

O/0040/26

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001732340

DESIGNATING THE UK

IN THE NAME OF MWR HOLDINGS, LLC

FOR THE TRADE MARK:

TWO PLUS TOUCAN

IN CLASSES 9, 38, 41 AND 42

AND

AN OPPOSITION THERETO UNDER NO. 443057

BY AGAPE MINISTRIES LTD

BACKGROUND AND PLEADINGS

1. The international registration shown on the cover page of this decision (“the IR”) was registered on 6 December 2022 in the name of MWR Holdings, LLC (“the holder”). With effect from the same date, the holder designated the UK as a territory in which it sought to protect the IR pursuant to the Protocol to the Madrid Agreement. A priority date of 6 June 2022 is claimed. Protection is sought for the goods and services shown in Annex 1 to this decision.

2. On 15 September 2023, the application to protect the IR in the UK was opposed by Agape Ministries Ltd (“the opponent”) based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under section 5(2)(b) of the Act, the opponent relies upon UKTM no. 3210046 for the trade mark TOUCAN, which was filed on 1 February 2017 and registered on 12 May 2017. The opponent relies upon some of the goods and services for which the mark is registered, as set out in Annex 2 to this decision. The opponent claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

4. Under section 5(4)(a) of the Act, the opponent relies upon the sign TOUCAN, which it claims to have used throughout the UK since as early as 2017 in relation to: “Printed matter; bookbinding material; photographs; stationery and office requisites, except furniture; adhesives for stationery or household purposes; instructional and teaching materials”. The opponent claims that use of the IR would be contrary to the law of passing off.

5. The holder filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use.

6. Neither party requested a hearing, and only the opponent filed written submissions in lieu. This decision is taken following careful consideration of the papers on file.

REPRESENTATION

7. The holder is represented by Bailey Walsh & Co LLP.

8. The opponent is represented by Mathys & Squire LLP.

EVIDENCE AND SUBMISSIONS

9. The opponent filed evidence in the form of the witness statement of Kathryn Thurston dated 2 September 2024, which is accompanied by 13 exhibits (KT1 to KT13). Ms Thurston is Digital Strategies Director for the opponent, a position she has held since October 2022.

10. The holder did not file evidence or submissions.

11. The opponent filed written submissions in lieu dated 11 December 2024.

RELEVANCE OF EU LAW

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

DECISION

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

“5(2) A trade mark shall not be registered if because –

(a)...

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

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

14. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

15. Given its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years prior to the filing date, it is subject to the use provisions in section 6A of the Act.

Proof of use

16. The relevant statutory provisions are as follows:

“6(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

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

17. Section 100 of the Act is also relevant, which reads:

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

18. The relevant period for assessing genuine use is the five-year period ending with the priority date of the IR i.e. 7 June 2017 to 6 June 2022.

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

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

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

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the

characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

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

Variant Use

21. There is evidence of the opponent using the word only mark TOUCAN, which will clearly be use upon which the opponent can rely. However, there are also other forms used by the opponent in the evidence, as follows:



(c) TOUCAN TOGETHER



22. Example (a) is acceptable use of the earlier mark as registered, as the use in colour and a different font will be covered by notional and fair use of the earlier mark (which is a word mark) and the addition of the device is simply use in conjunction with another mark, which is acceptable.¹ I note that example (b) contains an additional word. However, this is positioned in a smaller font below the word TOUCAN, meaning that the word TOUCAN is likely to still be viewed as indicative of the origin of the goods/services in issue. Consequently, I find this to be use upon which the opponent can rely.

23. I find the position to be less clear cut in respect of examples (c) and (d) because the positioning of the words side-by-side is more likely to indicate that they should be read as a unit. However, in combination these words have no clear meaning, nor have the parties suggested that there is any meaning attributable to them in combination. The word TOUCAN would, in my view, continue to indicate origin. Consequently, I also find this to be use upon which the opponent can rely.

¹ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

Sufficient Use

24. Ms Thurston explains that the opponent is the UK-arm of an international charity. The earlier mark is used in relation to a mobile and web application which assists couples with their relationship, based on Christian values. The application includes information and guidance about how to work through conflict within a relationship, learning about each other's "love languages" and exercises to improve communication.² Whilst I note that there are some (very limited) references to children in the app, these appear to be in the context of how to navigate the impact that children might have on a relationship. I note that example (a) appears on the opponent's website, as far back as 2017.³ There are also pages from within the relevant period which display example (b).

25. From the start of 2018, up to and including, January 2022, there were over 100,000 unique visitors to the opponent's website relating to the app.⁴ During the same period, there were over 8,000 downloads of the mobile application. I bear in mind that there is no information regarding whether these visitors are UK-based visitors. However, given that the opponent only operates within the UK, that seems to me to be a reasonable inference.

26. In addition to the app, the opponent publishes blog posts on the subject of improving relationships. There are examples of these in evidence dating back to 2020, which display examples (c) and (d).⁵ I note that there is some suggestion that the opponent also publishes physical materials under the earlier mark, but these all appear to me to be promoting the goods offered by the opponent under the mark or services offered by the opponent which are not offered under the mark at all, rather than being an attempt to create or maintain a market in those particular physical materials.⁶

² See exhibit KT7 and paragraph 17 of Ms Thurston's statement.

³ Exhibit KT3

⁴ Exhibit KT4

⁵ Exhibit KT9

⁶ Exhibit KT10

27. Between 2019 and 2022, the opponent spent at least £35,000 on promoting the earlier mark. The app is funded by donations, as the opponent is a charitable organisation, with the opponent having raised £130,000 to develop the first module of it by 2017. Since then, the opponent has spent over £200,000 on developing the app.

28. I note that there is a print out from the opponent's website advertising a live webinar under the earlier mark.⁷ However, this took place on 16 May 2024 which is well after the relevant period. Consequently, I do not consider that this assists the opponent.

29. Taking the evidence as a whole into account, I am satisfied that there has been genuine use of the earlier mark in relation to a mobile and web application for teaching and guiding couples about how to improve their relationship, and also in relation to electronic blog posts on the same subject.

Fair Specification

30. I now turn to consider what is a fair specification for the earlier mark. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

31. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, 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.

⁷ Exhibit KT10

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 subcategories.

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.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

32. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for

example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

33. There is no evidence of use by reference to the mark in relation to any physical equipment in class 9. The only use shown in this class is in relation to a mobile and web application and online (non-downloadable) blog posts. Both of these are on the subject of improving relationships. The terms in this class are subject to the following limitation:

“all the aforesaid goods to be used in relation with education and training or personal and social services rendered by others to meet the needs of individuals.”

34. I have no submissions as to how this term should be interpreted. In my view, it means that the goods must be used in relation to either education and training or personal and social services rendered by others to meet the needs of individuals. I consider that the use of the mobile and web application shown falls within the former category i.e. it relates to education and training on the topic of relationships. I consider this to be a sub-category of the software goods in class 9. I note that there is also evidence of genuine use in relation to electronic (non-downloadable) blog posts on the same topic. This would be covered by the term “electronic publications” in the opponent’s class 9 specification. I do not consider that the opponent’s use, which relates only to blog posts, would justify retention of the broader term which could also include publications in a variety of other formats.

35. I have considered whether the use shown could support a specification of publishing in class 41. However, as the opponent only appears to be posting its own blog posts (as opposed to providing a publishing service to others), I do not consider that it does. Whilst I note that the opponent has educational services in class 41, there is no evidence which demonstrates genuine use of educational services per se, outside of the application (which would fall within class 9). There also does not appear to be any other services in class 41 which can be supported by the evidence of use shown during the relevant period.

36. I also have seen no evidence which convinces me that there has been genuine use in relation to the services in class 45; there does not appear to be any social networking features within the app, for example. Whilst I note that the opponent has the term “consulting in the field of personal relationships” in class 45, there is no evidence of genuine use in relation to these services outside of the application (which, again, would be in class 9). Consequently, I do not consider that there is any genuine use in class 45.

37. Taking all of this into account, I consider a fair specification to be:

Class 9 Mobile and web applications; electronic publications in the form of blogs; all the aforesaid goods to be used in relation with education and training on the subject of relationships.

Section 5(2)(b) – case law

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of goods and services

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

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

40. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

Class 9

Downloadable software in the nature of a mobile application for providing content in the field of early childhood education; downloadable software in the nature of a mobile application for providing content, namely, audio, videos, shows, text and graphic works in the field of early childhood education.

41. These terms could include computer software for use by children which is aimed at education of the user, or it could include software in the field of early childhood education more generally (such as apps used by teachers or parents who wish to gain more knowledge about childhood education). The nature and method of use of the goods will clearly overlap with the opponent's goods because they are all software; specifically, mobile applications. The purpose of the goods will also overlap to the extent that they are all educational in nature. However, there is a difference between their specific purposes created by the differing topics i.e. education about relationships on the one hand and early childhood education on the other. There may be some overlap in user, as they could all be used by the general public. The goods are not complementary because they are not important or indispensable for each other.⁸ There is no competition given the differing subject matters. I have no evidence before me to suggest that there would be an overlap in trade channels, beyond the very high-level overlap that they may be sourced from the same app stores on a mobile phone. In my view, the goods are similar to between a low and medium degree.

Downloadable computer game software for use on mobile and cellular phones and handheld computers in the field of early childhood education.

42. This is computer game software for use in early childhood education. Consequently, this is likely to align with the former category of software discussed above i.e. software for use by children which has both an entertainment and educational function. Consequently, the same finding applies as discussed above.

⁸ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

Class 38

Streaming of audio, visual and audiovisual material via a global computer network in the field of early childhood education; streaming of children television shows and videos via a global computer network.

43. The nature and method of use of these services differ to the opponent's goods on the basis that they are a streaming service, whereas the opponent's goods are software or electronic publications. The purpose of the goods and services overlap in that they all have an educational aspect to them, but their specific purposes differ (with the opponent's being for improving relationships and the holder's being the streaming of materials related to early childhood education or children's entertainment). The user may overlap as they could all be used by members of the general public. However, I have no evidence before me to suggest that there would be an overlap in trade channels. The goods and services are not important or indispensable to each other, meaning that they are not complementary. There is no competition given the differing subject matter. Consequently, I find the goods and services to be dissimilar.

Class 41

Providing online non-downloadable videos in the field of early childhood education; educational and entertainment services, namely, providing online content in the field of early childhood education; educational and entertainment services, namely, providing online content comprising audio, videos, shows, text and graphic works in the field of early childhood education; educational and entertainment services, namely, providing online interactive children's stories; providing temporary use of non-downloadable computer learning games, interactive games, and educational video games.

44. Again, there is an overlap in purpose with the opponent's goods, by virtue of them all having an educational element to them. However, given the differing subject matters, the specific purposes are different (the opponent's being improving relationships and the holder's being related to early childhood education). The user

may overlap at a very general level, as they could all be used by members of the general public. However, the nature clearly differs. There is no competition or complementarity, for the same reasons discussed above. I have no evidence before me to suggest an overlap in trade channels. In my view, the goods and services are dissimilar.

Class 42

Providing online non-downloadable computer game software.

45. This term could include game software for children which has an educational aspect to it. There is, therefore, some overlap in purpose at a very general level although, as discussed above, the specific purpose would differ. However, by virtue of the fact that this is online software which is not downloadable, these services differ in nature and method of use to those of the opponent. The user may overlap as they could both be used by members of the general public. There is no competition or complementarity for the reasons discussed above. Again, I have no evidence to suggest an overlap in trade channels, nor do I consider it likely. In my view, the goods and services are dissimilar.

46. As some degree of similarity of goods and services is necessary for a successful opposition under section 5(2), the opposition must fail in respect of those goods/services that I have found to be dissimilar.⁹

The average consumer and the nature of the purchasing act

47. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

⁹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

48. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

49. The average consumer for the goods will be a member of the general public or a professional in the field of education. The average consumer is likely to take factors such as recommendations, in-app features and useability into account when purchasing the goods. They are likely to be purchased relatively infrequently but are unlikely to attract a high cost (if, indeed, they are chargeable at all at the point of purchase). In my view, a medium degree of attention will be paid during the purchasing process, although I recognise that a professional may pay a slightly higher degree of attention.

50. The goods are likely to be selected following perusal of signage on websites and in app-stores and on advertisements. Consequently, visual considerations will dominate the purchasing process. However, I do not discount an aural component to the purchase given that word-of-mouth recommendations may play a part.

Comparison of trade marks

51. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impression created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

53. The respective trade marks are shown below:

Opponent's trade mark	The IR
TOUCAN	TWO PLUS TOUCAN

54. The opponent's mark consists of the word TOUCAN. There are no other elements to contribute to the overall impression, which resides in the word itself.

55. The IR consists of the words TWO PLUS TOUCAN. The opponent submits that in the context of goods and services relating to childhood education the words “TWO PLUS” are likely to be seen as referring to the age range of the intended user. As such, the opponent submits that the words are descriptive. I accept that a significant proportion of average consumers are likely to view the mark in that way, in the context of goods which are aimed at children or childhood education. Consequently, the word TOUCAN plays the greater role in the overall impression of the mark.

56. Visually and aurally, the marks overlap in the presence of the word TOUCAN. The words TWO PLUS in the IR are points of visual and aural difference. In my view, the marks are visually and aurally similar to a medium degree.

57. Conceptually, the word TOUCAN will be understood as referring to a type of bird. It will have the same meaning in both marks. The words TWO PLUS will, for the significant proportion of average consumers in question, be understood as meaning that the app is applicable to those over the age of two. This is a point of conceptual distinction, albeit not a distinctive one. In my view, the marks are conceptually similar to between a medium and high degree.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

59. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

60. The earlier mark consists of the word TOUCAN, which is an ordinary dictionary word. It has no apparent connection with the goods in issue, nor have the parties suggested that there is one. In my view, the earlier mark is inherently distinctive to a medium degree (albeit at the higher end of medium, given that it is a somewhat unusual word in the context of the goods). Whilst the opponent has filed evidence of use, which I have summarised above, I do not consider it sufficient to establish enhanced distinctiveness. I have no evidence of market share and, whilst sufficient to establish genuine use, the evidence does not suggest to me that use has been on a scale and of an intensity that would be consistent with a business that has acquired enhanced distinctiveness.

Likelihood of confusion

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

trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

62. I have found as follows:

- a. The goods and services are similar to between a low and medium degree (except where I have found them to be dissimilar).
- b. The average consumer is a member of the general public or a professional user who will pay a medium (or slightly higher than medium) degree of attention during the purchasing process.
- c. The purchasing process is predominantly visual, although I do not discount an aural component.
- d. The marks are visually and aurally similar to a medium degree.
- e. The marks are conceptually similar to between a medium and high degree.
- f. The earlier mark is inherently distinctive to a medium degree (albeit at the higher end of medium).

63. For the significant proportion of average consumers who view the words TWO PLUS as indicating the age suitability of the content of the app, they may only recall the distinctive element (being the word TOUCAN), when factoring in the principle of imperfect recollection. In those circumstances, there is a likelihood of direct confusion for those goods that I have found to be similar.

64. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

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

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

66. I bear in mind that the word TOUCAN cannot be said to be strikingly distinctive as per the first category of *LA Sugar*. However, it is at the higher end of medium in terms of distinctiveness and, in my view, is sufficiently distinctive that you would expect only one undertaking to be using it in relation to similar goods. Alternatively, the addition of the words TWO PLUS are likely to be seen as a non-distinctive addition indicating that the app is aimed at those who are over two or contains content which relates to the education of those over two. Consequently, I find there to be a likelihood of indirect confusion for those goods that I have found to be similar.

67. The opposition based upon section 5(2)(b) of the Act is partially successful.

Section 5(4)(a)

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

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

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

aa)...

b) ...

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

69. I can deal with this ground relatively swiftly. I have summarised the opponent’s evidence of use above. This ground is reliant upon a different range of goods than those relied upon under section 5(2)(b). However, the evidence filed does not support the claim that the opponent has used the sign relied upon for the goods specified. The only possible aspect of the pleaded case that the opponent could rely upon is “instructional and teaching materials” which might include the blog posts for which there is evidence of use. However, the fields of activity would be sufficiently distant that the opponent would be in no stronger position than described under section 5(2)(b). This ground does not, therefore, improve the opponent’s case.

CONCLUSION

70. The opposition is successful in relation to the following goods for which, subject to appeal, the application is refused:

Class 9 Downloadable software in the nature of a mobile application for providing content in the field of early childhood education; downloadable software in the nature of a mobile application for providing content, namely, audio, videos, shows, text and graphic works in the field of early childhood education; downloadable computer game software for use on mobile and cellular phones and handheld computers in the field of early childhood education.

71. The opposition is unsuccessful in relation to the following goods and services for which the application may proceed to registration:

Class 38 Streaming of audio, visual and audiovisual material via a global computer network in the field of early childhood education; streaming of children television shows and videos via a global computer network.

Class 41 Providing online non-downloadable videos in the field of early childhood education; educational and entertainment services, namely, providing online content in the field of early childhood education; educational and entertainment services, namely, providing online content comprising audio, videos, shows, text and graphic works in the field of early childhood education; educational and entertainment services, namely, providing online interactive children's stories; providing temporary use of non-downloadable computer learning games, interactive games, and educational video games.

Class 42 Providing online non-downloadable computer game software.

COSTS

72. The holder has enjoyed the greater degree of success and, consequently, is entitled to a contribution towards its costs, based upon the scale set out in Tribunal Practice Notice 1/2023. I have applied an appropriate reduction for the only partial success. In the circumstances, I award the holder the sum of **£700**, calculated as follows:

Preparing a Counterstatement and considering the Notice of opposition	£200
Considering the opponent's evidence and submissions	£500
Total	£700

73. I therefore order Agape Ministries Ltd to pay MWR Holdings, LLC the sum of **£700**. 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 22nd day of January 2026

S WILSON

For the Registrar

ANNEX 1

Class 9

Downloadable software in the nature of a mobile application for providing content in the field of early childhood education; downloadable software in the nature of a mobile application for providing content, namely, audio, videos, shows, text and graphic works in the field of early childhood education; downloadable computer game software for use on mobile and cellular phones and handheld computers in the field of early childhood education.

Class 38

Streaming of audio, visual and audiovisual material via a global computer network in the field of early childhood education; streaming of children television shows and videos via a global computer network.

Class 41

Providing online non-downloadable videos in the field of early childhood education; educational and entertainment services, namely, providing online content in the field of early childhood education; educational and entertainment services, namely, providing online content comprising audio, videos, shows, text and graphic works in the field of early childhood education; educational and entertainment services, namely, providing online interactive children's stories; providing temporary use of non-downloadable computer learning games, interactive games, and educational video games.

Class 42

Providing online non-downloadable computer game software.

ANNEX 2

Class 9

Communications equipment; communications networks; communication software; computer databases; computer networking and data communications equipment; computer programmes; computer programs; computer software; computer software programs; computer software [programmes]; databases; downloadable electronic publications; electronic publications; media content; parts and fittings for communications apparatus; software; software for computers; all the aforesaid goods to be used in relation with education and training or personal and social services rendered by others to meet the needs of individuals.

Class 41

Providing electronic publications; publishing of electronic publications; providing online electronic publications; electronic publications (not downloadable); provision of on-line electronic publications (not downloadable); arrangement of conferences for educational purposes; arrangement of conferences for recreational purposes; arrangement of conventions for recreational purposes; arrangement of conventions for educational purposes; arranging and conducting of workshops and seminars; arranging and conducting of games; adult training; adult tuition; arranging and conducting of training workshops; arranging and conducting of workshops; arranging and conducting of training courses; arranging of training courses; coaching; conducting of educational events; conducting workshops [training]; consultancy services relating to vocational skills; education information; education (Religious -); education services relating to religion; educational services; guidance (Vocational -) [education or training advice]; health and wellness training; health education; instruction services; life coaching (training); personal coaching [training]; personal development courses; personal development training; providing of training; providing of training in the field of health care and nutrition; provision of educational health and fitness information; provision of training courses; religious education; religious educational services; religious training; self-awareness courses [instruction]; training; training and further training consultancy; training and instruction; training courses; training services; training services relating to health and safety; vocational guidance; vocational guidance [education or training advice]; vocational retraining; vocational

skills training; vocational skills training (provision of -); workshops (Arranging and conducting of -) [training]; all the aforesaid services to be used in relation with education and training or personal and social services rendered by others to meet the needs of individuals.

Class 45

Arrangement of conferences for personal and social services; arrangement of conventions for personal and social services; arranging and conducting of workshops and seminars for personal and social services; computer software licensing; consulting in the field of personal relationships; counselling relating to spiritual direction; internet-based social networking services; licensing of computer software; licensing of computer programs; on-line social networking services; online social networking services; online social networking services accessible by means of downloadable mobile applications; providing information about religion; spiritual advice; spiritual consultancy.