O/0959/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004033346
BY DANIEL PEACOCK
TO REGISTER:

CAREERBAY

AS A TRADE MARK IN CLASSES 35 AND 41

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 448684
BY EBAY INC.

BACKGROUND AND PLEADINGS

1. On 01 April 2024, Daniel Peacock ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 19 April 2024 in respect of the following services:

> **Class 35:** *Employment agency services; Human resources consultancy; Personnel placement; Providing employment information; Providing information relating to personnel recruitment; Rental of advertising space on the Internet for employment advertising; Personnel management and employment consultancy; Providing employment information via a global computer network; Personnel recruitment; Advertising; Business management; Personnel management; Dissemination of advertising for others via the Internet; Career information and advisory services (other than educational and training advice).*
>
> **Class 41:** *Publication of educational and training guides; Career information and advisory services (educational and training advice); Career counselling [training and education advice]; Education, teaching and training; Arranging of workshops and seminars; Conducting courses, seminars and workshops; Publishing by electronic means; Publishing of educational matter; Publishing of newsletters.*

2. On 19 July 2024, the application was opposed in its entirety by eBay Inc. ("the opponent") based upon Sections 5(2)(b) and 5(3)[1] of the Trade Marks Act 1994 ("the Act") with the opponent relying upon the following four trade marks[2] and services:[3]

[1] The opponent initially pleaded Section 5(4)(a) but this ground was withdrawn at the hearing.
[2] The first, third and fourth earlier mark are comparable mark based on earlier EUTM or IRs. 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 EUTM or IRs. These comparable marks enjoy the same filing and registration dates as its European counterpart
[3] The services relied upon by the opponent were narrowed down in the opponent's skeleton argument at paragraph 3.

UK00911576865 (“the first earlier mark”)



Filing date: 15 February 2013

Registration date: 20 August 2013

Priority date: 12 September 2012

Class 35: *Advertising; business management; business administration; On-line trading services, namely, operating on-line marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale and purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; advertising and advertisement services.*

Class 41: *Education; providing of training; educational services, namely, providing courses, classes and seminars in the fields of buying and selling via online marketplaces, as well as establishing and operating online marketplace businesses.*

UK00002185144 (“the second earlier mark”)

EBAY

Filing date: 22 December 1998

Registration date: 08 December 2000

Class 35: *Advertising services; business information and administration services; providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network.*

UK00901029198 (“the third earlier mark”)

EBAY

Filing date: 24 December 1998

Registration date: 22 June 2000

Class 35: *online trading services; Advertising services; business information and administration services.*
UK00901499599 (“the fourth earlier mark”) EBAY Filing date: 09 February 2000 Registration date: 06 June 2001 **Class 41:** *Education and entertainment services; provision of educational, entertainment and sporting facilities and activities.*

3. By virtue of their earlier filing dates, the four trade marks relied upon by the opponent are “earlier marks” in accordance with Section 6 of the Act. They had all been registered for more than five years at the filing date of the contested mark, and, as such, are all subject to the use conditions under Section 6A of the Act.

4. Under Section 5(2)(b), the opponent relies upon all of the earlier marks set out above.

5. The opposition based on Section 5(2)(b) and relying upon the first, second and third earlier mark is directed against all of the applied-for services in class 35 with the exception of the following services which are not opposed under this ground: *Employment agency services; Human resources consultancy; Personnel placement; Personnel management and employment consultancy; Personnel recruitment; Personnel management.* In addition, under this ground, the opposition based on the first and fourth earlier mark is directed against all of the services in class 41.

6. Under Section 5(2)(b), the opponent claims that there is a likelihood of indirect confusion because the marks are similar, and the services are identical or similar. In particular, the opponent pleads that there is a likelihood of indirect confusion claiming as follows:

"Such is the reputation of the Opponent's Marks that the "BAY" element of the Applicant's Mark will jump out at consumers and cause confusion in their minds as to whether the Applicant is part of or connected to or authorised by the Opponent."

7. Under Section 5(3), the opponent attacks all of the applied for services in the contested specification and relies upon the class 35 services (as set out above) of its first, second and third earlier mark. The opponent claims that its earlier marks have acquired a reputation in relation to the services relied upon. It also claims that use of the applied-for mark will take unfair advantage of the distinctive character and reputation of the earlier marks. In particular, the opponent relies on the reputation of eBay as a leading global on-line marketplace.

8. The applicant filed a defence and a counterstatement denying the claims made and putting the opponent to proof of use. Having denied the opponent's reputation in its defence, the applicant subsequently conceded that the opponent had demonstrated that the earlier marks have a strong *"reputation and an enhanced distinctive character for 'advertising' (albeit only arising from its on-line marketplace) and 'on-line trading services, namely, operating on-line marketplaces for sellers and buyers of goods and services'".*[4]

9. Both parties filed evidence during these proceedings.

10. The opponent is represented by CMS Cameron McKenna Nabarro Olswang LLP. The applicant is represented by Trade Mark Wizards Limited. A hearing took place before me, by video conference, on 25 June 2026. At the hearing, Mr Jamie Muir Wood (instructed by CMS Cameron McKenna Nabarro Olswang LLP) appeared for the applicant. Mr Chris Aikens (instructed by Trade Mark Wizards Limited) appeared for the opponent.

Relevance of EU Law

[4] Paragraph 10 and 57 of the applicant's skeleton argument

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

EVIDENCE

12. The opponent's evidence came in the form of a witness statement from Amber Leavitt dated 14 November 2024. Ms Leavitt is Senior Director and Associate General Counsel, Head of Intellectual Property at eBay, i.e. the opponent in these proceedings. Her witness statement is accompanied by 12 exhibits, being those labelled 1 -12, and is aimed at demonstrating use and reputation of the earlier marks.

13. The applicant's evidence came in the form of a witness statement from Daniel Peacock, the applicant himself, dated 21 January 2025. Mr Peacock's witness statement is accompanied by two exhibits being those labelled DP1 to DP2 and is a mix of evidence and written submissions referring to the following (a) definitions of 'BAY'; (b) evidence of third-party trade mark registrations containing 'BAY' as a suffix or ending; (c) evidence about the applicant's own website and (d) copy of a cease-and-desist letter from the opponent dated 23 May 2024.

14. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

MY APPROACH TO PROOF OF USE

15. The applicant has conceded that the opponent's earlier marks enjoy a strong reputation for *'advertising' (albeit only arising from its on-line marketplace) and 'on-line trading services, namely, operating on-line marketplaces for sellers and buyers of goods and services'".* Based on this concession, I will proceed on the basis that proof of use is conceded for the following services:

First earlier mark: *On-line trading services, namely, operating on-line marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale and purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; advertising and advertisement services.*

Second earlier mark: *Advertising services; providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network.*

Third earlier mark: *Advertising services; online trading services*

16. Accordingly, as correctly pointed out by Mr Aikens at the hearing, there are two groups of services in relation to which the proof of use is still relevant, namely (a) business management, business administration (as covered by the first earlier mark), business information and administration services (as covered by the second and third earlier mark) in class 35, and (b) education and entertainment services in class 41 (as covered by the first and fourth earlier mark). Consequently, I will address the opponent's evidence only insofar as it is relevant for the purpose of determining whether there has been genuine use of the earlier marks in relation to these services which are still in dispute.

DECISION

PROOF OF USE

Relevant statutory provision: Section 6A:

"(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."

17. As the first, the third and the fourth earlier mark are comparable marks, 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".

18. The relevant period for the purpose of the present opposition is the five years ending with the filing date of the application for the contested mark (31 March 2019 to 01 April 2024).

19. 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]."

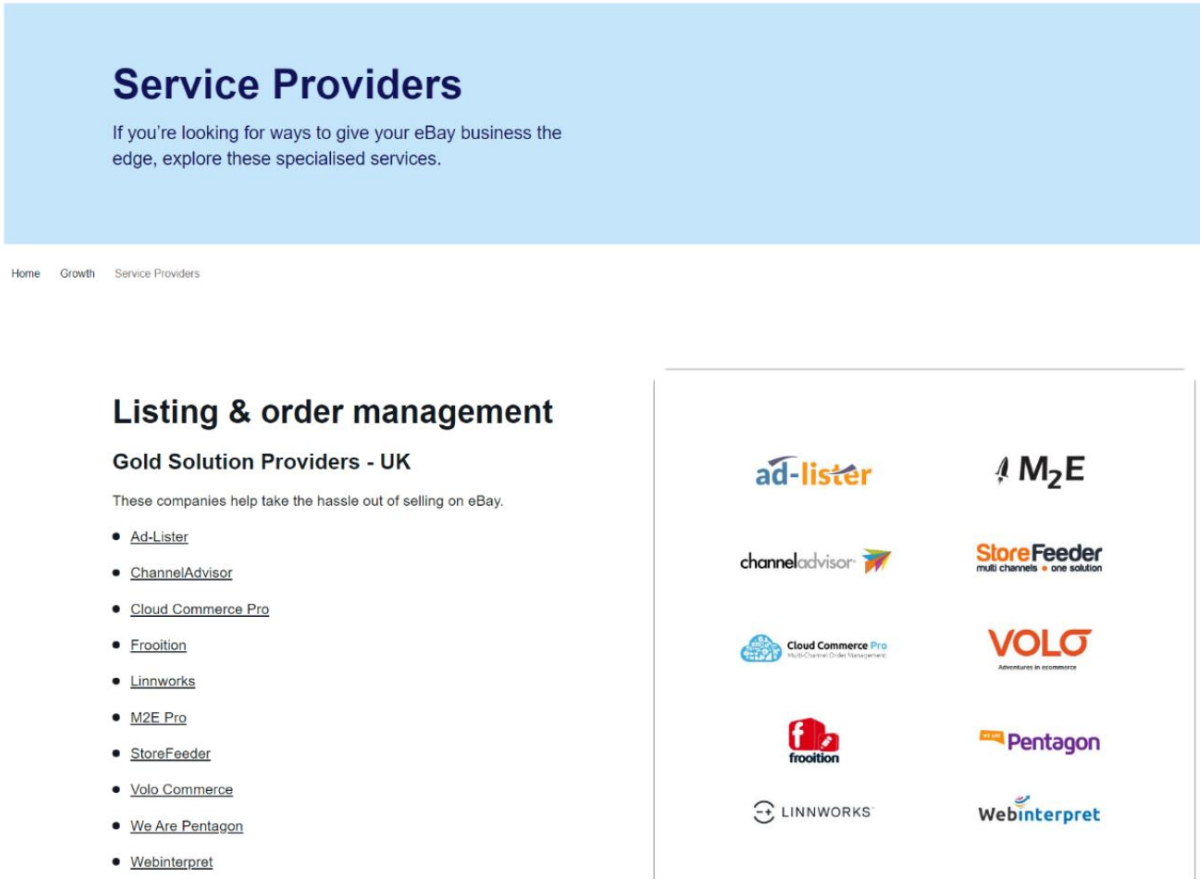
20. Proven use of a mark which fails to establish *that "the commercial exploitation of the mark is real"* because the use would not be *"viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark"* is, therefore, not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

21. At the hearing, Mr Aikens very helpful took me to the parts of the evidence that is relevant for the assessment of genuine use in relation to the services which are still in dispute (i.e. those for which no concession has been made). As regards the first group of services (i.e. *business management, business administration, business information and administration services*), Mr Aikens referred to paragraph 29 of Ms Leavitt's witness statement which is as follows:

"eBay also provides business administration and business management services in the form of multiple tools to help sellers manage their business and eBay listings efficiently. For instance, eBay has dedicated pages, as shown at Exhibit 05, which connect sellers with third-party business services providers, such as listing and order management solutions, advertising solutions and managed service agencies. These third-party solutions are already fully

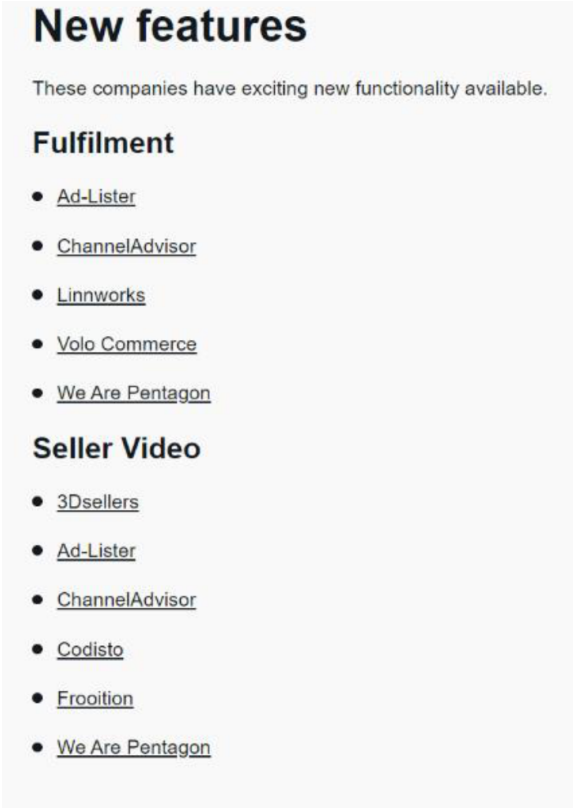
integrated with eBay's own tools and software to ensure a seamless experience for the seller"

22. Mr Aikens further referred me to pages 1 to 5 of exhibit 05 and pointed out that they are archived pages of the eBay.co.uk website as they appeared on 23 June 2022 (which is within the relevant period). He noted that the first page shows that the viewing is as 'business seller' and commented that it is a page that is for eBay's business customers who are businesses who sell on eBay. The page looks like that:



23. As explained by Ms Leavitt, these appear to be specialised services offered by third-party providers to assist eBay's business customers in managing the process of selling on eBay or reducing the associated administrative burden. Clearly eBay suggesting these services to its business customers is not the same as eBay providing the services. Similarly, other pages refer to third-party providers as having *"exciting new functionality available*" and *"promoted listing integrated into their software*", making it easier for eBay's business customers to increase their listing visibility. Other

pages refer to third-party providers being able to assist eBay's business customers with managing their inventory and processing orders, and e-commerce platforms having connectors for listing the sellers' website inventory on eBay. Examples are shown below:



New features

These companies have exciting new functionality available.

Fulfilment

- Ad-Lister
- ChannelAdvisor
- Linnworks
- Volo Commerce
- We Are Pentagon

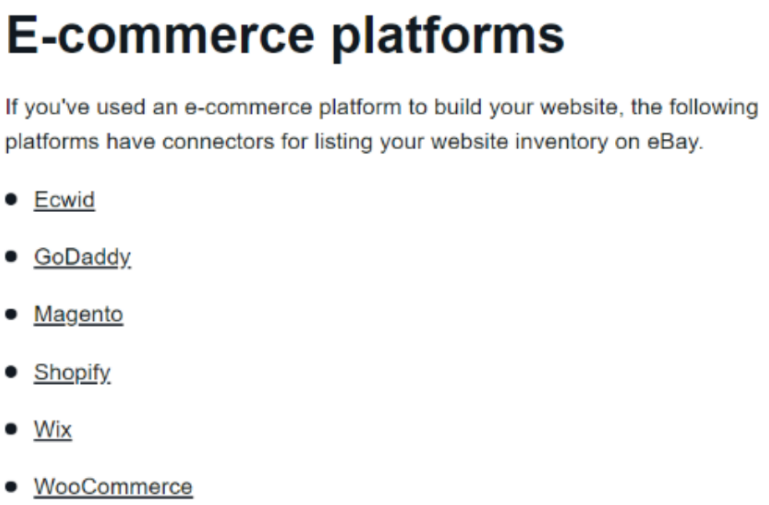
Seller Video

- 3Dsellers
- Ad-Lister
- ChannelAdvisor
- Codisto
- Frooition
- We Are Pentagon

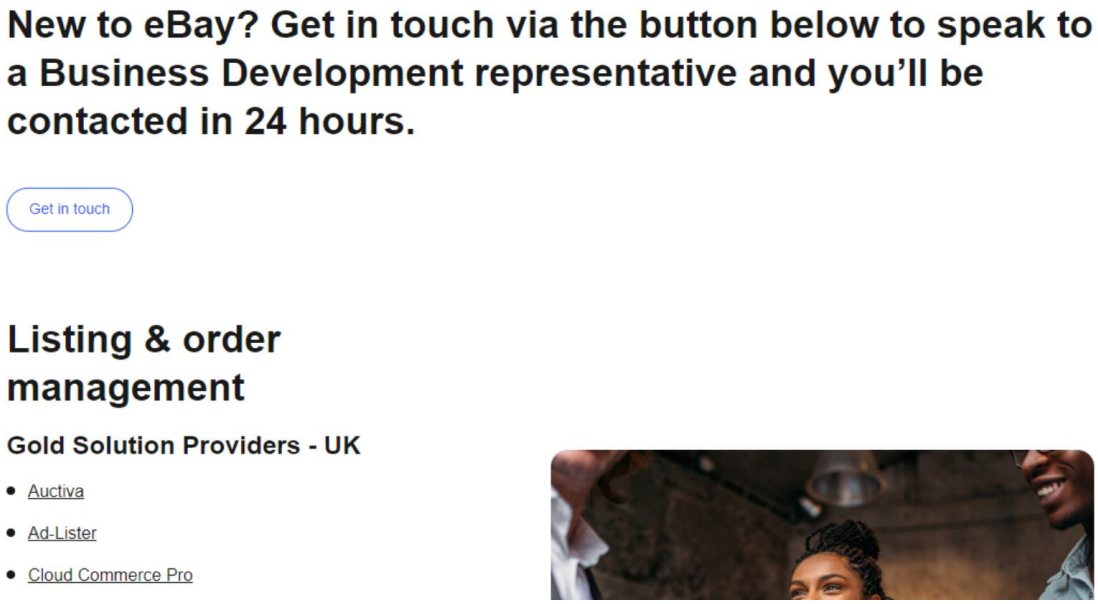
Promoted Listings

The following solution providers now have Promoted Listings integrated into their software, making it easier for you to increase your listings' visibility.

- 3Dsellers
- Ad-Lister
- ChannelAdvisor
- Cloud Commerce Pro
- Frooition
- Linnworks
- Volo Commerce
- We Are Pentagon



24. In addition, Mr Aikens referred to the page below which seems to offer eBay business customers the option of getting in touch with a business development representative, although no further information is provided as to what type of service is on offer:



25. Mr Aikens argued that this evidence shows that *"eBay is providing to its customers a curated list of a number of third-party service providers for eBay sellers"* and that this proves use of the eBay marks in relation to business information services, providing information, which is the availability of third-party service providers to businesses. He also argued that the services offered to businesses to help them develop their

business demonstrate use in relation to business management and business administration, on the basis that it assists those businesses in managing and administering their eBay selling activities.

26. I disagree. The evidence indicates that eBay provides links to third-party providers offering services intended to assist eBay sellers in the process of selling goods through the eBay platform. This appears to involve directing users towards third-party services rather than providing business information in its own right. The fact that eBay describes the services available and identifies the relevant providers only means that the eBay website contains business-related information. However, this would not fall within the ordinary meaning of providing a business information service in class 35 – the latter consists in supplying substantive information of commercial or business nature to others, intended to assist them in making business decisions, managing their commercial activities or developing their business opportunities. The evidence is clear in that eBay does not provide any advice on how to manage or improve the sellers' business, and the fact that the information is provided to business customers does not, in itself, make the service one of providing business information; any services offered to the sellers for the purpose of developing their business, is provided by the third-party companies signposted by eBay, not by eBay itself. Lastly, whilst one of the webpages indicates that sellers can get in touch with a business development representative at eBay, there is no information about the service provided, the number of customers who have used the services, and so on.

27. Accordingly, I find that the evidence fails to establish genuine use in relation *business management, business administration, business information and administration services* in class 35.

28. Turning to the education and entertainment services in class 41, Mr Aikens relied upon paragraphs 30 to 32 of Ms Leavitt's witness statement which are as follows:

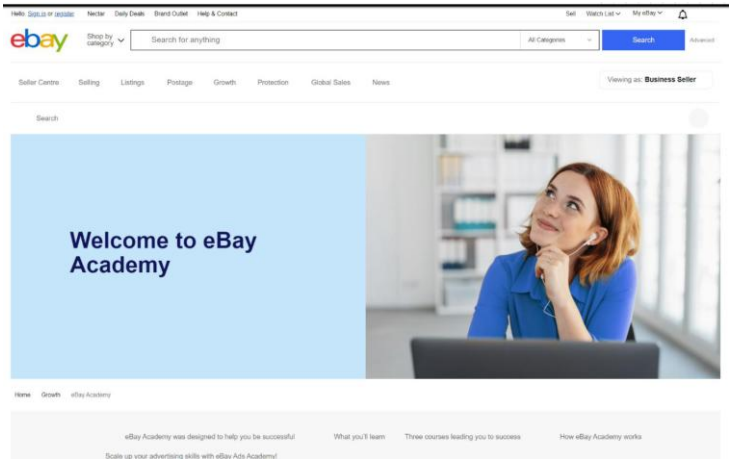
> *"eBay provides educational and training services via its Seller Centre that includes tutorials, tips, and FAQs about how to run a successful business on the platform. Within the Seller Centre, eBay Academy offers educational resources and webinars designed to help sellers grow their business, learn*

about platform updates, and improve their sales strategies. Examples of these educational and training resources are shown at Exhibit 06.

eBay conducts courses, seminars and workshops. For example, it offers a range of webinars to help sellers enhance their business knowledge, improve their selling strategies, and stay updated on platform changes. These webinars, examples of which are attached at Exhibit 07, are a valuable resource for both new and experienced eBay sellers, covering various aspects of e-commerce and how to succeed on eBay. For example, eBay Elevate is a webinar series created by eBay in partnership with Small Business Britain which aims to support businesses at all stages of their journey, providing advice on a variety of topics including building brand identity, building customer loyalty, and finance fundamentals.

eBay also offers a variety of newsletters and blog posts to keep sellers informed and engaged. Examples of these publications are attached at Exhibit 08. For instance, eBay publishes articles with tips, advice, updates and insights for sellers on numerous topics, such as preparing for peak trading season, Royal Mail tariff increases, and how deliveries may be impacted by events such as extreme weather and bank holidays".

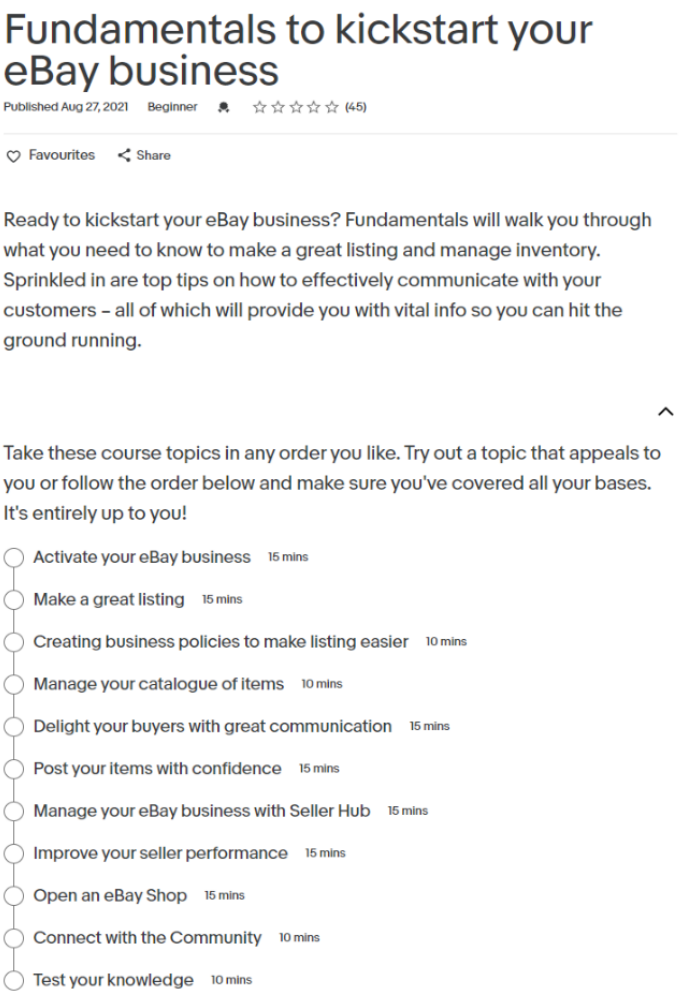
29. Mr Aikens further referred to exhibit 06 which he stated contains examples of educational training resources. The exhibit shows a webpage from the eBay website dated 22 April 2022 saying *'Welcome to the eBay Academy'* which I have reproduced below:



30. Mr Aikens also referred to the following text which is displayed on the same page:

> *"Whether you are new to eBay or have been selling for years, eBay academy has a wide range of free, interactive courses to offer to those just starting out or for those looking to enhance their existing eBay business, there is really something for everybody. You will have access to courses designed by eBay and experts to teach you how to grow your business and succeed on eBay. Learn at your own pace as part of an interactive, self-learning experience. Choose from a range of free, online courses such as how to open an eBay shop, master our tools and features, build and grow your brand, bring value from other sites and much more."*

31. An example of eBay courses is provided within the same exhibit. It shows the following course available on the eBay website with a publication date of August 2021:



32. Exhibit 07 shows further examples of courses available in the form of webinars available within the relevant period. These include: (a) a page dated 24 April 2023 showing eBay Elevate webinar series, including the following: how to create a rock solid business plan; how to build loyalty; managing online retail in a recession; learn product photography; how to find a secure grant funding; learn how to prepare for upcoming tax changes; (b) a webinar called ‘eBay Elevate: how to build a PR plan for your small business’ (20 April 2023); (c) a webinar called ‘Fuel your eBay sales: proven strategies for selling motorcycle parts’ (26 April 2023); (d) a webinar called ‘eBay Elevate: writing copy that stands out’ (27 April 2023); (e) a webinar called ‘eBay Elevate: growing your social presence on a budget’ (11 May 2023); (f) a webinar called ‘eBay Elevate: establishing a brand identity’ (17 May 2023); (g) a webinar called ‘eBay Elevate: search engine optimization basics’ (31 May 2023); (h) a webinar called ‘Learn how to drive sales with great reviews’ (5 April 2023); (i) a webinar called ‘eBay: safety and awareness’ (28 February 2024).

33. Mr Aikens argued that this evidence demonstrates that eBay offers free courses aimed at sellers who use the platform and wish to improve their skills or keep up to date with developments. He submitted that this evidence is sufficient to establish use in relation to educational services before the filing date. Mr Aikens further submitted that, as regards the scale of use, the opponent needs only demonstrate that the use is genuine and not merely token. He argued that the exhibited pages clearly show that the use was not intended merely to preserve the eBay trade mark registrations. He further submitted that given the overall scale of eBay operations, it can reasonably be inferred that the use in question constituted non-trivial commercial use.

34. In *Silberquelle GmbH v Maselli-Strickmode GmbH,* Case C-495/07, the Court of Justice of the European Union ("CJEU") held that:

> "17. It is settled case-law that 'genuine use' within the meaning of the Directive must be understood to denote actual use, consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (Case C-40/01 *Ansul* [2003] ECR I-2439, paragraphs 35 and 36, and Case C-442/07 *Verein Radetzky-Orden* [2008] ECR I-0000, paragraph 13).
>
> 18. It follows from that concept of 'genuine use' that the protection that the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d'être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings (*Ansul*, paragraph 37, and *Verein Radetzky-Orden*, paragraph 14).
>
> 19. As the Commission submitted in its observations to the Court and as the Advocate General stated in points 45 and 55 of his Opinion, it is essential, in the light of the number of marks that are registered and the conflicts that are likely to arise between them, to maintain the rights conferred by a mark for a given class of goods or services only where that mark has been used on the market for goods or services belonging to that class.

20. For the reasons set out in points 48 and 56 of that Opinion, that condition is not fulfilled where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter.

21. In such a situation, those items are not distributed in any way with the aim of penetrating the market for goods in the same class. In those circumstances, affixing the mark to those items does not contribute to creating an outlet for those items or to distinguishing, in the interest of the customer, those items from the goods of other undertakings.

22. In the light of the foregoing considerations, the answer to the question referred is that Articles 10(1) and 12(1) of the directive must be interpreted as meaning that, where the proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods, it does not make genuine use of that mark in respect of the class covering those items."

35. In *Claridge's Hotel Ltd v Claridge Candles* Ltd [2019] EWHC 2003 (IPEC), Mr Recorder Campbell QC (now KC) applied the case law of the CJEU, including *Ansul* and *Silberquelle,* as requiring that the effect of use relied on was to create or maintain a market for the goods/services covered by the registration. Consequently, he held that even though the claimant in *Claridge's* had applied that mark to toiletries and magazines, it had not sought to create a market for those goods; it had provided them [free of separate charge] to create or maintain the market for its hotel services. By contrast, the judge held that the claimant's mark had been put to genuine use in relation to restaurant, café, and bar services, as well as conference, business and health club services, notwithstanding the fact that these services were marketed only in connection with its hotel.

36. I find that the above case-law applies to the provision of the opponent's webinars. The webinars are offered free of charge to assist eBay's business customers in increasing their sales, thereby encouraging the use of the eBay platform and its online trading services. They are not offered with a view of penetrating the market for educational services in class 41. Nor does the provision of webinars on eBay website

contribute to creating an outlet for such services or enable consumers to distinguish those services, in terms of their commercial origin, from those of other undertakings.

37. In any event, even if I am wrong in that assessment, the evidence contains no information as to the extent or scale of the use, the number of webinars held during the relevant period, or the number of attendees from the UK (or the EU). In this connection, I reject Mr Aikens' submission that genuine use should be inferred from the scale of eBay business. As the case-law makes clear, a finding of genuine use cannot be based on inferences and suppositions.

38. The same considerations apply to the provision of newsletters and articles; whilst some examples of articles are provided,[5] they far from showing genuine use for entertainment services.

39. Accordingly, I find that the evidence fails to establish genuine use in relation to any of the opponent's services in class 41.

40. Consequently, the opposition will proceed based solely on the services for which genuine use has been conceded by the applicant.

Section 5(2)(b)

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

> "5(2) A trade mark shall not be registered if because –
>
> (a) …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

[5] Exhibit 08

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

42. 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 services

43. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

44. 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.

45. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. This is equally applicable to services. In *Boston Scientific Ltd v OHIM,* Case T-325/06, the General Court ("GC") stated that "complementary" means:

> "[…] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

46. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services

are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited,* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

47. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

48. The competing services are as follows:

The applicant's services	**The opponent's services**
Class 35: ~~*Employment agency services; Human resources consultancy; Personnel placement;*~~ *Providing employment information; Providing information relating to personnel recruitment; Rental of advertising space on the Internet for employment advertising;* ~~*Personnel management and employment consultancy;*~~ *Providing employment information via a global computer network;* ~~*Personnel recruitment;*~~ *Advertising; Business management;* ~~*Personnel management;*~~ *Dissemination of advertising for others*	<u>First earlier mark:</u> **Class 35:** *On-line trading services, namely, operating on-line marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale and purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; advertising and advertisement services.*

via the Internet; Career information and advisory services (other than educational and training advice). ~~**Class 41:** *Publication of educational and training guides; Career information and advisory services (educational and training advice); Career counselling [training and education advice]; Education, teaching and training; Arranging of workshops and seminars; Conducting courses, seminars and workshops; Publishing by electronic means; Publishing of educational matter; Publishing of newsletters.*~~	Second earlier mark: **Class 35:** *Advertising services; providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network.* Third earlier mark: **Class 35:** *Advertising services; online trading services*

49. Whilst the opponent has opposed the applicants' class 41 services based on the first and fourth earlier mark, it cannot longer rely on its class 41 services (because they have not survived the proof of use assessment). This means that the opponent can no longer rely on the fourth earlier mark at all (which covers only class 41). As regards the first earlier mark, admittedly, the opponent can continue to rely on this mark for some of its class 35 services. However, in its pleadings,[6] the opponent has pleaded the existence of similarity between the respective class 41 services (and such approach was maintained at the hearing); it did not plead that the applicant's class 41 services are identical or similar to any of its class 35 services. Accordingly, since (i) no identity/similarity was pleaded between the applicant's class 41 services and the opponent's class 35 services, and (ii) the opponent can no longer rely on the services in relation to which it has claimed that there is identity/similarity with the applicant's class 41 services, the opposition fails in relation to these services.

50. *Rental of advertising space on the Internet for employment advertising; Advertising; Dissemination of advertising for others via the Internet*. All three marks

[6] Annex 1

relied upon by the opponent cover advertising services, which are sufficiently broad to encompass the applicant's services. This would be the case even if I were to restrict the opponent's services to advertising services provided via an online marketplace. These services are **identical** on the principle outlined in *Meric.*

51. *Business management*. In its pleadings, the opponent relies on *business management*. This was also confirmed by Mr Aikens at the hearing. He stated:

> *"Next common ground, business management is identical to business management, I think that goes without saying. Our position is that business management is also identical to business information or business administration services because management in particular involves administration, so it overlaps with administration. If we are wrong about that we say they are at least similar to at least reach the 5(2)(b) threshold."*

52. However, the opponent can no longer rely on *business management*. In the absence of any other argument from the opponent as to why *Business management* is similar to any of the services upon which the opponent can continue to rely, I find that these services are **dissimilar** to the opponent's services.

53. *Providing employment information; Providing information relating to personnel recruitment; Providing employment information via a global computer network; Career information and advisory services (other than educational and training advice).*

54. In his skeleton argument, Mr Aikens argued that there is a degree of similarity between these services and the opponent's '*Business information and administration services*'. In particular, he said that both services involve the provision of information, that users overlap in the sense that businesses will use a service providing information relating to personnel recruitment, and an individual may seek both information relating to employment and careers, and information on how to start their own business. However, the opponent cannot rely on *Business information and administration services.* In the absence of any other argument from the opponent as to why these services are similar to any of the services upon which the opponent can continue to rely, I find that these services are **dissimilar** to the opponent's services.

55. For an opposition under Section 5(2(b) to be successful, some similarity of goods and services is essential.[7] Accordingly, the opposition based on Section 5(2)(b) fails for the services which I have found to be dissimilar, and will proceed only in relation to the following services which I have found to be identical to the opponent's services:

> **Class 35:** *Rental of advertising space on the Internet for employment advertising; Advertising; Dissemination of advertising for others via the Internet.*

Average consumer and the nature of the purchasing process

56. 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.

57. In *Iconix Luxembourg Holdings* (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

[7] *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

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 and 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.

58. The average consumer of the parties' advertising services in class 35 is a business user. The services will be selected online and from marketing material as well as from signs displayed on business premises. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural component to the purchase, particularly when the service is discussed with a marketing consultant, or a selection is made further to word-of-mouth recommendations.

59. The cost of services is likely to vary, but generally speaking considerations will be given to the specific services needed, i.e. branding, digital marketing, social media, the industry experience, the portfolio and track records and the clients testimonials and reviews. Taking the above factors into account, I find that the average consumer will demonstrate an above medium, but not outright high, level of attention in respect of the services.

Comparison of marks

60. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("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."

61. 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. The respective marks are shown below:

The applied-for mark	**The earlier mark**
CAREERBAY	 **EBAY**

The opponent's marks

62. The opponent's first earlier mark comprises the word 'ebay', with each of the letters displayed in a different colour, namely red, blue, yellow and green. The word 'ebay' plays the greatest role in the overall impression of the mark, followed by the use of colour. I find that the font, and the use of lowercase lettering are both fairly

unremarkable, and these elements play a significantly lesser role in the overall impression.

63. The opponent's second and third earlier mark comprise the single word 'EBAY'. I find the full mark contributes to its overall impression.

64. In his skeleton argument, Mr Aikens argued that the opponent's mark will be perceived as the letter 'E' and the word 'BAY', however, I do not think that in the context of advertising services at large, the average consumer will necessarily perceive the letter 'E' as referring to the services being provided online. Nevertheless, if the opponent's services are restricted to advertising provided in the context of an online marketplace, the average consumer will perceive the 'EBAY' mark as made up of the letter 'E' standing for electronic or digital, and the word 'BAY'. Otherwise, 'EBAY' will be perceived as a single invented word.

The applicant's mark

65. The applicant's mark consists of the word 'CAREERBAY'. It is common ground between the parties that although the words are joined together without a space, that does not prevent consumers from recognising the individual elements; as such, the applicant's mark will be understood as representing the two ordinary dictionary words 'CAREER' and 'BAY' with neither word dominating.

66. The services at issue under Section 5(2)(b) are *Rental of advertising space on the Internet for employment advertising; Advertising; Dissemination of advertising for others via the Internet.* Admittedly, in relation to *Rental of advertising space on the Internet for employment advertising,* the word 'CAREER' is descriptive of the subject matter of the services. However, I consider that in the context of the mark as a whole, the word 'CAREER' is not perceived as a separate descriptive element but rather forms a meaningful unit with the word 'BAY'. The overall impression is therefore conveyed by the combination 'CAREER' and 'BAY', in which both elements contribute to the meaning of the mark. Accordingly, I do not consider it appropriate to attribute significant less weight to the word 'CAREER' simply because it is descriptive when considered in isolation.

Visual similarity

67. Visually, the second earlier mark and the applicant's mark coincide in the sequence 'BAY' which is placed after the letter 'E' in the opponent's mark and after the word 'CAREER' in the application. I bear in mind that the beginnings of marks are more focussed upon, but that, in this case, the first elements 'CAREER' and 'E' are inherently less distinctive than the shared element 'BAY'. I also bear in mind that the shared element 'BAY' is not independently presented but is subsumed with the marks and that the marks are of different length, being four and nine letters respectably. Overall, I consider the marks to be similar to between a low and medium degree.

68. In the opponent's first earlier mark the different colours of the letters add a further difference; I do not accept that notional use of the applicant's mark includes use of the same range of colours. Accordingly, I consider the marks to be similar to a low degree.

Aural similarity

69. Aurally, the marks will be pronounced as 'EE-BEI' and 'CA-RHEA-BEI'. Overall, I consider the marks to be similar to between a low and medium degree.

Conceptual similarity

70. Conceptually, the parties agree on the meaning of the word 'BAY'. In his skeleton argument, Mr Aikens stated:

> *"The 'BAY' element is an ordinary English word. The Applicant has provided a dictionary entry for 'bay', namely:*
>
> *(a) A part of the coast where the land curves in so that the sea is surrounded by land on three sides.*
>
> *(b) A partly surrounded or marked space.*

The Opponent is content to adopt both those definitions, which are obviously related. In both the case of the Opponent's Marks and the Contested Application, the average consumer of all relevant services would give the word either one of its ordinary English meanings. There is no reason why the meaning given to it would differ as between the Opponent's Marks or the Contested Application.

The Opponent also contends that 'BAY' when used in the context of online trading services and advertising services has also become distinctive of the Opponent as a result of the very extensive use that has been made of it."

71. In his skeleton argument, Mr Muir Wood stated:

"Conceptually, the Earlier Marks allude to e-commerce through use of the 'E' prior to the word BAY, pointing to an online BAY or place to find things.

The Application has a different conceptual meaning, through use of the element 'CAREER', which implies that the mark is used in respect of services associated with careers or employment."

72. I agree with the parties that when perceived in the context of advertising services provided through an online marketplace, the earlier mark 'EBAY' will convey the meaning of e-commerce through the use of the 'E' prior to the word 'BAY', pointing to an online 'BAY' or place to find things. Alternatively, if the fair specification is not restricted and I consider the mark in the context of advertising services at large, 'EBAY' will be perceived as an invented word which will convey no meaning.

73. Turning to the applicant's mark 'CAREERBAY', bearing in mind my earlier finding that the mark will be perceived as comprising the two words 'CAREER' and 'BAY', and having regard to the nature of the services at issue, I consider that the mark as a whole will have the meaning of a 'BAY' or place where jobs or career opportunities are advertised - this meaning will clearly be conveyed when the mark is used for *rental of advertising space on the Internet for employment advertising.* Alternatively, when the mark is used for advertising unrelated to employment (*Advertising; Dissemination of*

advertising for others via the Internet), the words 'CAREER' and 'BAY' will nevertheless retain their individual meanings. However, in that context, the mark as a whole will convey the more general idea of a bay or a place associated in some way with careers, although the precise nature of that association will be less clear, given that the word 'CAREER' has no apparent relevance to the services concerned.

74. Overall, in both marks the English word 'BAY' will be understood as referring metaphorically to a place. However, the shared element does not appear independently in either mark, but forms part of two distinct units: 'EBAY' conveying the idea of an online place and 'CAREERBAY' suggesting a place associated with careers and employment. Taking these differences into account, I consider the marks to be conceptually similar to between a low and medium degree. Alternatively, if 'EBAY' is perceived as an invented word, the marks are conceptually different.

Distinctive character of the earlier mark

75. 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 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section

of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

76. Registered trade marks possess various 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 a mark can be enhanced by virtue of the use made of it.

77. The opponent's marks consist of the word 'EBAY', presented either in plain letters or in slightly stylised and coloured form.

78. To the extent that 'EBAY' is perceived as an invented word, the mark possesses a high degree of inherent distinctiveness.

79. As noted above, the applicant has accepted that the earlier marks enjoy a strong reputation in relation to *"advertising' (albeit only arising from its on-line marketplace) and 'on-line trading services.* Proceeding on the basis that the services at issue are identical to the opponent's advertising services and having regard to the applicant's concession as to the reputation of the earlier mark, I am satisfied that the distinctive character of the opponent's marks is enhanced to a very high degree in relation to the services at issue. In this connection, it makes no difference whether the specification on which the opponent may rely is limited to advertising arising from the 'EBAY' on-line marketplace. Even if that were the case (and the mark 'EBAY' is perceived as alluding to an online place), the applicant's concession as to the strong reputation of the earlier marks leads me to the same conclusion.

Likelihood of confusion

80. 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, including that a lesser degree of similarity between the respective

marks may be offset by a greater degree of similarity between the respective services and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

81. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, 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 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)."

82. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

> "13. As James Mellor QC sitting as the Appointed Person pointed out in Cheeky Italian Ltd v Sutaria (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

83. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

84. Earlier in this decision I found that:

- The marks are visually similar to a low degree (the first earlier mark) and between a low and medium degree (the second and third earlier mark). Aurally, they are similar to between a low and medium degree. Conceptually, the marks are either similar to between a low and medium degree, or dissimilar.

- The parties' services are identical.

- The average consumer is a member of the general public who will select the services mainly visually, with a medium or slightly above medium degree of attention.

- The earlier marks are distinctive to a very high degree as a result of the use the opponent has made of them.

85. The opponent's case is that the element 'BAY' is distinctive of the opponent. In seeking to counter this argument, the applicant has adduced state of the register evidence showing other trade mark registrations containing the term 'BAY'.[8] However, as correctly pointed out by Mr Aikens, it is well established that state of the register evidence is of no or little evidential value, and in itself does not assist in determining the distinctive character of the opponent's mark.

86. Mr Aikens put the opponent's case as follows:

> *"The average consumer would therefore associate the 'BAY' element in 'CAREERBAY' with eBay and believe that CAREERBAY is an offshoot of eBay focusing on career-related services, including providing advertisements for work, work experience, and the like."*

87. I do not accept this submission. The opponent's mark, 'EBAY', is presented as a unit. Although the average consumer may understand it as referring to an online marketplace and recognise the elements 'E' and 'BAY' within it, that does not mean that the element 'BAY' considered independently will be perceived as distinctive of the opponent. There is no evidence that the opponent has used 'BAY' on its own or that the word has acquired distinctiveness through use as an indication of the opponent's trade origin. 'BAY' is an ordinary English word and the fact that the opponent's mark is consistently presented as 'EBAY' rather than 'BAY' alone further undermine the contentious that the average consumer would isolate 'BAY' from the mark and regard it as the distinctive indicator of the opponent's business. Accordingly, I do not consider that the presence of the element 'BAY' in 'CAREERBAY' would lead the average

[8] DP1

consumer to believe that the applicant's services originate from the opponent or an economically related undertaking. There is no likelihood of confusion.

88. The opposition based on Section 5(b) fails in its entirety.

Section 5(3)

89. Section 5(3) states:

> "(3) A trade mark which-
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

90. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

> (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors*, paragraph 26.
>
> (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

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

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

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

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

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

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

mark; *L'Oreal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure).*

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

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot

be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

92. Given the applicant's concession I will proceed on the basis that the opponent has a strong reputation for the following services:

> First earlier mark: *On-line trading services, namely, operating on-line marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale and purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; advertising and advertisement services.*
>
> Second earlier mark: *Advertising services; providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network.*
>
> Third earlier mark: *Advertising services; online trading services*

93. These are the same services in relation to which Mr Aikens submitted that the earlier marks have a reputation, as stated in paragraph 44 of his skeleton argument:

> *"Under Section 5(3), the Opponent relies on the services in the specification for the Opponent's Marks set out in paragraphs 11 (online trading services) and 13 above (advertising services)".*

The Link

94. As I 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:

95. The degree of similarity between the conflicting marks. The marks are visually similar to a low degree (the first earlier mark) and between a low and medium degree

(the second and third earlier mark). Aurally, they are similar to between a low and medium degree. Conceptually, the marks are either similar to a low to medium degree, or dissimilar.

96. 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. As the services in relation to which the opponent has a reputation are the same as those which I have used for the comparison of the services under Section 5(2)(b), the same conclusions apply here, namely that the services are dissimilar with the exception of the following services which I have found to be identical: *Rental of advertising space on the Internet for employment advertising; Advertising; Dissemination of advertising for others via the Internet.* I also find that the contested *Employment agency services; Human resources consultancy; Personnel placement; Personnel management and employment consultancy; Personnel recruitment; Personnel management* are dissimilar to the opponent's advertising services (even if they are restricted to services provided in the context of an online marketplace) and online marketplace services. The services have different natures, purposes and methods of use, they are neither complementary nor in competition and do not share trade channels.

97. The strength of the earlier mark's reputation. The applicant has conceded that the earlier marks have a strong reputation for the services relied upon as set out above.

98. The degree of the earlier mark's distinctive character, whether inherent or acquired through use. The earlier marks have a very high degree of distinctiveness.

99. Whether there is a likelihood of confusion. There is no likelihood of confusion in relation to any of the services at issue.

100. Admittedly, the level of similarity required for the public to make a link between the marks for the purposes of Section 5(3) may be less than the level of similarity required to create a likelihood of confusion.[9]

[9] *Intra-Presse SAS v OHIM,* Joined cases C-581/13P & C-582/13P

101. Given the strength and very high degree of distinctiveness of the mark 'EBAY' in relation to the services for which the earlier marks have a reputation, in the context of which the average consumer will understand 'EBAY' as a made up word containing the element 'E' and the word 'BAY' alluding to an online place where to find things or advertise goods and services, I consider that the presence of the shared element 'BAY' in 'CAREERBAY' will result in the earlier marks being brought to mind by the later mark when identical services are involved. In my view, consumers who are familiar with the 'EBAY' earlier marks will be able to make such a link when confronted with the later 'CAREERBAY' mark used for identical services. A link is established.

102. The only damage pleaded by the opponent is unfair advantage. In his oral submissions, Mr Aikens argued the point as follows:

> *"Then, we rely on the positive attributes of eBay, chiefly its success and popularity. We say that the effect of that is that the average consumer sees eBay as the go-to online marketplace for goods in the UK, or the market leader if you like. The effect of the 'Bay' element in CAREERBAY and the link that the average consumer would make with eBay is that the average consumer would perceive CAREERBAY in the same way. So, that name would indicate the go-to site or market leading site for recruitment, advertising, and employment services in the UK and therefore people are more likely to go to the Applicant's site than others with different names. We say that is purely because of the name, CAREERBAY, and the link people would make with eBay and the perception of CAREERBAY as the go to site or market leader would only have been achieved as a result of the Opponent's investment in advertising and promoting the eBay marks and its enormous success over the last 25 or so years".*

103. In *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods/services offered under the later trade mark was required to establish unfair advantage by virtue of a transfer of image.

104. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited and Anor,* [2019] EWHC 2003 (IPEC).

105. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) 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."

106. See also *Manpower Direct (UK) Limited v Manpower Group Inc.* [2019] EWHC 849 (Ch).

107. Mr Aikens put the opponent's case as follows:

> *"The Opponent's Marks have a reputation (i) for an online marketplace on which a wide range of goods and services is offered and sold, and (ii) for advertisements which are capable of reaching a broad and large audience. The Opponent's Marks are naturally associated with the positive attributes of a success and popularity.*

That is as a result of the huge investment the Opponent has made in advertising and promoting its business and the eBay online marketplace. There will be a transfer of image of those positive attributes of eBay to each of the services provided by the Applicant, such that, even in those circumstances where the average consumer would not be confused, the Applicant's services will seem more attractive to the average consumer by reason of their association with eBay. The Applicant will thereby be free-riding on the repute of the Opponent's Marks and he will be benefiting from the association with the positive attributes of eBay without having made the huge investment in advertising and promotion that eBay has made. That advantage is unfair."

108. I agree with Mr Aikens that there is unfair advantage in relation to identical services. In particular, I consider that the identity of the advertising services at issue, which are identical to those in respect of which the earlier marks enjoy a strong reputation, together with the strength of that reputation, is sufficient to result in the applicant's mark benefitting from the power of attraction, reputation and prestige of the 'EBAY' earlier marks. This would enable the applicant to exploit, without paying any financial compensation and without being required to make any effort of its own in that regard, the marketing efforts made by the opponent to create and maintain the image of the earlier marks. In particular, I consider that the EBAY's image as a major global advertising platform would benefit the applicant's mark in the context of advertising services and that this image would be transferred to the applicant's mark. In this connection, I agree with Mr Aikens that as a result of this transfer, the applicant's mark would be perceived as denoting a go-to site or market-leading platform for advertising and recruitment services in the UK. However, the distance between the opponent's services and the remaining services at issue is such that the relevant public would not establish a link between the marks. Alternatively, even if such a link were to be made, it would be so fleeting not to cause any detriment or damage.

109. For the sake of completeness, I should briefly mention that the applicant has also argued that despite a period of coexistence on the market as a result of the applicant's trading activities, there is no evidence of a change in the economic behaviour of the average consumer of the services. As correctly point out by Mr Aikens, the absence of

such evidence is not fatal because the relevant case-law establishes that a serious likelihood of a change is sufficient.[10]

110. The opposition is successful under Section 5(3) in relation to the following services:

> **Class 35:** *Rental of advertising space on the Internet for employment advertising; Advertising; Dissemination of advertising for others via the Internet.*

OUTCOME

111. The opposition has been successful under Section 5(3) in relation to the following services which will be refused registration:

> **Class 35:** *Rental of advertising space on the Internet for employment advertising; Advertising; Dissemination of advertising for others via the Internet.*

112. The opposition has failed in relation to the remaining services which will proceed to registration:

> **Class 35:** *Employment agency services; Human resources consultancy; Personnel placement; Providing employment information; Providing information relating to personnel recruitment; Personnel management and employment consultancy; Providing employment information via a global computer network; Personnel recruitment; Business management; Personnel management; Career information and advisory services (other than educational and training advice).*
>
> **Class 41:** *Publication of educational and training guides; Career information and advisory services (educational and training advice); Career counselling [training and education advice]; Education, teaching and training; Arranging of workshops and seminars; Conducting courses, seminars and workshops;*

[10] Easy Group and Easy Live Auction [2022] EWHC 3327 (Ch)

Publishing by electronic means; Publishing of educational matter; Publishing of newsletters.

COSTS

113. Each party has achieved a measure of success. Hence, I direct that each party bear their own costs.

Dated this 26th day of October 2026

TERESA PINTO
For the Registrar