O/0133/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003898845
BY TICK TICK TRADER LTD AND ABDERRAZAK BOUKILI MAKHOUKHI
TO REGISTER THE FOLLOWING TRADE MARK:

TickTickTrader

IN CLASS 41

AND

AN OPPOSITION THERETO UNDER NUMBER 442257
BY TIKTOK INFORMATION TECHNOLOGIES UK LIMITED

BACKGROUND AND PLEADINGS

1. On 10 April 2023, Tick Tick Trader Ltd and Abderrazak Boukili Makhoukhi (jointly "the Applicant") applied to register the trade mark shown on the cover page of this decision in the UK ("the contested mark"). The application was accepted and published for opposition purposes on 28 April 2023 in respect of the following services:

Class 41: *Education and training.*

2. On 28 July 2023, TikTok Information Technologies UK Limited ("the Opponent") opposed the application in full based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). The Opponent relies upon the following trade mark:

Trade mark number UK00003469550 ("the earlier mark")
Representation: TikTok/Tik Tok (series of two)
Filing date: 24 February 2020
Registration date: 9 August 2020
Specification relied upon for section 5(2)(b):
Class 41: *Educational services; training services.*
Specification relied upon for section 5(3):
Class 9: *Software, application software.*
Class 45: *Online social networking services.*

3. Given its dates of filing and registration, the Opponent's mark qualifies as an earlier mark under section 6(1)(a) of the Act but is not subject to the use provisions at section 6A. For the purposes of this opposition, the Opponent may rely upon all the goods and services for which its mark is registered without proving use.

4. Under section 5(2)(b), the Opponent claims that the contested mark is similar to its earlier mark and that the services at issue are identical or, in the alternative, highly similar. On this basis, the Opponent claims there is a likelihood of confusion.

5. Under section 5(3), the Opponent claims to have a substantial reputation in the UK[1] in its earlier mark for the goods and services set out above. The Opponent claims that use of the contested mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

6. The Applicant filed a defence and counterstatement denying the entirety of the Opponent's claims, including denying any similarity between the goods and services. It was later admitted, at the hearing, that the services relevant to section 5(2)(b) are identical. It was also admitted that the Opponent's earlier mark has a reputation for *online social networking services* in Class 45, but not for *software, application software* in Class 9. I will return to these admissions at the relevant points in my decision.

7. During the evidence rounds, the Opponent filed evidence in chief alongside written submissions and the Applicant filed evidence in chief, but the Opponent did not file evidence in reply. A hearing took place before me on 17 March 2025. The Opponent was represented by Alison Cole of Taylor Wessing LLP; the Applicant was represented by Seaghan Davey of 11 South Square chambers, instructed by Trade Mark Wizards Limited.

EVIDENCE AND SUBMISSIONS

8. The Opponent filed evidence in chief in the form of the witness statement of Maya Muchemwa dated 27 February 2024 and its corresponding 20 exhibits (labelled "Exhibits A-T"). Ms Muchemwa is a Trade Mark Attorney at Taylor Wessing LLP, the Opponent's legal representatives. The accompanying submissions are dated 27 February 2024.

9. The Applicant filed evidence in chief in the form of the witness statement of Abderrazak Boukili Makhoukhi dated 29 April 2024 and one corresponding exhibit, comprising 240 pages (labelled "ABM"). Abderrazak Boukili Makhoukhi is the Applicant in these proceedings. I heard detailed submissions regarding the relevance of the

[1] The Opponent claims also to have a substantial reputation in the EU, though the relevant territory for these proceedings is the UK.

Applicant's evidence by both parties at the hearing. I will return to these if it becomes necessary to do so later in my decision.

10. I have taken the entirety of the evidence and submissions into account in reaching this decision and will refer to them below where necessary.

DECISION

Relevance of EU law

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

Section 5(2)(b)

12. Section 5(2)(b) of the Act states:

> "5(2) A trade mark shall not be registered if because –
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

Relevant law

13. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("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 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.

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of services

14. The Applicant's services are *education and training* in Class 41; the Opponent's services relied upon for this ground are *educational services; training services* in Class 41. It was admitted by the Applicant's representative at the hearing that these services are identical.

The average consumer and the purchasing act

15. It is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to

be selected by the average consumer. 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. (as he then was) 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

16. The parties' services are broad in nature and the average consumer could be any member of the general public, including businesses and professionals, interested in education or training services, in any field. The parties' respective positions on the purchasing process differ. The Opponent suggests the average consumer would pay a low to average degree of attention.[2] The Applicant argues a high degree of attention would be paid on the basis that education and training services are not an everyday purchase: they involve commitment as opposed to an impulse purchase. I agree with the Applicant; it is difficult to see why the average consumer would pay a low to medium degree of attention to the selection of these services. In fact, given the importance to either an individual or a business of selecting the most appropriate education or training provider, with consideration given as to the particular course offerings, facilities and resources, I would expect the average consumer to pay a high degree of attention to the purchase.

17. The services are most likely to be selected visually, following a review of printed materials or online materials. As a consequence, visual considerations are likely to dominate the process, although not to the extent that aural considerations in the form of word-of-mouth recommendations, for example, can be discounted.

[2] The Opponent's skeleton argument states "The Applicant's defence is silent on this point. This should be taken as an admission." The Applicant's defence was clear that it denied each of the Opponent's claims and so, whilst acknowledging it has since made concessions in relation to other pleadings, I do not consider the Applicant's position here to be an admission of the Opponent's position.

Comparison of marks

18. 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 impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

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

19. 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 trade 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.

20. The marks to be compared are as follows:

The earlier mark (series of two)	**The contested mark**
TikTok Tik Tok	TickTickTrader

Overall impression

21. The Opponent's position is that (i) the overall impression of its earlier mark lies in the mark as a whole and (ii) the word 'trader' in the contested mark is descriptive (referring to any trading entity) and will carry little to no weight in the overall impression, which lies in "TickTick". The Applicant disagrees with ignoring the word 'trader' on the basis it is not descriptive of the services.

22. The overall impression of the earlier mark resides in the element 'tiktok', whether presented as one word or two.

23. In regard to the contested mark, the meaning of 'trader' is a person involved in the activity of buying, selling or exchanging goods or services. The parties seem to be in agreement on the definition, but not on the weight it should be afforded in the mark. Whilst it is not the most distinctive word inherently, in my view, 'trader' is not directly descriptive of education and training services and plays a role in the overall impression of the mark, which resides in the mark as a whole.

24. The point of visual similarity between the marks is that the two words that make up the earlier mark and the first two words of the contested mark are short words (three and four letters, respectively), that all begin with the letter T and end with the letter K. The differences are the letter I versus O in the second word of each mark, and the presence of two letter C's and the additional word 'trader' in the contested mark. Balancing the similarities and differences, there is a medium degree of visual similarity between the marks.

25. The earlier mark will be pronounced, as two syllables, identically to the words 'tick tock' used in the English language to represent the sound that a clock makes. The contested mark will be articulated in its entirety, as the three ordinary words 'tick tick trader', comprising four syllables. The aural similarities lie in the identical first syllables and the beginning and end of the second syllables. The I versus O sound in the second syllable and the word 'trader' in the contested mark create the aural difference. Overall, I find there to be a medium degree of aural similarity between the marks.

26. The Opponent's position on the concepts of the marks is that both its earlier mark and the 'tick tick' element of the contested mark represent the sound of a clock; on the basis that trader is not distinctive in the contested mark, the Opponent suggests there is no conceptual difference between the marks.

27. The Applicant submits that the earlier mark is an invented word with no clear concept and that 'tick tick' in the contested mark refers to checking things off a list, specifically in relation to a trader given the inclusion of that word.

28. I remind myself that a relevant conceptual message is one which is capable of being immediately grasped by the average consumer.[3] I consider that the average consumer will immediately assign the earlier mark the concept of the sound of a clock. Whilst this is usually spelt 'tick tock', the identical pronunciation will cause a parallel between the two to be drawn.

29. The most likely concept associated with the contested mark is, as the Applicant suggested, checking or ticking things off a list, with the additional concept of a trader. Whilst I acknowledge that one definition of the word 'tick' solus is the sound made by a clock, when it is repeated and combined with the word 'trader' as in the contested mark, it is hard to see why consumers would see 'tickticktrader' and, absent the context of a clock, immediately think of the sound of one. Accordingly, I find the marks to be conceptually dissimilar.

Distinctive character of the earlier mark

30. In *Lloyd Schuhfabrik Meyer*, 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

[3] *Ruiz Picasso v OHIM*, [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

31. 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/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

32. At the hearing, the Opponent confirmed it was not pleading enhanced distinctiveness as the evidence did not support such a finding for the services relied upon under section 5(2)(b). As such, I will assess the inherent distinctive character of the earlier mark, which comprises the words 'tik tok', presented either as two words, or one. As discussed earlier, the earlier mark will be seen as a reference to the sound of a clock, though not spelt in the usual way. This has no clear meaning in relation to the services relied upon and I consider the mark to be inherently distinctive to a high degree.

Likelihood of confusion

33. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the

average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services 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 respective trade marks may be offset by a greater degree of similarity between the respective goods/services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the goods/services 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.

34. I have found the marks to be visually and aurally similar to a medium degree and conceptually dissimilar. I have found the earlier mark to have a high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public (including businesses and professionals) who, paying a high degree of attention, selects the services, which are identical, predominantly by visual means, though I have not discounted an aural element to the purchase.

35. The Opponent attests to a likelihood of both direct and indirect confusion. The difference between the two was described in the following terms by Iain Purvis KC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc:*[4]

> "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 recognised 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

[4] BL O/375/10.

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)."

36. The differences between the marks include the addition of two letter C's (one each between the letters I and K) in the contested mark, the letter I in the contested mark versus the letter O in a similar position in the earlier mark, as well as the entire word 'trader' at the end of the contested mark. Since direct confusion involves simply recalling one mark for the other with no process of reasoning, for me to be satisfied that there is such a likelihood requires me to find that the average consumer will misremember all of the aforesaid differences. I have borne in mind the interdependency principle and that the services are identical, as well as the tendency

for consumers to pay greater attention to beginning of marks[5] and that the first syllable of each mark is pronounced identically, with both beginning with the letters T and I. However, there are clear differences between the marks and, in my view, there are too many differences for the consumer to forget or not notice, particularly when considering the high level of attention paid and the different conceptual message portrayed by each mark. As such, I do not consider there to be a likelihood of direct confusion.

37. I turn now to indirect confusion. The examples given by Mr Purvis in *L.A. Sugar* are not exhaustive. Rather, they were intended to be illustrative of the general approach.[6]

38. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC, sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

39. Ms Cole explained the Opponent's position on indirect confusion at the hearing:[7]

> "There is also a significant risk of indirect confusion. Applying the *L.A. Sugar* criteria, TIKTOK is a strikingly distinctive mark as we have said. The Applicant has added the non-distinctive term TRADER and in fact TRADER is a logical and consistent extension of a brand. As I have said […] it would refer to anything that is being traded. The Opponent is also the owner of registrations for TIKTOK SHOP, TIKTOK PAY, TIKTOK LIVE, many […] uses and registrations for extensions of the brand, and TRADER would be seen as another. So the average consumer, on seeing TICKTICKTRADER, would believe it was a brand extension of the TIKTOK mark."

[5] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.
[6] See *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17 at [81] to [82].
[7] Transcript of the Stenograph Notes of Marten Walsh Cherer Ltd. made at the Hearing on 17 March 2025.

40. With respect to Ms Cole, I cannot see any logic in this argument. The contested mark is not simply 'tiktok' with the additional word 'trader'. It requires me to have found that consumers would first be mistaken, i.e. directly confused, between the "TickTick" component of the contested mark and "TikTok" and then assume a connection between the undertakings on the basis of the addition of the word 'trader'. Even taking account of the high degree of inherent distinctiveness of the earlier mark, "TickTick" and "TikTok" have clear differences as I have explained above, and I do not find that they will be misremembered for one another. Neither are those differences logical with any form of brand variation. There would be no plausible explanation for adding the two letter C's and changing the letter O to an I, or vice vera. I do not envisage a scenario, either falling into one of the categories suggested by Mr Purvis, or otherwise, whereby consumers assume the undertakings responsible for each mark are the same or related. There is no likelihood of indirect confusion.

Section 5(2)(b) outcome

41. The section 5(2)(b) ground of opposition has failed.

Section 5(3)

42. Section 5(3) states:

> "5(3) 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."

43. Section 5(3A) states:

"Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

44. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oréal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

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

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

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

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

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

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

(g) 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.*

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

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

45. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. 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 contested mark. 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.

Reputation

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

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

47. The Opponent relies upon its earlier mark in relation to *software, application software* in Class 9 and *online social networking services* in Class 45. The Applicant

conceded a reputation in relation to the Class 45 services, only, though did not stipulate the strength of such reputation. In any event, for reasons that will become apparent, I will proceed on the basis that the Opponent has a substantial[8] reputation for all the goods and services relied upon.

Link

48. My assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

49. The marks are visually and aurally similar to a medium degree and conceptually dissimilar.

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

50. I have not yet compared the Applicant's services to the goods and services relied upon by the Opponent under this ground. The competing goods and services are set out in the table below:

Earlier specification	**Contested specification**
Class 9: *Software, application software.* Class 45: *Online social networking services.*	Class 41: *Education and training.*

51. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services,

[8] As per the Opponent's pleadings.

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. As the General Court said in *Boston Scientific Ltd v OHIM*,[9] goods and services are complementary when:

> "…there is 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."

52. The judgment of Jacob J (as he then was) in *Avnet Incorporated v Isoact Limited* is also relevant:[10]

> "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

53. The Opponent suggests its Class 9 goods and the contested services are similar on the basis that software applications can include educational content. At the hearing, Ms Cole expanded on the argument, submitting that when comparing applications to education and training, "it is obvious that the uses are the same" given that education and training providers use an application to offer their services, resulting in the users, nature and trade channels being the same and there being a complementary relationship between the two. Ms Cole referred to the Opponent's evidence on this point: a Wikipedia printout referring to 'TikTok' as a social media platform that is used to make short-form videos in genres including education.[11]

54. I disagree with Ms Cole's assessment. The nature of software applications as goods is not the same as education and training services, neither are their purposes

[9] Case T-325/06.
[10] [1998] F.S.R. 16.
[11] Exhibit A.

the same. The core purpose of software applications is to enable users to accomplish particular tasks on computers or devices. The core purpose of education and training services is to enhance the users' knowledge or skills through a particular learning process. In line with *Avnet,* it is these core meanings that I will consider, as opposed to any services that would simply be considered incidental to the core purpose.

55. I have in mind that it may be appropriate to conclude complementarity between goods and services (even where the nature and purpose is different) in circumstances where they are used together, and the public will believe that the responsibility lies with the same undertaking.[12] However, even if the goods and services are almost always used together, it does not automatically follow that they are similar for trade mark purposes.[13] As such, even in circumstances where the provider of education and training services uses an application to offer those services, they are not so important for one another that consumers will assume the undertakings are the same or related. There is no complementary relationship between *software, application software* and *education and training services.* There is no other basis for a finding of similarity between these goods and services: the manner in which they are used and the way in which they reach their respective markets are different. The fact that users may overlap to the extent that they access the Applicant's services via the Opponent's goods is not sufficient, by itself, for a finding of similarity.

56. Turning to the Opponent's *online social networking services*, the Applicant suggests these are vastly different to its *education and training services.* Beyond the broad assertion that there is similarity between these services, I have no specific submissions from the Opponent. I see no obvious similarity between these services, which have, when considering their core meanings, entirely different purposes. If the Opponent's submissions referred to in the comparison with its software application goods were intended to be interpreted in relation also to its online social networking services, the same reasoning I gave there applies here. The fact that social networking services may have educational content, or that education and training providers may offer their services online via social networking does not mean the services are similar for trade mark purposes. Their respective users, methods of use and trade channels

[12] *Sanco SA v OHIM,* Case T-249/11.
[13] *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13.

do not overlap, and they are neither in competition nor complementary. I find no similarity between these services.

The strength of the earlier mark's reputation

57. I have proceeded on the basis that the earlier mark has a substantial reputation for the goods and services relied upon.

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

58. I did not assess the earlier mark's enhanced distinctiveness under section 5(2)(b) given the different goods and services relied upon under section 5(3). Whilst I do not consider that it materially improves the Opponent's case due to the earlier mark's high degree of inherent distinctive character, given my approach to proceeding on the basis of a substantial reputation, I will proceed also on the basis of an enhanced distinctive character in "TikTok/Tik Tok", to a very high degree.

Whether there is a likelihood of confusion

59. The relevant services under section 5(2)(b) were different to those relevant to this ground. Though the services were identical, I found there to be no likelihood of confusion. I bear in mind that the level of similarity required for the public to make a link between the marks for the purposes of section 5(3) may be less than the level of similarity required to create a likelihood of confusion under section 5(2)(b): *Intra-Presse SAS v OHIM.*[14]

60. As noted above, there does not need to be similarity between goods and services for a link to be found, but it is, nonetheless, a relevant factor. Despite the Opponent's substantial reputation and the earlier mark's high degree of inherent distinctive character (enhanced to a very high degree through use), the combination of the differences between the marks and the dissimilarity between the goods and services

[14] Joined cases C-581/13P & C-582/13P.

persuades me that no link will be made in the mind of consumers: seeing "TickTickTrader" in relation to education and training services will not bring 'TikTok' to mind.

Section 5(3) outcome

61. The section 5(3) ground of opposition is dismissed.

CONCLUSION

62. The opposition has failed and the application may proceed to registration in full.

COSTS

63. The Applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I award the following:

Considering the statement of grounds and preparing a counterstatement	£300
Preparing evidence and considering the other side's evidence	£600
Preparing for and attending a hearing	£800
Total	**£1700**

64. I therefore order TikTok Information Technologies UK Limited to pay Tick Tick Trader Ltd and Abderrazak Boukili Makhoukhi (jointly) the sum of £1700. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 19th day of February 2026

MRS E FISHER
For the Registrar