O/0980/26

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. UK00004113754 IN THE NAME OF POPAL TECHNOLOGY LIMITED FOR THE TRADE MARK:



IN CLASSES 21 & 28

AND

AN APPLICATION FOR INVALIDITY UNDER NO. 508699 BY INTELEX GROUP HOLDINGS (UK) LIMITED

BACKGROUND AND PLEADINGS

1. POPAL TECHNOLOGY LIMITED ("the proprietor") is the owner of the trade mark shown on the cover page of this decision ("the contested mark"). The contested mark was applied for on 18 October 2024 and was granted registration on 10 January 2025. It stands registered for the following goods:

Class 21: Towel racks; dish drying racks; wall-mounted drying racks for laundry; drying racks for laundry; laundry drying racks; spice racks; vegetable racks; clothes racks, for drying; toilet paper racks; towel rails; draining trays; fitted racks for wiping, drying, polishing and cleaning paper; drying racks for washing; drying racks for clothes; dispensers for paper towels; holders for toilet paper; toilet paper holders; paper towel dispensers; sponges for toilet use; paper hand towel dispensers; toilet tissue holders; paper cups; toilet brushes; brushes for cleaning; scrubbing brushes; cleaning cloth; brushes; soap racks; shampoo racks; racks for drying clothes; clothes drying racks.

Class 28: Toys balloons; toy blocks; toys; toy dolls; toy cars; jigsaw puzzles; toy imitation cosmetics; inflatable games for swimming pools; toy tents; smart toys; spinning fidget toys; sand toys; golf clubs; basketball baskets; balance beams; cards [games]; board games; musical toys; infant toys; water squirting toys.

2. On 3 April 2025, the contested mark was subject to an application for invalidity under section 47 of the Trade Marks Act 1994 ("the Act") brought by Intelex Group Holdings (UK) Limited ("the applicant"). The application is reliant upon sections 5(2)(b) and 5(4)(a) of the Act and is aimed only at those class 28 goods of the contested mark.

3. Under the section 5(2)(b) ground, the applicant relies on the following registrations:



(series of three)

UK registration no. 4060762

Filing date 6 June 2024; registration date 30 August 2024

Relying on all goods and services, being those set out in the Annex of this decision.

("the applicant's first registration"); and

WARMIES

UK registration no. 909038456[1]

Filing date 19 April 2010; registration date 28 September 2010

Relying on some goods, namely:

Class 28: Toys, playthings, soft and plush toys, dolls, teddy bears, all filled or impregnated with scented substances; toys, playthings, soft and plush toys, dolls, teddy bears, containing seed or grain which can be microwave heated; heatable toys, heatable playthings, heatable soft and plush toys, heatable dolls, heatable teddy bears, all being not for medical purposes; heatable toys, heatable playthings, heatable soft and plush toys, heatable dolls, heatable teddy bears, all containing seed or grain and/or essential oil and all being not for medical purposes.

("the applicant's second registration");

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



UK registration no. 916372393
Filing date 4 April 2017; registration date 11 August 2017
Relying on some goods, being those identical to that of the second registration.
("the applicant's third registration"); and

WARMIES
UK registration no. 4058001
Filing date 30 May 2024; registration date 30 August 2024
Relying on some services, namely:

Class 35: Retail and wholesale services relating to the retail of hot water bottles, heat pads for warming, seed or grain filled warmers which are microwave heated and are used for warming the body; retail and wholesale services relating to the retail of pillows and cushions, scented pillows and cushions, pillows and cushions containing seed or grain, scented pillows and cushions containing seed or grain, pillows and cushions containing seed or grain and essential oil, heatable pillows and cushions; retail and wholesale services relating to the retail of heatable footwear and slippers containing seed or grain which can be microwave heated, eye masks and sleep masks; retail and wholesale services relating to the retail of toys, playthings, soft and plush toys, dolls, teddy bears, all filled or impregnated with scented substances; retail and wholesale services relating to the retail of toys, playthings, soft and plush toys, dolls, teddy bears, containing seed or grain which can be microwave heated, heatable toys, heatable playthings, heatable soft and plush toys, heatable dolls, heatable teddy bears, heatable soft and plush toys, heatable dolls,

heatable teddy bears, all containing seed or grain and/or essential oil.

("the applicant's fourth registration").

4. Under the section 5(2)(b) ground, the applicant claims that the marks at issue are all similar and that the goods and services at issue are all similar. As such, it is claimed that there exists a likelihood of confusion between them.

5. Under the section 5(4)(a) ground, the applicant relies on the unregistered sign 'WARMIES' which it claims to have been using throughout the UK since 1995 in respect of the same class 28 goods relied upon under the second and third registrations above. As a result of this use, the applicant claims to enjoy the benefits of a protectable level of goodwill. As such, it is claimed that use of the contested mark would cause a misrepresentation amongst the relevant public and, subsequently, this would cause damage to the applicant's goodwill and business.

6. The proprietor filed a counterstatement wherein it denied the claims against it and requested that the applicant provide proof of use for its second and third registrations.

7. The applicant is represented by Adamson Jones and the proprietor is represented by Monyin Lin Chien. Only the applicant filed evidence in chief with the proprietor opting to file submissions. No hearing was requested and only the applicant filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying

assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

9. The applicant's evidence came in the form of the witness statement of David James Hamilton Tweedale dated 18 December 2025. Mr Tweedale is the director of the applicant, a position he has held since 27 August 2024. His statement is accompanied by 15 exhibits, being DJHT1 to DJHT15, and was adduced in order to demonstrate the applicant's use of the marks in its registrations.

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

DECISION

Section 47: legislation

11. Section 5(2)(b) and 5(4)(a) grounds have application in invalidation proceedings by virtue of section 47(2) of the Act, which states as follows:

> "47. –
>
> […]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(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.

[…]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or

(where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

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

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

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

[…]

(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."

Proof of use

12. As set out above, the proprietor requested that the applicant provide proof of use for the marks in its second and third registrations. While this is noted, I do not consider that a proof of use assessment is necessary. I say this because the marks in these registrations are identical or suitably similar to the applicant's other marks, being those that are not subject to the use provisions. Further, the class 28 goods for which those marks are protected are also included in the specification of the first registration. I will, therefore, proceed with the section 5(2)(b) ground in respect of the first and fourth registrations only.

13. In light of the above, I will, for ease of reference, alter the definitions used to refer to these registrations. Further, the only difference between the marks in the first registration is their use of colour which, in my view, is inconsequential. I can, therefore, simply refer to one of them throughout the course of this decision. Given that it is presented in black and white, I will proceed on the basis of the second mark in the first registration and will simply refer to it as 'the applicant's first mark'.

As for the fourth registration, this consists of one mark so I will refer to it simply as 'the applicant's second mark'.

14. Given their filing dates, the first and second marks qualify as earlier trade marks in accordance with the provisions of section 6(1)(a) of the Act (reproduced below). As neither mark completed their registration process more than five years prior to (1) the filing date of the contested mark and (2) the filing date of the application in issue, the use provisions set out in section 47(2B) of the Act do not apply. The consequence of this is that the applicant may rely on all of the goods and services identified in its invalidation application.

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

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

> "(2) A trade mark shall not be registered if because-
>
> (a) […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

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

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only."

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

"(6)(1) In this Act an "earlier trade mark" means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

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

[…]

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

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may

retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of goods and services

19. It is noted that the applicant's first mark's specification includes a broad range of goods and services across several classes (including class 35 services, being the same as the services under the applicant's second mark). While noted, it is my view that the applicant's class 28 goods in its first mark's specification represent its best case. Therefore, I will conduct my comparison in reliance upon those goods.

20. The parties' class 28 goods are as follows:

The applicant's goods and services	The proprietor's goods
Class 28 Toys, playthings, soft and plush toys, dolls, teddy bears, all filled or impregnated with scented substances; toys, playthings, soft and plush toys, dolls, teddy bears, containing seed or grain which can be microwave heated; heatable toys, heatable playthings, heatable soft and plush toys, heatable dolls, heatable teddy bears; heatable toys, heatable playthings, heatable soft and plush toys, heatable dolls, heatable teddy bears, all containing seed or grain and/or essential oil.	Class 28 Toys balloons; toy blocks; toys; toy dolls; toy cars; jigsaw puzzles; toy imitation cosmetics; inflatable games for swimming pools; toy tents; smart toys; spinning fidget toys; sand toys; golf clubs; basketball baskets; balance beams; cards [games]; board games; musical toys; infant toys; water squirting toys.

21. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

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

24. Before proceeding to consider the comparison of the class 28 goods at issue, I consider it necessary to discuss the scope of the applicant's goods. Despite being spread over a number of terms, the applicant's goods primarily cover soft toys akin to a teddy bear or any other form of plush toy that, regardless of what it is filled with, can be warmed up to act as an alternative to a hot water bottle. It is my view that the primary purpose of such goods would be to be cuddled in the same way a

plush toy would, but with the added benefit of this product warming up the user. I reach this finding because the heated nature of the goods means that they are unlikely to be any other form of a playable toy such as a toy car or a play set made of plastic. This is because to transfer the heat safely and without burning the user, the material used is likely to be soft.

25. In addition to the above, the specification includes a term that covers a toy filled with scented substances. Unlike the type of good discussed above, I do not consider that this product is limited in the same way that it will likely cover a soft toy. This is because scented substances may be inserted into a range of different types of toys to assist in recreating certain smells. For example, a kitchen playset with plastic foods may be created in a way so that the scent of the real-life food is recreated in the toy.

26. Bearing the above in mind, I will now proceed to compare the goods at issue.

Toys; toy dolls; infant toys.

27. The above terms are toys but are not limited in any way so are, therefore, broad enough to encompass the applicant's terms of "heatable soft and plush toys". These goods are, therefore, identical under the principle outlined in *Meric*.

Sand toys.

28. The above term is worded broadly. Therefore, while I consider that it sufficiently covers toys for playing in the sand such as a toy sand bucket and spade, for example, it may also cover a plush toy that is filled with sand which can, in turn, be heated up. I say this based on my understanding that sand is a material that can hold thermal energy and be heated safely to impart warmth on the user. Alternatively, the above term covers kinetic sand which, itself, can be used as a

toy and included in playsets where the sand can be scented.[2] As a result, I find that the term is capable of covering the same goods as the applicant's "heatable soft and plush toys" and "toys, playthings, […] all filled or impregnated with scented substances". In this context, I find that these goods are identical, be that self-evidently or under the principle outlined in *Meric* (regardless of which term technically encompasses which).

Toy imitation cosmetics.

29. I see no reason why the above term would not cover toy cosmetics that include scented elements to replicate the smell of real cosmetics. Further, in considering the applicant's term of "toys, playthings, […] all filled or impregnated with scented substances", I am of the view that it can cover toy cosmetics. In this context, I find that these goods are identical, be that self-evidently or under the principle outlined in *Meric* (regardless of which term technically encompasses which).

Toys balloons; toy blocks; toy cars; jigsaw puzzles; inflatable games for swimming pools; smart toys; spinning fidget toys; cards [games]; board games; musical toys; water squirting toys.

30. I do not consider that any of the above goods can reasonably be said to be toys that are commonly thought to be heatable or scented. That being said, taking the example of the applicant's scented goods discussed in the preceding comparison, I find that there is some degree of similarity with the applicant's term of "toys, playthings, […] all filled or impregnated with scented substances". This is because this term can cover ordinary playthings that just so happen to be scented.[3] Clearly these do not cover toy cars, blocks or puzzles for example, but they are goods that are played with (to entertain the user) meaning that despite a difference in nature

[2] On this point, I refer, for example, to something akin to a kitchen playset that includes 'ingredients' that are made of kinetic sand and scented to replicate the smell of various foodstuffs.
[3] I have given thought to a comparison with the applicant's heatable goods but, in my view, those goods will not readily be played with as they will, instead, act as alternatives to hot water bottles.

and method of use, they overlap in purpose. In addition, the goods will likely be produced by the same undertakings and sought from the same retailers, leading to an overlap in trade channels. Further, they overlap in user and may even share a competitive relationship on the basis that someone may choose to buy a musical toy over something like a scented playset in line with that discussed above, or vice versa. As a result, I find that these goods are similar to a medium degree.

Toy tents; golf clubs; basketball baskets; balance beams.

31. Firstly, while it uses the word 'toy', I do not consider that a toy tent is something that would necessarily be played with in the same way as the toy goods discussed in the preceding comparison. I say this because my understanding of toy tents is that they are simply tents made for children to play in (such as those used to create forts, for example), not with. Secondly, the remaining terms are not toys but are, instead, items of sports equipment. As a result, I do not consider that these goods share any overlap in nature, method of use or purpose with any of the applicant's goods. I accept that they may be available via the same retailers (such as supermarkets or large online retailers) but they are likely to be placed in different sections and not likely to be found in close proximity to one another. As for the user, I appreciate that the user bases for both parties' goods are very large so, inevitably, there will be some overlap. That being said, I do not consider that either of these overlaps are sufficient to lead to a finding that these goods share a material degree of similarity. They are, therefore, dissimilar.

32. In light of the above, I remind myself that where goods and services are dissimilar under section 5(2)(b) grounds, there can be no likelihood of confusion.[4] Therefore, the present ground fails against the following:

Class 28: Toy tents; golf clubs; basketball baskets; balance beams.

[4] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

33. Before proceeding, I consider it necessary to briefly touch upon the applicant's class 35 services in its second mark's specification. While there is a case for similarity between the retail services of the applicant and the goods of the proprietor,[5] this would clearly be at a much lower degree than the identity found above. As such, even though the applicant's second mark is a word only mark, I am of the view that the reliance upon identical goods and a figurative mark offers the applicant its best case. I say this because if there is confusion between the marks on identical goods then the outcome in respect of the second mark is irrelevant. Alternatively, if there is no confusion between them, then I see no basis where a word only mark on less similar goods and services would offer a different outcome.

The average consumer and the nature of the purchasing act

34. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

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

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

[5] On the basis that the retail services for which the mark is registered relate to the same goods on the basis of which I have carried out the goods comparison.

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

36. The goods at issue will be sought by members of the general public at large who will, for the most part, be selecting them on behalf of their children.[6] The goods will be available via a range of retailers, be that general retailers or toy stores. The goods may also be available online. In physical stores, the goods will be displayed on shelves where they will be self-selected by consumers after visually inspecting the product. A similar process will apply to goods selected online as they will be

[6] Though I appreciate that even some toy goods that are used as alternatives to hot water bottles will be selected by adults.

selected after the consumer views an image of them on a website. The goods will, therefore, be selected by primarily visual means, though I do not discount an aural component playing a role by way of word of mouth recommendations or advice from sales assistants.

37. For the most part, the goods at issue will be relatively inexpensive and purchased fairly frequently. Some terms, however, are broad enough to cover more expensive toys and will, therefore, be selected with a lesser degree of frequency. In terms of the level of attention paid, I find that this will be medium regardless of who the end user will be. I say this because the selection process will not be casual and will attract consideration of factors such as materials used, features, suitability (especially when it comes to age recommendations), safety, and, for the heatable goods, advertised longevity of the heated element.

Comparison of the marks

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

39. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the

light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

40. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

41. In light of the fact that the comparison above covered only goods from the applicant's first mark, the applicant's second mark is no longer at issue. As such, the present ground proceeds in respect of the applicant's first mark only, which for the remainder of this ground, I will refer to simply as 'the applicant's mark'.

42. The respective trade marks are shown below:

The applicant's mark	The contested mark
	

43. I have submissions from both parties in respect of the comparison of the marks at issue. While I do not intend to repeat those submissions here, I can confirm that I have taken them into account and, where necessary, will discuss them below.

Overall impression

The applicant's mark

44. The applicant's mark is a figurative mark that consists of the word 'warmies' in a standard black typeface. Below this are the much smaller words 'SNUGGABLE', 'HUGGABLE' and 'LOVEABLE', all separated by a small vertical line. Above the word 'warmies' is a device element which consists of the letter 'w' surrounded by a heart. Not only because of its size but because the 'w' will be understood as standing for 'warmies', I find that the device will play a lesser role in the overall impression of the mark. The dominant element will, therefore, be the word 'warmies', especially given its size and placement in the centre of the mark. As for the words at the bottom of the mark, these will play lesser roles not only due to their size but because they simply indicate that the goods sold under the mark are snuggable, huggable and loveable. These are positive attributes and, therefore, I find that these words carry a laudatory meaning.

The contested mark

45. The contested mark is a figurative mark that consists of white verbal elements on a black rectangular background which, itself, sits on a white background. There are three verbal elements, the first being a large character that sits at the beginning of the mark. This appears very similar to a letter 'H'. The remaining elements sit to the right of this letter and are the letters 'armie', which sit above the letters 'omy.'. Both are presented in a stylised white typeface.

46. In respect of the textual element, I note that the parties' submissions refer to it as saying 'Warmie Homy'. While this may very well have been the intention of the proprietor, I must consider the understanding of the average consumer. In short, I am not convinced that 'Warmie Homy' is the most obvious reading of the mark. Instead, I consider 'Harmie Homy' to be more likely given that the first letter

appears to simply be, on first glance, a large letter 'H' which then feeds into the following letters, creating 'Harmie' and 'Homy'. That being said, I do accept that there exists a significant proportion of consumers who will see the mark as 'Warmie Homy'.[7] I say this on the basis that those consumers, when viewing the first character, will notice the small break in the right vertical line, the partial break in the left vertical line and the upwards indented horizontal line, all of which point to a dissection of this character that results in its upper half also representing a 'W'.[8] Despite this, the larger 'H' will still be seen as the first letter of the second word, being 'Homy'. The overall impression of the mark is dominated by the elements that can be read, being 'Warmie Homy'. The unique nature of the first character in the mark is such that it also plays a role in the overall impression of the mark, albeit a slightly lesser one.

Visual comparison

47. Visually, the marks share the letters 'w-a-r-m-i-e'. They differ in all other aspects, including the way in which the letters are presented. I see no merit in discussing each point of visual difference save to say that they are numerous. Given that the shared letters make up six of the seven letter word that dominates the overall impression of the applicant's mark, I consider that it is a considerable point of similarity. That being said, the points of difference are, again, numerous and regardless of their roles in their respective marks, they clearly impact upon the visual comparison of the marks. Overall, I find that the marks are visually similar to between a low and medium degree.

Aural comparison

[7] It is this significant proportion of consumers that represent the applicant's best case. As such, it is these consumers that I will focus the remainder of the section 5(2)(b) ground on. I do so because, as per *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, if a likelihood of confusion exists for a significant proportion of consumers, then this is sufficient to warrant the intervention of this Tribunal.

[8] I also bear in mind that 'Harmie' is not a recognisable word and the consumer will try and read the mark in a way which makes sense to them. For the avoidance of doubt, I do not consider that this applies to 'Homy' as, for reasons that will become obvious below, this will be associated with a known word.

48. I do not consider that additional verbal elements in the applicant's mark will be pronounced. As a result, the applicant's mark will be pronounced as the two syllable word, 'warmies' (WORE-MEES), which will be pronounced in the ordinary way. I say this because (1) the consumer would not seek to articulate the 'w' in the device as it clearly will be understood as standing for 'warmies' and (2) the words at the bottom not only add significant length to the aural element of the mark but are purely laudatory in nature, thereby adding no trade mark significance.

49. On the basis of how I have proceeded with the contested mark above, its aural element is 'Warmie Homy'. This consists of four syllables that will be pronounced as 'WORE-MEE-HOE-MEE'. In comparing these marks, the first two syllables are close to identical with the only difference coming in the 'S' in the applicant's mark. On this point, I remind myself that beginnings of marks tend to have greater aural impacts than their ends.[9] The third and fourth syllables in the contested mark have no counterpart in the applicant's mark and, therefore, act as points of aural difference. Taking all of this into account, I am of the view that the marks at issue are aurally similar to a medium degree.

Conceptual comparison

50. In considering the applicant's mark, I find that the words 'snuggable', 'huggable' and 'loveable' will not contribute to the overall concept of the mark to any meaningful degree. This is on the basis that they will simply be viewed as having laudatory meanings in the context of the goods at issue and, therefore, they do not carry any trade mark significance. This means that the concept of the applicant's mark is dominated by the word 'warmies'. This will be viewed as a play on the word

[9] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

'warm' which, in the context of the applicant's goods, will be understood as something that *maintains or imparts heat*[10] to a moderately hot temperature.

51. The contested mark's concept derives from the words 'Warmie Homy'. The word 'Homy' will be understood in two ways, either as a misspelling of the word 'homie' or a play on the word 'home' (so as to rhyme with the word 'warmie'). The former meaning is that associated with the slang term for a friend whereas the latter will clearly be understood as the place where someone lives. The word 'Warmie' will be understood as a play on the word 'warm' and the meaning of this will be determined by the consumers' perception of the word 'Homy'. If perceived as a play on the word 'home', 'warmie' will be associated with something of a *moderate heat*, thereby leading to the concept of the mark as a whole being that of a moderately hot home. If perceived as a misspelling of 'homie', 'warmie' will be understood as someone showing *affection or kindliness* which, in turn, will lead to the overall concept of the mark being a reference to a kind and affectionate friend. For the avoidance of doubt, I find that both of these concepts will be understood by different, but both significant, proportions of consumers.

52. In comparing the concepts of the marks, I will focus on the consumers that understand the contested mark as referring to a 'warm home'. I do so because this represents the applicant's best case and because the word 'home' is more common so is most likely to be the first concept evoked. In this scenario, I am of the view that the concept of 'warm' associated with both marks is somewhat similar in that it references something being of a moderately hot temperature. The idea of a 'home' is, however, clearly a point of conceptual difference as it specifically indicates what it is that is warm or warming. Overall, I consider that the shared use of 'warmie' is sufficient to warrant a finding that the marks are conceptually similar to a medium degree insofar as 'warmies' and 'warmie' will both be perceived as similar distinctive misspellings of the word 'warm'.

[10] https://www.collinsdictionary.com/dictionary/english/warm. For the avoidance of doubt, all definitions of 'warm' discussed this section of my decision derive from this source.

Distinctive character of the applicant's mark

53. 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)."

54. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use. The applicant has filed

evidence of use and I will, therefore, consider whether this suitably enhances the distinctive character of the marks. Before doing so, I will consider the inherent position.

55. The applicant's mark is a figurative mark with the central element 'warmies', situated below a heart/w device and above the words 'SNUGGABLE', 'HUGGABLE' and 'LOVEABLE'. As above, the word 'warmies' will be understood as something that maintains or imparts heat. For the heatable goods of the applicant, this is borderline descriptive (or at the very least highly allusive)[11] of the purpose of said goods. However, some of the goods at issue are not heatable but simply scented. In this context, 'warmies' is not descriptive or allusive but neither is it remarkable (by virtue of its obvious connection to the word 'warm'). As for the remaining elements, these are fairly unremarkable and will not impact greatly upon the mark. I say this because (1) the device of the heart/w will simply be understood as standing for 'warmies' and (2) the words at the bottom of the mark are laudatory in nature. In addition, I consider that regardless of its borderline descriptive/highly allusive nature, 'warmies' is clearly intended to be the indicator of origin from a trade mark perspective. Overall, I find that the applicant's mark possesses a low degree of distinctive character (for the heatable goods) and a medium degree of distinctive character (for the scented goods).

56. I turn now to consider whether there exists an enhanced degree of distinctive character due to the use made of the marks. The evidence before me sets out that the applicant was founded in 1995 and aimed to find a new way to relieve aches and pains. The solution of microwavable wheat bags was later transformed into the plush toy brand known as 'Warmies', which was launched in 2014.

57. In terms of sales in the UK for the class 28 goods relied upon, the applicant has provided both revenue and unit sales figures for the years 2018 to 2025.[12] While

[11] On the basis that 'warmie' is not actually a dictionary defined word.
[12] DJHT1

the figures are presented quarterly, I will reproduce the annual figures below. The 2025 figures are not relevant to the present assessment and, as for the 2024 figures, they are only relevant insofar as they cover the first three quarters of that year (given that the relevant date for the present assessment is 18 October 2024).

58. The figures are as follows:

Year	**Sales figures (£)**	**Unit sales**
2018	804,574	170,806
2019	1,166,351	237,589
2020	3,310,461	747,787
2021	2,042,240	233,464
2022	2,873,472	590,488
2023	3,367,656	472,955
2024	2,782,997	645,230
Total	**16,347,751**	**3,098,319**

59. In terms of the retail of the applicant's goods, it is noted that they are sold via well-known third-party national retailers. Evidence on this point is provided that shows a total of 32 third party retailers and it is noted that these include retailers such as Tesco, Amazon, Sainsbury's, Next and Ryman, amongst others.[13] A breakdown of revenue associated with each retail outlet is provided and I note that the three largest retailers are Tesco, Amazon and Sainsbury's, respectively. It is also noted that the applicant sells its goods directly to consumers (for a total of approximately £1.2 million worth of sales between 2019 and 2024). In respect of the latter point, further evidence is provided that shows between 2020 and 2024, the applicant took 74,431 orders of its goods via its website.[14]

[13] DJHT2
[14] DJHT15

60. In respect of advertising, the applicant has provided a breakdown as to its spend from 2022 to 2025.[15] This is broken down to general advertising spend, digital marketing, literature and brochures, P.R. and photography. I do not intend to go over the breakdown in detail but note that, holistically, the evidence confirms the following spend between 2022 and the first three quarters of 2024 (being just before the relevant date):

Year	**Spend (£)**
2022	75,680
2023	88,016
2024	188,879
Total	**352,575**

61. In terms of the goods sold, the applicant has provided a range of catalogues showing the goods offered between 2018 and 2024.[16] I do not intend to discuss these in any great detail but note that they consistently show heatable plush toys such as the following:[17]



[15] DJHT3
[16] DJHT4 to DJHT10 (DJHT11 includes a catalogue from 2025 so is not relevant here).
[17] See page 3 of DJHT5

62. In respect of the goods shown in evidence, they are all clearly heatable plushies. It is noted that there is only one reference to the goods being 'scented'.[18] Further, any reference to scented goods in the narrative evidence comes via reference to the applicant's 'Hot-Pak' and 'Beddy Bear' goods. These were launched in the 1990s, long before the launch of the 'warmies' brand in 2014. In respect of such goods, I am, without anything further on the point, not content to attribute the wider use before me to the applicant's term of "toys, playthings, soft and plush toys, dolls, teddy bears, all filled or impregnated with scented substances". In short, I consider it reasonable to suggest that the applicant should have provided more specific evidence on the point to allow me to attribute its use to such goods.

63. Evidence is provided that discusses some of the accolades and awards that the applicant's 'warmies'-branded class 28 goods have achieved.[19] This includes, but is not limited to, being shortlisted for the 2022 and 2023 Gift of the Year and, in 2024, it was 'Highly Recommended' as the Gift of the Year and, in the same year, was also a finalist. It also won the 2023 Independent Toy Awards (where it was also 'Commended'). This evidence is noted but the only supporting evidence regarding the awards is a series of badges shown on a printout. In short, there is nothing to suggest the reach of such awards or how they were voted on (be that via a select panel or by the wider general public, for example).

64. Press coverage of the applicant's brand is discussed and the supporting evidence comes via two articles, one being an article from the Northamptonshire Telegraph dated 11 March 2025 and the other being an article regarding the 'Toy World Magazine Awards' from 23 June 2023. While noted, I am not convinced that this demonstrates a wide range of press coverage as it covers just two examples and, further, the articles are either from a local publication or a publication for which no supporting evidence as to readership or reach is provided.

[18] See page 5 of DJHT4. An additional reference is noted at DJHT11 but this is from after the relevant date so is of no assistance here.
[19] DJHT12

65. In respect of its social media accounts, the applicant has provided evidence that shows that, on Facebook and Instagram it has 13,930 and 27,773 lifetime followers, respectively.[20] The data provided sets out that 88% of the Facebook followers and 73% of the Instagram followers are from the UK. In addition, this same evidence provides Instagram analytics which confirms that the Instagram account reached 3.3 million people and had 111,600 content interactions between 11 November and 11 December 2025. While the social media evidence is noted, it speaks to the position by 10 or 11 December 2025. This is over a year after the relevant date and I, therefore, have nothing to suggest the figures as at the relevant date. That being said, the reach of 3.3 million people is likely to have some relevance to the position prior to the relevant date, though I am unable to say precisely how much.

66. In considering the evidence as a whole, I appreciate that I have nothing before me to suggest the size of the relevant market. While that may be the case, it is my view that the relevant market for the applicant's heatable plush toys is not likely to be a very large one. I say this because the market at issue is not the broader soft toy market but neither is it the hot water bottle market. It is, instead, a rather niche market. As such, I am of the view that the sales figures provided are significant in the context of said market. Further, while the evidence of sales is not very longstanding, it does cover a period of around seven years which is clearly not reflective of short-term use. In addition, the advertising figures are not necessarily reflective of a large advertising spend but they clearly reflect a concerted effort across different types of advertising methods to promote the brand.

67. As a result of the above, I am of the view that the evidence before me is sufficient to warrant a finding that the applicant's mark has achieved an enhanced degree of distinctiveness due to the use made of it, but only in respect of the heatable goods

[20] DJHT14

at issue. That being said, I do not consider the level of use to be high enough to warrant a finding that the distinctiveness of the applicant's mark has been enhanced to a high degree. I say this in light of the inherent position, which was low. As a result, I find that the distinctiveness of the applicant's mark has been enhanced to a medium degree in respect of the term "heatable soft and plush toys". As above, the inherent position in respect of the scented goods (which was medium) remains.

Likelihood of confusion

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

69. I found the goods at issue to be identical or similar to a medium degree. The average consumer base will be members of the general public who will select them via primarily visual means (though I do not discount an aural component) whilst paying a medium degree of attention. I have found the marks to be visually similar to between a low and medium degree and aurally and conceptually similar to a

medium degree. Lastly, I have found that the applicant's mark possesses a low degree of inherent distinctiveness in respect of "heatable soft and plush toys" and a medium degree in respect of its scented goods. However, the position in respect of the heatable goods has been enhanced due to the use of the mark.

70. Taking all of the above into account, I do not consider that the consumer will inaccurately recall or misremember the marks for one another. Even if consumers overlook the presence of the 's' at the end of the shared element, I do not consider that consumers would misremember the inclusion of the word 'Homy' in the contested mark. As a result, I consider that the consumers, in seeking to recollect the contested mark, would pin their recollection of the verbal element as a whole and would not, therefore, mistake it for 'warmies'. Consequently, I do not consider that there exists any likelihood of direct confusion, even when the marks are viewed on identical goods.

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

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

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

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

must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

74. In considering the issue of indirect confusion, I remind myself that it is not always the case that all differences between marks are noticed. In the present case, I consider that the difference stemming from the letter ‘s’ will be overlooked. This is because (1) it sits at the end of the applicant’s mark and (2) this difference is subsumed into the centre of the verbal element of the contested mark. For the avoidance of doubt, I consider that the other points of difference will all be noticed.

75. It is my view that when the consumer is confronted by the parties’ marks, the common element will be viewed as a shared indicator of origin for the marks, be that whether the consumers view it as ‘warmies’ or ‘warmie’.[21] I say this because whilst I appreciate that ‘warmies’ is not distinctive to a high degree, it does enjoy an enhanced degree of distinctiveness and will, therefore, benefit from some degree of recognition across the consumer base. Therefore, consumers will believe that the contested mark is from the same or economically connected undertaking as that which is responsible for the ‘warmies’ brand, especially in the context of identical goods. Even with the addition of the word ‘Homy’, I still consider that this connection will be made. Even though this alters the concept of the mark as a whole, the shared reference to ‘warmth’ presented in the same distinctive misspelling will be noticed. Further on this point, I find that ‘Homy’ will indicate a sub-brand of ‘Warmie’/‘Warmies’ that focuses on goods specifically for use in the home. This could either relate to a much larger heatable plush toy that is intended for use solely in the home[22] or a plush that is designed in a way to impart heat into a space/room (and not only the person), thereby creating a ‘warm home’. In addition, I accept that the adaptation of that word from ‘home’ to ‘homy’ is somewhat unusual but, in my view, consumers will simply view this alteration as

[21] Again, the difference here will be overlooked.
[22] I appreciate that goods of such a size may not necessarily be those that are microwavable goods like those of the applicant but, in my view, this does not prevent them from still being heatable goods.

an attempt to keep some form of unique rhythmic bounce by having the words rhyme. Lastly, I find that the presentational differences between the marks, as well as the device element and the laudatory words in the applicant's mark, will simply be put down to alternative marks used by the same or economically connected undertakings in different contexts.

76. In addition to the above, I consider that the same finding applies when it comes to those goods which I found to be similar to the applicant's scented goods. Even though such goods do not benefit from an enhanced degree of distinctive character, the inherent meaning of the mark on these goods is such that it gives the mark a medium degree of distinctiveness, further supporting the shared use of 'warmie' (and the overlooking of the difference in this element) as being an indicator of origin for both marks. As such, 'warmies' is not likely to be viewed as coincidental use meaning that, in my view, the reasons given above are equally applicable here, namely that the addition of 'Homy' will be viewed as a reference to a sub-brand of goods used specifically for the home.

77. Taking all of the above into account and even bearing in mind the case law discussed at paragraph 73 above, I find that there exists a likelihood of indirect confusion between the marks at issue. For the avoidance of doubt, this applies regardless of the level of similarity between the goods at issue, be they similar to a medium degree or identical.

78. As a result, I find that the present ground succeeds against those goods that I have found identical or similar. It fails, however, for the goods that I have found to be dissimilar. I will now proceed to consider the section 5(4)(a) ground.

Section 5(4)(a)

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

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

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

80. Subsection (4A) of section 5 of the Act states:

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

81. 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)."

82. 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 Dates

83. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 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.' "

84. The contested mark was applied for on 18 October 2024. It does not have a priority date and the proprietor has filed no evidence of any earlier use that could be said to be the behaviour complained about. As such, the relevant date for the invalidation proceedings is 18 October 2024.

Goodwill

85. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), 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."

86. 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 off 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."

87. 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."

88. 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."

89. I have discussed the applicant's evidence above and found it sufficient to give rise to an enhanced distinctive character. While I appreciate that the present test is not the same as the one conducted above, the test for enhanced distinctiveness is far more onerous than that for goodwill. As such, I consider that the applicant's evidence is sufficient to give rise to a finding that the applicant enjoys a strong level of goodwill in the UK and that the sign relied upon, being 'WARMIES', is distinctive and/or associated with that goodwill. Given the specific focus of the evidence on heatable plush toys (and the lack of any specificity regarding the scented goods, which I have discussed when considering enhanced distinctiveness above), this finding applies only to the term "heatable soft and plush toys".

Misrepresentation

90. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

> “is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

91. And later in the same judgment:

> “.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

92. In considering a misrepresentation, I remind myself that I found the goods that benefit from a protectable goodwill were identical to the following goods of the proprietor:

Class 28: Toys; toy dolls; sand toys; infant toys.

93. Under the present ground, the question is not identity or similarity of goods but whether the parties operate in the same or similar fields of business. Here, it is clearly the case that the above goods of the proprietor operate in the same field of

business as the applicant, especially given that the above goods of the proprietor are capable of covering heatable plush toys.

94. In respect of the above goods, I remind myself that although the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it has been acknowledged that they are unlikely to produce different outcomes in practice.[23] Even though the applicant's sign is different from its mark that was at issue under the section 5(2)(b) ground, I rely on the same findings I have made in respect of a likelihood of indirect confusion at paragraphs 74 to 77 above. This is because the applicant's sign is simply a word only sign for 'WARMIES' and I see no reason why the conclusions reached when considering confusion would not apply here given that, arguably, the sign is more similar to the contested mark. As such, I find that there exists a misrepresentation in respect of the above goods.

95. I turn now to consider the remaining goods, which are as follows:

Class 28:	Toy imitation cosmetics; toys balloons; toy blocks; toy cars; jigsaw puzzles; inflatable games for swimming pools; toy tents; smart toys; spinning fidget toys; golf clubs; basketball baskets; balance beams; cards [games]; board games; musical toys; water squirting toys.

96. While some of the above goods are toys, they are specific types of toys and I am not convinced that they are goods that exist in the same or sufficiently similar fields of business as those of the applicant.[24] As for the sporting equipment, such goods are clearly in different fields to that of the applicant. On this point, I remind myself

[23] *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501
[24] I remind myself that, under the section 5(2)(b) ground, some of these goods were similar to the applicant's scented toy goods but I am not satisfied that any goodwill vests in such goods.

that the burden for overcoming distant fields of activity under the present ground is a heavy one. In the present case, the applicant has not filed any evidence that discharges this burden and, in my view, I do not consider it appropriate to find that enjoying a protectable goodwill in respect of heatable plush toys automatically means that the applicant is duly protected against use of a similar mark for any and all types of toys (or the sporting equipment, for that matter). Such a finding would provide the applicant a very broad scope of protection and, in the present case, I do not consider this appropriate, especially given the very specific nature of the toys covered by its evidence. As a result, there exists no misrepresentation for these goods. Without a misrepresentation, there can be no damage meaning that the present ground fails in respect of the same.

97. I turn now to consider damage in respect of those goods listed at paragraph 92 only.

Damage

98. In respect of the goods for which there exists a misrepresentation, I find that the risk of damage is easily foreseeable in the form of, for example, a loss of sales. The present ground, therefore, succeeds in respect of the same.

CONCLUSION

99. The application succeeds in part meaning that the contested mark is, subject to any successful appeal of my decision, declared partially invalid. As per section 47(6) of the Act, the application for the contested mark is deemed never to have been made in respect of the following goods:

Class 28: Toys; toy dolls; sand toys; infant toys; toy imitation cosmetics; toys balloons; toy blocks; toy cars; jigsaw puzzles; inflatable

games for swimming pools; smart toys; spinning fidget toys; cards [games]; board games; musical toys; water squirting toys.

100. The application, however, fails in respect of some goods meaning that, again, subject to any successful appeal, the contested mark may remain registered for those. Further, there are some goods that were not subject to the present application.[25] The goods for which the contested mark may remain registered are as follows:

Class 21: Towel racks; dish drying racks; wall-mounted drying racks for laundry; drying racks for laundry; laundry drying racks; spice racks; vegetable racks; clothes racks, for drying; toilet paper racks; towel rails; draining trays; fitted racks for wiping, drying, polishing and cleaning paper; drying racks for washing; drying racks for clothes; dispensers for paper towels; holders for toilet paper; toilet paper holders; paper towel dispensers; sponges for toilet use; paper hand towel dispensers; toilet tissue holders; paper cups; toilet brushes; brushes for cleaning; scrubbing brushes; cleaning cloth; brushes; soap racks; shampoo racks; racks for drying clothes; clothes drying racks.

Class 28: Toy tents; golf clubs; basketball baskets; balance beams.

COSTS

101. While the contested mark survives for some goods (and those that were not targeted in these proceedings), it has been declared invalid for the majority of the targeted goods. As a result, I find that it is the applicant who has enjoyed the greater degree of success. The applicant is, therefore, entitled to a contribution

[25] For these goods, the conclusion that the mark remains registered for the same is not subject to appeal as they were not at issue in my decision.

towards its costs based on the scale set out in Tribunal Practice Notice 1/2023. In the circumstances, I consider it appropriate to reduce the costs award to some degree to reflect the proprietor's partial success in defending its mark for some goods. I award the applicant the sum of £1,200 as a contribution towards its costs. The sum is calculated as follows:

Preparing an application for invalidity and considering the counterstatement:	£250
Preparing evidence:	£600
Preparing written submissions:	£350
Sub-total:	£1,200
Reduction:	*-£200*
Official fees (not subject to a reduction):	£200
Total:	**£1,200**

102. I hereby order POPAL TECHNOLOGY LIMITED to pay Intelex Group Holdings (UK) Limited the sum of £1,200. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of October 2026

A COOPER
For the Registrar

ANNEX 1

Class 11

Hot water bottles; heat pads for warming; seed or grain filled warmers which are microwave heated and are used for warming the body.

Class 16

Printed matter; books; magazines; printed publications; periodicals; posters; photographs; calendars; greeting cards; paper; paper articles; stationery; gift vouchers; book tokens; protective covers for books; stationery and educational supplies.

Class 20

Pillows and cushions; scented pillows and cushions; pillows and cushions containing seed or grain; scented pillows and cushions containing seed or grain; pillows and cushions containing seed or grain and essential oil.

Class 25

Heatable footwear and slippers containing seed or grain which can be microwave heated; eye masks; sleep masks.

Class 28

Toys, playthings, soft and plush toys, dolls, teddy bears, all filled or impregnated with scented substances; toys, playthings, soft and plush toys, dolls, teddy bears, containing seed or grain which can be microwave heated; heatable toys, heatable playthings, heatable soft and plush toys, heatable dolls, heatable teddy bears; heatable toys, heatable playthings, heatable soft and plush toys, heatable dolls, heatable teddy bears, all containing seed or grain and/or essential oil.

Class 35

Retail and wholesale services relating to the retail of hot water bottles, heat pads for warming, seed or grain filled warmers which are microwave heated and are used for warming the body; retail and wholesale services relating to the retail of pillows and cushions, scented pillows and cushions, pillows and cushions containing seed or grain, scented pillows and cushions containing seed or grain, pillows and cushions containing seed or grain and essential oil, heatable pillows and cushions; retail and wholesale services relating to the retail of heatable footwear and slippers containing seed or grain which can be microwave heated, eye masks and sleep masks; retail and wholesale services relating to the retail of toys, playthings, soft and plush toys, dolls, teddy bears, all filled or impregnated with scented substances; retail and wholesale services relating to the retail of toys, playthings, soft and plush toys, dolls, teddy bears, containing seed or grain which can be microwave heated, heatable toys, heatable playthings, heatable soft and plush toys, heatable dolls, heatable teddy bears, heatable soft and plush toys, heatable dolls, heatable teddy bears, all containing seed or grain and/or essential oil.

Class 40

Personalisation gift services of hot water bottles, heat pads for warming, seed or grain filled warmers which are microwave heated and are used for warming the body; personalisation gift services of pillows and cushions, scented pillows and cushions, pillows and cushions containing seed or grain, scented pillows and cushions containing seed or grain, pillows and cushions containing seed or grain and essential oil, heatable pillows and cushions; personalisation gift services of heatable footwear and slippers containing seed or grain which can be microwave heated, eye masks and sleep masks; personalisation gift services of toys, playthings, soft and plush toys, dolls, teddy bears, all filled or impregnated with scented substances; personalisation gift services of toys, playthings, soft and plush toys, dolls, teddy bears, containing seed or grain which can be microwave heated, heatable toys, heatable playthings, heatable soft and plush toys, heatable dolls, heatable teddy bears, heatable soft and plush toys, heatable dolls, heatable teddy bears, all containing seed or grain and/or essential oil.