pods; Coffee capsules; liquid and powdered drinks mixes; coffee essences and extracts.

Class 32

Beers; non-alcoholic beers; low alcohol beers; reduced alcohol beers; mixed drinks containing beer; energy drinks; mineral and aerated waters and other non-alcoholic beverages; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 33

Alcoholic beverages, except beers.

Class 36

Insurance services; financial affairs; monetary affairs; real estate affairs; provision of prepaid cards and tokens; electronic funds transfer; electronic funds transfer services; charitable fundraising and support services to promote the welfare of children; charitable collections; charitable fund raising; child sponsorship services; managing and monitoring of charitable funds; distribution and allocation of charitable

funds; financial arrangements to facilitate charitable giving; information and consultancy services in relation to the aforesaid services.

Class 38

Telecommunications; providing access to the Internet; providing access to electronic databases, providing access to GPS navigation services; electronic mail; wireless messaging services; in particular telecommunications services that enable a user to send and /or receive messages via a wireless data network; data communication via the Internet for the uploading, posting, demonstration, displaying, tagging, blogging, sharing or otherwise providing of electronic media or information; webcasting services; providing online chat rooms and electronic bulletin boards for the transmission of messages, images, sounds, geographic information (geotagging) and other data between computer users; photographic and image processing, namely providing online access to digital images via a global computer network; wireless transmission of data, namely services that enable a user to send and receive messages via a wireless data network using a hand-held portable electronic device; telecommunication services for the transmission and reception of voice communication; broadcasting radio and/or television programmes; audio and video on demand transmission; streaming of audio and visual content; audio and visual broadcasting; transmission and delivery of audio and visual content; news agencies; news services; providing online chat rooms and electronic bulletin boards for the transmission of messages between computer users; providing mobile and fixed communication channels as well as communication via (mobile) telephone; voice messaging services; data communications by radio, telecommunications and satellite; facilitating access to a worldwide computer network for downloading computer software, computer programs and information; e-mail services; providing access to databases; providing multiple user access to a global computer information network; consultancy and information regarding the aforesaid services, whether or not via the Internet, online or via other (electronic) channels; aforementioned services amongst others via the Internet or other electronic networks; none of the aforesaid services having the primary function of data acceleration or data transportation, including the

acceleration of data storage or acceleration across transmission lines, except the provision of and providing access to WIFI networks providing access to the internet and other online services, and including providing subscription services thereto.

Class 39

Recovery of vehicles.

Class 41

Organising competitions; Organising of entertainment competitions; Entertainment services relating to competitions; Arranging of competitions via the Internet; Entertainment services; Interactive entertainment; Live entertainment; Sports entertainment services; Online entertainment services; Conducting of sports competitions; Conducting of competitions on the Internet; Organising of sporting events, competitions and sporting tournaments; education; providing of training; entertainment; sporting and cultural activities; providing online electronic publications; entertainment services; television entertainment, production, presentation, publishing, distribution and rental of television programmes and/or motion picture features; film production, other than advertising films; providing non-downloadable films and television shows via video-on-demand transmission services; entertainment services in the nature of ongoing television series and movies in the fields of action adventure, animation, anime, biography, classics, comedy, crime, documentary, drama, faith, family, fantasy, film-noir, history, horror, international, musical, mystery, romance, science fiction, sports, thrillers, war, and westerns; entertainment services in the nature of development, creation, production, distribution, and post-production of motion picture films, television shows, special events, and multimedia entertainment content; entertainment services in the nature of a live theatrical, musical or comedic performance; production and distribution of motion picture films and television shows; providing entertainment services via a global communication network in the nature of websites featuring a wide variety of general interest entertainment information relating to motion picture films, television show programs, musical videos, related film clips, photographs, and other multimedia materials; providing online non-downloadable

video clips and other multimedia digital content containing audio, video, artwork, and/or text from or related to an ongoing television series; providing entertainment information via a website; providing information, reviews, and recommendations regarding movies and television shows via a website and video-on-demand transmission services; Electronic games services; Organization of electronic game competitions; Electronic game services provided by means of the internet; Electronic games services provided via a global computer network; Online gaming services; Providing online games; Film studios; Film distribution; Film production; Film editing; Film showings; Film directing, other than advertising films; Video film production; Presentation of films; Entertainment by film; Leasing of films; Performance of films; Showing of films; Cinematographic film showings; Cinematographic film studio services; Exhibition of video films; Rental of cinematographic films; Production of television films; Rental of video films; Production of video films.

Class 42

Design of games; Software as a service [SaaS] featuring software platforms for electronic gaming.

Class 44

Telemedicine Services; Therapy services; healthcare services.