O/1191/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3874720

BY GIBGAB LTD

TO REGISTER:

AS A TRADE MARK IN CLASS 45

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 440829 BY

TELEFONICA UK LIMITED

BACKGROUND AND PLEADINGS

1. On 5 February 2023, GibGab Ltd ("the applicant") applied to register the trade mark shown on the front cover of this decision in the United Kingdom in respect of the following services:

> *Class 45*
> *Online social networking services; Internet-based social networking services; On-line social networking services; Online social networking services accessible by means of downloadable mobile applications.*

2. On 16 May 2023, the application was opposed by Telefonica UK Limited ("the opponent"). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") and concerns all the services in the application.

3. The opponent relies on three marks. The first of these is UKTM No. 916958613, **GIFFGAFF**, with an application date of 6 July 2017 and a registration date of 13 December 2017. It is registered for goods and services in Classes 9, 16, 18, 25, 37, 38, 39, 41, 42, 43, 44, 45. This mark qualifies as an earlier mark under section 6(1)(a) of the Act. The opponent also sought to rely on UKTM Nos. 3896719 and 3901353. These have application dates of 3 April 2023 and 17 April 2023 respectively. As these dates come after the application date of the contested mark, and there is nothing on the register to say that priority is claimed from marks filed in other jurisdictions, they are not earlier marks and so I dismiss any claims made on the basis of them.

4. The opponent claims that the parties' marks are similar. In answer to question 1 on the notice of opposition, it states that it is relying up on all services in Classes 38 and 45 of its specification. These are listed in the Annex to this decision. However, in its statement of grounds, it claims that the applied-for services are similar to the term *Message sending* in Class 38 and identical to services in Class 45 of its specification. Consequently, it claims that there is a likelihood of confusion on the part of the public, including a likelihood of association.

5. It will be noted that there is some inconsistency between the answers given by the opponent to the questions in the notice of opposition and to the text provided in the

statement of grounds. I consider that it is worth quoting in full that part of the statement of ground addressing the similarity of the services. It says:

> "4. … the class 45 services covered by the subject application are identical or highly similar to the goods and services covered by the Earlier Marks owned by the Opponent. The identity and similarity is briefly discussed below:
>
> > Class 38 – The term 'message sending' in class 38 of the Opponent's Earlier Mark is similar to the term 'Online social networking services' in class 45 of the applied for mark. This is because sending messages is a large part of online social networking. As such, it is highly likely that these services would be provided by the same party, and be understood as such by the consumer.
> >
> > Class 45 – The identity is clear in this class and will not be discussed in further detail at this stage."

6. Under section 5(3), the opponent states in answer to question 1 on the notice of opposition that the earlier mark has a reputation in relation to the goods in Class 9 and the services in Class 38. These are listed in the annex to this decision.

7. In its statement of grounds, it claims that it has *"a massive reputation … in relation to its core telecommunication goods and services, retail services, and financial services"*.[1] It further claims that use of the contested mark would, without due cause, take unfair advantage of the distinctive character or repute of the earlier mark. It asserts that the earlier mark is *"portrayed as a young, trendy, healthy, cool and high tech brand to its consumers"*. Furthermore, or in the alternative, it claims that use of the contested mark could result in detriment to the distinctive character or repute of the earlier mark. Again, there is some inconsistency between the claims made in response to the questions in the notice of opposition and the text of the statement of grounds as to the extent of the reputation of the earlier mark.

8. The applicant filed a defence and counterstatement denying the claims made in the statement of grounds and putting the opponent to proof of use of its mark for the

[1] At [6].

services relied on under section 5(2)(b) and the alleged reputation of the earlier mark. On the subject of the similarity of services under section 5(2)(b), it says:

> "3. As to paragraph four:
>
> …
>
> b. It is denied that 'message sending' in Class 38 is similar to 'Online Social Networking Services' in Class 45. No reasonable consumer would confuse an online social networking platform (such as the Applicant) with a provider of telecoms connectivity (such as the Opponent).
>
> c. It is denied that there is any over-lap between the Class 45 services used by the Opponent and those proposed to be used by the Applicant. The Applicant will provide no service currently or historically provided by the opponent in this, or any, Class."

Discussion of the Pleadings

9. The need for pleadings to be fully particularised was emphasised by Professor Phillip Johnson, sitting as the Appointed Person, in *SkyClub Trade Mark*, BL O/044/21 at [23]-[28]. At [26] he quoted Lord Hoffmann's statement in *Barclays Bank Plc v Boulter* [1999] 1 WLR 1919 at [1923]:

> "The purpose of the pleadings is to define the issues and give the other party fair notice of the case which he has to meet."

10. After having explained the requirements of the Rules, Tribunal Practice Notice ("TPN") 4/2000 contains the following guidance on the content of statements of grounds and counterstatements:

> "10. The Registrar will also expect the statement to set out the relevant section eg 5(2) and subsection, eg 5(2)(a). The statement should also set out, as appropriate, those goods or services which the opponents contend are similar or identical to those covered by the earlier trade mark(s). Claims in the alternative will be acceptable.
>
> …

> 19. A defence should comment on the facts set out in the statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove.
>
> 20. The counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. …"

11. In *Skyclub*, Professor Johnson explained at [22] that it would be possible to file an adequately particularised notice of opposition by completing the boxes on the TM7 form, and that there is no need to file a separate statement of grounds: *"an Opponent has a fully pleaded claim based on the completion of the boxes on Form TM7 alone."* He went on to say that it was not possible to file an adequately particularised defence simply by filling out the boxes, and that it would be wrong to proceed on the basis that anything that it not admitted is denied.

12. The issue here is that the part of the form TM7 containing the boxes says one thing, while the statement of grounds says something else. It appears to me that the applicant has responded to the claims made in the statement of grounds, rather than those made by filling in the boxes on the form. Given what Professor Johnson said in *Skyclub*, I am prepared to take the completed boxes on the TM7 form as the extent of the opponent's pleadings.

13. The effect of this is that the applicant has only denied that one of the services in Class 38 is similar to the Class 45 services covered by its application. Rule 62(1)(e) of the Trade Mark Rules 2008 gives me the power to agree to an application by a party to amend its pleadings. However, as the Court of Appeal clearly stated in *Magdeev v Tssvetkov* [2019] EWCA Civ 1802, I cannot consider something requiring an application, if such an application has not been made. Consequently, it would be wrong for me to proceed as if the applicant had denied that all the Class 38 services were similar to its services.

14. I will say something briefly about the pleadings under section 5(3). I have quoted above the claims made in the statement of grounds, where it claims a reputation in telecommunications goods and services, retail services and financial services. In

Tulliallan Burlington Ltd v European Union Intellectual Property Office (EUIPO), Case T-213/16, the General Court ("GC") held that any reputation must be in goods and/or services covered by the earlier mark. As the earlier mark is not registered for retail services in Class 35 or financial services in Class 36,[2] the opponent may not rely on them.

15. It is unfortunate that the problem with the pleadings was not identified earlier. I have considered whether it would be appropriate to invite both parties to amend their pleadings: first, the opponent to clarify the extent of its case; and then the applicant to respond to that clarification. However, for reasons that will become apparent I have concluded that it is not justified at this stage to put the parties to the cost of potential amendments to the pleadings, and thus cause further delay. As I make my way through this decision, I will explain at each appropriate point why I have reached this conclusion.

EVIDENCE AND SUBMISSIONS

16. Only the opponent filed evidence. This comes in the form of a witness statement from Anish Shonpal, dated 22 November 2023, and accompanied by 16 exhibits. Mr Shonpal is General Counsel at giffgaff Limited, a wholly owned subsidiary of Telefonica UK Limited. He states that he has been associated with the company since September 2016. His evidence concerns the reputation of the earlier mark.

17. Neither party requested a hearing and both filed written submissions in lieu on 18 March 2024.

REPRESENTATION

18. In these proceedings, the opponent is represented by Stobbs and the applicant is represented by Cerberus Law Limited.

RELEVANCE OF EU LAW

19. 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

[2] These services are to be found in the specification of UKTM No. 3901353, which is not an earlier mark.

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.

DECISION

Proof of Use

20. Section 6A of the Act is as follows:

> "(1) This section applies where-
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section 'the relevant period' means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if–
>
> (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

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

(4) For these purposes–

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

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

[(5) and (5A) Repealed]

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

21. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

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

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

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

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

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

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

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

22. The relevant date for the purposes of these proceedings is the application date for the contested mark, i.e. 5 February 2023. The opponent is therefore required to show that it has used the mark for the services relied on in the five-year period from 6 February 2018 to 5 February 2023.

23. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W. F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [72]; *Leno* at [55].

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

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office*

[EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

> '19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. …
>
> 22. … it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal … comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.'"

The opponent's evidence

24. Mr Shonpal describes the business of giffgaff Limited in the following terms:

> "My Company is a mobile virtual network operator providing telecommunication services to the consumer mobile segment under the brand **giffgaff**. It was launched in 2009. Our core business is the provision

of SIM only mobile services, but we also offer the purchase of handsets (outright or via loans), and we provide online charging platform services to other mobile virtual network operators."[3]

25. An article from the *Daily Telegraph* website, dated 26 May 2015, explains that being a mobile virtual network operator *"means it piggybacks on an existing network. In Giffgaff's case, it uses the network infrastructure built by its parent company, O2"*.[4]

26. Mr Shonpal states that Exhibit AS2 contains extracts from his company's website that show the range of services offered. They contain information about mobile telecommunications services. These pages are, however, undated and were captured on 13 November 2023. An extract from the opponent's 2022 strategic report in Exhibit AS6 confirms that it provides SIM cards. It also refers to the sale of handsets.

27. The following table shows turnover, profit and the number of new customers attracted to the business between 2018 and 2022:[5]

Year	Turnover £	Profit £	New customers
2018	449,222,000	30,560,000	435,995
2019	490,814,000	33,529,000	304,742
2020	500,081,000	25,517,000	237,495
2021	524,439,000	42,550,000	216,935
2022	559,054,000	66,337,000	107,930

28. The strategic report in Exhibit AS6 states that 88% of the turnover in 2022 came from the mobile service business, with 12% contributed by the handset business.[6] This compares with an 11.1% share of revenue generated by handsets in 2018, 11.5% share in 2019, 11.8% in 2020 and 10.6% in 2021.[7]

29. Mr Shonpal does not provide any figures for how much his company spends on marketing and promotion. He does say that the company had sponsored a number of television programmes:

[3] Paragraph 7.
[4] Exhibit AS8, page 82. The opponent's company name was O2 (UK) Limited between 19 April 2002 and 30 May 2008: see Exhibit AS1, page 9.
[5] Witness statement, paragraph 11.
[6] Page 54.
[7] Pages 57-60.

i) *The Big Bang Theory,* shown on E4 and sponsored in 2012. A press release dated 4 April 2012 states that this was originally a nine-month partnership. It is not clear whether sponsorship continued after this period;[8]

ii) *Rude Tube*, a TV show on Channel 4 which the company also began sponsoring in 2012. It is mentioned in the press release cited above as part of the partnership but, as with *The Big Bang Theory*, it is not clear how long the programme was sponsored;[9]

iii) All of E4's entertainment programmes in January and February 2015;

iv) *The Voice*, a music competition show on ITV. The company sponsored the second series of the show which began in January 2018;[10]

v) *The Crystal Maze*, an entertainment show on Channel 4 sponsored in 2018;[11] and

vi) *The Circle*, a reality TV show on Channel 4 also sponsored in 2018.[12]

30. Some of these exhibits contains extracts of conversations in the giffgaff community about the shows. The article on *The Voice* also shows the following examples of "idents" for use on the show. The word "giffgaff" appears in a slightly stylised typeface. It also states that the idents feature fans of the show and their tweets.

[8] Exhibit AS9.
[9] Exhibit AS10.
[10] Exhibit AS12.
[11] Exhibit AS13.
[12] Exhibit AS14.

31. In addition, the company sponsored awards at the Music Video Awards in 2016 and 2017, but these were before the relevant period.[13]

32. He explains that the company uses its community of *"members"* (as it likes to call its customers) as advocates, promoting its services to others and earning rewards for recommending the service or sharing ideas. An article from *Marketing Week* dated 30 August 2017 entitled "How Giffgaff's alternative take on loyalty is 'saving the brand a fortune'".[14] This article was published before the start of the relevant period, as was *The Daily Telegraph* article which I have quoted above. Mr Shonpal states that a later article from *Marketing Week*, published in 2019, discusses the success of the business. However, only the beginning of this article is in evidence.[15] It contains an image (reproduced below) showing the word "giffgaff" in a standard sans serif typeface. The origin of this image is not clear.

[13] Exhibit AS15.
[14] Exhibit AS7, pages 63-66.
[15] Exhibit AS8, pages 85-86.

33. More recent information can be found in the strategic report in Exhibit AS6, which states that the giffgaff community has over 300,000 visitors a month and members answer over 3,800 new questions a month in 2022.[16] Exhibit AS4 contains printouts from the Help and Support section of the Giffgaff community website. It shows questions being answered by members of the community. While most of these are fairly close in date to the time that the printout was made (13 November 2023), the initial post on this section shows one post from 20 August 2018.

34. Mr Shonpal lists the awards won by the company in the relevant period:[17]

2018	uSwitch Network of the Year Which? Recommended provider (7th year running) Mobile Choice Awards – Best Value Network Music and Sound Awards Winner PC Pro Awards – Best Mobile Data Provider
2019	uSwitch Network of the Year uSwitch Best Network for Data What Mobile Awards – Best MVNO PC Pro Awards – Best Mobile Data Provider Which? Recommended provider (8th year running)
2020	uSwitch Network of the Year Which? Recommended provider (9th year running) uSwitch Highly Recommended – Best Pay As You Go Network uSwitch Highly Recommended – Best Retailer for Customer Service Silver Award for International Customer Experience
2021	uSwitch Network of the Year D&AD New Blood Awards Winner Global Search Awards 2021 – Best use of Search Blogsphere Awards – Lifestyle Influencer Brand Campaign of the Year Ofcom Customer Service Tracker – Top of Mobile Leader Board

[16] Page 52.
[17] Paragraph 16 and Exhibit AS16.

	Expert Reviews Mobile Network Awards – Best Overall Highly Commended 2021, Best Value Highly Commended 2021 and Most Reliable Highly Commended 2021
2022	Which? Recommended provider uSwitch Network of the Year uSwitch Best Pay As You Go Network uSwitch Best SIM Only Network KPMG Nunwood – 49th in the UK Top 100 Companies for Customer Experience

35. The opponent was also placed second in a survey run by Choose (a price comparison service) on the best customer service in the mobile telecommunications industry in 2022.[18]

Assessment of genuine use

36. The opponent submits that this evidence shows that it has made genuine use of the contested mark for all the goods and services relied on. I shall focus my analysis here on the services relied on under section 5(2)(b), returning to what the evidence shows about the Class 9 goods when I come to consider the claims made under section 5(3). I pause briefly to remind myself that the applicant put the opponent to proof of use of all services in Classes 38 and 45.

37. The opponent's specification in Classes 38 and 45 contains a very long list of services. In the latter class particularly, it includes services that are not shown in the evidence and in respect of which it is difficult to understand how there could be any similarity with the contested services (for instance, *Babysitting* and *Baggage inspection for security purposes*). Indeed, later in its submissions on section 5(2)(b), the opponent compares the contested services to a subset of the services covered by the earlier mark. It would have been helpful both for the Tribunal and the applicant if the opponent had more fully particularised its pleadings and submissions earlier in the proceedings. I will focus my assessment of use on those services listed in the part of the opponent's submissions dealing with the comparison between the services, as it

[18] Exhibit AS5.

is reasonable to take the view that the opponent considers these are its best case. They are as follows:[19]

> *Class 38*
>
> *Telecommunications; cable television broadcasting; cellular telephone communication; communications by computer terminals; communications by fiber [fibre] optic networks; communications by telephone; computer aided transmission of messages and images; electronic bulletin board services [telecommunications services]; electronic mail; facsimile transmission; information about telecommunication; message sending; paging services [radio, telephone or other means of electronic communication]; providing access to databases; providing internet chatrooms; providing telecommunication channels for teleshopping services; providing telecommunications connections to a global computer network; providing user access to global computer networks; radio broadcasting; wireless broadcasting; telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services.*
>
> *Class 45*
>
> *Legal services; licensing of computer software [legal services]; introduction and social networking services; on-line social networking services; social introduction, networking and dating services; dating services provided through social networking; providing information in the field of personal relationships.*

38. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period (6 February 2018 to 5 February 2023). As the earlier mark is a comparable mark, the relevant territory for the part of the period up to 31 December 2020 is the EU; thereafter, it is the UK.

39. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the EU ("CJEU") noted that:

[19] They appear in the table on page 5 of the opponent's submissions. The pagination is my own.

"36. It should, however, be observed that … the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.

…

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national mark.

…

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

40. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited* [2016] EWHC 52, Arnold J (as he then was) reviewed the case law since *Leno* and concluded as follows:

> "228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.
>
> 229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument is not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.
>
> 230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that 'genuine use in the Community will in general require use in more than one Member State' but 'an exception to that general

> requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State'. On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

41. The GC restated its interpretation of *Leno* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of that judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

42. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant five-year period. In making this assessment I am required to consider all relevant factors, including the scale and frequency of the use shown; the nature of the use shown; the services for which use has been shown; the nature of those services and the markets for them; and the geographical extent of the use shown.

43. The evidence pertaining to the relevant period mostly shows the mark as a plain word with no stylisation. In a couple of instances, mentioned above, there is some stylisation, as shown below:

44. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Professor Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the question of variant use under s. 46(2). The points made apply equally to the assessment under section 6A(4)(a). He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
>
> 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is supposed figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE

sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still".

45. The stylisation consists in vertical lines joining the first three letters of the mark together and joining the letter "a" to the "f" that follows. In my view, this stylisation is so minor that it does not alter the distinctive character of the earlier mark as a whole. I therefore find that the stylised version is an acceptable variant of the earlier mark.

46. On the basis of the evidence filed, I am satisfied that the opponent has used the mark in the UK for a mobile telecommunications service in the form of a mobile virtual network operator. The levels of use, as shown in the turnover and numbers of customers, are such that I am prepared to accept that the use in the UK is sufficient to constitute genuine use of the EUTM from which the comparable mark was derived in the EU in the period up to 31 December 2020. The average consumer would, in my view, expect such a service to provide the user with the ability to make telephone calls, send messages, access information on the internet and use downloadable applications. I do not see any evidence of any other type of communications service, such as those delivered through fibre-optic networks. I note that the 2015 article from *The Daily Telegraph* mentions a broadband service, but it is not clear whether this was offered during the relevant period. Nor does Mr Shonpal show that the opponent has used the mark for television or radio broadcasting, facsimile transmission or paging services. I am also of the view that the mark has not been used for electronic mail. While I accept that electronic mail may be viewed and sent using a mobile telephone on a mobile telecommunications network, the same can be said about many different applications. The essence of an electronic mail service is access to the software for

reading, composing, sending, storing and searching mail and the provision of a certain amount of storage capacity, and I do not see that the opponent has used the mark in such a way as to create or maintain a share of the market for these services. I consider that the same applies in the case of providing access to databases and telecommunication channels for teleshopping services.

47. I understand *Electronic bulletin board services [telecommunications services]* to be a service that enables users to share information or discuss topics in a public, or semi-public, way, as all other users will be able to see and respond to the messages. I consider that the opponent's community pages are an example of such a service. Exhibits AS4, AS9 and AS13 show messages posted in 2018. The 2022 report also states that *"The giffgaff community has over 300,000 visitors a month and members answer over 3,800 new questions a month."*[20] There is no evidence covering the intervening period, but I consider it unlikely that the level of engagement shown in 2022 would have happened overnight, and there is evidence indicating that the community was active before the relevant period. I am therefore satisfied that the opponent has genuinely used the earlier mark for these services.

48. To my knowledge, internet chatrooms are a slightly different service. These provide the opportunity for a group of users to communicate with each other in real time. The opponent has provided me with no detailed submissions on whether it supplies these services. On the basis of what I can see in the evidence, a user would post a query or a comment, to which others could then reply. Although some of the dates are obscure, Exhibit AS14 shows that responses to the original message were posted at least hours after the original message was posted on 30 August 2018 at 12.34 (for instance, at 18.43 and 20.23).[21] This does not suggest to me that the communication was happening in real time. I find that the mark has not been genuinely used for *Providing internet chatrooms.*

49. I understand that *Telecommunications portal services; Internet portal services* are services that provide a gateway to other services or sources of information. I have

[20] Exhibit AS6, page 52.
[21] See pages 138 and 139.

been given no evidence to indicate that the earlier mark has been used for such services.

50. Turning now to the Class 45 services, I can see no evidence that the earlier mark has been used for any legal services or introduction and dating services. In my view, the average consumer would not describe the services of the giffgaff community as social networking services. They would expect users of such services to set up a profile and share information, photographs and videos. From the evidence I have before me, I cannot say that the earlier mark has been used in connection with such services. The onus is on the opponent to show this and, in my view, it has not done so.

Framing a fair specification

51. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification for the purposes of an assessment of genuine use. He said:

> "244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.
>
> 245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to

ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark."

52. As I have already noted, the telecommunications services provided under the mark are mobile telephone services. The specification contains the terms *Mobile telecommunications services* and *Cellular telephone communication*. I consider that the latter term is synonymous with the former and so both are included in a fair specification. A broader term is *Communications by telephone*. It encompasses services that use different technologies to make the connection between the devices. I do not consider that is arbitrary to treat *Mobile telecommunications services* as a distinct subcategory. The price comparison site choose.co.uk published a report ranking various mobile telephone service providers and the table in paragraph 34 above shows a number of awards dedicated to mobile telephony. Consequently, I find that *Communications by telephone* and the even broader *Telecommunications* and *telecommunications services* should not be included in a fair specification.

53. The following services are ones that the average consumer would expect to receive from a mobile telephone communications provider: *Computer aided transmission of messages and images; information about telecommunication; message sending; providing access to databases; providing telecommunications connections to a global computer network; providing user access to global computer networks.* However, for the reasons given above I consider that it would be fair to limit these to services delivered by mobile telecommunications services.

54. I have already found that the earlier mark has been genuinely used for *Electronic bulletin board services [telecommunications services]*.

55. In my view, a fair specification would be the following:

Class 38

Cellular telephone communication; computer aided transmission of messages and images by means of mobile telecommunications; electronic bulletin board services [telecommunications services]; information about mobile telecommunication; message sending by means of mobile telecommunications; providing access to databases by means of mobile telecommunications; providing mobile telecommunications connections to a global computer network; providing user access via mobile telecommunications to global computer networks; mobile telecommunications services.

Section 5(2)(b)

56. Section 5(2)(b) of the Act is as follows:

> "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."

57. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the CJEU 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

> 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater degree of similarity between the marks and vice versa;

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

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

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

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

Comparison of services

58. It is settled case law that I must make my comparison of the services on the basis of all relevant factors. These include the nature of the services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the GC said in *Boston Scientific Ltd v OHIM*, Case T-325/06, goods and services are complementary when:

> "82. … 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."

59. The services to be compared are shown in the table below:

Contested services	**Earlier services**
	Class 38 *Cellular telephone communication; computer aided transmission of messages and images by means of mobile telecommunications; electronic bulletin board services [telecommunications services]; information about mobile telecommunication; message sending by means of mobile telecommunications; providing access to databases by means of mobile telecommunications; providing mobile*

Contested services	Earlier services
	telecommunications connections to a global computer network; providing user access via mobile telecommunications to global computer networks; mobile telecommunications services.
Class 45 *Online social networking services; Internet-based social networking services; On-line social networking services; Online social networking services accessible by means of downloadable mobile applications.*	

60. The applicant has not denied that any of the Class 38 services above are similar, except for *Message sending by means of mobile telecommunications*. In the absence of any amendment to its pleadings, I must therefore treat it as having admitted that all the other terms are similar. I shall, however, proceed to compare *Message sending by means of mobile telecommunications* with the contested services. This is because the opponent has made some specific submissions on this point. It refers me to three earlier decisions of this Tribunal (*Match Group, LLC v Muzmatch Limited*, BL O-087-20; *Shopify Inc. v Shopee Singapore Private Limited*, BL O/0757/23; and *Witty Technologies Ltd v JHO Intellectual Property Holdings, LLC*, BL O/0727/23) where three separate Hearing Officers considered that social networking services were similar to between a medium and fairly high degree to online communication and messaging services, on the basis that social networking services commonly featured a messaging function. The Hearing Officer in *Match Group* said:

> "*Telecommunications; transmission of sound, text and/or images; electronic on-line services for the receipt and delivery of messages, documents, images and other data by electronic transmission; electronic mail services; providing personal electronic web pages and featuring user-*

provided content; electronic messaging services; providing access via a global computer network to electronic bulletin boards; providing communication services to web communities; electronic on-line services for the receipt and delivery of messages, documents, images and other data by electronic transmission; computer-aided electronic information and communication services for private users; delivery of digital audio and/or video by telecommunications; transfer of information and data via online services and the Internet; providing on-line chatrooms and electronic bulletin boards for transmission of messages amongst users; services with regard to processes for transmission of data, in particular texts, images and audio and video files, on mobile terminals and on systems on the Internet

76. The above services are all concerned with the provision of means of communication to users online. It is common for social networking and dating websites as covered by the earlier specification in class 45, to allow users to create personal profile pages and to feature a messaging function within the site; it is entirely plausible that messages could be written, video or audio. Whilst it may be less likely for dating sites where personal security is more of a concern, I see no reason why a social networking site would not also incorporate electronic bulletin boards. There is, therefore, similarity in both nature and purpose, users will be the same and there is clear potential for complementarity. These services are similar to a fairly high degree."

61. I agree with the analysis. The opponent's messaging services in the present case are slightly narrower, in that they are limited to those using mobile communications. However, I do not consider that this makes a difference to the analysis, as the users of the applicant's services can access them on their smartphones or other mobile devices. I find that the contested services are similar to the opponent's *Message sending by means of mobile telecommunications* to between a medium and high degree.

Average consumer and the purchasing process

62. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch) at [60]. For the purposes 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 and services in question: see *Lloyd Schuhfabrik* at [26].

63. The opponent submits that the average consumer is a member of the general public who will pay an average level of attention during the purchasing process. The applicant makes no specific submissions on this point, although it does argue that the audiences targeted by the two parties are different. I have, however, already found that the users of the services will be the same.

64. I agree with the opponent that the average consumer is a member of the general public, although the services will also be purchased by businesses. The cost of the services is, in my view, likely to be fairly low. Social networking applications may be free to download and use, with their costs funded by advertising, although it is possible that paid-for options may also be available. Message sending services may also be available for no, or low, cost. However, even where there is no direct cost to the user, or such costs are low, the average consumer will still take into account factors such as functionality and customer service. In the case of a social network, they may also consider how widely used that network is. Consequently, I find that a medium degree of attention will be paid during the selection process.

65. The services are likely to be selected from websites or app stores, so the average consumer will see the mark when deciding which provider to choose. They may also see advertisements on a variety of media. In addition, the average consumer may receive word-of-mouth recommendations. Therefore, I find that the purchasing process will largely be visual, although some role will be played by the aural element of the mark.

Comparison of marks

66. It is clear from *SABEL* (particularly at [23]) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The

same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks: see *Bimbo*, paragraph 34.

67. The respective marks are shown below:

Contested mark	**Earlier mark**
	GIFFGAFF

68. The earlier mark is a plain word mark. In *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17, the GC held at [39] that such plain word marks protected the word or words contained in the mark in whatever form, colour or typeface. The opponent submits that it will be perceived as an invented word. According to the evidence it has filed, the word is a Scots word that means *"mutual giving"*.[22] However, even if some consumers are aware of this meaning, I consider that there is a substantial proportion, and possibly a majority, of consumers who would see the mark as an invented word. There are no other elements to contribute to the overall impression of the mark.

69. The contested mark is a composite mark with a verbal and a figurative element. The verbal element consists of the word "GibGab" shown in a grey sans serif typeface, with the first three letters emboldened. The opponent argues that, despite this difference in the presentation, the average consumer would read the verbal element as a single word. The applicant does not make any specific submissions on this point, although it contends that *"it is clear that both names are constructed from two syllables with a repeating internal consonant-vowel structure"*.[23] In my view, the capitalisation of

[22] Exhibit AS3, page 22.
[23] Written submissions, paragraph 10.

the second “G” makes it more likely that the average consumer will see the mark as consisting of two words. I also consider that the use of a bold typeface for the first part of the verbal element reinforces the construction of the contested mark.

70. To the left of the verbal element, is a device. I note that the applicant’s counterstatement and written submissions focus on the verbal element of the mark and say nothing about this device and its role in the overall impression of the mark. The opponent submits that it is the verbal element that is the dominant and distinctive element of the mark. I agree. The triangular-circular element in orange, purple and blue will, in my view, be perceived by the average consumer as being decorative, so its contribution is only minor.

Visual comparison

71. The opponent’s mark has eight letters, while the verbal element of the contested mark has six. They also contain two syllables, the first of which begins with the letters “GI-” and the second of which begins with the letters “GA-”. The applicant submits that *“The double ‘f’ in ‘GiffGaff’ creates a unique visual pattern, which does not occur in ‘GibGab’. This variance in lettering contributes to their distinct appearances, making them easily distinguishable upon closer inspection.”*[24] However, the case law is clear that the average consumer does not undertake a detailed analysis of the marks and is unlikely to see them side-by-side. I accept that the end of each syllable is a point of visual difference between the marks, as is the device and the use of a bold typeface for only part of the mark. Taking all these factors into account, and bearing in mind my finding that the verbal element is the dominant and distinctive element of the contested mark, I find that the marks are visually similar to at least a medium degree.

Aural comparison

72. The applicant submits that:

> “13. … Phonetically, the differences between ‘GiffGaff’ and ‘GibGab’ are significant when considering the principles of phonology, the study of how sounds are organised and used in natural languages.

[24] Written submissions, paragraph 12.

14. Vowel Sounds: both names use the short ‘i’ sound in their first syllables, but the vowels in their second syllables differ (‘a’ in ‘Gaff’ versus ‘a’ in ‘Gab’). While the differences may seem minor, it alters the resonance and duration of the vowel sound, contributing to the overall distinction in pronunciation.

15. Consonant Sounds: The consonant sounds play a crucial role in distinguishing the two names. The voiceless ‘f’ sound in ‘GiffGaff’ involves friction caused by breath flow through a narrow opening between the lower lip and the upper teeth, creating a softer, elongated sound. In contrast, the voiced ‘b’ sound in ‘GibGab’ is a plosive sound produced by obstructing airflow with the lips, leading to a sharper, more abrupt sound. These differences in sound production affect the names’ audibility and perception, further distinguishing them to listeners.”

73. I am not persuaded that the letter “a” in the respective marks would be pronounced differently. While I accept that the “ff” and “b” sounds do differ, it does not seem to me likely that the average consumer would apply the same analytical approach to the marks as set out by the applicant. The marks have the same two-syllable structure, with each syllable beginning with the same letter. They also share the same vowel pattern. Consequently, I find that the marks are aurally similar to a medium to high degree.

Conceptual comparison

74. The applicant submits that:

“16. … Conceptually, the names evoke different images and ideas due to their phonetic and structural differences. ‘GiffGaff’ might be associated with a sense of efficiency or reliability, suggested by the sharper ‘f’ sound, whereas ‘GibGab’ might evoke concepts of conversation or informality, partly due to the softer ‘b’ sounds. This conceptual distinction, driven by the names’ auditory qualities, further separates the brands in the minds of consumers.”

75. It appears to me that here the applicant is eliding the conceptual comparison with the aural comparison. In *Retail Royalty Company v Harringtons Clothing Limited*, BL O/593/20, Mr Philip Harris, sitting as the Appointed Person, explained that:

> "75. … conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trade mark acknowledgement) or a level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken."

76. I do not consider that the meanings posited by the applicant are immediately perceptible by the average consumer. I have already said that I consider that a significant proportion of consumers would perceive the earlier mark to be an invented word. I also take the view that they would come to the same conclusion with respect to the contested mark. Neither mark has a concept and therefore no conceptual comparison can be made. If the consumer were to be aware of the Scots word "giffgaff", the earlier mark would have a meaning while the contested mark would not.

Distinctive character of the earlier mark

77. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> "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)."

78. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, 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 the mark can be enhanced by the use that has been made of it. As I have found that a significant proportion of average consumers would believe the earlier mark to be an invented word, it would have a high level of inherent distinctive character. Even if the average consumer were aware of the Scots word, this is not immediately allusive of the services provided and so I would find that the mark would have a medium level of inherent distinctive character.

79. I turn now to consider whether the inherent distinctive character has been enhanced through the use made of the mark for the services at issue. These are *Message sending by means of mobile telecommunications*, which I have already found would be a service that the average consumer would expect a mobile telecommunications supplier to provide. The mark has been in use since 2009 and the turnover figures in paragraph 27 above show a year-on-year increase. New customers were also being attracted to the business between 2018 and 2022. The mark features in reviews of mobile telecommunications providers and has won awards listed in paragraph 34. The opponent has also used the mark in sponsoring television programmes between 2012 and 2018. Taking the evidence as a whole, it is my view that the distinctive character of the earlier mark has been enhanced to a very high degree (for those consumers who believe the word to be invented) and to a high degree (for those consumers who understand the Scots word).

Conclusions on likelihood of confusion

80. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the services at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. There is no law setting out

precisely what weight should be attached to each of the factors or providing a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services or vice versa.

81. Earlier in my decision, I found that:

a) The contested services are similar to a medium to high degree to the opponent's *Message sending by means of mobile telecommunications*;

b) The average consumer is a member of the general public, paying a medium degree of attention, in what is largely a visual purchasing process. However, I do not discount the possibility of word-of-mouth recommendations;

c) The average consumer would perceive the earlier mark as an invented word, although there may be some who are aware of its meaning in Scots. The overall impression of the mark lies in this word;

d) The verbal element "GibGab" is the dominant and distinctive element of the contested mark;

e) The marks are visually and aurally similar to at least a medium degree;

f) For those consumers who see both words as invented, neither has a concept;

g) For those consumers who understand the meaning of "giffgaff", the marks are conceptually different;

h) The earlier mark has a high degree of inherent distinctive character for those consumers who believe it to be an invented word, and a medium degree for those who understand its meaning. This distinctive character has been enhanced to a very high and a high level respectively.

82. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that

the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc,* BL O/375/10, at [16].

83. The applicant submits that there is no evidence of any confusion between the marks. In *Maier & Anor v ASOS & Anor*, [2015] EWCA Civ 220, Kitchin LJ (as he then was) said that:

> "80. … the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur."

84. There is no evidence from the applicant to suggest that the contested mark has been used and so this submission does not help its case.

85. To my mind, this is a case in which there is either a likelihood of direct confusion or no likelihood of confusion at all. If the average consumer recognises that the marks are different, I see no reason why they should believe that they are two marks belonging to the same undertaking or to connected undertakings. The differences between the marks are not those common to brand extensions or sub-brands.

86. Given the imperfect recollection of the average consumer and the enhanced distinctive character of the earlier mark, it is my view that there is a likelihood of confusion between the two marks, as the services are similar to a medium to high degree. For a significant proportion of consumers, there will be no conceptual content

to help them distinguish between the marks and the shared pattern of syllables beginning with “GI” and “GA” will make mistakes likely to occur.

87. It is my view that the medium to high degree of visual (and aural) similarity between the marks point towards a likelihood of direct confusion, given the imperfect recollection of the average consumer, the enhanced distinctive character of the earlier mark, and the medium to high degree of similarity between the services. For a significant proportion of consumers, there will be no conceptual content to help them distinguish between the marks. I find it is likely that these consumers will mistake one mark for the other and be directly confused. In *Comic Enterprises Ltd v Twentieth Century Fox Film* Corporation [2016] EWCA Civ 41, the Court of Appeal held that if the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court, then it may properly find infringement. The same principle applies in opposition proceedings. In my view, the proportion of consumers likely to be confused is sufficient for the opposition to succeed under section 5(2)(b).

88. The opposition has succeeded where the services are those in respect of which the applicant denied any similarity and which were included in the opponent’s statement of grounds as well as the defence by the applicant. Consequently, it would put the applicant in no better position to invite either party to amend its pleadings.

89. Although the opposition has succeeded under section 5(2)(b), I shall for the sake of completeness briefly consider the claim made under section 5(3).

Section 5(3)

90. Section 5(3) of the Act is as follows:

> “A trade mark which-
>
> (a) is identical with or similar to an earlier trade mark,
>
> […]
>
> shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due

cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

91. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. I have already made this finding under section 5(2)(b). Secondly, the opponent must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

92. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). The law appears to be as follows:

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

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

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

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks

and between the goods and/or services, the extent of the overlap between the relevant consumers for those goods and/or services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

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

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

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

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

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

j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of

the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal.*

Reputation

93. In *General Motors*, the CJEU held that:

"24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade

mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

94. As with the assessment of proof of use, the relevant territory is the EU up to 31 December 2020 and the UK thereafter until the relevant date of 5 February 2023.

95. On the basis of the evidence that I have summarised earlier in my decision, I am satisfied that the earlier mark has a strong reputation for mobile telecommunications services. I accept that the evidence focuses on the UK market, but the CJEU held in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case 301/07, that *"the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community".*[25] The reputation is for a provider that views its customers as a community and uses them to generate new business, develop new ideas and provide advice to other customers. The *Marketing Week* article dated 30 August 2017 states that *"Community is king at Giffgaff"* and *"Fundamentally the company takes its 'mobile network powered by you' position seriously, nurturing a highly engaged community of members who are rewarded for their level of interaction".*[26] A *Daily Telegraph* article said on 26 May 2015 that *"The company's entire business model rests on its community: members not only help new customers, they recruit new 'Gaffers' to the network, and come up with strategies to grow the business."*[27]

96. I turn now to the goods. In my summary of the evidence, I have referred to the opponent's business selling handsets, which accounted for between 10.6% and 12% of revenue between 2018 and 2022. Exhibit AS3 contains a printout showing a range of mobile telephone handsets for sale in the "Black Friday" pre-Christmas sale period running up to 6 December 2023. This is after the relevant date. Even so, the handsets shown are produced by Apple and Samsung. There is no evidence that the opponent has been using the earlier mark for the handsets themselves; rather they appear to have used the mark for the associated retail services. The Class 9 specification also contains the term *SIM Cards*. It is clear from the evidence that the opponent supplies free SIM cards which then need to be activated to enable use of the opponent's

[25] See [20]-[30].
[26] Exhibit AS7, pages 63-64.
[27] Exhibit AS8, page 82.

telecommunications services. In my view, the reputation is attached to these services, rather than to the supply of SIM cards. I shall therefore proceed on this basis.

Link

97. In assessing whether the relevant public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel* at [42]. I have already set out my findings on the strength of the reputation of the earlier mark. I shall now consider the remaining factors.

The degree of similarity between the conflicting marks

98. I adopt the findings I made under section 5(2)(b): that the marks are similar to at least a medium degree and aurally similar to a medium to high degree and that they are conceptually neutral (where the average consumer does not understand the meaning of "GIFFGAFF") or dissimilar (where the average consumer is aware of the meaning).

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

99. Earlier in my decision, I found that the average consumer would expect a mobile telecommunications service to involve a number of different services, including message sending, which I found to be similar to the contested services to a medium to high degree. I note here that I found that both parties' services would be targeted towards the same users.

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

100. The earlier mark has a high degree of inherent distinctive character for those consumers who believe it to be an invented word, and a medium degree for those who understand its meaning. This distinctive character has been enhanced to a very high and a high level respectively.

Whether there is a likelihood of confusion

101. I found there to be a likelihood of direct confusion under section 5(2)(b).

Conclusions on link

102. Where there is a likelihood of confusion, there is automatically a link created in the mind of the relevant public: see *Intel* at [57].

Damage

103. The opponent submits that it also follows from a finding of a likelihood of confusion that there will be damage through unfair advantage, and refers me to the paragraph from *Intel* to which I have just referred. However, that paragraph solely concerns the effect of a likelihood of confusion on the existence of a link. A finding of damage requires a change in the economic behaviour of the customers for the services offered under the contested trade mark (in the case of unfair advantage) or of the customers for the services offered by the opponent (in the case of detriment).

104. I shall deal first with the claim of unfair advantage. In *L'Oréal*, the CJEU said:

> "50. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

105. Earlier in the same case, the CJEU also said:

> "41. As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a

transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation."

106. In my view, the reputation of the opponent as a community-based operation is an image that would be attractive in the context of social networking services. The likelihood that the public would mistake one mark for the other means that the image of the earlier mark is likely to be transferred to the contested mark, which is likely to result in that later mark appearing more attractive to the consumer. Such an advantage would be unfair as the applicant would not have invested the same time and resources in developing such an image, and would benefit from the investment made by the opponent. I find that the claim of unfair advantage is made out and, as the applicant has not claimed that it has due cause to use the contested mark, the opposition succeeds under section 5(3).

OUTCOME

107. The opposition is successful and Application No. 3874720 is refused registration.

COSTS

108. The opponent has been successful in these proceedings and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 1/23. In the circumstances, I make the following award:

£250 for preparing a statement and considering the other side's statement.
£1000 for preparing evidence.
£350 for preparing of written submissions in lieu of a hearing.
£200 to cover official fees.
£1800 in total

109. I have awarded sums at the bottom of the scale for preparing a statement and preparing written submissions in lieu of a hearing. This is because of the concerns I have raised about the particularisation of the pleadings, and because the written submissions contained arguments based on two marks that were not in fact earlier marks.

110. I therefore order GibGab Ltd to pay Telefonica UK Limited the sum of £1800. This sum is to 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 17th day of December 2024

Clare Boucher
For the Registrar,
Comptroller-General

Annex

Relevant Goods and Services of the Earlier Mark

Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; digital telecommunication apparatus and instruments; digital tablets; tablet computers; computer hardware; computer application software; computer software downloadable from the Internet; recorded computer software; software applications; mobile software applications, downloadable applications for multimedia devices; computer games; computer game software; computer software applications, downloadable; computer games programs; PDAs (Personal Digital Assistants); pocket PCs; mobile telephones; selfie sticks [hand-held monopods]; smart rings; smartphones; smartwatches; laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; protective clothing; protective helmets; televisions; headphones; global positioning system [GPS] apparatus; satellite navigation devices; computer software recorded onto CD Rom; SD-Cards (secure digital cards); glasses; spectacle glasses; sunglasses; protective glasses and cases therefor; contact lenses; cameras; camera lenses; MP3 players; audio tapes, audio cassettes; audio discs; audio-video tapes; audio-video cassettes; audio-video discs; video tapes; video cassettes; video discs; CDs, DVDs; downloadable electronic publications; downloadable image files; downloadable music files; mouse mats; magnets; mobile telephone covers; mobile telephone cases; hands free kits for phones; magnetic cards; encoded cards; mobile phone application software; software for telecommunication; software for the processing of financial

transactions; electronic notice boards; electric batteries; battery chargers; security alarms; security cameras; security warning apparatus; security control apparatus; security surveillance apparatus; computer software for security purposes; computer software for insurance purposes; SIM cards; interactive touch screen terminals; aerials; alarms; electric cables; chemistry apparatus and instruments; recorded computer operating programs; computer peripheral devices; data processing apparatus; diagnostic apparatus, not for medical purposes; distance measuring apparatus; distance recording apparatus; downloadable ring tones for mobile phones; electronic tags for goods; eyepieces; goggles for sports; magnetic identity cards; intercommunication apparatus; loudspeakers; magnetic data media; mathematical instruments; modems; electric monitoring apparatus; television apparatus; testing apparatus not for medical purposes; telecommunication transmitters; parts and fittings for all the aforesaid goods.

Class 38

Telecommunications; cable television broadcasting; cellular telephone communication; communications by computer terminals; communications by fiber [fibre] optic networks; communications by telephone; computer aided transmission of messages and images; electronic bulletin board services [telecommunications services]; electronic mail; facsimile transmission; information about telecommunication; message sending; paging services [radio, telephone or other means of electronic communication]; providing access to databases; providing internet chatrooms; providing telecommunication channels for teleshopping services; providing telecommunications connections to a global computer network; providing user access to global computer networks; radio broadcasting; rental of telecommunication equipment; rental of telephones; satellite transmission; telecommunications routing and junction services; teleconferencing services; telegraph services; telephone services; television broadcasting; telex services; transmission of digital files; transmission of greeting cards online; transmission of telegrams; voice mail services; wire services; wireless broadcasting; telecommunications services; provision of broadband telecommunications access; broadband services; wireless communication services; digital communication services; broadcasting services; television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; Internet access services; email and text messaging

services; telecommunications information provided via telecommunication networks; services of a network provider, namely rental and handling of access time to data networks and databases, in particular the Internet; communications services for accessing a database; leasing of access time to a computer database; providing access to computer databases; rental of access time to a computer database; operation of a network, being telecommunication services; providing electronic bulletin board services; providing access to weblogs; providing access to podcasts; chatroom services for social networking; providing online forums; forums for social networking; providing access to computer database in the fields of social networking, social introduction and dating; providing electronic telecommunication connections; routing and connecting services for telecommunications; rental of telecommunications equipment; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

Class 45

Legal services; security services for the physical protection of tangible property and individuals; security services for the protection of property and individuals; management and use of copyright; arbitration services; babysitting; baggage inspection for security purposes; chaperoning and escorting in society [chaperoning]; clothing rental; copyright management; dating services; guards; intellectual property consultancy; legal research; licensing of intellectual property; licensing of computer software [legal services]; introduction and social networking services; on-line social networking services; social introduction, networking and dating services; dating services provided through social networking; providing information in the field of personal relationships; preparation of personality profiles; security services; security guard services; security marking of goods; security assessment of risks; monitoring of security systems; public events security services; rental of security apparatus; security inspection services for others; bodyguard services; leasing of internet domain names; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.