

O/0973/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF APPLICATION NOS. 3694000 & 3694015
IN THE NAME OF L&S PRINTS DIGITAL LIMITED
IN CLASSES 20, 24, 28, 35 & 40**

**AND IN THE MATTER OF OPPOSITIONS THERETO
UNDER NOS. 431965 & 432176
BY NERDY BANANA LIMITED**

AND

**IN THE MATTER OF REGISTRATION NO. 3663045
IN THE NAME OF L&S PRINTS DIGITAL LIMITED
IN CLASS 28**

**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 505827
BY NERDY BANANA LIMITED**

AND

**IN THE MATTER OF APPLICATION NO. 3767569
IN THE NAME OF NERDY BANANA LIMITED
IN CLASSES 20, 24, 25, 28, 35 & 40**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 437270
BY L&S PRINTS DIGITAL LIMITED**

BACKGROUND AND PLEADINGS

1. L&S Prints Digital Limited (“LS”) is the registered proprietor of the UK trade mark displayed at (i) below. LS has also applied to register the trade marks shown at (ii) and (iii) below in the UK.

(i) 

Registration no. 3663045

Filing date: 1 July 2021

Registration date: 31 December 2021

(“LS’ registration”)

(ii) **MINI ME**

Application no. 3694000

Filing date: 13 September 2021

Publication date: 17 December 2021

(“LS’ first application”)

(iii) 

Application no. 3694015

Filing date: 13 September 2021

Publication date: 24 December 2021

(“LS’ second application”)

2. LS’ registration stands registered in respect of *dolls; plush dolls; fabric dolls; stuffed dolls; toy dolls* in class 28. Registration of LS’ first application is sought for goods and services in classes 20, 28 and 35, whereas registration of its second application is sought for goods and services in classes 20, 24, 28, 35 & 40. These are set out in full in the annex to this decision.

3. On 17 March 2022 and 24 March 2022, respectively, Nerdy Banana Limited (“NB”) opposed LS’ applications in full under ss.5(4)(a), 3(1)(c), 3(1)(d) and 3(6) of the Trade

Marks Act 1994 (“the Act”). On 25 January 2023, ND made an application for a declaration of invalidity in respect of LS’ registration pursuant to s.47 of the Act. The invalidation is brought on the same grounds as the oppositions.

4. Under s.5(4)(a) of the Act, NB claims that it has substantial goodwill in relation to which it has used the sign **MINI ME** throughout the UK since 2012. The goods for which the sign is said to have been used are *personalised novelty items including dolls, cushions and clothing*.¹ NB claims that use of LS’ marks would be contrary to the law of passing off.

5. Under s.3(1)(c), NB argues that LS trades in personalised gift products whereby an image or other description of a person is deployed on the product so that it denotes that person in some way. NB contends that LS’ marks are descriptive of such personalised gift products.

6. Under s.3(1)(d), NB submits that LS’ marks have become customary in the trade of personalised gift products which feature an image of a person being reproduced in miniature.

7. As for s.3(6), NB claims that LS has known of its use of the sign since at least 2020. It alleges that LS applied to register its marks to prevent NB and third parties from using them, even though their use predates that of LS. On this basis, NB submits that LS’ marks were filed in bad faith.

8. LS filed counterstatements denying the grounds of opposition and invalidation. Specifically, its respective positions are as follows:

(i) In respect of NB’s claim under s.5(4)(a), LS admits that NB’s *novelty dolls and cushions* are identical or similar to its goods and services but denies that *clothing* is identical or similar to its goods and services. It admits that its marks are similar to NB’s sign. However, it denies that NB has used its sign for the

¹ I note that in the invalidation action, NB claims use of the sign in respect of *personalised novelty items namely dolls, cushions and clothing*.

goods claimed since 2012 or that any use it may have made of the sign is sufficient for NB to have acquired passing off rights;

(ii) It denies the opposition under ss.3(1)(c) and 3(1)(d) of the Act;

(iii) LS states that it has used its marks since 2018. Having become aware of NB's use in November 2019, it sought advice in May 2020 about the possibility of protecting the marks but was not able to proceed with an application at that time. It instead applied for its registration in July 2021. LS argues that the applications were subsequently made to ensure it has protection for the word mark as well as specifications which adequately cover the goods and services it provides. LS submits that such circumstances do not constitute bad faith and denies NB's claim under s.3(6) of the Act.

9. On 18 March 2022, NB applied to register the mark **MINI ME** in the UK, under number 3767569 ("NB's application"). It was published for opposition purposes on 5 August 2022. Registration is sought for goods and services in classes 20, 24, 25, 28, 35 and 40. These are outlined in the annex to this decision.

10. On 3 November 2022, LS opposed NB's application under ss.5(1), 5(2)(b) and 5(4)(a) of the Act. The opposition is directed against all the goods and services thereof except those in class 25.

11. Under s.5(1), LS relies upon its first application and all its goods and services. It claims that the competing marks are identical. It also argues that the parties' goods and services are identical.

12. Under s.5(2)(b), LS relies upon its registration and second application and all their goods and services. It contends that the competing marks are similar. It also argues that the parties' goods and services are identical or similar. On this basis, it submits that there is a likelihood of confusion.

13. Turning to s.5(4)(a), LS claims that it has goodwill in relation to which it has used the signs shown below throughout the UK since 2018. The goods and services for

which the signs are said to have been used are set out in the annex to this decision. LS contends that use of NB's application would constitute passing off.

(i) **MINI ME**



(ii)



(iii)



(iv)

14. NB filed a counterstatement denying the grounds of opposition. NB admits that the parties both use 'MINI ME' for the same or similar goods and services. However, it denies that LS' use predates its own use; NB argues that it owns prior goodwill and, therefore, any confusion between the marks gives rise to an actionable claim for passing off against LS. It also highlights that the marks relied upon by LS are subject to opposition and invalidity proceedings.

15. LS is professionally represented by Virtuoso Legal. NB has been represented throughout the proceedings by Tom Hope. Both parties filed evidence. No hearing was requested but both parties filed written submissions in lieu of attendance. This decision is taken following careful consideration of all the papers before me.

RELEVANCE OF EU LAW

16. 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, s.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 AND SUBMISSIONS

17. NB's evidence is given in the witness statement of Charlie Rodman, together with 13 exhibits (CR1-CR13), and two witness statements from Christopher Rodman, which were filed with 27 exhibits (CJR1-CJR5 and CJR6-CJR27).

18. The witnesses are both directors and 50% shareholders of NB, Charlie Rodman being its Managing Director and Christopher Rodman being its Secretary. The former provides evidence as to NB's business activities relating to 'MINI ME' and dealings between the parties. The latter largely gives evidence to substantiate NB's s.3 claims.

19. NB filed written submissions dated 4 July 2023, 24 October 2023 and 15 November 2023.²

20. LS filed evidence consisting of a witness statement from Lance Dentith, together with 24 exhibits (LD1-LD24), and a witness statement from Simon Dentith, which was accompanied by seven exhibits (1-7).

21. Lance Dentith is Managing Director of LS. He sets out the background of the company and its use of 'MINI ME'. He also provides evidence of NB's business activities and responds to each ground of opposition/invalidation. Simon Dentith does not explain what position he holds but confirms he is "of" LS.³ He responds to the evidence of Christopher Rodman.

² NB filed written submissions during the evidence rounds (4 July 2023). It later filed written submissions in lieu of a hearing (24 October 2023). However, alongside its own written submissions in lieu, LS filed the witness statement of Simon Dentith as additional evidence. Whilst this evidence was admitted into the proceedings, to maintain the balance of fairness NB was given further time to comment upon the same. Further written submissions were then filed (15 November 2023).

³ Simon Dentith being a duly authorised and appropriate person to give evidence on behalf of LS has not been challenged by NB.

22. LS filed written submissions dated 24 October 2023.

23. I have taken all the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

MY APPROACH

24. If NB's opposition and invalidation actions are successful, LS will have no valid earlier marks to rely upon in its opposition action. As such, although the latter is not wholly dependent on the outcome of the former,⁴ it is convenient to first deal with NB's oppositions and application for invalidity. I will then consider LS' opposition to the extent that it is necessary to do so.

NB'S OPPOSITIONS AND APPLICATION FOR INVALIDITY

25. Sections 5(4)(a), 3(1)(c), 3(1)(d) and 3(6) have application in invalidation proceedings because of the provisions of s.47 of the Act, the relevant parts of which state as follows:

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

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

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

⁴ LS relies upon alleged unregistered rights under s.5(4)(a). NB's oppositions and application for invalidity have no bearing on these.

(a) [...]

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

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

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

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

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 3(1)(c)

26. Section 3(1)(c) of the Act reads as follows:

“(1) The following shall not be registered—

(a) [...]

(b) [...]

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended

purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) [...]

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

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

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

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

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

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

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

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the

same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

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

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

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

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

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

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

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

28. The relevant dates for determining whether LS' marks are objectionable under this ground are their filing dates: 1 July 2021 for LS' registration and 13 September 2021 for LS' applications.

29. The position under s.3(1)(c) must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.⁵ The relevant public will vary depending on the particular goods or services concerned. Given the

⁵ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

nature of the applied-for goods and services, it is my view that they may be purchased by members of the general public or business users. A normal (medium) level of attention will be paid by the general public when purchasing the goods and associated retail services. A slightly higher level of attention may be demonstrated by business users in the purchasing of, for example, advertising or supply chain management services since their selection will, ultimately, have consequences for their own business.

30. LS' first application is in word-only format and consists of the words 'MINI ME' with no other elements. The words will be understood as forming part of a singular term and, as such, it is both words in combination that dominate the overall impact of the mark.

31. LS' registration and second application are figurative and consist of the words 'MINI ME!' in a slightly stylised, coloured font. Although it is somewhat difficult to make out, the dot of the exclamation mark contains what appears to be a smiley face design. In my view, the term 'MINI ME' has the most impact in the mark. The exclamation mark and the stylisation (including the smiley face design, font and colours) also contribute to the overall impact but will, ultimately, be seen as decorative.

32. Firstly, I remind myself that NB's pleaded case under this ground is as follows:⁶

“[LS] trades in personalized gift products where an image or other descriptor of a person (typically a human or other animal) is deployed on the product so that the product in some way represents that person. The term MINI ME is inherently descriptive of such personalized gift products, namely where an image or other descriptor of a person is used on or in relation to that product so that it denotes in some way the person so described.”

33. In the context of these pleadings, I note that some of LS' services, such as *advertising services, website traffic optimisation, office functions and business*

⁶ Aside from using the terms “The Applicant”/“The Registrant” interchangeably, the pleadings are identical in NB's Form TM7s and Form TM26(I).

administration, for instance, clearly cannot be described as products (personalised or otherwise). It is difficult to envisage the circumstances in which the average consumer would perceive LS' marks as descriptive in the manner pleaded by NB for any of these services. It seems to me that NB's best case is in relation to LS' goods in classes 20, 24 and 28, as well as some of its services (such as the associated retail services).

34. Christopher Rodman has provided a range of dictionary definitions for the term 'MINI ME', most notably from Collins Dictionary.⁷ They are consistent in defining the term as meaning "a person who resembles a smaller or younger version of another person". I accept these definitions, which confirm rather than contradict my own impression of the term. It is my view that the average consumer would understand the term in accordance with its dictionary meaning.

35. Whilst the average consumer would extract a meaning from the term 'MINI ME', it does not automatically follow that LS' marks would be perceived as descriptive. There is certainly an allusive connection between that meaning and LS' goods, particularly where they can be personalised or produced in such a way so as to resemble a miniature version of an individual. However, in my view, that it is not descriptive of the same or a characteristic thereof. The recognised meaning relates to *a person* that resembles another, not an inanimate object. The term may be used to refer to a doll, toy or cushion which has been personalised to resemble an individual, but, to my mind, in such circumstances it would allude to the goods, rather than describe them.

36. I am not persuaded otherwise by NB's evidence. Christopher Rodman has provided the following printouts:⁸

- (i) An article from the UK website of *Metro News* dated 18 November 2012, entitled "Ever wanted your own 3D mini-me doll?". It discusses a machine that records a full-body image to create a plaster model figurine of the individual.

⁷ Exhibit CJR2

⁸ Exhibit CJR3

(ii) An article from the global website of *Weekly World News* dated 27 June 2013, entitled “MINI-ME DOLLS”. It says that a company based in the UK was offering similar figurines using a 3D printer.

(iii) A still image of a YouTube (GB) video from *Financial Times* dated 14 March 2014, entitled “Meeting my 3D ‘Mini Me’”.

(iv) An article from *The Herald* dated 13 October 2014, entitled “Teacher launches Mini Me dolls range”. It says that their “soft toy range allows children to choose a doll that resembles them”.

(v) An article from the UK website of *Daily Record* dated 24 January 2015, entitled “[...] customised Mini Me toys are big business in helping kids return to traditional play”. It discusses the same teacher’s business. In referring to one of the dolls, it says “[...] her favourite doll, which is just like a mini version of herself”.

(vi) An article from *Daily Mail Online* dated 6 February 2015, entitled “[...] Designer launches range of mini-me dolls made to look exactly like their owners [...]”.

(vii) An article from the global website of *Vogue* dated 8 February 2017, entitled “[...] Is a Barbie! The Model Reveals Her Mini-Me on Instagram”. It says the model joined “Mattel’s stable of celebrity mini-mes”.

(viii) An article from the global website of Unilad dated 7 February 2020, entitled “Mini-Me Dolls You Can Get To Look Like You Are Perfect For Long Distance Relationships”. It discusses Firebox’s personalised dolls.

37. Although this evidence is from before the relevant dates, I am not convinced that it shows descriptive use of the term ‘MINI ME’. Some of the instances presented appear to use the words in a trade mark sense, i.e. to indicate a line of products as originating from single sources. As for the others, I do not consider a small number of arguably descriptive uses (for instance, the articles in *The Metro*, *Weekly World News*,

Daily Mail Online and *Vogue*) to be compelling evidence that the term is descriptive. The term forms part of headlines or news stories, which often seek to use memorable or appealing language; none of the examples provided shows the term being used in trade as a description in connection with a particular product.

38. Moreover, Christopher Rodman has evidenced printouts from *minime4u.com*, *minimemodels.co.uk* and *minimepillow.co.uk*.⁹ These printouts were obtained on 5 January 2023. Therefore, they cannot be relied upon as showing the position at the relevant dates. Although printouts from Whois are included, showing that the domains were registered on 16 January 2008, 28 March 2017 and 3 September 2020, respectively, mere ownership of a domain does not prove that the website is actually in operation or what it looked like at any time since registration of the domain. In any event, I do not consider any of the printouts to be compelling evidence of descriptive use of the term ‘MINI ME’ in relation to the relevant goods; most, if not all, of the websites appear to be using the term in a trade mark sense.

39. I recognise that it is not necessary that the sign in question is actually used in a way that is descriptive for it to fall foul of s.3(1)(c); it is sufficient, by virtue of the wording of the provision, if the sign *could* be used for such purposes. However, all the above leads me to conclude that the average consumer would not immediately perceive LS’ marks in the manner pleaded by NB without further mental processing or analysis, and I do not consider that there is a reasonably foreseeable risk thereof in the future. For these reasons, I am not satisfied that LS’ marks are exclusively descriptive in relation to any of their goods or services.

40. NB’s claims under s.3(1)(c) are dismissed.

Section 3(1)(d)

41. Section 3(1)(d) of the Act reads as follows:

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

⁹ Exhibit CJR4

[...]

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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

42. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court (“GC”) summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

43. The question to be determined is whether, at the relevant dates of 1 July 2021 and 13 September 2021, LS' marks had become customary in the current language or in the *bona fide* and established practices of the trade to designate the relevant goods and services in classes 20, 24, 28, 35 and 40. This must be based upon the perception of the average consumer of the goods and services in the UK. For this assessment, I adopt my findings at paragraph 29.

44. NB's pleaded case under this ground is as follows:¹⁰

"The trade mark has been used and is currently used by others than [LS] and [NB] to designate goods which are the subject of the Application, namely personalized gift products where an image of a person (human or other animal) is reproduced in miniature."

45. Firstly, I note that the above pleadings specifically mention *goods*, namely personalised gift products. As I noted that paragraph 33, some of LS' services are clearly not personalised gift products. Therefore, there is no logical basis for

¹⁰ Aside from using the terms "the Applicant"/"the Registrant", "the Opponent"/"the Applicant", and "the Application"/"the Registration" interchangeably, the pleadings are identical in NB's Form TM7s and Form TM26(I).

concluding that LS' marks had become customary in the current language or in the *bona fide* and established practices of the trade to designate those services.

46. As for the remaining goods and services, I have already found that I do not consider that the average consumer would perceive LS' marks as descriptive of personalised gift products. To my mind, there is also insufficient evidence to establish that the term 'MINI ME' had, at the relevant dates, become customary in the current language or established practices in the trade of any of the goods or relevant services. I have already outlined that some of the articles appear to refer to the term 'MINI ME' in a trade mark sense, whilst some others employ the term in a journalistic context. None shows the term being used in trade to designate goods or services. The printouts from undertakings using the term on their websites are from January 2023. Therefore, they do not assist NB in establishing how the term was used at the relevant dates.

47. As a consequence, NB's claims under s.3(1)(d) are dismissed.

Section 5(4)(a)

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

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

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

(aa) [...]

(b) [...]

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

49. Subsection (4A) of s.5 states:

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

50. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

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

51. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action".

Relevant date

52. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the Registrar's assessment of the relevant date for the purposes of s.5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

53. The *prima facie* relevant dates are the filing dates of LS' registration and applications, i.e. 1 July 2021 and 13 September 2021, respectively. However, Lance Dentith says that the 'MINI ME' (a product consisting of a soft-filled toy with a customisable printed face) was officially brought to market by LS in November 2018. Moreover, NB's own case is that LS launched its 'MINI ME' products in November 2018.¹¹ From the evidence, the earliest public facing use of 'MINI ME' by LS appears to have been a post on the Facebook page of British Made Gifts ("BMG"), dated 9 November 2018, entitled "NEW PRODUCT ALERT – MINI ME DOLLS".¹² Consequently, I must assess what the position would have been at 9 November 2018 before considering whether the position would have been any different at the *prima facie* relevant dates.

¹¹ See the witness statement of Charlie Rodman, §25.

¹² Exhibit LD4; Lance Dentith says that LS operates the website www.britishmade.gifts.com and I infer from this that it also operates the Facebook page.

Goodwill

54. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

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

55. Charlie Rodman says that NB was incorporated on 21 January 2013, him having traded as a sole trader under the name ‘Doodletogs’ from around March 2011. The company was originally named Doodletogs Limited before changing its name to NB on 9 November 2018. When the Doodletogs website was launched in 2011, Charlie Rodman says that it offered novelty ‘MINI ME’ t-shirts and vests. Printouts from the website, obtained via the Wayback Machine, have been provided.¹³ Those which are dated are from 3 November 2012, 2 January 2013, 3 July 2014 and 25 June 2014. Links to a t-shirt/vest design called “Mini Me’s On Holiday”/“Mini Me” are visible. An example is shown below. Charlie Rodman says that these items referenced a character called Mini Me from the Austin Powers film franchise. A sales fulfilment confirmation dated 19 May 2016 relating to six of these t-shirts has been provided.¹⁴



¹³ Exhibit CR3

¹⁴ Exhibit CR3

56. Although I note the printouts and the sales fulfilment document, this use refers to a fictional character. The words are used to inform prospective customers about what imagery they should expect to find emblazoned across the front of that particular t-shirt/vest, as opposed to the other novelty t-shirts/vests offered, i.e. it refers to and consists of the design of the t-shirt/vest. Consumers are extremely unlikely to interpret this decorative use as an indication of trade origin.¹⁵ Such use cannot found a claim for passing off; it does not assist NB.

57. Charlie Rodman says that from this initial “novelty use” of ‘MINI ME’, other products were developed over time. He provides a printout of the supersocks.co.uk website, obtained via Wayback Machine and dated 11 November 2019.¹⁶ This shows Christmas-themed socks featuring repeated patterns of individuals’ faces, as shown below. Sales fulfilment confirmations have been evidenced, which show the sale of five pairs of the socks on 25 November 2017 to a customer in the UK and two pairs on 9 December 2017.¹⁷ Christopher Rodman has also provided data which shows sales of the socks between 1 November 2017 to 31 December 2017,¹⁸ which amounted to £1,756.61.



58. However, the sales fulfilment confirmations do not use the ‘MINI ME’ sign; the products are labelled as “Elf Me” and “Santa Me” socks. The same is true of the sales data provided by Christopher Rodman. The image above does use the words, though

¹⁵ See, by analogy, the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Wild Child Trade Mark* [1998] RPC 455.

¹⁶ Exhibit CR4

¹⁷ Exhibit CR4

¹⁸ Exhibit CJR18

as part of a longer sentence. I am not convinced that use of 'MINI ME' in this context is distinctive of NB. In addition, it is not clear whether the image appeared on the website at that time; it is labelled as "carousel slider (as archived)" but what this means has not been explained. In any event, the printout of the website is from November 2019, i.e. after the earliest public facing use of 'MINI ME' by LS.

59. According to Charlie Rodman, other 'MINI ME' products which sold well were personalised cushions and pillows; in some cases, these are said to have taken the form of dolls. Mock-up designs for 20 such products are in evidence.¹⁹ These are shown below. They were ordered by Fitfam Limited and required by 30 June 2017. Payments were made by this company on 22 March 2018 and 26 July 2018, for £4,138.00 and £6,455.39, respectively.²⁰



60. Whilst the words "mini me" appear in the above, this is a mock-up design. There is no indication of how the cushions/dolls were presented to potential customers prior to purchase. Moreover, Charlie Rodman does not confirm that the payments from Fitfam were for this exact order. He says they were "related" payments. It seems unlikely that these sums, totalling around £10,500, represented payment for these goods.²¹

¹⁹ Exhibit CR5

²⁰ Exhibit CR5

²¹ This is because this sale of 20 cushions would account for around half of the total turnover for 2018 (which is discussed below), a year in which Charlie Rodman says NB had over 11,000 customers.

61. Charlie Rodman says that he secured a licence from Minimonos (an online game) to run its website for selling merchandise. A mock-up for the website, used for his licencing pitch, has been provided.²² “MINI ME’S” can be seen in the navigation bar along with other products such as t-shirts and hoodies. The “MINI ME’S” are said to have been cushions incorporating the design of characters from the game. An example is provided below. There is no evidence of what the website looked like whilst it was in operation.



62. Even if the operational website was identical to the mock-up, sales through this channel to customers in the UK were extremely small. A royalty report addressed to DoodleTogs Limited, for 1 January 2013 to 31 March 2013, is in evidence.²³ This shows that Doodletogs achieved royalties of £8.90 from the sale of six of these products to customers in the UK with gross invoice prices amounting to £112.46. Charlie Rodman says that the store did not last long and sales of the “MINI ME’S” amounted to £2,000. The royalty report shows that Doodletogs received 8% of the sales value for these products. From this, a reasonable inference would be that the total royalties received during the lifespan of the store were £160. However, Charlie Rodman does not say that the total sales only included those to the UK; this seems unlikely, given that the only report provided also includes sales to USA, Australia and New Zealand.

63. In June 2018, Charlie Rodman set up a dedicated website for ‘MINI ME’ personalised dolls: snugzy.com. A printout from this website, obtained via the Wayback Machine, has been provided.²⁴ Underneath the ‘SNUGZY’ mark is the strapline “CREATE YOUR OWN MINI ME!”. These are shown to be personalised doll-

²² Exhibit CR6

²³ Exhibit CR6

²⁴ Exhibit CR7

shaped cushions featuring individuals' faces. However, this printout is from 11 November 2019. Another website was launched for these products: minime.co.uk. However, the printouts provided are undated and Charlie Rodman says that the website was launched in 2022.²⁵ Evidence of both websites is, therefore, from after the earliest public facing use of 'MINI ME' by LS.

64. The following turnover figures for sales of what Charlie Rodman describes as 'MINI ME' products to UK customers have been provided:

Year	Turnover (£)	Customers	Goods sold
2012	1,200	600	T-shirts
2013	5,000	2,000	Cushions, t-shirts
2014	4,000	2,500	Cushions, t-shirts
2015	7,000	4,000	Cushions, t-shirts
2016	10,000	5,000	Cushions, t-shirts
2017	15,000	4,000	Cushions, t-shirts, dolls, socks
2018	22,500	11,250	Cushions, t-shirts, dolls, socks
Total	64,700	29,350	

65. These figures are supported by sales data from Christopher Rodman,²⁶ to the extent that they show the sale of socks for £1,756.61 in 2017 (via the Super Socks website) and £11,947.17 for socks and underwear in 2018 (via the Snugzy website). However, this use of the words 'MINI ME' does not appear to have been made for the purposes of distinguishing the goods of NB from those of other undertakings. Even accepting that this use of 'MINI ME' was for those purposes, and whilst the turnover figures not being broken down by particular product is not fatal to NB's case,²⁷ the

²⁵ Exhibit CR8

²⁶ Exhibit CJR18

²⁷ In *Mercis B. V. v Bunnyjuice, Inc.*, BL O/0064/24, Dr Brian Whitehead, sitting as the Appointed Person, said that it is not appropriate to break the business down at the same level of granularity under passing off law as is done for assessing proof of use, reputation or enhanced distinctive character. This is because goodwill attaches to the business, rather than to isolated goods or services.

turnover figures are very small, amounting to around £65,000 (at best) over a seven-year period.

66. Charlie Rodman also gives the following internet traffic information:

Year	Website visits
2012	22,900
2013	77,572
2014	73,164
2015	41,996
2016	97,462
2017	386,894
2018	990,594
Total	1,690,582

67. He says that around 90% of these were from UK internet users. This would amount to around 1.5million. This number could include repeat visits, so does not necessarily show the number of unique visitors. In any event, Charlie Rodman does not say which website(s) these relate to, so I infer that they represent all visits to the multiple websites he mentions in his statement. Not all of them have been shown to feature 'MINI ME' products. Therefore, it is not possible to ascertain what proportion of these internet users would have encountered the 'MINI ME' sign. I note that Christopher Rodman provides data which shows that the Snugzy website had 1,497 visits in 2018 (98% of which he says was for the UK site).²⁸

68. Charlie Rodman says that NB has deployed a range of online marketing tools, including website optimisation, product sampling, giveaways, product placement, social media campaigns and pay-per-click campaigns, as well as advertising on social media. The amounts NB is said to have spent on promoting 'MINI ME' goods in the UK are as follows:

²⁸ Exhibit CJR14

Year	Marketing spend (£)
2014	500
2015	2,000
2016	10,000
2017	18,800
2018	69,400
Total	100,700

69. What has not been provided is any supporting documentary evidence of any marketing or promotional activities being conducted before the first public facing use by LS. For example, there is no evidence of any product giveaways or pay-per-click campaigns. Without this evidence, it is difficult to determine how significant the promotional effort was prior to November 2018. The amount spent is small and, in isolation, is not indicative of a large or concerted effort to promote the 'MINI ME' sign.

70. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence

must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

71. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

72. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark* [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not

acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

73. Moreover, in *Smart Planet Technologies, Inc. v Rajinda Sharma*, BL O/304/20, Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, *Reckitt & Colman Product v Borden* [1990] RPC 341, *HL and Erven Warnink B.V. v J. Townend & Sons (Hull) Ltd* [1980] RPC 31. After reviewing these authorities, Mr Mitcheson concluded that:

“[...] a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

74. No information about the size of the relevant market has been provided, and there is no evidence before me to that effect. It is my impression that the UK market for novelty gifts is likely to be substantial. I accept that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small.²⁹ However, the turnover figures provided do not, to my mind, indicate that NB has accrued significant or substantial goodwill through its use of the ‘MINI ME’ sign. This is particularly the case, given that at least some of the use was not for the purposes of distinguishing NB’s goods from those of other undertakings. Moreover, the sign relied upon is relatively low in distinctiveness. As noted above, the combination of the words ‘MINI ME’ is defined as meaning “a person who resembles a smaller or younger version of another person”. In the context of personalised novelty items (which may feature an image of an individual on the product to create a miniature version of them), I reiterate that the words are allusive of the kind of goods offered under the sign. Bearing this in mind, as well as the aforementioned deficiencies in NB’s evidence, I

²⁹ See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

am unable to find, on the balance of probabilities, that NB had a more than trivial level of goodwill at the earlier relevant date. As NB could not have sustained a passing off claim at the earliest public facing use by LS, there can be no passing off at the *prima facie* relevant date.

Conclusion

75. NB's claims under s.5(4)(a) are dismissed.

Section 3(6)

76. Section 3(6) of the Act states as follows:

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

77. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, 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 the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54].”

78. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed?

(c) Was it established that the contested application was filed in pursuit of that objective?

79. It is necessary to ascertain what the applicant knew at the relevant date.³⁰ In these proceedings, there are two: 1 July 2021 and 13 September 2021. Evidence about subsequent events may be relevant if it casts light backwards on the position at the relevant date.³¹

80. In answering the first two *Alexander Trade Mark* questions, I note that NB's pleaded case under this ground is that LS has known about NB's use of 'MINI ME' since 2020. It alleges that LS applied to register its marks in bad faith so as to misappropriate the right to use the marks and prevent NB (and others) from using it, even though their use predates that of LS by several years. In concrete terms, I take this to be a claim that, having become aware of NB's activities, LS applied for its marks as a blocking strategy. If it is proven that LS applied for its marks solely to block others' use of the same or similar marks, this would be an objective for which they could not properly be filed.³²

81. In considering the third *Alexander Trade Mark* question, I note that evidence in support of NB's bad faith claims comes from Christopher Rodman. He says that LS' representatives stated in correspondence that LS had been keeping NB's online business activity under regular observation, in particular, the Snugzy website selling 'MINI ME' dolls. On this basis, Christopher Rodman states that LS knew that 'MINI ME' was a mark in use by NB prior to applying for its marks, and that, in seeking to monopolise the mark in this way, LS was acting in bad faith. He also points to LS' assertion that NB was infringing its mark on the basis of a stylised form of 'MINI ME'. Christopher Rodman adds that further evidence of LS' bad faith is that, within its marketing materials, it claims that its dolls are the original 'MINI ME', which it knows to be unfounded.

³⁰ *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)

³¹ *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

³² See, for example, *Copernicus-Trademarks v EUIPO (LUCO)*, Case T-82/14, in which the GC found that the filing of EU trade marks for the purposes of blocking applications by third parties, and without an intention to use the mark, was an act of bad faith.

82. In support of the above narrative, Christopher Rodman relies upon correspondence between the parties' representatives and copies of LS' marketing materials.³³ The bundle of correspondence contains the letter from LS' representatives, dated 18 February 2022, referenced in NB's pleadings. Whilst I have read this letter (as well as the other correspondence), I do not consider it supports the contention made by Christopher Rodman. Firstly, LS admitted in its counterstatement that it had become aware of NB's use in November 2019. However, the letter does not say or suggest that LS had been keeping NB's activities under regular observation for any sinister motive. The letter is from after LS had applied for its marks and achieved registration of one. It is also from before these proceedings commenced. The trade mark system works on a first to file basis. It is typical for an entity that has applied for (and registered) a trade mark, being aware of use of an identical or similar sign by another entity, to inform that entity of its intention to protect its intellectual property rights. To my mind, the letter does not establish what LS' intentions were at the time of making its applications. The sending of this letter does not, in and of itself, strike me as indicative of any sinister motive on the part of LS in previously making its applications.

83. In any event, the mere fact that a trade mark applicant knew that another party used the trade mark in the UK is not sufficient to establish bad faith.³⁴ That applicant may have reasonably believed that it was entitled to apply to register the mark.³⁵ I have already outlined that LS' first public facing use of 'MINI ME' was on 9 November 2018. Lance Dentith's evidence shows that the first sale of LS' 'MINI ME' dolls was on 20 November 2018, with further sales following in November and December that year.³⁶ Even if LS was aware of NB's activities in November 2019, the evidence shows that LS had used 'MINI ME' before that was the case. LS making applications for marks it had used before becoming aware of a competitor does not strike me as indicative of a departure from accepted standards of ethical behaviour or honest commercial and business practices. Rather, it appears to be an entirely legitimate objective, particularly

³³ Exhibits CR12 and CJR5

³⁴ *Lindt, Koton*, paragraph 55

³⁵ *Hotel Cipriani*

³⁶ Exhibits LD5 and LD6

where, as in the present case, there is a distinct lack of evidence to establish that LS applied for the marks simply to block NB's or third parties' commercial activities.

84. The marketing materials consist of two printouts, one from the BMG website and the other from what appears to be a store on Amazon UK. Both contain LS' registration/second application, albeit with the words stacked vertically. Both printouts contain a claim that they are the original 'MINI ME'. I do not consider this establishes that there was any sinister motive in LS applying for its marks. NB may not agree with such a marketing claim being made by LS, but that is not relevant to the question of what LS' intentions were at the time it made its trade mark applications. The printouts are also undated, so are unhelpful in establishing LS' motive at the relevant dates.

85. As per the case law cited above, an allegation of bad faith is a serious allegation which must be distinctly proved. Moreover, it is for the party alleging bad faith to prove it. The initial evidential burden falls upon NB; only when a rebuttable presumption of lack of good faith is established does the burden shift to LS to rebut the allegation. Taking all of the above into account, I am not satisfied that it has been established that LS' marks were filed in pursuit of the alleged objective. NB has failed to raise a *prima facie* case of bad faith and, therefore, its claims under this ground are dismissed.

LS' OPPOSITION

86. As all of LS' marks have survived NB's oppositions and application for invalidity, LS' marks qualify as earlier trade marks in accordance with s.6 of the Act and may be relied upon for the purposes of LS' opposition. As they had not completed their registration processes five years or more before the filing date of NB's application, they are not subject to the use provisions.

87. The relevant parts of s.5 of the Act read as follows:

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

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

[...]

(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.”

[...]

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

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

(aa) [...]

(b) [...]

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

(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.”

88. In addition, s.5A of the Act states:

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

Section 5(1)

Identity of the marks

89. In order for a claim under s.5(1) of the Act to succeed, the competing marks are required to be identical. The question of when a mark may be considered identical to another was addressed in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, where the Court of Justice of the European Union (“CJEU”) held that:

“54. [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

90. LS’ first application and NB’s application both consist of the words ‘MINI ME’ with no other elements. The marks are clearly identical.

Identity of goods and services

91. The goods and services to be compared can be found in the annex to this decision.

92. *Cushions and soft furnishings [cushions]* in class 20 of NB’s application are clearly identical to *cushions and soft furnishings* in class 20 of LS’ first application.

93. *Teddy bears* appears in class 28 of NB’s application and that of LS’ first application. These goods are plainly identical.

94. In addition to situations where goods or services are literally identical, the law requires that goods or services be considered identical where one party's description of its goods or services encompasses the specific goods or services covered by the other party's description (and vice versa).³⁷

95. *Dolls* in class 28 of NB's application encompasses all kinds of dolls, including *dolls printed with customer supplied photographic images* and *soft fabric dolls with printed cushion faces* in class 28 of LS' first application. These goods are to be regarded as identical.

96. *Toys* in class 28 of NB's application also incorporates all kinds of toys, such as *customised [...] toys with faces made of images from supplied digital photo images* in class 28 of LS' first application. These goods are also identical. It is my view that the same reasoning applies to *playthings* in class 28 of NB's application, since it is another name for a toy.³⁸

97. *Retail [...] services relating to dolls, teddy bears, toys, playthings, cushions [...]* in class 35 of NB's application is identical to *retail services relating to dolls being gifts and cushions being gifts* and *online retail services relating to teddy bear type articles being gifts* in class 35 of LS' first application. This is because they either describe the same services or fall within the scope of one another.³⁹ The same rationale is applied to *[...] wholesale services relating to dolls, teddy bears, toys, playthings, cushions [...]* in class 35 of NB's application and *wholesale services relating to dolls, cushions and teddy bear type toys being gifts and cushions being gifts* in class 35 of LS' first application.⁴⁰ These services are also identical.

98. I have considered the other goods and services in NB's application and record here, for the avoidance of doubt, that I do not consider them to be identical to the goods and services of LS' first application. In short, this is because they do not

³⁷ *Gérard Meric v OHIM*, Case T-133/05

³⁸ <https://dictionary.cambridge.org/dictionary/english/plaything>

³⁹ For example, *retail services relating to dolls* falls within the ambit of *retail [...] services relating to toys*, a doll being a kind of toy.

⁴⁰ For example, *[...] wholesale services relating to toys* includes *wholesale services relating to dolls*.

describe the same goods and services, and neither can they reasonably be said to encompass one another.

Conclusion

99. As a result of my findings above, LS' claim under s.5(1) of the Act succeeds in relation to the following goods and services:

Class 20: Cushions; soft furnishings [cushions].

Class 28: Teddy bears; dolls; toys; playthings.

Class 35: Retail and wholesale services relating to dolls, teddy bears, toys, playthings, cushions.

100. LS' claim under this ground fails in respect of the remaining goods and services of NB's application.

Section 5(2)(b)

101. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of goods and services

102. The goods and services to be compared are outlined in the annex to this decision. As LS' claim under s.5(1) of the Act has already succeeded in relation to some of NB's goods and services, I will focus my comparison on those which remain. LS' registration and second application are identical, and I note that the latter covers more goods and services than the former. Therefore, I will proceed on the basis of LS' second application as its reliance on its registration does not put it in a more favourable position.

103. At paragraph 94, I have outlined a key principle in determining whether goods/services are identical. That principle is, of course, equally applicable under this ground.

104. When assessing similarity between goods/services, all relevant factors relating to those goods/services should be taken into account. In *Canon*, Case C-39/97, the CJEU stated at paragraph 23 of its judgment that those factors include, *inter alia*, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary.

105. Furthermore, the relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity between goods/services also include an assessment as to their respective users and trade channels.

106. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that 'complementary' means that:

“[...] 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.”

107. 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/services is to assess whether the relevant public are liable to believe that responsibility for the goods/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.”

108. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46 to 57, the GC held that, although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

109. In *Tony Van Gulck v Wasabi Frog Ltd*, BL O/391/14, Mr Geoffrey Hobbs QC as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of

determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

110. However, on the basis of *Sanco SA v OHIM*, Case C-411/13P, and *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05, at paragraphs 30 to 35 of the judgment, upheld on appeal in *Waterford Wedgwood Plc v Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

(i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

(ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

(iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

(iv) The GC's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

Class 24

Soft furnishings

111. The above goods encompass all forms of soft furnishings, including *soft furnishing product items detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal, or the same featuring pets* in class 24 of LS' second application. These goods are identical.

Class 35

Retail and wholesale services relating to clothing, footwear, headgear, namely personalized items of clothing, footwear and headgear for adults

112. The nature and method of use of the above services overlap with those of *retail services relating to dolls being gifts and cushions being gifts* and *wholesale services relating to dolls, cushions and teddy bear type toys being gifts and cushions being gifts* in class 35 of LS' second application since they are all retail/wholesale services which would involve similar activities. It is my view that the respective services are also likely to reach the market through shared trade channels and may be offered by the same undertakings. For example, in my experience, it is not uncommon for a retailer of gift items such as cushions (which may or may not be personalised) to also offer retail services relating to personalised t-shirts through the same outlets. The respective services also share users. They are not complementary in the sense outlined in case law, and there is no real competition between them. Overall, I find that there is a medium degree of similarity between the respective services.

Retail and wholesale services relating to [...] cushion covers, pillows, pillow covers, throws, blankets, beanbags

113. The nature, intended purpose and method of use of the above services clearly differs from *cushions and soft furnishings* in class 20 and *soft furnishing product items detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal, or the same featuring pets* in class 24 of

LS' second application. However, the products referred to in NB's services can all be described as soft furnishings, which would be covered by LS' goods. In this connection, I consider LS' goods to be important to the operation of NB's retail and wholesale services and consumers are likely to believe that responsibility for the goods and services lies with the same undertaking. Moreover, the respective goods and services are available through the same channels of trade. For example, cushion covers and the retail of cushion covers are typically offered together by the same undertaking. Users of the respective goods and services will also overlap. In light of all this, I find that there is a medium degree of similarity between the respective goods and services.

Class 40

Custom manufacture of gift products featuring animal and human faces

114. Although I note that LS' second application has services in class 40, none appears to be a custom manufacturing, design or printing service.⁴¹ As s.60A of the Act stipulates, services are not to be regarded as similar to one another simply because they appear in the same class. However, s.60A also states that goods and services are not to be regarded as being dissimilar merely because they appear in different classes. In this regard, I note that *customised dolls and toys with faces made of images from supplied digital photo images* appears in class 28 of LS' second application. Whilst the nature, intended purpose and method of use of the respective goods and services clearly differ, it is my view that they are likely to reach the market through shared channels of trade and may be offered by the same undertakings. Moreover, the customised dolls and toys (which could reasonably be described as gift products) and NB's custom manufacturing services are important to one another in such a way that consumers may assume that responsibility for them lies with the same undertaking. As such, they are complementary. The goods and services also have overlapping users. Taking all of this into account, I find that there is a medium degree of similarity between them.

⁴¹ I note that LS' class 40 services comprise retail and sales services, which are proper to class 35. However, nothing in LS' opposition appears to turn on these services being incorrectly classified.

The average consumer and the nature of the purchasing process

115. As the case law above indicates, I must determine who the average consumer is for the parties' goods and services and the manner in which they are likely to select those goods and services. The average consumer has been described in these terms:⁴²

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The [...] relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

116. The goods and services at issue under this ground of opposition are available to the general public. However, wholesale services are more likely to be sought by other businesses. The cost of the goods and services may vary, though, overall, they are likely to be relatively inexpensive. They are also likely to be purchased relatively frequently, overall. The goods and services will not be merely casual purchases, with consumers having regard to factors such as style, quality, price and comparability with other items when selecting the goods and the range of goods on offer when selecting the services. Business users may also consider factors such as stock levels and speed of delivery when selecting wholesale services. Taking all of this into account, I find that the average consumer (members of the general public and business users) will demonstrate a medium level of attention during the purchasing process. The goods are typically purchased from retail establishments and their online equivalents, after a visual inspection of the goods or viewing information on websites. The services are likely to be selected following an inspection of the premises' frontage, or after viewing information on websites or in advertisements. Business users are likely to purchase

⁴² *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60

wholesale services after viewing information on websites, in business directories or brochures. In light of this, I find that the purchasing process is predominantly visual in nature. Nevertheless, I do not discount aural considerations entirely, since it is possible that the average consumer will receive word-of-mouth recommendations or wish to discuss the services with the provider.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

118. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as

invented words. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

119. LS' second application is figurative and comprises the words 'MINI ME!' in a slightly stylised, coloured font. The dot of the exclamation mark contains a smiley face design. The distinctiveness of the mark predominantly lies in the words 'MINI ME'. The exclamation mark and stylisation (including the smiley face, font and colours) also contribute to the distinctiveness of the mark. However, these elements are, ultimately, decorative. As such, they do not elevate the distinctiveness of the mark as a whole materially above that provided by the words. As previously outlined, the words 'MINI ME' will be understood as meaning a person who resembles a smaller or younger version of another person. In my view, this meaning alludes to goods which can be personalised or produced in such a way so as to resemble a miniature version of an individual, as well as retail and wholesale services concerned with the same. In light of this, I find that LS' second application possesses a relatively low level of inherent distinctive character.

120. LS has filed evidence and I must now determine whether it has demonstrated that its mark had an enhanced distinctive character at the relevant date of 18 March 2022.

121. Lance Dentith says that LS announced the launch of its 'Mini Me' customisable doll on social media, after it was safety tested on 31 August 2018.⁴³ The BMG Facebook page posted on 9 November 2018 stating "NEW PRODUCT ALERT – MINI ME DOLLS" and on 27 November 2018 stating "CREATE A MINIATURE CUDDLY ALTER-EGO [...] MINI ME".⁴⁴ The BMG Instagram page also posted a picture of various customisable dolls with the caption "Meet our MINI ME family" on 12 November 2018. The first sale of such a product was on 20 November 2018, with further sales in November and December of that year.⁴⁵ Lance Dentith says these

⁴³ A copy of the test report of that date is provided at Exhibit LD3.

⁴⁴ Exhibit LD4

⁴⁵ Exhibits LD5 and LD6

sales were to customers in the UK, in locations such as Bradford, Leicester, Nottingham and Newport. He also says that they were primarily made through the BMG website. Christopher Rodman criticised the evidence of sales for not showing the specific location of any of the customers. I agree.

122. According to Lance Dentith, a third party, Firebox.com, released LS' product in November 2018 under a drop-shipping agreement. Under such an arrangement, LS manufactured and dispatched the orders directly to Firebox's customers. An article dated 24 January 2019 states that these goods were already on the market at that time.⁴⁶ Although they were originally called 'Voo You' dolls, Lance Dentith says that Firebox rebranded these to the 'Mini Me' doll in August 2020 with LS' permission.

123. Lance Dentith says that in July 2019 LS entered a drop-shipping agreement with another third party, Bluecrate.com. A printout from its Facebook page has been provided.⁴⁷ This shows Bluecrate promoting the customisable dolls. Lance Dentith says their primary market is the USA. Since the relevant market for assessing enhanced distinctive character is the UK market, any sales in the US market do not assist LS. Simon Dentith's evidence, however, is that Bluecrate's sales of 'Mini Me' products were predominantly in the UK; sales information has been provided which shows UK sales by Bluecrate.⁴⁸

124. According to Lance Dentith, LS has a number of licence arrangement deals for 'Mini Me' products with Premier League football clubs. He says that they are offered to the clubs through the drop-shipping option, though LS is also permitted to make sales through the BMG website. A printout of the same, showing customisable 'Mini Me' dolls for sale in a range of club attire options, has been provided.⁴⁹ Whilst Lance Dentith's position on LS' licence arrangements was challenged by Christopher Rodman, and this challenge was responded to by Simon Dentith, the evidence provided by both witnesses consists of email correspondence, dated after these proceedings commenced, from third parties regarding authorisation for LS to use the

⁴⁶ Exhibit LD7

⁴⁷ Exhibit LD8

⁴⁸ Exhibit 3

⁴⁹ Exhibit LD17

clubs' branding on their products. This evidence is hearsay and I place no weight on it, not least because it is contradictory.

125. Lance Dentith provides the following turnover figures for sales of LS' 'Mini Me' prior to the relevant date:

Year	Turnover (£)	No. of customers
2018	4,654.67	194
2019	342,606.21	14,279
2020	1,032,585.58	43,042
2021	1,061,024.74	44,227
2022 ⁵⁰	596,673.74	24,826
Total	3,037,544.94	126,568

126. Simon Dentith confirms that a significant proportion of the 2018 sales were from the drop-shipping agreement with Firebox. As noted above, Firebox did not sell the products under the 'Mini Me' mark until August 2020. As these sales were under a different mark, they do not assist LS. Information provided by Simon Dentith shows that around £550 was accrued from sales via the BMG website that year.⁵¹ That same information shows that around £52,000 of the sales from 2019 were in the USA, and around £13,000 of the sales in the UK that year were by Firebox (under a different mark). These sales do not assist LS. I also note that more than £50,000 worth of sales from 2020 were to the US market. Around £66,000 was accrued by Firebox in the UK in 2020, and any before August of that year would not have been under the 'Mini Me' mark. In 2021 and 2022, respectively, over £20,000 and £1,000 worth of sales were to the US market. All this is to say that the evidence shows that LS' relevant turnover would have been less than the figures shown in the table above.

127. Lance Dentith says that LS' 'Mini Me' was nominated for a Gift of the Year award in 2022 and provides a printout from its website showing the goods in its novelty

⁵⁰ I bear in mind that the figure for 2022 reflects sales for the entire year but the relevant date falls in March of that year. This means that a proportion of sales was likely to have been after the relevant date.

⁵¹ Exhibit 3

section.⁵² Printouts for entries in the 2022 and 2024 competition, albeit after the relevant date, suggest that companies enter themselves,⁵³ but that does not detract from them being featured on the website. In my view, a bigger issue is that LS has not provided any information as to how widely the competition is known or promoted. I also note that some famous individuals, such as Rio Ferdinand and Katie Price, have purchased a ‘Mini Me’, though the printout from the BMG website is undated.⁵⁴

128. In terms of advertising spend, Lance Dentith provides the following figures:

Year	Expenditure (£)
2019	1,960.32
2020	89,696.56
2021	172,596.58
2022 ⁵⁵	41,672.49
Total	305,925.95

129. Lance Dentith provides a screenshot from Trustpilot, which shows that BMG has 4.8 stars overall from 3,996 reviews.⁵⁶ However, the printout is undated and there is no indication as to the proportion of the reviews which concerned products sold under the ‘Mini Me’ mark. Simon Dentith says that the Trustpilot page was created in December 2019. Evidence provided by Christopher Rodman shows that several ‘Mini Me’ reviews were made by UK-based purchasers in 2020.⁵⁷

130. I note that information relating to LS’ website visits has been provided.⁵⁸ This appears to show that it had around 23,000 “online store sessions” in 2019, around 600,000 in 2020 and over 1million in 2021. For each month before the relevant date in 2022,⁵⁹ the website appears to have had around 100,000. It is not clear what

⁵² Exhibit LD14

⁵³ Exhibit CJR15

⁵⁴ Exhibit LD15

⁵⁵ Again, I bear in mind that the figure for 2022 reflects expenditure for the entire year but the relevant date falls in March of that year. This means that a proportion of this expenditure is likely to relate to activities after the relevant date.

⁵⁶ Exhibit LD16

⁵⁷ Exhibit CJR9

⁵⁸ Exhibit LD18

⁵⁹ January, February and March

proportion of these sessions were from internet users based in the UK and, as Christopher Rodman says, the figures likely relate to all BMG sessions (rather than ones relevant to only 'Mini Me' products).

131. There is no evidence going to the size of the relevant market and LS has not provided any information as to the share of that market held by the goods and services offered under its mark. The evidence establishes that 'Mini Me' branded goods were sold to UK customers prior to the relevant date through various outlets including LS' website and third parties such as Firebox. Some of the sales must have lead to reviews being posted on Trustpilot. Turnover figures have been provided, amounting to around £3million between 2018 and 2022. However, LS' relevant turnover would have actually been smaller, given that Firebox' sales prior to August 2020, any sales to customers in the USA, and any sales after 18 March 2022 cannot be taken into account. In this connection, I consider the turnover accrued by LS to be modest. Moreover, the evidence suggests that around £300,000 was spent by LS on advertising prior to the relevant date, but no evidence of any actual advertising activities has been provided. The figure, in and of itself, is not indicative of an intensive advertising effort. LS' website had over 1million online store sessions, though I cannot ascertain how many of them were by UK-based customers or whether they solely related to 'Mini Me' products. LS' goods also appeared in the nominees for Gift of the Year in 2022. Nevertheless, I am unable to determine how widely known or promoted those awards were at the relevant date. In light of all this, I am not satisfied that evidence demonstrates that the inherent distinctiveness of LS' second application had been enhanced through use at the relevant date.


Comparison of trade marks

132. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo* that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

133. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

134. The marks to be compared are as follows:

LS' second application	NB's application
	MINI ME

135. LS' second application is figurative and comprises the words 'MINI ME', presented in a coloured font. The words are followed by an exclamation mark, the dot of which contains a smiley face design. The overall impression of the mark is dominated by the words 'MINI ME'. The exclamation mark and stylisation play a much lesser role. This is because they will be perceived as decorative embellishments of the words.

136. NB's application is in word-only format and consists of the words 'MINI ME' with no other elements. The overall impression of the mark lies in the combination of the words.

137. Visually, the competing marks coincide in their shared use of the identical words 'MINI ME'. They differ insofar as LS' second application contains additional matter,

namely the exclamation mark and stylisation. Bearing in mind my assessment of the overall impressions, I find that there is a high degree of visual similarity between the competing marks.

138. The exclamation mark and stylisation will have no material impact on how the words 'MINI ME' are articulated in LS' second application. Therefore, the competing marks are aurally identical, both comprising the same three syllables, i.e. "MI-NI-ME".

139. To my mind, the exclamation mark and smiley face design in LS' second application convey no real concept, over and above their existence as a punctuation mark and a facial expression, respectively. The message of both marks is a person who resembles a smaller or younger version of another person. As such, I find that the competing marks are conceptually identical. If the exclamation mark and smiley face design do impact the message conveyed by LS' second application, the marks remain conceptually similar to a high degree, given they coincide in identical dominant elements.

Likelihood of confusion

140. 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. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of LS' earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful 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.

141. 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 down to the responsible undertakings being

the same or related. As Mr Iain Purvis QC, sitting as the Appointed Person, explained in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

“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).”

142. These three categories of indirect confusion are not exhaustive. Rather, they were intended to be illustrative of the general approach.⁶⁰ I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.⁶¹ It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.⁶²

143. Lance Dentith says that a number of customers have been deceived into thinking that NB's products derive from or are affiliated with LS. I acknowledge that instances of actual confusion may be powerful evidence that there exists a likelihood of confusion.⁶³ However, the only evidence provided by Lance Dentith in support of his contention consists of one undated printout from Facebook showing a user asking BMG, by way of a tagged comment, if a 'Snugzy' personalised doll is one which they have produced.⁶⁴ This is simply not sufficient for the purposes of establishing actual consumer confusion prior to the relevant date and I place no weight on it in the global assessment which follows.

144. Earlier in this decision, I concluded that:

- The parties' goods and services either identical or similar to a medium degree;
- The average consumer may be a member of the general public or a business user, both demonstrating a medium level of attention during the purchasing process;
- The purchasing process is predominantly visual in nature, though aural considerations have not been excluded;

⁶⁰ As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

⁶¹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

⁶² See the Court of Appeal's comments in *Liverpool Gin Distillery*, paragraph 13.

⁶³ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220

⁶⁴ Exhibit LD24

- LS' mark possesses a relatively low level of inherent distinctive character, which has not been enhanced through use;
- The overall impression of LS' mark is dominated by the words 'MINI ME', whereas the exclamation mark and stylisation play a much lesser role;
- The overall impression of NB's application is dominated by the words 'MINI ME';
- The competing marks are visually similar to a high degree, aurally identical, and conceptually similar to a high degree if not identical.

145. I acknowledge that there are differences between the competing marks, namely the exclamation mark and the stylisation in LS' second application having no counterparts in NB's application. Moreover, I accept that LS' second application is relatively low in distinctive character. However, that does not preclude a finding of a likelihood of confusion.⁶⁵ The marks are highly similar overall, being visually similar to a high degree, aurally identical and conceptually similar to at least a high degree. They coincide in the word element 'MINI ME', which constitutes the entirety of NB's application and is the dominant element of LS' second application. The exclamation mark and the stylisation in LS' second application play a much lesser role in the overall impression. In my view, it is likely that the average consumer may misremember the particular presentation of the mark; the average consumer is more likely to retain and recall the words 'MINI ME'. Taking into account the principle of imperfect recollection, it is considered that the differences between the marks are likely to be insufficient for the average consumer to distinguish the parties' respective goods and services. The average consumer, paying a medium level of attention, may not recall the competing marks with sufficient accuracy to differentiate between them. Consequently, I find that there is a likelihood of direct confusion.

146. In the event that the average consumer immediately notices and recalls the differences between the competing marks, they will also identify the shared words 'MINI ME'. Although this common element is relatively low in distinctive character, it is

⁶⁵ *L'Oréal SA v OHIM*, Case C-235/05 P

the only element of NB's application and dominates the overall impression of LS' second application. Whether consciously or unconsciously, this will lead the average consumer through the mental process described in *L.A Sugar*. It is my view that the addition or removal of the stylisation and the exclamation mark to or from an identical word element readily lends itself to the use of a variant 'MINI ME' marks with and without decorative elements, with the plain word mark being used in documents such as invoices or directories and the stylised, perhaps more eye-catching version being used in marketing materials. Taking all of the above into account, as well as the case law principles set out above, I am satisfied that the average consumer, paying a medium level of attention, would assume a commercial association between the parties, or sponsorship on the part of LS, due to the presence of the identical words 'MINI ME'. Accordingly, I find that there is a likelihood of indirect confusion.

147. Although it was not specifically pleaded, Charlie Rodman says in his witness statement that there has been co-existence between the parties in using 'MINI ME' on their respective products. In *Victoria Plumb Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch), Carr J considered the CJEU's judgment in *Budějovický Budvar NP v Anheuser-Busch Inc. (BUDWEISER)*, Case C-482/09, and the Court of Appeal's judgments in that case and in *IPC Media Ltd v Media 10 Ltd* [2014] EWCA Civ 1403, and stated that a defence of honest concurrence use could, in principle, defeat an otherwise justified claim of trade mark infringement where the two parties had been using the same or closely similar names honestly for a long time and the guarantee of origin of the claimant's trade mark was not impaired by the defendant's use.

148. The *BUDWEISER* case demonstrated that honest concurrent use may be relevant in cancellation proceedings, and I can see no reason why it would not be relevant in opposition proceedings. Nevertheless, the CJEU noted that the circumstances of that case were exceptional. The Court's answer to the third question put to it was as follows:

"In the light of the foregoing, the answer to the third question is that Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of an earlier trade mark cannot obtain the cancellation of an identical later trade mark designating identical goods where there has been a long period of honest

concurrent use of those two trade marks where, in circumstances such as those in the main proceedings, that use neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services.”

149. Whether the exceptional circumstances referred to by the CJEU in *BUDWEISER* apply in a particular case is, ultimately, a question of fact. The evidence adduced by the parties does not show that the businesses have coexisted for a long period. Charlie Rodman suggests that the co-existence was in effect from around March 2020 (when he says he became aware of LS) until February 2022. That is a period of roughly only two years. Even the full evidential picture shows, at best, only a few more years of commercial activity. In my view, the evidence falls a long way short of what would be required to mount a successful honest concurrent use defence.

Conclusion

150. LS’ claim under s.5(2)(b) is successful.

Section 5(4)(a)

151. The relevant statutory provisions and general case law principles for determining a claim under this ground have been outlined under NB’s oppositions/invalidation. They are, of course, equally applicable here.

Relevant date

152. The *prima facie* relevant date is the filing date of NB’s application, i.e. 18 March 2022. NB’s evidence suggests that its first public facing use of ‘MINI ME’ was on the Snugzy website on 11 November 2019.⁶⁶ However, LS’ evidence shows a Snugzy Facebook post containing the words from 5 November 2019.⁶⁷ Therefore, I must

⁶⁶ Although there is evidence of earlier ‘use’ by NB, the use in relation to Austin Powers’ inspired novelty t-shirts or Christmas-themed socks, for instance, is not the behaviour complained about. Moreover, there are other issues with the ‘use’, such as, for example, it being descriptive or internal use.

⁶⁷ Exhibit LD11

assess what the position would have been at 5 November 2019 before considering whether the position would have been any different at the *prima facie* relevant date.⁶⁸

Goodwill

153. I have already discussed LS' evidence above. I remind myself that 'MINI ME' products were launched on BMG's social media accounts in November 2018, with the first sale being achieved that same month. LS entered into agreements with third parties for the sale of 'MINI ME' products in the UK, though only one (Bluecrate) used the term 'MINI ME' before the first public facing use by NB. The sales figures provided show an extremely small amount of turnover in 2018 when excluding Firebox's sales under a different sign: £550. Sales significantly improved in 2019. When excluding Firebox's sales and sales in the USA, the turnover was around £270,000. However, even though LS and Bluecrate may have had a drop-shipping agreement, the printouts from the latter's Facebook page in 2019 make no reference to LS at all.⁶⁹ In fact, one commenter asked Bluecrate specifically whether *it* could manufacture a particular design of doll. I have substantial concerns about who would own any goodwill generated through Bluecrate's sales. No evidence of the drop-shipping agreement has been filed, and even though Lance and Simon Dentith say that Bluecrate used 'MINI ME' with LS' permission, that does not decisively prove that LS would own the goodwill. It is considered that the goods would likely have been purchased on the strength of Bluecrate's reputation, rather than that of LS, and the public would likely perceive Bluecrate as being responsible for the character or quality of the goods, even though LS may have been in fact. All this leads me to conclude that Bluecrate's sales in 2019 cannot be relied upon. This is particularly the case, given the lack of cogent evidence on the point. The evidence shows that Bluecrate's sales in 2019 amounted to around £225,000, leaving a much smaller figure. Moreover, LS only spent around £2,000 advertising 'MINI ME' goods in 2019 and some of this may have been in connection with activities after the first public facing use by NB. LS' website had around 23,000 online sessions in 2019, though I cannot say how many of them were by UK-based customers or whether they solely related to 'MINI ME' products. Given the

⁶⁸ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11

⁶⁹ Exhibit LD8

aforementioned issues with the evidence, the small turnover figures and the allusiveness of the words 'MINI ME' the evidence does not, on the balance of probabilities, establish that LS accrued significant or substantial goodwill by the earlier relevant date. As LS could not have sustained a passing off claim at the earliest public facing use by NB, there can be no passing off at the *prima facie* relevant date.

Conclusion

154. LS' claim under s.5(4)(a) is dismissed.

OVERALL OUTCOMES

155. NB's oppositions and invalidation under ss.5(4)(a), 3(1)(c), 3(1)(d) and 3(6) of the Act have failed. Subject to any appeal against this decision, LS' applications will proceed to registration and LS' registration will remain registered in the UK.

156. Although LS' opposition under s.5(4)(a) has failed, its opposition under ss.5(1) and 5(2)(b) of the Act have succeeded. Subject to any appeal against this decision, NB's application will be refused in relation to the goods and services in classes 20, 24, 28, 35 and 40. NB's application will proceed to registration in the UK in respect of the goods in class 25 which were not opposed.

COSTS

157. LS has been successful and is entitled to a contribution towards its costs, based upon the scale in published in Tribunal Practice Notice 2/2016.⁷⁰ In the circumstances, I award LS the sum of **£2,400** which is calculated as follows:

Considering NB's statements and preparing counterstatements ⁷¹	£900
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⁷⁰ The proceedings having commenced after 1 July 2016 but before 1 February 2023.

⁷¹ The figure for this activity accounts for considering NB's two Form TM7s and its Form TM26(I), as well as preparing three Form TM8s, in NB's oppositions and invalidation.

Preparing a statement and considering NB's counterstatement ⁷²	£300
Preparing evidence and considering NB's evidence	£700
Preparing written submissions in lieu of a hearing	£300
Official fees ⁷³	£200
Total	£2,400

158. I order Nerdy Banana Limited to pay L&S Prints Digital Limited the sum of **£2,400**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 11th day of October 2024

James Hopkins
For the Registrar

⁷² The figure for this activity accounts for LS' preparation of its Form TM7 and considering NB's Form TM8 in LS' opposition.

⁷³ Connected with the filing of Form TM7 in LS' opposition.

Annex

Goods and services of UK00003694000 (LS' first application)

Class 20: Cushions and soft furnishings; cushions and soft furnishings customised to feature human faces; cushions and soft furnishings and cushions featuring images of people and pets; cushions and soft furnishings detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal, or the same featuring pets.

Class 28: Teddy bears and similar soft toys; customised dolls produced as soft furnishing cushions; production of customised items as toys, teddy bears and soft fabric toy visual reproductions of humans and pets; dolls printed with customer supplied photographic images; soft fabric dolls with printed cushion faces; customised dolls and toys with faces made of images from supplied digital photo images, dolls detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal.

Class 35: Advertising and sale of gift items and customised gift items online; advertising and sale of customised soft toys and doll items online; supply chain management services; advertising services; advertising and advertisement services relating to soft toys and dolls through online methods via a website or the internet; banner advertising; radio advertising; online advertising and sales via social media channels; online and digital marketing advertisements; newspaper advertising; television advertising classified advertising; response advertising; outdoor advertising; publicity and advertising; trade show and event advertising; direct market advertising; advertising and marketing through the internet and social media channels; online advertising services via mobile electronic devices; direct mail advertising; mail-order advertising; providing business information via a website; providing information relating to soft toys, soft furnishings and customised printed soft-toy dolls via a website or online publication; sales administration; sales promotion; product sales information; sales promotion services; sales promotion for others; sales promotion services relating to soft toys, dolls and cushions; administration relating to sales methods; sales promotion for third parties; sales promotions at point of purchase or sale, for others;

provision of contract sales forces; publicity and sales promotion services; provision of commission sales staff; online advertisements; online digital marketing and advertising; online ordering services; online advertising services; website traffic optimisation; website traffic optimisation; providing marketing information via websites over the internet and social media channels. advertising; business management; business administration; office functions; retail services relating to dolls being gifts and cushions being gifts; online retail services relating to dolls being gifts, online retail services relating to teddy bear type articles being gifts and cushions being gifts; wholesale services relating to dolls, cushions and teddy bear type toys being gifts and cushions being gifts. the sale and supply of customised gift products such as cushions as gifts, featuring human and animal faces; customised gift items featuring images of people and pets, the sale of dolls and customised cushions through e-commerce and online sales, detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal.

Goods and services of UK00003694015 (LS' second application)

Class 20: Cushions and soft furnishings; cushions and soft furnishings customised to feature human faces; cushions and soft furnishings and cushions featuring images of people and pets; cushions detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal, or the same featuring pets.

Class 24: Soft furnishing product items detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal, or the same featuring pets.

Class 28: Teddy bears and similar soft toys; customised dolls produced as soft furnishing cushions; production of customised items as toys, teddy bears and soft fabric toy visual reproductions of humans and pets; dolls printed with customer supplied photographic images; soft fabric dolls with printed cushion faces; customised dolls and toys with faces made of images from supplied digital photo images, dolls detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal.

Class 35: Advertising and sale of gift items and customised gift items online; advertising and sale of customised soft toys and doll items online; supply chain management services; advertising services; advertising and advertisement services relating to soft toys and dolls through online methods via a website or the internet; banner advertising; radio advertising; online advertising via social media channels; online and digital marketing advertisements; newspaper advertising; television advertising classified advertising; response advertising; outdoor advertising; publicity and advertising; trade show and event advertising; direct market advertising; advertising and marketing through the internet and social media channels; online advertising services via mobile electronic devices; direct mail advertising; mail-order advertising; providing business information via a website; providing information relating to soft toys, soft furnishings and customised printed soft-toy dolls via a website or online publication; sales administration; sales promotion; product sales information; sales promotion services; sales promotion for others; sales promotion services relating to soft toys, dolls and cushions; administration relating to sales methods; sales promotion for third parties; sales promotions at point of purchase or sale, for others; provision of contract sales forces; publicity and sales promotion services; provision of commission sales staff; online advertisements; online digital marketing and advertising; online ordering services; online advertising services; website traffic optimisation; website traffic optimisation; providing marketing information via websites over the internet and social media channels; advertising; business management; business administration; office functions; retail services relating to dolls being gifts and cushions being gifts; online retail services relating to dolls being gifts, online retail services relating to teddy bear type articles being gifts and cushions being gifts; wholesale services relating to dolls, cushions and teddy bear type toys being gifts and cushions being gifts.

Class 40: Retail services connected with the sale of customised gift products such as cushions as gifts, featuring human and animal faces; customised gift items featuring images of people and pets, the sale of dolls and customised cushions through e-commerce and online sales, detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal.

Goods and services of UK00003767569 (NB's application)

Class 20: Cushions; soft furnishings [cushions].

Class 24: Soft furnishings.

Class 25: Clothing; footwear; headgear, namely personalized items of clothing, footwear and headgear for adults.

Class 28: Teddy bears; dolls; toys; playthings.

Class 35: Retail and wholesale services relating to clothing, footwear, headgear, namely personalized items of clothing, footwear and headgear for adults; retail and wholesale services relating to dolls, teddy bears, toys, playthings, cushions, cushion covers, pillows, pillow covers, throws, blankets, beanbags.

Class 40: Custom manufacture of gift products featuring animal and human faces.

Goods and services relied upon by LS under s.5(4)(a)

Cushions and soft furnishings; cushions and soft furnishings customised to feature human faces; cushions and soft furnishings and cushions featuring images of people and pets; cushions detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal, or the same featuring pets; soft furnishing product items detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal, or the same featuring pets; teddy bears and similar soft toys; customised dolls produced as soft furnishing cushions; production of customised items as toys, teddy bears and soft fabric toy visual reproductions of humans and pets; dolls printed with customer supplied photographic images; soft fabric dolls with printed cushion faces; customised dolls and toys with faces made of images from supplied digital photo images, dolls detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal; advertising and sale of gift items and customised gift items online; advertising and sale of customised soft toys

and doll items online; supply chain management services; advertising services; advertising and advertisement services relating to soft toys and dolls through online methods via a website or the internet; banner advertising; radio advertising; online advertising via social media channels; online and digital marketing advertisements; newspaper advertising; television advertising classified advertising; response advertising; outdoor advertising; publicity and advertising; trade show and event advertising; direct market advertising; advertising and marketing through the internet and social media channels; online advertising services via mobile electronic devices; direct mail advertising; mail-order advertising; providing business information via a website; providing information relating to soft toys, soft furnishings and customised printed soft-toy dolls via a website or online publication; sales administration; sales promotion; product sales information; sales promotion services; sales promotion for others; sales promotion services relating to soft toys, dolls and cushions; administration relating to sales methods; sales promotion for third parties; sales promotions at point of purchase or sale, for others; provision of contract sales forces; publicity and sales promotion services; provision of commission sales staff; online advertisements; online digital marketing and advertising; online ordering services; online advertising services; website traffic optimisation; website traffic optimisation; providing marketing information via websites over the internet and social media channels; advertising; business management; business administration; office functions; retail services relating to dolls being gifts and cushions being gifts; online retail services relating to dolls being gifts, online retail services relating to teddy bear type articles being gifts and cushions being gifts; wholesale services relating to dolls, cushions and teddy bear type toys being gifts and cushions being gifts; retail services connected with the sale of customised gift products such as cushions as gifts, featuring human and animal faces; customised gift items featuring images of people and pets, the sale of dolls and customised cushions through e-commerce and online sales, detailing various types of outfits and made to resemble mini versions of a person in a particular profession or character portrayal.