

O/0170/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF INTERNATIONAL REGISTRATION
DESIGNATING THE UK NO. 1621113
IN THE NAME OF BEIJING DAJIA INTERNET INFORMATION TECHNOLOGY
CO., LTD.

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 433444
BY K-WAY S.P.A.

AND

IN THE MATTER OF UK REGISTRATION NOS.
911396521, 2524036 & 800854200
IN THE NAME OF K-WAY S.P.A.

AND APPLICATIONS FOR REVOCATIONS
UNDER NOS. 505425, 505426 & 505427
BY BEIJING DAJIA INTERNET INFORMATION TECHNOLOGY CO., LTD.

AND

IN THE MATTER OF INTERNATIONAL REGISTRATION
DESIGNATING THE UK NO. 1700454
IN THE NAME OF K-WAY S.P.A.

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 441117
BY BEIJING DAJIA INTERNET INFORMATION TECHNOLOGY CO., LTD.

Background and pleadings

1. On 30 July 2021, Beijing Dajia Internet Information Technology Co., Ltd. (“BDIIT”) registered the international registration **KWAI**, under no. 1621113 (“BDIIT’s IR”). With effect from the same date, BDIIT designated the UK as a territory in which it seeks protection under the terms of the Protocol to the Madrid Agreement. BDIIT’s mark claims a priority date of 27 May 2021 (China). Protection is sought for goods and services in classes 9, 35, 36, 38, 41, 42 and 45. These are set out in the annex to this decision.

2. On 11 May 2022, K-Way S.p.A. (“KWS”) partially opposed the protection of BDIIT’s IR in the UK under sections 5(2)(b) and 5(3) of the Trade Marks Act (“the Act”). The opposition is directed at the following services of BDIIT’s IR:

Class 35: Administration of consumer loyalty programs; providing commercial information and advice for consumers in the choice of products and services; provision of an online marketplace for buyers and sellers of goods and services.

3. KWS relies on the following trade marks:

(i) **K WAY**

UK registration no. 2524036

Filing date: 18 August 2009

Priority date: 24 July 2009 (Italy)

Registration date: 25 December 2009

(“KWS’ first registration”)

(ii) **K WAY**

UK registration no. 800854200

Filing date: 19 January 2005

Registration date: 4 December 2006

("KWS' second registration")¹



(iii)

UK registration no. 911396521

Filing date: 4 December 2012

Seniority date: 30 September 1982 (UK)

Registration date: 2 May 2013

("KWS' third registration")²

4. KWS' registrations stand registered in respect of goods in classes 3, 9, 16, 18, 25 and 28. These are set out in full in the annex to this decision.

5. For the purposes of its claim under section 5(2)(b), only the goods in class 25 of KWS' registrations are relied upon. KWS contends that the competing marks are similar and that the parties' goods and services are identical and/or similar. On this basis, KWS submits that there is a likelihood of confusion.

6. Under section 5(3), KWS claims that its registrations have a reputation in respect of *articles of clothing, footwear and headgear* in class 25. KWS argues that its reputation is such that use of BDIIT's IR, without due cause, would take unfair advantage of the repute of its marks or, in the alternative, be detrimental to the distinctive character of its marks. It is also claimed that the relevant public would believe there is an economic connection between the users of the competing marks.

¹ KWS' second registration is a comparable mark based upon its international registration designating the EU no. 854200, which was automatically created under article 56 of the Withdrawal Agreement between the UK and EU on 1 January 2021.

² HWS' third registration is a comparable mark based upon its EUTM no. 11396521, which was automatically created under article 54 of the Withdrawal Agreement on 1 January 2021.

7. Subject to the applications for revocation detailed below, KWS' registrations qualify as earlier trade marks in accordance with section 6 of the Act. As they had all completed their registration processes more than five years before the priority date of BDIIT's IR, they are subject to the use requirements specified in section 6A of the Act.

8. BDIIT filed a counterstatement denying the grounds of opposition. It also indicated that it would require KWS to provide proof of use and reputation of its registrations.

9. On 10 October 2022, BDIIT made applications to revoke KWS' registrations under sections 46(1)(a) and 46(1)(b) of the Act.

10. Revocation is sought under section 46(1)(a) as a result of alleged non-use in the five-year periods immediately following the dates on which the marks were registered, namely:

(i) 26 December 2009 to 25 December 2014, seeking an effective revocation date of 26 December 2014 (KWS' first registration);

(ii) 5 December 2006 to 4 December 2011, seeking an effective revocation date of 5 December 2011 (KWS' second registration); and

(iii) 3 May 2013 to 2 May 2018, seeking an effective revocation date of 3 May 2018 (KWS' third registration);

11. Revocation of all three registrations is sought under section 46(1)(b) due to alleged non-use in the following five-year periods:

(i) 26 May 2016 to 25 May 2021, seeking effective date of revocation of 26 May 2021; and

(ii) 10 October 2017 to 9 October 2022, seeking an effective date of revocation of 10 October 2022.

12. KWS filed counterstatements defending its marks for all the goods for which they are registered, claiming that the marks have been used in respect of the same.

13. On 21 July 2022, KWS registered the international registration **K-WAY**, under no. 1700454 (“KWS’ IR”). With effect from the same date, KWS designated the UK as a territory in which it seeks protection under the terms of the Protocol to the Madrid Agreement. KWS’ IR claims a priority date of 17 February 2022 (EUIPO). Protection is sought for goods and services in classes 9, 35, 41 and 42. These are set out in the annex to this decision.

14. On 2 June 2023, BDIIT opposed the protection of KWS’ IR in the UK under section 5(2)(b) of the Act. BDIIT’s relies upon its IR and the goods and services in classes 9, 35, 41 and 42 thereof underlined in the annex. Subject to it surviving the opposition brought by KWS, BDIIT’s IR constitutes an earlier mark in accordance with section 6 of the Act. It is not yet protected and, therefore, is not subject to the proof of use provisions set out in section 6A of the Act.

15. In addition, BDIIT relies upon its UK trade mark registration no. 914956023, **kwai** (“BDIIT’s registration”). BDIIT’s registration was filed on 23 December 2015 and became registered on 27 September 2018. Although the registration has been revoked with effect from 28 September 2023 as a result of separate proceedings, it was still a valid registration at the priority date claimed by KWS’ IR.³ At that point in time, the mark stood registered for goods and services in classes 9, 35, 38, 41, 42 and 45. These are included in the annex. For the purposes of the opposition, BDIIT relies on the goods and services in classes 9, 35, 41, 42 and 45 which are underlined. As the mark had not been registered for five years or more at the priority date claimed by KWS’ IR, it is not subject to the use provisions in section 6A.

16. BDIIT contends that the parties’ goods and services are identical or similar. BDIIT’s primary position in respect of the competing marks is that they are not similar, reflecting its position in KWS’ opposition. However, it submits that, should it be

³ See, by analogy, *Cooper International Spirits LLC*, Case C-622/18, in which the Court of Justice of the European Union held that a trade mark proprietor can still rely on the rights arising from its registration in relation to infringing acts committed prior to the effective date of revocation.

determined that 'K WAY' and 'KWAI' are similar marks, it must follow that 'K-WAY' and 'KWAI'/'kwai' are similar. In such circumstances, BDITT argues that there is a likelihood of confusion.

17. KWS filed a counterstatement denying the ground of opposition.

18. Only KWS filed evidence. A hearing was requested and held before me, by video conference, on 13 February 2025. KWS was represented by Rowland Buehrlen of Beck Greener LLP. BDIT has been represented throughout these proceedings by Wynne-Jones IP Limited but elected not to attend the hearing or file written submissions in lieu.

Relevance of EU law

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

Evidence

20. KWS' evidence is given in the witness statement of Federico Trono, dated 6 July 2023, and 19 exhibits (FT1-FT9, FT12, FT17-FT24 and FT26).⁴ Mr Trono is the Chief Executive Officer of BasicNet S.p.A ("BasicNet"), the parent company of the BasicNet Group, which is said to fully control KWS. He provides evidence of use of KWS' registrations.

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

⁴ Mr Trono's statement was originally accompanied by 26 exhibits (FT1-FT26). However, this exceeded the Tribunal's page limit for evidence in chief. Following a case management conference, KWS reduced the volume of its evidence by removing Exhibits FT10, FT11, FT13-16 and FT25.

My approach

22. Given that the outcome of BDIIT's revocation actions may affect the validity of KWS' registrations, it is convenient to deal with them first. If or to the extent that it is necessary to do so, I will then consider the opposition brought by KWS. As the outcome of this may, in turn, affect the validity of BDIIT's IR, I will deal with the opposition brought by BDIIT last.

BDIIT's revocations

Legislation and case law

23. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

24. Moreover, section 100 of the Act states:

“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.”

25. As KWS' second and third registrations are comparable marks, it may rely upon their use in the EU for any parts of the relevant periods which fall prior to IP Completion Day, that being 31 December 2020.⁵

26. 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].

⁵ Part 1, Schedule 2A of the Act, paragraph 8

(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].”

27. He then stated as follows:

“107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Limited v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

'19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

...

22. ... it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

The evidence

28. Mr Trono gives evidence that ‘K WAY’ began in Paris in 1965 when Léon-Claude Duhamel designed a lightweight, waterproof jacket that could be folded into a small bag. He says that 250,000 jackets were sold in the first year. According to Mr Trono, the ‘K WAY’ trade marks were purchased by BasicNet in February 2004 and are now owned by KWS (which is, itself, 100% owned by BasicNet). These details are confirmed in brand presentations from 2016 and 2022.⁶ I also note from the presentations that ‘K WAY’ stores were first opened in Italy and France in 2010 and 2013, respectively. Jackets, swimwear, polo shirts and suitcases are pictured. The presentations list some co-branding ventures between ‘K WAY’ and other fashion

⁶ Exhibits FT1 and FT2

designers/brands, including Marc Jacobs, Saint Lauren, Fendi and Comme des Garçons.

29. According to Mr Trono, 'K WAY' goods have been extensively distributed in the UK and EU through a network of licensees, distributors and agencies. Details of this network (as of July 2022) are given, comprising entities in the UK, Ireland, Belgium, the Netherlands, Luxembourg, France, Italy, Spain, Germany, Austria and Romania. I note that GL Gameck (Perthshire) was the licensee of 'K WAY' in the UK between 1 January 2013 and 31 December 2020, whilst Four Marketing (London) has been the UK licensee since 1 January 2021. In addition, Mr Trono provides a list of physical stores in Europe in which 'K WAY' products are offered for sale. As of June 2022, there were 74 stores across Belgium, France, Italy and Luxembourg. Stores were opened each year between 2013 and 2022.

30. Mr Trono has provided the following turnover figures (€) for EU sales prior to IP Completion Day:⁷

Year	Italy	France	Benelux
2015	42,425,990	2,803,517.60	793,790.61
2016	45,920,546	3,535,618	872,103.31
2017	50,517,698	5,117,449	918,546.82
2018	53,426,777	6,825,914	1,555,157.53
2019	60,391,517	10,229,396	1,580,380.94
2020	52,118,960	14,026,852	1,829,548.07
Total	304,801,488	42,538,746.60	7,549,527.28

31. Further, turnover figures (€) for 2009 to 2014 have also been provided.⁸ These are as follows:

2009	
Austria	303,309

⁷ Exhibit FT21

⁸ Exhibit FT21

Belgium	987,855
Germany	936,216
Italy	5,925,610
Total	8,152,990
2010	
Austria	278,190
Belgium	234,929
Germany	1,092,887
Italy	10,307,748
Total	11,913,754
2011	
Austria	22,514
Germany	246,076
Italy	15,393,517
Total	15,662,107
2012	
Austria	1,673
France	9,844
Germany	3,220
Italy	19,910,442
Spain	4,122
Total	19,929,301
2013	
Belgium	213,302
France	630,336
Germany	24,308
Hungary	148,237
Italy	28,254,489
Spain	-138
United Kingdom	235,442
Total	29,505,976
2014	

Belgium	696,144
France	1,827,908
Italy	35,781,244
Netherlands	144,425
United Kingdom	305,112
Total	38,754,833
Grand total	123,918,961

32. Mr Trono has provided product catalogues for 2018 and 2019,⁹ in which ‘K WAY’ branded jackets, trousers, tracksuits, tops, dresses, jumpers, hoodies, gloves, hats, bags, suitcases, belts, bottle carriers, tablet cases, wallets, scarves and beauty cases can be seen. In addition, Mr Trono has evidenced invoices demonstrating the sale of ‘K WAY’ goods to customers in Spain, Italy and France between 27 June 2019 and 17 December 2020.¹⁰ The invoices include swimwear, polo shirts, jackets, trousers, jumpers, shirts, t-shirts, shorts, chinos, dresses, hats, scarves, gloves, tracksuits, suitcases, bags, wallets, tablet covers and keyholders. I note that, where discernible, the invoices range from €3,256.18 to €103,092.20. The clothing goods shown in the catalogues and invoices are for men, women and children.

33. Mr Trono has evidenced a selection of invoices showing sales from Italy direct to customers in the UK.¹¹ They are dated between 30 June 2020 and 24 September 2022. The invoices predominantly show the sale of ‘K WAY’ branded backpacks, luggage and wallets. The sale of these goods accrued around €1,672. However, I also note that the invoices dated 14 December 2021, 4 July 2022, 12 September 2022 and 27 September 2022 show the sale of ‘K WAY’ jackets and sports trousers. The sale of these goods generated €694.

34. In addition to the aforementioned goods, Mr Trono says that the ‘K WAY’ marks are used in respect of notebooks. In support of this, he has provided a printout from Amazon (UK) showing the listing of a “Moleskine x K-Way” notebook.¹² The printout is

⁹ Exhibits FT22 and FT23

¹⁰ Exhibits FT23 and FT24

¹¹ Exhibit FT20

¹² Exhibit FT26

not dated, but the listing says that the product was first available on 19 August 2022. Also evidenced is an invoice, dated 31 December 2022, from Moleskine to a customer in London; this shows the sale of 11 such notebooks.¹³

35. The success of 'K WAY' is said to be partly due to several collaborations with prestigious brands and stylists, such as Marc Jacobs, Lacoste and Versace. In this connection, Mr Trono provides BasicNet co-branding magazines (2011-2019 and 2020), which show images of clothing branded with 'K WAY' as well as the marks/designs of other undertakings.¹⁴ For example, the following can be seen on a jacket from a co-branding exercise with Versace in 2013:



36. In addition to the co-branding magazines, Mr Trono provides press articles relating to such activities.¹⁵ These consist of an article in *Vogue* (Italy), dated 2 October 2015, which refers to a collaboration with Hydrogen; and articles in *GQ* (Italy) and *MF Fashion* (Italy), dated 12 July 2013 and 10 May 2013, respectively, which refer to the collaboration with Versace.

37. Mr Trono says that 'K WAY' has participated in several prestigious international runway shows, including Berlin Fashion Week (2016), Milan Designer Week (2016), Milan Fashion Week (2021-2023), Bread & Butter Berlin (2012-2014), and Pitti Immagine Uomo Florence (2009, 2011-2013, and 2017-2020). Press releases from

¹³ Exhibit FT26

¹⁴ Exhibits FT4 and FT5

¹⁵ Exhibit FT6

BasicNet on this subject are in evidence.¹⁶ The first is dated 8 January 2020 and states that 'K WAY' had its first official runway show at Pitti Immagine Uomo. The second is dated 16 December 2011 and states that 'K WAY' was to take part in an exhibition at Pitti Immagine Uomo for the third time in January 2012. The last is dated 1 July 2013 and states that 'K WAY' was to return to Bread & Butter in July 2013.

38. According to Mr Trono, 'K WAY' has featured on billboards in several major cities in Europe. In this regard, he provides images of 'K WAY' billboards in Paris and London (both December 2021).¹⁷ An example is shown below. In addition, he says that 'K WAY' has sponsored events such as the Winter Olympic Games in Albertville, France, in 1992; the Golden Skate Awards international ice-skating gala since 2009 (location not given); the World Figure Skating Championship in 2018 in Milan; and the Artissima international contemporary art fair in Turin since 2009.



39. Insofar as UK-specific marketing is concerned, Mr Trono says that the UK licensee spent €216,418 in 2021 and €388,889 in 2022. He provides a report documenting the results of an advertising campaign run in 2021.¹⁸ This focused on content creation and driving brand awareness on social media such as Instagram, Facebook and TikTok, as well as physical advertisements in cities and at festivals. The report suggests that the campaign achieved a combined reach of around 8million on social media. Mr Trono has also provided a photograph of a London bus adorned with 'K WAY' branding, though I note that the image is not dated.¹⁹ In addition to this, Mr Trono provides a range of UK press articles.²⁰ These include:

¹⁶ Exhibit FT8

¹⁷ Exhibit FT7

¹⁸ Exhibit FT17

¹⁹ Exhibit FT18

²⁰ Exhibit FT19

(i) Articles in *Drapers* (11 January 2016), *Style* (*Sunday Times* supplement, 22 July 2018), *Gay Times* (4 October 2018), *Menswear Style* (28 November 2018), *Telegraph* (14 December 2018), *GQ* (6 July 2021), *Evening Standard* (21 September 2021) and *Life&Style* (25 October 2022) featuring 'K WAY' jackets;

(ii) Articles in *Evening Standard* (26 June 2018), *Elle* (1 July 2018 and 4 October 2018), *Coach* (27 July 2018), *You* (27 July 2018) and *Frow* (4 October 2018) featuring 'K WAY' swimwear, and an article in *DJ* (4 October 2018) featuring a 'K WAY' hat;

(iii) Articles in *Independent* (17 January 2022) and *Perfect Magazine* (25 January 2022) regarding the 'K WAY' runway show at Milan Fashion Week 2022;

(iv) Articles in *Pause* (7 September 2018), *Global Blue* (10 September 2018), *Wonderland* (11 September 2018), *Tmrw* (11 September 2018) and *Drapers* (14 September 2018 and 17 September 2018) regarding a collaboration between Kappa and 'K WAY'. A range of clothing, including boilersuits, hoodies, jackets and tracksuits can be seen in the articles. *Drapers* and *Tmrw* also mention launch parties in Hackney and Shoreditch;

(v) Articles in *Fashion United* (26 April 2021), *High Snobiety* (16 July 2021 and 8 December 2021) and *GQ* (31 August 2021) referring to clothing collaborations and co-branding ventures between 'K WAY' and Saint Laurent, Comme des Garçons and Engineered Garments;

(vi) Articles in *Mail Online* (4 October 2017), *Proper* (10 June 2021) and *GQ* (27 June 2022), which show The Saturdays' Vanessa White, musician Nico B and actor Kit Harrington in 'K WAY' clothing. I note that *Proper* refers to the brand as "[...] French rainwear heroes K-Way, famed for their iconic, packable jackets"; and

(vii) An article in *MWB* (12 May 2017) about a 'K WAY' store being opened in Covent Garden.

40. Mr Trono says that the 'K WAY' marks have reached such a level of popularity that the term appears in Italian and French dictionaries. Printouts from two Italian dictionaries in which "K-way" appears as an entry are provided in support of this.²¹ However, the printouts are not dated so it is not possible to ascertain when this occurred. Moreover, although Mr Trono gives a list of what he describes as the most prestigious Italian dictionaries, he does not say which ones the printouts are from. There is no other information about the dictionaries. There also appears to be a listing in Wikipedia (Italy) which includes 'K-Way', but I place no weight on this.²² Mr Trono says that the reputation of the 'K WAY' marks is also illustrated by the 'Fiat Panda K.WAY' car, which was launched at the Geneva International Motor Show in March 2015. The evidence shows that the seats of this car were adorned with 'K WAY' branding.²³ However, there is no information about how many of the cars were sold or where, or how many attendees were at the motor show for its launch.

41. Finally, Mr Trono refers to numerous decisions issued by the Italian courts, the French Institut National de la Propriété and the General Court regarding the reputation of 'K WAY' marks. However, it is well established that previous decisions of other national offices or courts in other jurisdictions are not binding on the Registrar. Whilst I acknowledge that legal principles established by the General Court prior to the UK's exit from the EU are binding, that does not extend to particular fact-finding exercises such as, for example, whether evidence demonstrates that a mark has a reputation. I shall say no more about them.

Form of the marks

42. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under section 46(2). He said:

²¹ Exhibit FT3

²² Exhibit FT3. As far as I understand it, Wikipedia is a community-based encyclopaedia that any user can contribute to or edit. This means that the content may be unverified.

²³ Exhibit FT12

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).


17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD

MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

43. KWS’ first and second registrations both consist of ‘K WAY’. The distinctive character of these marks lies in ‘K WAY’ itself. Throughout the evidence, the marks ‘K-Way’ and ‘K-WAY’ are used in plain font. Although there may be differences in capitalisation and the addition of a hyphen between the verbal elements, both evidenced marks represent acceptable variant use of the marks as registered. Firstly, KWS’ marks are registered in word-only format; they are protected for the words themselves, not the form in which they are presented.²⁴ As such, the difference in capitalisation must not be taken into account. Moreover, I do not consider that the addition of the hyphen alters the distinctive character of the marks as registered. The hyphen is, in the circumstances, a non-distinctive element. Its inclusion does not alter the way in which the marks will be perceived; it still acts as a space between the letter ‘K’ and the word ‘WAY’.

44. I note that the ‘K WAY’ marks are also presented in the following figurative formats (in colour, greyscale and black/white):

(i)  ; and

(ii) 

45. I consider both to represent acceptable variant use of the marks as registered. This is because use of a mark encompasses both its independent use and its use as

²⁴ See *La Superquimica v EUIPO*, Case T-24/17, *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, and *PW Branding, Inc v Zabou Group Limited*, BL O/0234/25.

part of another mark taken as a whole or in conjunction with that other mark.²⁵ Although the words 'K WAY' are presented alongside or below a device element, separated by a small circle/dot device, and sometimes in colour, they continue to be the indicator of economic origin.

46. As for KWS' third registration, there is use of the mark as registered. Further, I consider the evidenced mark at paragraph 44(i) above to be acceptable variant use of the mark as registered. The device element is smaller and is presented alongside 'K WAY', rather than above. However, as can be seen in Professor Johnson's guidance in *Lactalis*, changes in figurative elements are generally less likely to change the distinctive character than those related to word elements. I consider that to be the case here. The elements of the mark are, themselves, unaltered. The only difference is the size and positioning of the device. This does not alter the distinctive character of the mark.²⁶

47. However, I do not consider the use of 'K-Way' or 'K-WAY' in plain fonts to be acceptable variant use of the mark as registered. The distinctive character of KWS' third registration does not solely lie in the words 'K WAY'. The device also materially contributes to its distinctiveness, albeit to a lesser extent. Therefore, although the use of colour and replacing the small circle/dot device with a hyphen does not alter the distinctive character of the mark as a whole, the removal of the device does. Such use may not be relied upon for the purposes of my assessment of KWS' third registration.

Sufficient use

KWS' first registration

48. It will be recalled that non-use has been alleged in the five-year periods between 26 December 2009 and 25 December 2014, 26 May 2016 and 25 May 2021, and 10 October 2017 and 9 October 2022. I will first focus my attention on the latest of these,

²⁵ See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paragraphs 31-35

²⁶ *Athleta (Itm) Inc v Sports Group Denmark A/S, Jarrold & Sons Limited* [2025] EWCA Civ 1584, paragraphs 45-54

since genuine use within the same will be sufficient to defeat the revocation action.²⁷ Only UK use is relevant for the purposes of this assessment.

49. I remind myself that an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²⁸ Taking all of the above into account, the evidential picture suggests that there has been some use of 'K WAY' in the UK. The invoices show that there were sales of 'K WAY' branded goods to consumers in this territory during the relevant period. Moreover, the UK licensee is said to have spent around €600,000 in marketing in 2021 and 2022, and there is some evidence that such activities have taken place. The evidence also includes quite a large number of UK publications which referred to 'K WAY' goods during the relevant period.

50. Nevertheless, the authorities stipulate that not every commercial use of a mark may automatically be deemed to constitute genuine use. KWS has provided no details of the size of the relevant markets or any evidence as to the shares of the same held by 'K WAY' goods. KWS has also failed to provide turnover figures for this five-year period (the only figures being available for 2013 and 2014). This is evidence that ought to have been readily available to KWS.

51. Whilst it is sufficiently clear that 'K WAY' goods were sold in the UK during the relevant period, the invoices show that only around €2,400 was accrued through the sale of luggage and clothing products. This would equate to a tiny proportion of the relevant markets. Although I accept that the invoices are not intended to be exhaustive, there is no other supporting evidence (such as turnover figures) which would enable me to conclude that actual use of the mark was on a more significant scale.

52. I note that there is also no evidence that any of the brand presentations, product catalogues or co-branding magazines were distributed to any consumers in the UK. Although I acknowledge that KWS' participated in fashion shows during the relevant

²⁷ See section 46(3) of the Act, set out above.

²⁸ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

period, and my own impression is that the fashion industry is somewhat international in nature, there is no evidence as to whether there were any UK attendees at these overseas events, or how many attendees there were overall. Similarly, there is no evidence to suggest that the sponsorship of overseas sporting or art events exposed any UK consumers to the mark during the relevant period; there is no evidence as to how widely publicised these events were in the UK or, for example, whether they were televised in this territory.

53. Moreover, I acknowledge that the UK licensee is said to have spent around €600,000 in marketing 'K WAY' goods in the UK in 2021 and 2022. This is a reasonable sum. There is also evidence of advertising activities taking place, namely the "It's a thing" campaign in 2021. This suggests that flyers were posted in London and Manchester as well as at the Reading, Leeds and Parklife festivals. However, there is no detail regarding how many individuals in the UK would have been exposed to the flyers in these locations. Similarly, there is no evidence going to how many consumers would have encountered 'K WAY' through seeing performers at the festivals wearing KWS' clothing. The figures regarding social media reach appear fairly significant on the face of it, but it is not clear whether this activity was purely in relation to followers/social media users in the UK. Overall, it is my view that there is a lack of detail as to the impact of the campaign in this territory.

54. Finally, the evidence demonstrates that 'K WAY' was referred to in multiple third-party publications during the relevant period, including *GQ*, *The Telegraph*, *The Evening Standard*, and *The Independent*. As previously explained, a number of these showed 'K WAY' clothing products, referred to KWS' collaboration with Kappa and other fashion brands, and discussed 'K WAY' launch parties in London. Although I understand that at least some of them are large, national publications, no circulation figures have been provided. As such, it is not possible to determine how significant exposure of the mark was in the UK through this press coverage. Moreover, there is no detail in any of the articles relating to levels of sales or commercial activities.

55. Although I do not doubt that some commercial activity was conducted in the UK in connection with 'K WAY', it is my view that the evidence provided is insufficiently solid or specific to meet the requisite standard of proof. Following a careful consideration of

the evidence in its entirety, I am not satisfied that KWS has demonstrated genuine use of its mark in the UK for any of the goods for which it is registered.

56. The middle five-year period significantly overlaps with the latest five-year period. For the same reasons, I find that there has been no genuine use within the middle five-year period either.

57. As for the earliest five-year period, it is my view that KWS' position is weaker. This is because much of the evidence already discussed cannot assist KWS, given that it relates to activities conducted after 25 December 2014. Whilst there may have been a UK licensee from 2013 until the end of this period, there is no evidence of actual sales of 'K WAY' goods during this time. No invoices to UK consumers have been provided and there is no evidence of any retail outlets existing in this territory. One of the co-branding magazines covers part of this five-year period, but there is no evidence of any co-branded goods being sold in the UK. The fashion shows were not held in this territory and there is no evidence that any UK consumers attended those which took place during this time. The same is true of the ice-skating and art events. There is a distinct lack of marketing activities in the UK in respect of this five-year period. None of the UK press articles is from this time. I note that turnover figures have been provided, showing that KWS' accrued over €540,000 through the sale of 'K WAY' branded goods in the UK in 2013 and 2014. However, without any information as to the size of the relevant markets, it is difficult to contextualise the figures (though it is my understanding that the markets for clothing and luggage products in the UK are very large). Perhaps more importantly in this case, the turnover figures have not been broken down by reference to the different goods sold under the mark. As Professor Johnson, again sitting as the Appointed Person, stated in *W Sternoff LLC v Peter Kertels*, BL O/0984/25:

“15. [...] in relation to proof of use (and distinctiveness or reputation) the assessment of the evidence is by its nature forensic and stringent. As Daniel Alexander QC, both sitting as a deputy High Court judge and as an Appointed Person, has emphasised, it is important to ensure that when proving use the registered proprietor has dotted all the i's and crossed all of the t's in its evidence: *Abanka DD v Abanca Corporacion Bancaria SA* [2017] EWHC 2428

(Ch), [88]; *Gerry Weber International Ag V Guccio Gucci Spa* [2015] RPC 9, [1]. Any evidence not meeting this high standard can properly be disregarded by the tribunal.

[...]

26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or a split between the two. This is why particularisation is so important as without it the figures provide no evidence of use for either good A or good B. The same applies where the same good is sold under trade mark A and trade mark B.

27. Evidence of sales is only useful for establishing genuine use where it sets out the sales revenue for a particular and identified good (or service) and it is clear that that good or service is sold under the trade mark. Only where there is only one good being sold and it is sold under only one trade mark can global figures be sufficient.”

58. On the basis of the turnover figures provided, it is not possible to ascertain how economically significant KWS’ use of its mark was during this period for any of the particular goods in its specification. Taking all of the evidence into account, I find that there was no genuine use within the earliest five-year period.

KWS’ second and third registrations

59. In respect of these registrations, non-use has been alleged in the following five-year periods: 5 December 2006 to 4 December 2011 (KWS’ second registration), 3 May 2013 to 2 May 2018 (KWS’ third registration), 26 May 2016 to 25 May 2021, and 10 October 2017 to 9 October 2022. I will again focus my attention on the latest of these first, given that genuine use within the same will be sufficient to defeat the revocation actions. Use in both the UK and EU is relevant for the purposes of this assessment.

60. I have already discussed the UK evidence for this five-year period. With regards to the UK, my comments at paragraphs 49-58 are equally applicable here. As for the EU, it is sufficiently clear that there has been use of the marks. Physical stores offering goods bearing the 'K WAY' marks were opened in Belgium, France, Luxembourg and Italy between the beginning of the relevant period and IP Completion Day. Unchallenged turnover figures have been provided which suggest that over €200million was accrued through the sale of 'K WAY' goods in Italy, France and the Benelux countries during this time. The turnover figures are supported by invoices to the extent that they demonstrate the sale of 'K WAY' goods to customers in Spain, Italy and France in 2019 and 2020. Magazines are in evidence which suggest that 'K WAY' was involved in co-branding exercises with other fashion brands during this time, at least some of which I understand to be well-known. In addition, 'K WAY' was present at several fashion shows/events and sponsored an EU-based ice-skating event before IP Completion Day.

61. However, as noted above, not every commercial use of a mark may automatically be deemed to constitute genuine use. As was the case with the UK-specific evidence, KWS has provided no details of the size of the relevant markets or any evidence as to the shares of the same held by 'K WAY' goods in the EU.

62. Whilst the turnover figures are clearly significant and indicate that the mark was used in a significant part of the EU prior to IP Completion Day, as was the case with the UK figures, they have not been broken down by reference to the particular goods sold under the marks. This is a key deficiency in the evidence; it is not possible to ascertain how significant use was in connection with any of the particular goods in the specifications. Although clothing (particularly jackets) and items of luggage appear to be the main focus of the evidence, these are not the only goods shown in the evidence. KWS' specifications are also not limited to these kinds of goods, or even the classes within which they fall. Even in the relevant classes, the specifications contain a range of different terms relating to clothing and luggage products. It would not, therefore, be appropriate to assume that a significant proportion of the turnover must have related to any particular product.

63. The turnover figures are, again, supported to a certain extent by invoices. The invoices clearly prove that sales took place, and I acknowledge that they are only a selection of such documents. However, without being read in conjunction with specific turnover figures or broader unit sales numbers, it is difficult to ascertain what level of business the invoices actually represent or how significant it was in the context of the EU market. The invoices that have been provided show a low or, in some cases, very low quantity of each good having been sold under the marks. For example, at their highest they show that around 2,200 jackets were sold before IP Completion Day. That is likely to represent a very small proportion of the EU market for such goods.

64. I also accept that physical stores were open (or opened) prior to IP Completion Day. Nevertheless, there is, again, a lack of detail in this regard. The narrative evidence suggests that 'K WAY' branded goods were sold through these outlets, but there is no indication as to how many products, or how many of each kind of product, were sold in these physical retailers. A similar issue arises with the evidence relating to KWS' co-branding activities. Whilst the list of fashion brands that have collaborated with 'K WAY' appears impressive on the face of it, there is no evidence of how many of the co-branded goods were sold at any time prior to IP Completion Day.

65. As for the fashion shows and the sponsorship by 'K WAY' of the ice-skating and art events, there is no information about how many attendees there were, how widely these events were publicised, or what (if any) business resulted from them.

66. Although I do not doubt that there has been some commercial activity, it is my view that the evidence provided is insufficiently solid or specific to meet the requisite standard of proof. Following a careful consideration of the evidence in its entirety, including the UK and EU use, I am not satisfied that KWS has demonstrated genuine use of its marks for any of the goods for which they are registered during this period.

67. The five-year period from 26 May 2016 to 25 May 2021 significantly overlaps with that already assessed. Considering the evidence in the round, even acknowledging that the turnover figures are even higher for this period (in excess of €300million), I make the same ultimate finding for the same reasons. KWS has not sufficiently demonstrated genuine use in this period.

68. As for the five-year period from 3 May 2013 to 2 May 2018, much of the same evidence is relevant. Physical stores were opened in the EU during this period. Around €280million in turnover was accrued through the sale of 'K WAY' goods, including around €540,000 in the UK. Again, magazines from KWS suggest that it collaborated with other fashion brands during this period. KWS attended fashion shows to promote the 'K WAY' marks in Berlin, Milan and Florence, and sponsored ice-skating and art events in Italy. However, these parts of the evidence encounter the same issues already discussed. In addition to the foregoing, I note that there were references to some of KWS' co-branding activities in EU-based publications in 2013 and 2015. The brand also featured in UK publications during this five-year period. However, no circulation or internet traffic figures have been provided for any of these publications. In the circumstances, it is not possible to determine how many consumers in the UK or EU would have encountered the marks through the same. I also note that there are no invoices in respect of this five-year period. As such, there is no evidence of what goods were actually sold. Taking all of the evidence into account, I find that KWS has failed to establish genuine use within this five-year period.

69. Finally, much of the evidence post-dates the five-year period between 5 December 2006 and 4 December 2011. However, I note that the first 'K WAY' store was opened in Italy in 2010. The turnover figures suggest that around €35million was accrued through the sale of 'K WAY' branded goods in the EU between 2009 and 2011. Whilst this is not an insignificant sum, it is much lower than for the other five-year periods already discussed. More importantly, as was the case with the other figures, KWS has not broken these figures down by reference to the different types of goods sold under the marks. There are no invoices for this five-year period so, again, it is difficult to ascertain what goods were actually sold. Whilst some of the co-branding activities may have occurred in this five-year period (one of the magazines covers 2011-2019), there is no evidence of how many goods were sold as a result of this or what they were. A small number of the fashion shows took place during this five-year period but, as already discussed, there is no information as to how many attendees there were at the same or whether any business resulted from 'K WAY' being in attendance. KWS is said to have sponsored the Golden Skate Awards and an art event during this time (since 2009). However, without any details of attendee numbers or how widely these were publicised, it is not possible to determine how many consumers would have been

exposed to the marks this way. Moreover, no location is given for the gala, so it is not proven that it took place in the relevant territory. There is no evidence of advertising during this five-year period and no information as to KWS' marketing expenditure. There does not appear to have been any press coverage during this time. In light of all the above, I find that the marks were not put to genuine use during this five-year period.

Conclusion

70. BDIIT's applications to revoke KWS' registrations are successful. Each mark will be revoked from the earliest date requested.

71. As a result of this, KWS has no valid earlier marks to rely upon in its opposition to BDIIT's IR. Its claims under sections 5(2)(b) and 5(3) cannot proceed. I now, therefore, turn to consider BDIIT's opposition against KWS' IR.

BDIIT's opposition

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

72. Sections 5(2)(b) and 5A of the Act state as follows:

“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.”

“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.”

73. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2025] UKSC 25:²⁹

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

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

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

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

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

²⁹ Having previously been found in numerous decisions of the EU courts.

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

My approach

74. As BDIIT's IR and registration are equally similar to KWS' IR, and the goods and services of BDIIT's IR appear to be more similar to KWS' goods and services than its registration, BDIIT's IR appears to represent its best case. I will proceed to determine the opposition on the basis of this mark only. BDIIT's reliance on its registration will not improve its position.

Comparison of goods and services

75. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated, at paragraph 23, that:

“In assessing the similarity of the goods or services concerned, [...] 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.”

76. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity were:

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

77. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity

between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court stated that ‘complementary’ means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

78. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for them lies with the same undertaking (or an economically connected) undertaking.

79. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court stated that:

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

Class 9

Downloadable virtual goods, namely, computer programs featuring cosmetics and perfumery, watches, footwear, clothing, headwear, eyewear, helmets for sports, sports goggles, bags, sports bags, backpacks, sports equipment, art, toys and accessories for use online and in online virtual worlds

80. The above term describes a range of downloadable virtual goods which are defined as being computer programs. *Computer programs (downloadable software)* in

class 9 of BDIIIT's IR is not limited in any way and would, therefore, cover such virtual goods. As such, the respective goods are to be regarded as identical in accordance with *Meric*.

Downloadable software for providing access to an online virtual environment

81. The above term falls within the scope of *computer programs (downloadable software)* in class 9 of BDIIIT's IR. These goods are identical under the principle outlined in *Meric*.

Sound and music recordings; downloadable digital music

82. To my mind, although worded slightly differently, these terms describe the same goods as *downloadable music files* in the specification of BDIIIT's IR. They are identical. If that is not correct, given the clear overlaps in nature, method of use, purpose, trade channels and user, the respective goods are highly similar.

Class 35

Retail store services in relation to downloadable software, namely virtual goods, cosmetics and perfumery, watches, footwear, clothing, headwear, eyewear, helmets for sports, sports goggles, bags, sports bags, backpacks, sports equipment, art, toys and clothing accessories for use online; on-line retail store services in relation to downloadable software, namely virtual merchandise, namely, cosmetics and perfumery, watches, footwear, clothing, headwear, eyewear, helmets for sports, sports goggles, bags, sports bags, backpacks, sports equipment, art, toys and clothing accessories

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

84. In *Tony Van Gulck v Wasabi Frog Ltd*, BL O/391/14, Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the law concerning comparisons between retail services and goods. At paragraph 9 of his judgement, he said that:

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

85. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*, Case C-411/13P, and *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v Assembled Investments (Proprietary) Ltd*, Case C-398/07P, Mr Hobbs concluded that:

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

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

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

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

86. KWS' services in this class refer to retail services, either in store or online, connected with the sale of downloadable software consisting of a range of virtual goods. Plainly, these services have a different nature, method of use and purpose when compared with *computer programs (downloadable software)* in class 9 of BDIIT's IR. However, BDIIT's software goods cover the goods that are the subject of KWS' retail services. In this connection, the respective goods and services are complementary; BDIIT's goods are integral to KWS' services and the connection between them is such that the average consumer is likely to believe that responsibility for both lies with the same undertaking. Moreover, the respective goods and services are likely to reach the market through the same channels of trade; one would expect software goods and the retail thereof to be offered together by the same undertaking. Users will also overlap. Taking all of this into account, I find that there is a medium degree of similarity between the respective goods and services.

Class 41

Production of music

87. These services are in KWS' specification and class 41 of BDIIT's IR. They are identical.

Entertainment services, namely, providing on-line, non-downloadable virtual cosmetics and perfumery, watches, footwear, clothing, headwear, eyewear, helmets for sports, sports goggles, bags, sports bags, backpacks, sports equipment, art, toys and clothing accessories for use in virtual environments; entertainment services, namely, providing online video games; providing online music, not downloadable

88. The above terms describe various types of entertainment services. They are encompassed by the broad term *entertainment services* in class 41 of BDIIT's IR. The respective services are identical under *Meric*.

Providing an interactive website for virtual reality game services

89. The above term is constructed in such a way so as to indicate that, at its core, it is a service for providing a website. However, such a service would fall within class 42, along with other website creation, design, development, hosting and maintenance services. Alternatively, services involving the provision of access to a website would fall within class 38. Broadly, class 41 includes education, entertainment, sporting and cultural activities. With this in mind, I interpret the above service as being the provision of virtual reality game services via an interactive website, with the game services predominating. It falls within the scope of *game services provided online from a computer network* in class 41 of BDIIT's IR. The respective services are identical in accordance with *Meric*.

Class 42

*Providing non-downloadable computer software for the creation, production and modification of digital animated and non-animated designs and characters, avatars, digital overlays and skins for access and use in online environments, virtual online environments, and extended reality virtual environments; providing a computer application software for virtual reality game services; entertainment services, namely, providing online non-downloadable game software*³⁰

90. It is my understanding that *software as a service [SaaS]* in class 42 of BDIIT's IR refers to the provision of centrally hosted software, which is often licensed on a subscription basis. As it is a means of providing software to consumers, it is my view that KWS' services are encompassed by BDIIT's service, rendering them identical

³⁰ I note that this term is introduced as an entertainment service. However, such services fall within class 41. As such, I have interpreted this term as covering the provision of game software as a service in the normal way insofar as class 42 is concerned. In any event, the use of "namely" limits the scope of protection to what follows and has the same effect as my own interpretation here.

under the principle in *Meric*. If I am wrong about that, the respective services still overlap in nature, intended purpose, method of use, users and trade channels. They would also be in competition, since a customer could choose between accessing software by licensed subscription or simply accessing it online. In light of this, if the respective services are not identical, I find that they are highly similar.

Electronic storage of digital music

91. *Electronic data storage* in class 42 of BDIIT's IR covers the storage of all electronic data, including digital music. The respective services are identical in accordance with *Meric*.

*Entertainment services, namely, providing virtual computer environments in which users can interact for recreational, leisure, or entertainment purposes*³¹

92. As outlined above, *software as a service [SaaS]* in class 42 of BDIIT's IR involves the provision of software to the consumer. The software could provide access to, or otherwise relate to, the virtual computer environments in KWS' service. The virtual environments, themselves, are an expression of computer software. As such, the respective services overlap in nature and purpose. They also overlap in method of use in that they will be accessed in the same way. The respective services are likely to reach the market through overlapping trade channels and may be provided by the same undertakings. Users will also overlap. The respective services are not complementary. However, there is a degree of competition between them since the software being provided under BDIIT's services may relate to the virtual environments described in KWS' service. Taking all of this into account, I find that the respective services are highly similar.

³¹ Again, this term is introduced as an entertainment service. Such services are proper to class 41. As this term appears in class 42, I have interpreted it as covering the provision of virtual computer environments as an IT service at its core, rather than an entertainment service per se. In any case, the use of "namely" limits the scope of protection to what follows; it has the same effect as my own interpretation.

Average consumer

93. As the authorities indicate, I must determine who the average consumer is for the parties' goods and services and how they are likely to be selected. The average consumer is deemed to be reasonably well informed, observant and circumspect.³²

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

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

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

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

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

³² *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60

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

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

95. The goods and services at issue are available to the general public, though I acknowledge that some, such as, for example, *production of music*, may also be used by businesses or professionals. The frequency at which the goods and services are purchased and the associated cost are likely to vary. For instance, *downloadable digital music* is likely to be a relatively casual, regular and inexpensive purchase, whereas *production of music* may be sought less frequently and is likely to attract a higher outlay. The attentiveness shown during the purchasing process is likely to vary accordingly. However, overall, I find that the average consumer (whether that be the general public or business/professional users) will demonstrate a medium level of attention.

96. The goods at issue all comprise downloadable software and music, which will typically be purchased via websites or online platforms. The services are likely to be purchased directly from the provider after viewing information on the internet or, insofar as the physical retail services are concerned, following an inspection of the premises' frontage. Consequently, I find that the purchasing process will be predominantly visual in nature. However, I do not exclude aural considerations entirely, as it is possible that the average consumer may receive word-of-mouth recommendations or wish to discuss the goods and services with the provider.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an

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

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

98. Registered trade marks possess varying degrees of inherent distinctive character. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

99. Although the distinctive character of a mark may be enhanced as a result of it having been used in the market, BDIIT has filed no evidence of use. As such, I have only the inherent position to consider.

100. BDIIT’s IR is a word-only mark which consists of the word ‘KWAI’. As there are no other elements, the distinctiveness of the mark lies in the word itself. The word has no obvious meaning. Rather, it appears to be an invented word. On this basis, I find that the mark possesses a high level of inherent distinctive character.

Comparison of trade marks

101. It is clear from *Sabel BV v Puma AG*, Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. This case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, 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.”

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

103. The marks to be compared are as follows:³³

KWS' IR	BDIIT's IR
K-WAY	KWAI

³³ I note that BDIIT's pleaded position with respect to the marks was that they were similar in the event that the marks were considered similar in KWS' opposition to BDIIT's IR. However, that opposition has not proceeded. As BDIIT's pleadings are strictly no longer relevant, I will proceed on the basis that, by virtue of making a claim under section 5(2)(b) of the Act, it has argued that the competing marks are similar. In any event, Mr Buehrlen conceded that the marks are similar at the hearing.

Overall impressions

104. KWS' IR is a word-only mark consisting of the word 'K-WAY'. The overall impression is dominated by the verbal element, i.e. 'K WAY'. The hyphen provides a contribution but plays a much lesser role.

105. BDIIT's IR is a word-only mark comprising the word 'KWAI'. The overall impression of the mark lies in the word itself.

Visual comparison

106. The competing marks are similar in that the first three letters are the same and appear in the same order. They differ to the extent that their respective fourth letters are different, i.e. 'Y' and 'I'. However, this difference appears at the end of the respective marks, and it is the beginnings of marks which tend to have more visual impact.³⁴ KWS' IR also contains a hyphen after its first letter, a feature which is not replicated by BDIIT's IR. However, this plays a much lesser role in the mark. Bearing in mind my assessment of the overall impressions, I find that there is a high degree of visual similarity between the competing marks.

Aural comparison

107. BDIIT's IR comprises a single syllable. There is no standard pronunciation since it is an invented word. In my view, it is most likely to be articulated as "KWAI" (rhyming with the word 'eye'). Given the presence of the hyphen in KWS' IR, it is my view that it is likely to be pronounced as two syllables, i.e. "KAY-WAY". The competing marks are aurally similar in that they both begin with a "K" sound. There is also only a subtle difference between the "WAY" and "WAI" sounds at their respective endings. The competing marks are aurally different insofar as KWS' IR contains an additional syllable and the "K" is elongated into the "KAY" sound. Overall, I find that there is between a medium and high degree of aural similarity between the competing marks.

³⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Conceptual comparison

108. As outlined above, BDIIT's IR is an invented word. It does not convey any concept. KWS' IR also appears to be an invented word. However, whilst the average consumer normally perceives a mark as a whole, they tend to break it down into verbal elements which suggest a concrete meaning or resemble words known to them.³⁵ As 'K' and 'WAY' are separated by a hyphen, the average consumer may perceive the mark as comprising the letter 'K' and the dictionary word 'WAY', thereby extracting these meanings from the mark. Therefore, to the extent that the competing marks convey any concepts, they are conceptually dissimilar.

Likelihood of confusion

109. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of BDIIT's IR, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

110. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

³⁵ *Usinor SA v OHIM*, Case T-189/05, paragraphs 62-68

111. Earlier in this decision, I concluded as follows:

- The parties' goods and services are identical or similar to at least a medium degree;
- The average consumer may be a member of the general public or a business/professional user, who will pay a medium level of attention during the purchasing process, overall;
- BDIIT's IR possesses a high level of inherent distinctive character;
- The overall impression of BDIIT's IR lies in the word 'KWAI';
- The overall impression of KWS' IR is dominated by the verbal element 'K WAY', whilst the hyphen plays a much lesser role;
- There is a high degree of visual similarity between the competing marks;
- There is between a medium and high degree of aural similarity between the competing marks;
- The competing marks are conceptually dissimilar.

112. I acknowledge that there are differences between the competing marks, namely the differing last letters and the inclusion of a hyphen in KWS' IR. I also accept that the marks are relatively short in length, each containing four letters, and that differences may have a greater impact in shorter marks. I recognise that the competing marks are conceptually dissimilar and that conceptual differences may counteract visual and aural similarities.³⁶ However, there is no special test for 'short' marks.³⁷ Moreover, it is not always the case that conceptual differences counteract visual and aural similarities.³⁸ Here, the competing marks share three out of four letters in the

³⁶ *The Picasso Estate v OHIM*, Case C-361/04 P

³⁷ *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20, paragraph 43

³⁸ *Nokia Oyj v OHIM*, Case T-460/07.

same order. The difference created by the letters 'Y' and 'I' appears at the ends of the marks, whereas the three common letters appear at their beginnings. In addition, whilst KWS' IR contains a hyphen, it plays a much lesser role in the overall impression. Overall, there are relatively high levels of visual and aural similarity between the competing marks. Taking this into account, as well as the distinctiveness of BDIIT's mark and the principles of imperfect recollection and interdependency, it is my view that the differences between the competing marks may not be sufficient to distinguish the parties' goods and services. Even in circumstances where the average consumer is paying a higher level of attention, it is my view that the marks may not be recalled with sufficient accuracy to differentiate between them. Consequently, I find that there is a likelihood of direct confusion.

Conclusion

113. BDIIT's claim under section 5(2)(b) is successful.

Overall outcomes

114. BDIIT's applications under sections 46(1)(a) and 46(1)(b) of the Act have been successful. Subject to any appeal against this decision, KWS' first registration (registration no. 2524036) will be revoked from 26 December 2014; KWS' second registration (registration no. 800854200) will be revoked from 5 December 2011; and KWS' third registration (registration no. 911396521) will be revoked from 3 May 2018.

115. KWS' opposition under section under sections 5(2)(b) and 5(3) of the Act has been unsuccessful. Subject to any appeal against this decision, BDIIT's IR (international registration no. 1621113) will become protected in the UK for all the designated goods and services.

116. BDIIT's opposition under section 5(2)(b) of the Act has been successful. Subject to any appeal against this decision, KWS' IR (international registration no. 1700454) will be refused protection in the UK.

Costs

117. BDIIT has been successful and is entitled to a contribution towards its costs, based upon the scales published in Tribunal Practice Notices 2/2016 and 1/2023.³⁹

118. Following the filing of the statements and counterstatements, BDIIT did not engage with the proceedings. It filed no evidence and did not attend the hearing. I also note that, although a case management conference took place at which KWS challenged a preliminary view of the Tribunal, and was ultimately unsuccessful, BDIIT elected not to attend.

119. In the circumstances, I award BDIIT the sum of **£2,600**, which is calculated as follows:

Considering KWS' statement and preparing a counterstatement (opposition no. 433444)	£400
Preparing statements and considering KWS' counterstatements (cancellation nos. 505425, 505426 and 505427)	£900
Preparing a statement and considering KWS' counterstatement (opposition no. 441117)	£300
Considering KWS' evidence ⁴⁰	£300
Official fees ⁴¹	£700

³⁹ I note that, although the proceedings were consolidated, KWS' opposition and BDIIT's revocations commenced before 1 February 2023, whereas BDIIT's opposition commenced after. This means that the scale published in TPN 2/2016 applies to the two former actions and that published in TPN 1/2023 applies to the latter.

⁴⁰ Whilst the award for this activity falls below the scale minimum, this part of the scale covers "preparing evidence and considering and commenting on the other side's evidence". Although BDIIT is likely to have incurred costs associated with considering KWS' evidence, it neither commented on it nor filed evidence of its own.

⁴¹ Official fees paid in connection with filing a Form TM26(N) in cancellation nos. 505425, 505426 and 505427, and a Form TM7 in opposition no. 441117.

120. I order K-Way S.p.A. to pay Beijing Dajia Internet Information Technology Co., Ltd. the sum of **£2,600**. This sum is to be paid within 21 days of the expiry of the appeal period, or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 27th day of February 2026

James Hopkins
For the Registrar

Annex

Goods and services of BDIIT's IR (international registration no. 1621113)

- Class 9: Computer software, recorded; computer software applications, downloadable; downloadable music files; downloadable image files; electronic publications, downloadable; computer programs (downloadable software); downloadable emoticons for mobile phones; downloadable software applications for smartphones; downloadable e-wallets; computer game software, downloadable; computer game software, recorded; computer programs, downloadable.
- Class 35: Pay per click advertising; online advertising on a computer network; advertising agency services; publicity; advertising; providing user rankings for commercial or advertising purposes; administration of consumer loyalty programs; consumer profiling for commercial or marketing purposes; providing commercial information and advice for consumers in the choice of products and services; provision of an online marketplace for buyers and sellers of goods and services; sales promotion for others; business management of performing artists; updating and maintenance of data in computer databases.
- Class 36: Insurance brokerage; providing insurance information; processing of credit card payments; processing of debit card payments; electronic funds transfer; e-wallet payment services; charitable fund raising.
- Class 38: Broadcasting programs via the Internet; broadcasting pay-television programs; providing access to databases; providing online forums; transmission of podcasts; video-on-demand transmission; streaming of data; providing internet chatrooms; videoconferencing services; communications by computer terminals; message sending.
- Class 41: Educational services; instruction services; arranging and conducting of conferences; providing online electronic publications, not downloadable;

providing television programmes, not downloadable, via video-on-demand services; providing user reviews for entertainment or cultural purposes; providing user rankings for entertainment or cultural purposes; subtitling; dubbing; production of shows; production of music; providing online videos, not downloadable; providing online music, not downloadable; entertainment services; providing information in the field of entertainment; game services provided online from a computer network.

Class 42: Technological research; quality control; computer software design; computer system design; software as a service [SaaS]; electronic data storage; user authentication services using technology for e-commerce transactions; user authentication services using single sign-on technology for online software applications; graphic arts design.

Class 45: Dating services; online social networking services; leasing of internet domain names; copyright management; licensing of intellectual property; licensing of computer software [legal services]; registration of domain names [legal services]; licensing [legal services] in the framework of software publishing.

Goods of KWS' first registration (UK registration no. 2524036)

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides, trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddler; bags and luggage; duffel bags; hand bags, school bags, rucksacks, backpacks, mono backpacks, beauty cases, suitcases, briefcases, trolleys, all purpose sports bags, purses, pouches, wallets; lanyards.

Class 25: Articles of clothing, footwear and headgear, including active wear, sportswear, such as sport trousers, sport suits, sport shorts; swimwear bathing suits, bikinis, slippers, swimming trunks, swimming cap, pareos,

bras, ponchos; underwear such as bodies, boxers, T-shirts, tanks, bras, coulottes, leotards, shorts, slippers, string briefs, tops, thongs; leatherwear and loungewear; bathrobes, nightdresses, pajamas; apparel of any design and nature made from fabrics of any nature, such as pants, trousers, workwear, overalls, jeans, shorts, jackets, coats, waistcoats, overcoats, raincoats, hosiery, knitwear, sweaters, cardigans, fleece and polar fleece tops and bottoms, jumpers, pullovers, twin sets, woven shirts; vests, training and track suits, bodies, shirts, sweat shirts, plush shirts, polo shirts, nightshirts, T-shirts, tank tops, cut and sew tops, dresses, skirts, trousers-skirts, gowns; socks; robes; bands; scarves, neck and face masks (bands); gloves and mittens; headwear, such as hats, caps, bandanas, visors and head bands, wrist bands; belts and ties; footwear, shoes, dress shoes, sneakers, boots, chaps, sandals, slippers, sport and athletic shoes, studded shoes; trekking shoes; ski boots and trekking boots.

Goods of KWS' second registration (UK registration no. 800854200)

- Class 9: Optical apparatus and instruments, namely eye glasses, sunglasses, spectacles, lens and frames for spectacles, parts and fitting for all the aforesaid goods; goggles; jackets, vests, pants, trousers, shoes, boots, caps and gloves, all for workers and for protection against accidents, irradiation and fire; safety goggles; helmets.
- Class 18: Luggage; trunks and travel bags; duffel bags; hand bags, knapsacks, rucksacks, school bags; shoulder bags; suitcases, briefcases; all purpose sport bags; purses, wallets; umbrellas and parasols.
- Class 25: Articles of clothing, namely swimwear, underwear, sports uniforms, jerseys, pants, trousers, jeans, shorts, jackets, wind jackets, overalls, coats, overcoats, raincoats, hosiery, sweaters, cardigans, fleece and polar fleece tops and bottoms, training and track suits, shirts, woven shirts, sweat shirts, polo shirts, t-shirts, tank tops, tops, cut and sew tops, dresses, skirts, gowns, socks, robes, head bands and neck bands,

scarves; gloves, hats, caps, belts, ties; shoes, boots, chaps, sandals, slippers, sport and athletic shoes.

Class 28: Gymnastic and sporting goods and equipment, namely balls for games, such as for football/soccer, basketball, volleyball, tennis, golf, hockey, baseball and rugby; body boards, body guards, hand guards, elbow guards, knee guards, shin guards, protective padding, all for athletic use; gloves for games; roller skates, ice skates, in-line roller skates; swimming flippers; skis, ski racquets, snow boards; bags specially adapted for sports equipment.

Goods of KWS' third registration (UK registration no. 911396521)

Class 3: Soaps; Perfumes, essential oils, cosmetics, hair lotions; Dentifrices, Aftershave lotions, After-shave balms, Cleansing milk, Talcum powder, protective sun creams, Astringents for cosmetic purposes, Skin-cleansing preparations, Foundation creams, Tonic lotions, Compacts, Eye shadow, Blush, Mascara, Skin cream, Eyeliners and lip liners, Lipsticks, Skin lotion, Blush powder, Creams and lotions for removing make-up, Beauty masks, Nail care preparations, Nail varnish remover, Nail strengthening preparations, cuticle balm, nail polish preparations.

Class 9: Eyeglass, Sunglasses, Eyeglass and Mounts, Protective glasses and spectacles; Safety clothing, safety gloves, safety caps, safety eyewear; head guards; Covers for electronic apparatus, covers for mobile telephones and for tablets.

Class 16: Printed matter, Including stationery articles, Decalcomanias (transfers), Bookmarkers, Tickets, Tag labels, Cards, Business cards, Greeting cards, Invitations, And stickers, Gift voucher, Writing or drawing books, Diaries, Block note pads; Photographs, posters, calendars; Printed publications, books, periodicals, manuals and handbooks, magazines, newspapers, newsletters, catalogues, brochures and pamphlets; Correspondence articles, including writing paper and envelopes; Sets of

stationery materials, articles and implements for writing and drawing, in particular pens, ball-point pens, fountain pens, marker pens, permanent markers, highlighter pens, underlining pens, rollerball pens, fine tip pens; Pencils, chalk, crayons, cases for pens and for drawing.

Class 18: Umbrellas, parasols and walking sticks; Trunks [luggage], Bags, travelling bags, Hold-alls, Handbags, Scholbags, Backpacks, Sling backpacks, Beauty cases, Attaché cases, Trolley bags, Sports bags, Briefcases, Purses, Handbags, Pocket wallets, Neck lanyards.

Class 25: Articles of clothing for sports and leisure wear, In particular, Trousers, Shortalls, Jackets [clothing], Windbreakers, Topcoats, Coats, Waterproof clothing, Vests, T-shirts, Sweaters, Shirts, Fleece, Polo shirts, T-shirt, Skirts, Stockings, Sashes for wear, Mitts, Belts, Neckties, Salopettes, Sweat suits, Suits, Bonnets; Underwear, In particular, Pants, Undershirts, Heated jumpers, Camisoles, Bras; Dressing gowns; Pajamas (am); Hats, Bandanas; Footwear, In particular, Shoes, Boots, Chaps, Sandals, Slippers, Slippers; Casual footwear.

Goods and services of KWS' IR (internation registration no. 1700454)

Class 9: Downloadable virtual goods, namely, computer programs featuring cosmetics and perfumery, watches, footwear, clothing, headwear, eyewear, helmets for sports, sports goggles, bags, sports bags, backpacks, sports equipment, art, toys and accessories for use online and in online virtual worlds; downloadable software for providing access to an online virtual environment; sound and music recordings; downloadable digital music.

Class 35: Retail store services in relation to downloadable software, namely virtual goods, cosmetics and perfumery, watches, footwear, clothing, headwear, eyewear, helmets for sports, sports goggles, bags, sports bags, backpacks, sports equipment, art, toys and clothing accessories for use online; on-line retail store services in relation to downloadable

software, namely virtual merchandise, namely, cosmetics and perfumery, watches, footwear, clothing, headwear, eyewear, helmets for sports, sports goggles, bags, sports bags, backpacks, sports equipment, art, toys and clothing accessories.

Class 41: Entertainment services, namely, providing on-line, non-downloadable virtual cosmetics and perfumery, watches, footwear, clothing, headwear, eyewear, helmets for sports, sports goggles, bags, sports bags, backpacks, sports equipment, art, toys and clothing accessories for use in virtual environments; entertainment services, namely, providing online video games; providing online music, not downloadable; production of music; providing an interactive website for virtual reality game services.

Class 42: Providing non-downloadable computer software for the creation, production and modification of digital animated and non-animated designs and characters, avatars, digital overlays and skins for access and use in online environments, virtual online environments, and extended reality virtual environments; electronic storage of digital music; providing a computer application software for virtual reality game services; entertainment services, namely, providing online non-downloadable game software; entertainment services, namely, providing virtual computer environments in which users can interact for recreational, leisure, or entertainment purposes.

Goods and services of BDIIT's registration (UK registration no. 914956023)

Class 9: Computer game software; computer; programs (downloadable software); downloadable image files; downloadable music files; animated cartoons; cameras (photography); batteries, electric; headphones; electronic agendas; network communication equipment.

Class 35: Advertising; publicity; business inquiries; commercial information agencies; on-line advertising on a computer network; marketing; sponsorship search; presentation of goods on communication media, for

retail purposes; telemarketing services; artist broker; personnel management consultancy; systemization of information into computer databases; web site traffic optimization; web site traffic optimisation.

Class 38: Providing internet chatrooms; message sending; providing online forums; wireless broadcasting; computer aided transmission of messages and images; voice mail services; transmission of greeting cards online; transmission of digital files; videoconferencing services; providing access to databases.

Class 41: Education; providing online electronic publications, not downloadable; publication of texts, other than publicity texts; production of shows; organization of shows (impresario services); mobile library services; bookmobile services; tape distribution; subtitling; providing on-line videos, not downloadable; modelling for artists.

Class 42: Computer programming; consultancy in the design and development of computer hardware; technical research; quality control; meteorological information; packaging design; conversion of data or documents from physical to electronic media; software as a service (SaaS); cloud computing; cartography services.

Class 45: Online social networking services; licensing of computer software (legal services); licensing of intellectual property; personal background investigations; chaperoning; escorting in society (chaperoning); clothing rental; marriage agencies; dating services; copyright management; registration of domain names (legal services).