

O/0179/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00004025806

BY SHI LIANG

TO REGISTER THE FOLLOWING TRADE MARK:

**SkyDuck**

IN CLASS 9

AND

AN OPPOSITION THERETO UNDER NUMBER 448389

BY SKY LIMITED

## BACKGROUND AND PLEADINGS

1. On 14 March 2024, Shi Liang (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision (“the applicant’s mark”). The application was accepted and published for opposition purposes on 29 March 2024 and registration is sought for the following goods:

*Class 9: USB cables for cellphones; Uninterruptible electrical power supplies; Solar-powered rechargeable batteries; Stands adapted for mobile phones; Protective films adapted for smartphones; Protective covers for smartphones; Power wires; Mobile telephone batteries; Low-voltage power supplies; Chargers for smartphones; Cell phone cases; Cell phone battery chargers for use in vehicles.*

2. On 1 July 2024, Sky Limited (“the opponent”) opposed the application in its entirety under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following two earlier trade marks for its opposition:

**SKY**

UK000003377563

Filing date: 2 September 2009

Date of entry in register: 22 March 2019

Priority claimed from EUIPO; priority date 2 March 2009

(“the 563 mark”)

For the purposes of these proceedings, the opponent is relying on some of its goods and services. These goods and services are listed in **Annex 1** of this decision.





(series of two marks)

UK000003859806

Filing date: 15 December 2022

Date of entry in register: 10 March 2023

("the 806 stylised mark series")

For the purposes of these proceedings, the opponent is relying on some of its goods and services. These goods and services are listed in **Annex 2** of this decision.

3. Given the filing dates, the opponent's marks qualify as earlier marks, in accordance with section 6 of the Act. However, as they have not been registered for five years or more at the filing date of the application, they are not subject to the proof of use provisions set out in section 6A of the Act. As a consequence, the opponent may rely upon all of the goods and services for which the earlier marks are registered without having to establish genuine use.

4. Under section 5(2)(b), the opponent submits that due to the high similarity between the marks and the identity/similarity of the goods and services, there exists a likelihood of confusion, including a likelihood of association.<sup>1</sup>

5. The applicant filed a defence and counterclaim denying the grounds of the opposition.<sup>2</sup>

6. The applicant is represented by IBE Avocat – Isabelle Bertaux; the opponent is represented by Dentons UK and Middle East LLP. Only the opponent filed evidence. Neither party requested a hearing. Only the opponent chose to file written submissions in lieu of a hearing.

7. 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

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<sup>1</sup> Form TM7 and statement of grounds dated 31 May 2024, paragraph 14 of SOG.

<sup>2</sup> Form TM8 and counterstatement dated 26 July 2024, paragraph 8.

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 AND SUBMISSIONS**

8. The opponent filed the witness statement of Mr William Corbett which is dated 13 March 2025. Mr Corbett is Senior Legal Counsel at the Sky group of companies, a position he has held since June 2024. Mr Corbett's witness statement is accompanied by 23 exhibits, WC01 – WC23. The evidence adduces the opponent's brand, its use and its reputation in the UK.

9. I do not intend to summarise the opponent's evidence or submissions any further at this stage. However, in reaching my conclusion, it should be noted that I have taken careful consideration of all the evidence and submissions. I will refer to them throughout my decision where I deem it necessary to do so.

## **DECISION**

### **Section 5(2)(b)**

10. Sections 5(2)(b) and 5A of the Act state:

“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.”

## Relevant Law

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

### The principles

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

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

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

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

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

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

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

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

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

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

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

## **COMPARISON OF GOODS AND SERVICES**

12. The applicant's goods are listed in paragraph 1 of this decision, and the opponent's goods and services are listed in Annex 1 and Annex 2 of this decision.

13. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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."

14. The opponent has produced submissions on the comparison of the goods and services that appear in the form of two tables; one appears in the opponent's statement of grounds and the other appears in its submissions in lieu. In the table in its submissions in lieu, the opponent

identifies a term or terms in the application and identifies multiple terms in its specification that it states are highly similar or identical. The opponent then submits that the intended purpose, trade channels, providers and end users are the same and that the goods and services are complementary. The submissions that have been made on this point are noted but they are vague. The table set out in the statement of grounds is less precise than the above, although there is the additional mention of competition between the parties' class 9 goods.

15. In these circumstances, I bear in mind the comments of Iain Purvis KC, sitting as the Appointed Person in *SMARTX*:<sup>3</sup>

“[It] is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. [This] would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made.”

16. However, given that the opponent has made some (albeit vague) submissions on the factors to be considered, I will proceed to compare terms where the opponent has made submissions.

#### *USB cables for cellphones*

17. I consider that the term “*USB cables for cellphones*” in the application, is encompassed by the term “*ethernet hardware, adapters, cables, transceivers, switches and controllers*” (in class 9 in the opponent's '806 stylised mark series). Therefore, I find the goods to be identical on the principle outlined in *Meric*.

#### *Uninterruptible electrical power supplies*

18. In the absence of any evidence or submissions to assist me, it is my understanding that the applicant's goods are devices that provide immediate and temporary electrical power to equipment when the main source of power fails. This is to ensure that the connected equipment is able to keep running without interruption. These devices are often used for

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<sup>3</sup> BL O/0911/24

computers, monitors, servers and medical equipment. I consider that these goods fall within the broader category of “*power supply units*” that appear in the opponent’s specification (in class 9 of the opponent’s ‘806 stylised mark series). This is on the basis that, it is my understanding that a power supply unit provides electrical power to other devices. This is what the applicant’s goods do; it supplies power when connected to equipment and continues to supply power when the main supply fails. Therefore, I consider the goods to be identical on the principle outlined in *Meric*.

*Stands adapted for mobile phones; Protective films adapted for smartphones; Protective covers for smartphones; Cell phone cases; Chargers for smartphones; Cell phone battery chargers for use in vehicles.*

19. In the absence of any evidence or submissions to the contrary, it is my view that the term “*computer software, devices, and hardware for transmitting, receiving, synchronizing, displaying, backing-up, monitoring, controlling, sharing, coding, decoding, encrypting, accessing, remotely accessing, creating, collecting, storing, securing, removing, transferring, disseminating, locating, organizing or otherwise utilizing data, voice, multimedia, audio, visual, music, photographs, drawings, images, audiovisual, video, text, graphics or other data, including over a global communications network*” in the opponent’s specification (in the opponent’s ‘563 mark) is a very broad term that could include mobile phones. I consider that there is similarity between the opponent’s term and the above terms in the applicant’s specification. The above terms in the application are all accessories that are specifically for mobile phone or can be used for mobile phones. Given that the accessories are dependent on a mobile telephone for their use and that it is common for undertakings to offer the sale of mobile telephones and accompanying accessories, I consider these goods to be complementary in line with the case law referred to above. The nature and uses of the goods differ, but the users will overlap. Additionally, mobile telephones and their accessories can be found under the same category online and in the same or adjacent aisles in physical stores. Overall, I find these goods to be similar to at least a medium degree.

*Mobile telephone batteries*

20. Applying the reasoning above that the term “*computer software, devices, and hardware for transmitting, receiving, synchronizing, displaying, backing-up, monitoring, controlling, sharing, coding, decoding, encrypting, accessing, remotely accessing, creating,*

*collecting, storing, securing, removing, transferring, disseminating, locating, organizing or otherwise utilizing data, voice, multimedia, audio, visual, music, photographs, drawings, images, audiovisual, video, text, graphics or other data, including over a global communications network*" (in the opponent's '563 mark) in the opponent's specification is a very broad term that could include mobile phones. Many of the opponent's goods may operate by relying on batteries, and, thus, there is a degree of complementarity between the competing goods in the sense that "one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for those goods lies with the same understanding."<sup>4</sup> Moreover, such goods may be sold in the same stores. They also share the same users and method of use as one is integral part of the other. However, the goods differ in nature and purpose. Overall, I find a medium degree of similarity between the goods.

#### *Low-voltage power supplies*

21. In the absence of any evidence or submissions to the contrary, it is my view that the applicant's goods are power supply units that are designed to deliver electricity at lower voltage levels, as opposed to mains voltage. Taking the above into account, I consider that these goods will be encompassed by the term "*power supply units*" in the opponent's specification (in class 9 of the opponent's '806 stylised mark series). Therefore, I consider the goods to be identical on the principle outlined in *Meric*.

#### *Power wires*

22. It is my understanding that the applicant's goods are electrical cables or wires that carry electrical power from one source to an electrical or electronic device. I consider that these goods are similar to the term "*ethernet hardware, adapters, cables, transceivers, switches and controllers*" (in class 9 in the opponent's '806 stylised mark series). It is my view that the term power cables can be used interchangeably with the term power wires and are therefore, encompassed by the above term. However, even beyond that, in the event I am mistaken, wires are used within the cable as conductors and are generally also composed of insulated layers and protective sheaths. I consider that there will be an overlap in purpose, to conduct/provide electricity. Further, they may be an overlap in user. However, the specific method of use and nature of the goods will differ. I do consider that they will overlap in trade channels and there is a complementary relationship between the goods. I am not of the view

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<sup>4</sup> See *Boston Scientific*, Case T-325/06.

that the goods are in competition. Taking the above into account, if I am mistaken, I find the goods to be similar to at least a medium degree.

#### *Solar-powered rechargeable batteries*

23. I consider that the applicant's goods are similar to "power supply units" (in the opponent's '806 mark series) in the opponent's specification. This is on the basis that they will overlap in general purpose, to provide an energy source to various items. I also consider that the goods will overlap in trade channels and users who are looking to supply energy to their various goods. However, it is not my view that the nature of the goods will be the same. Nor do I consider that the goods will overlap in the method of use - given that power supply units will provide immediate and temporary electrical power to equipment when the main source of power fails, and the applicant's goods will provide immediate power solely. There may be an element of competition between the goods, but they are not complementary. Taking the above into account, I find the goods to be similar to a low to medium degree.

#### **THE AVERAGE CONSUMER AND THE PURCHASING ACT**

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

25. Following the goods and services comparison, only the goods remain at issue, , it is with this in mind that I consider the average consumer for the goods at issue. The applicant has not made submissions about the average consumer for the goods and services at issue.

The opponent submits that the average consumer is a member of the general public and “*they will have no special degree of attention or care when selecting the goods.*”<sup>5</sup> I consider that the average consumer for the goods at issue will be members of the general public. Goods like USB cables for cellphones and batteries are everyday consumer goods that are likely to be relatively frequent, inexpensive purchases. Others, such as larger solar-powered rechargeable batteries, are likely to be more occasional purchases/selections which attract a greater cost. The average consumer’s thought process will vary accordingly, with the former being more casual purchases and the latter being more considered. In the main, the goods are likely to be purchased from retailers, where they will be self-selected by the average consumer. The goods may also be purchased from more specialist suppliers or online retailers, where they will be selected after viewing information in brochures, catalogues or on websites.

26. The average consumer will consider various factors, such as cost and whether the goods meet their specific needs. The purchasing process for the goods will be predominantly visual in nature. Nevertheless, I do not discount aural considerations entirely, since it is possible that the average consumer may wish to discuss the goods with a sales representative or the supplier. Taking all of the factors into account, the level of attention paid during the goods will be medium.

## **COMPARISON OF TRADE MARKS**

27. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo*, that:


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

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<sup>5</sup> Opponent’s submissions in lieu, paragraph 40

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

29. The marks to be compared are as follows:

The opponent's earlier marks	The applicant's contested mark
<p style="text-align: center;"><b>SKY</b> ("the 563 mark")</p>  <p style="text-align: center;">("the 806 mark")</p>	<p style="text-align: center;"><b>SkyDuck</b></p>

30. The applicant submitted that the ordinary dictionary words in its mark cannot be disassociated with one another and that there is no dominant element within the mark. This is denied by the opponent; the opponent submits that the applicant's mark is made up of two distinct elements due to the capitalisation of Sky and Duck. The opponent's submissions were that SKY in the applicant's mark is the dominant and distinctive element of the mark on the basis that DUCK is descriptive of the applicant's goods. I agree with the applicant's submission and consider that the applicant's mark consists of the textual element SkyDuck, which will be seen as the two ordinary words SKY and DUCK, conjoined. The overall impression of the mark lies in the two conjoined words, with neither being more dominant or distinctive. I will discuss the opponent's submission that DUCK is descriptive in the conceptual comparison.

31. The opponent's '563 word mark consists solely of the textual element SKY, the overall impression residing in that one word. The opponent's stylised mark consists of the word SKY presented in a stylised font with the letters K and Y joined in one place. One mark in the '806

stylised mark series is in colour with shades of orange, red, pink, purple and blue; the other mark in the series is in greyscale. The dominant element of the stylised mark is the textual component, with the stylisation playing a lesser role.

32. Visually, the applicant's mark and the opponent's word mark share the element SKY, being the only component of the opponent's marks and the first component of the applicant's mark. They differ in that the applicant's mark contains the additional element DUCK. This results in a medium level of visual similarity. The same assessment applies to the applicant's mark and the opponent's stylised mark, save for the stylisation, which lowers the similarity to slightly below a medium degree.

33. Aurally, the applicant's mark and the opponent's marks share the word SKY, which will be pronounced in the ordinary way: as the only component in the opponent's marks and the first component in the applicant's mark. The difference resides in the additional component DUCK in the applicant's mark, which will be pronounced in the ordinary way. Further, the opponent's marks consist of only one syllable, whereas the application consists of two, this will further point towards the differences between the marks being more readily noticed. The applicant's mark is aurally similar to a medium degree to both the opponent's marks.

34. Turning to the conceptual comparison, I am conscious that the conceptual message of a mark must be capable of immediate grasp by the average consumer to be relevant. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*.<sup>6</sup>

35. The opponent submits that SKY has no meaning in relation to goods applied for in the applicant's mark but that the marks share the same conceptual meaning in respect of the word SKY.<sup>7</sup> I agree that the opponent's marks comprise the ordinary word SKY, which has a clear, precise meaning being the word for the space directly above the earth. Further, I agree with the opponent that SKY has no meaning in relation to the goods at issue. I do not consider that the combination of SKY and DUCK, conjoined, conjures in the mind of the average consumer a clear or immediate concept beyond the ordinary meaning of the two words individually.

36. Further, the opponent's submissions that the applicant's specification relates to the battery and power supply sector, of which it submits that DUCK is a defined recognised term in the market, does not persuade me that DUCK, particularly when preceded by the unrelated word SKY, is descriptive. Taking all of the above into account, I conclude that there is a

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<sup>6</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

<sup>7</sup> Opponent's submissions in lieu, paragraph 30

medium degree of conceptual similarity on the basis of the common presence of the word SKY. This finding applies to both the opponent's earlier marks.

## **DISTINCTIVE CHARACTER OF THE EARLIER MARK**

37. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other 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).”

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

39. I will begin by assessing the inherent distinctiveness of the opponent's marks. The opponent's marks consist of the word SKY, either as word-only or presented in a stylised font. As discussed in the conceptual comparison, SKY has no meaning in relation to the goods relied upon; it has no descriptive or allusive qualities in respect of the goods and services at issue. However, it is a common dictionary word referring to the space above the earth. I find the opponent's '563 word mark to have a medium degree of inherent distinctive character. The

stylisation in the '806 stylised mark does not materially alter the distinctiveness and so my finding applies equally to both earlier marks.

40. I shall now consider whether the inherent distinctive character has been enhanced through the use made of the mark. For the present circumstances, it is use in the UK that is relevant because the test for confusion will be assessed by reference to the average consumer who is a member of the UK general public.

41. The opponent has submitted that 'Sky' has been used as a trade mark and house mark for over 35 years in the UK and has provided figures demonstrating its sales. The opponent's evidence indicates that the opponent had an annual revenue of £13.6 billion, contributed £15.3 billion gross value to the UK GDP in 2018 and made *£8.6 billion in revenue in 2017 in the UK.*<sup>8</sup> Whilst these figures are substantial the evidence that has been provided by the opponent has a number of limitations, such as not being broken down in relation to particular goods and services and being inclusive of two countries (at a minimum). Further, the evidence is primarily in relation to the services that the opponent provides, such as broadband services, this is not relevant in the current circumstances. I will only aim to discuss the evidence in so far as it can be said to relate to the opponent's class 9 goods.

42. The opponent states that it sells various goods at its online shop, and has done so for a number of years, inclusive of televisions, WiFi hubs, cables, mobile phone accessories, drones and smart watches.<sup>9</sup> I note only televisions, cables, mobile phone accessories are relied upon in this opposition. The evidence does display televisions, cables and mobile phone accessories on the opponent's webpage dated 5 November 2021, however, none of the goods bear the opponent's mark. Rather, they bear the trade marks of other companies. Therefore, these webpages do not offer assistance to the opponent's claim of enhanced distinctiveness in relation to its class 9 goods.

43. As I mentioned previously, whilst various turnover figures have been provided in the evidence, they have not been broken down in relation to sales of the goods or services at issue. Therefore, it is difficult for me to determine the intensity and any potential long-standing nature of the mark in relation to the goods. Further, whilst market share evidence has been provided in relation to the services at issue, none has been provided in relation to the goods.

44. I note that the opponent provided evidence demonstrating promotion in relation to a range of sky products, as displayed below, which it states it advertised using various methods

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<sup>8</sup> Opponent's witness statement, paragraph 2.2.2

<sup>9</sup> Opponent's witness statement, paragraph 5.4.3

such as television advertisements, in national and regional press advertisements, cinema adverts, radio and social media advertising.<sup>10</sup>

<b>Year (as at 30 June)</b>	<b>Sales, General and Administrative Expenditure for Sky Group in UK and Ireland (£million)</b>
2018	2,696
2017	2,699
2016	2,899
2015	2,781

45. Whilst the evidence is in relation to the UK and Ireland, that is not where the problem lies, as whilst I cannot determine how much was spent in relation to each country, given its vast size of use it is reasonable for me to infer that a decent proportion relates to use in the UK. The problem lies in that the evidence is not broken down in relation to the goods and services provided and I have not seen any evidence of advertising in relation to the goods at issue.

46. Taking all the above into account, the opponent's evidence is insufficient to demonstrate enhanced distinctiveness in relation to its class 9 goods. The goods displayed on the opponent's website do not bear the opponent's mark; consequently, I cannot conclude that any of the turnover figures provided are for goods bearing its mark. This also applies in relation to the marketing figures. Further, there is no evidence of the intensity or long-standing use of the mark in relation to any of the goods bearing the opponent's mark. Therefore, the opponent maintains its inherent distinctive finding of a medium degree of enhanced distinctive character.

## **LIKELIHOOD OF CONFUSION**

47. 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. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks

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<sup>10</sup> Opponent's witness statement, paragraph 6.1.4 to 6.1.9

may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

48. I have found the marks to be visually, aurally and conceptually similar to a medium degree to the opponent's '563 word mark. I have found the applicant's mark to be aurally and conceptually similar to a medium degree and visually similar to a slightly lower than medium degree to the opponent's '806 stylised mark. I have found the opponent's mark to be inherently distinctive to a medium degree. I have found the average consumer to be a member of the general public. I have identified that the level of attention paid during the selection process of the goods will be medium. The purchasing process is predominantly visual, although aural considerations are also relevant. I have found the goods to vary from similar to a low to medium degree to identical.

49. The two types of confusion were described by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:

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

50. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:<sup>11</sup>

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<sup>11</sup> BL O/375/10

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

51. Despite the opponent’s submission that the applicant’s mark will be recalled and remembered by the word SKY, I have found the word DUCK not to be descriptive of the goods at issue. As such, I cannot identify any reason why the average consumer would mistake SkyDuck to SKY. I have taken into consideration that consumers may play a greater degree of attention to the beginning of marks.<sup>12</sup> However, this is a general rule and is not applicable in all cases. In the current circumstances, the applicant’s mark contains an additional word (albeit conjoined), rendering the marks significantly different in length. Taking everything into account, I find that the average consumer will notice the difference between SkyDuck and the opponent’s mark SKY word mark and will not be directly confused between the two. This is the case even taking into account the interdependency principle and identity between the goods, and the services for which there is enhanced distinctiveness. There is no likelihood of direct confusion. This finding also applies to the opponent’s ‘806 stylised mark series.

52. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a

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<sup>12</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

53. Moving onto consider indirect confusion, the opponent submitted that ‘SKY’ in the applicant’s mark maintained an independent distinctive character. I take into account the decision *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*<sup>13</sup> in which Arnold J (as he was then) considered the impact of the CJEU’s judgement in *Bimbo, Case C-591/12P*, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the

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<sup>13</sup> [2015] EWHC 1271 (Ch)

competent authority to carry out a global assessment taking into account all relevant factors.”

54. I have already found that SKY and DUCK, do not form a unitary meaning in the applicant’s marks. Conceptually, I found that they will be seen as two ordinary dictionary words, separately. Therefore, I agree that the word SKY has an independent distinctive character in the applicant’s mark, and this component is identical to the opponent’s mark. On the basis that I have found that SKY has independent distinctive character in the applicant’s mark I will have consider of the *Medion* principle.<sup>14</sup> I appreciate that the applicant’s mark *may* be viewed as consisting of two signs that have distinctive character independent of their wholes.<sup>15</sup> However, I do not consider that this applies to the opponent’s marks. In relation to the ‘563 word mark whilst the word is slightly stylised, I see no reason why the word mark SKY would be viewed by consumers as having distinctive significance independent of the mark as a whole. Similarly, in relation to the ‘806 stylised mark, while SKY may be a different colour and slightly stylised, I see no reason why consumers would view it as having distinctive significance independent of the mark as a whole. Instead, the mark will simply be viewed as being the singular sign SKY. As such, my primary view is that the *Medion* principle does not apply.

55. Alternatively, however, even if the *Medion* principle were to apply and the opponent’s mark was deemed as consisting of two distinctive signs, it would still be of no assistance to the opponent. As set out in paragraph 21 of *Whyte and Mackay* (a paragraph that was also specifically cited by Professor Johnson in *Be:FIT*),<sup>16</sup> just because marks may share a common element that has its own distinctive character independent of the whole, it does not automatically follow that there is confusion.

56. Whilst SKY has independent distinctive character, I have already found that DUCK is not descriptive and will not be overlooked by the average consumer. I do not consider that SKY is so distinctive that average consumers would assume that no one, other than the opponent, would use this word in their trade mark. Even if the opponent’s marks were to benefit from an enhanced distinctive character, I see no reason why consumers would view the marks in this way. Bearing in mind the goods applied for by the applicant, DUCK is neither descriptive nor non-distinctive and so it is difficult to see why consumers would see SkyDuck as a sub-brand or brand-extension of SKY.

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<sup>14</sup> See *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04

<sup>15</sup> Whilst I do not consider this to be the case, for the sake of completeness, I raise the possibility of it doing so here to demonstrate that the *Medion* principle is of no assistance in any event.

<sup>16</sup>See BL O/385/18, paragraph 9 onwards

57. The opponent did provide evidence (whilst attempting to prove enhanced distinctiveness) of the sub-brands it has, inclusive of SKY SPORTS, SKY BET, SKY NEWS and several more. However, the opponent has not sought to rely on these marks, either individually or as a family of marks. Despite this, I note that the structure of the opponent's marks consists of SKY followed by a descriptive/ allusive element associated with the goods and services provided, such as broadband services for SKY BROADBAND. In addition, I note that the opponent's marks are unconnected and do not form a cohesive whole, that is not the case for the applicant's mark. Further, the second word in the applicant's mark is not descriptive/allusive.

58. Considering all of the above, I cannot see a proper basis for indirect confusion, falling into the examples in *L.A. Sugar* or otherwise, nor has an alternative reasoning been provided by the opponent. This finding that I have made applies to the '563 word and '806 stylised mark series.

## **CONCLUSION**

59. There is no likelihood of confusion. The opposition under section 5(2)(b) has been unsuccessful. The applicant's mark may, subject to any successful appeal against my decision, proceed to registration for all of the goods applied for.

## **COSTS**

60. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I have calculated as follows:

Preparing a statement and considering the other side's statement	£250
Considering the other side's evidence	£600
<b>Total</b>	<b>£850</b>

61. I therefore order Sky Limited to pay Shi Liang the sum of £850. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 3<sup>rd</sup> day of March 2026**

**A KLASS**

**For the Registrar**

## **Annex 1 – word mark**

(The first earlier right)

### Class 9

Apparatus for recording television programmes; apparatus for recording, transmission, reproduction or reception of sound, images or audio visual content; electrical and electronic apparatus for use in the reception of satellite, terrestrial or cable broadcasts; speakers; computer hardware, apparatus and instruments all for transmitting, displaying, receiving, storing and searching electronic information; computer software and telecommunications apparatus to enable connection to databases and the Internet; audio and/or video file recorders and/or players; apparatus and instruments for the reception of radio and television broadcasts including the reception of cable, satellite and digital broadcasts; communication apparatus and instruments; data carriers; data storage apparatus; electrical telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; electronic telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; film reproducing instruments and apparatus; parts and fittings for all the aforesaid goods; electrical communication equipment; electronic communication equipment; computer software, devices, and hardware for transmitting, receiving, synchronizing, displaying, backing-up, monitoring, controlling, sharing, coding, decoding, encrypting, accessing, remotely accessing, creating, collecting, storing, securing, removing, transferring, disseminating, locating, organizing or otherwise utilizing data, voice, multimedia, audio, visual, music, photographs, drawings, images, audiovisual, video, text, graphics or other data, including over a global communications network; computer software, operating system software, devices, and hardware for synchronizing data, files, e-mails, contacts, calendars, task lists, text messages, photos, music, audio, visual, audio visual, video, text, graphics, programs and other information between computers and hand-held or other devices, and vice versa; communications platforms for enabling instantaneous, continuous, scheduled and perpetual synchronization of data between computers and hand-held or other devices, and vice versa; parts and fittings for all the aforesaid goods.

### Class 38

Telecommunications services; mobile and fixed telecommunications services; communications services; satellite, cellular and radio communication services; television and radio broadcasting; transmission and communication services; broadcasting and/or transmission of radio and/or television programmes and/or films; satellite, DTT, cable, DSL

and broadband broadcasting and/or transmission of audio and/or audio visual programming; transmission of audio, video and/or audio visual programming (by any means); transmission of video films; broadcasting and transmission of television programmes and films to personal computers; broadcasting and communications by means of or aided by computer; transmission of audio, video and/or audio visual programming by Internet protocol (IPTV); provision of access and/or connectivity to broadband networks whether fixed, portable or wireless; transmission of text, messages, sound and/or pictures; telecommunication and/or communication and/or broadcast and/or transmission of audio visual content; communication of information (including web pages), data by radio, telecommunications and by satellite; telephone, mobile telephone, message collection and transmission, radio-paging, call diversion, answerphone and directory enquiry services; computer aided transmission of messages and images; messaging services namely, sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these formats; short message services (SMS); multimedia messaging services (MMS); voicemail services; provision of access to electronic conferencing, discussion groups and chat rooms; communications services by satellite, television and/or radio; news agency services; provision of access to news, current affairs and sports information; electronic mail services; telecommunication services relating to the Internet; telecommunication of information (including web pages); interactive television services being telecommunications and/or communications and/or broadcasting and/or transmission services; interactive services for television viewers including those watching on mobile telephones and PCs being telecommunications and/or communications and/or broadcasting and/or transmission services; television broadcasting services incorporating interactive services for viewing guides and intelligent automated selection for programme recordal; interactive services for television viewers facilitating the recordal of programmes automatically initiated on the basis of customer viewing habits/preferences being telecommunications and/or communications and/or broadcasting and/or transmission services; providing interactive television viewers (including those watching on their mobile telephones or PCs) with access to information, data, graphics, audio and/or audio-visual content from a restricted group of Internet websites or portals; broadcasting and transmission of interactive television, interactive games, interactive news, interactive sport, interactive entertainment and interactive competitions; video on demand and near on demand telecommunication and/or communication and/or broadcast and/or transmission services; streaming delivery of video on demand streams to viewers; providing access to movies, videos and television programmes to viewers on demand and near on demand; providing access to a database storing information relating to a variety of goods and services; enabling access to the Internet; provision of a connection between websites and television viewers via an interactive television portal; Internet portal services; web portal

services; provision of broadband services; interactive television portal services providing access to Internet websites for television viewers via their television receiving equipment including digital television receiving equipment; providing access to Internet websites to mobile telephone users; factual information services relating to television broadcasting; audio visual communication services; data communication services; data broadcasting services; delivery of messages; telecommunication and/or communication and/or broadcast and/or transmission of radio programmes, television programmes, films and motion pictures; telecommunication and/or communication and/or broadcast and/or transmission of audio and/or visual material and material from pre-recorded video tapes: transmission of radio programmes, television programmes, films, motion pictures, pre-recorded video tapes, audio and/or visual material, pre-recorded video cassettes, DVDs or pre-recorded video discs; message sending; telephonic or telephone communications services; wireless communication services; organisation of call information; call screening services; call alerting services; provision of communication services for accessing a communications or computer network; provision of communication services for accessing entertainment, education, information and data via telephone, line, cable, wire or fibre, database or computer network; provision of communication services for accessing and retrieving information, messages, text, sound, images and data via a computer or computer network; provision of communication services for accessing and retrieving radio and television programmes; consultancy, synchronization, transfer and transmission of programs, data, files, e-mails, contacts, calendars, task lists, text messages, photos, music, audio, visual, audio visual, video, text, graphics, programs and other information via telecommunications and global communications networks; data synchronization over telecommunications, communications and computer networks; online video on demand or near on demand telecommunication and/or communication and/or broadcast and/or transmission services; online telecommunications services to enable the accessing and retrieving of data, files, e-mails, contacts, calendars, task lists, text messages, photos, music, audio, visual, audio visual, video, text, graphics, programs and other information via a computer or computer network or electronic device including services provided over a global communications network.

## **Annex 2 – stylised mark**

(second earlier right)

### Class 9:

Audio, visual and/or audio visual entertainment devices; televisions; television apparatus; apparatus for recording, transmission or reproduction of sound or images; data processing equipment; speakers; soundbars; personal video recorders and/or audio, visual and/or audio visual content streaming and entertainment devices; remote controls for sound bars; microphones; cameras; smart watches; wearable activity trackers; games controllers; wearable peripherals for playing video games; home automation control devices for controlling home automation systems, home automated cooking and refrigeration appliances, heating, lighting, air conditioning, home security and home monitoring systems; software for room, office and/or venue automation control devices for controlling room, office and/or venue automation systems, heating, lighting, air conditioning, room, office and/or venue security and room, office and/or venue monitoring systems;<sup>17</sup> connecting cables for audio, visual and/or audio visual devices and wireless local area network devices; computer hardware; computer peripherals; ethernet hardware, adapters, cables, transceivers, switches and controllers; TV linking devices; IO (input output) linking devices; USB dongles (wireless local area network adapters); power supply units; low noise blockers; micro filters; voice and gesture activated hardware for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content.

### Class 35:

Online retail services relating to hardware and software for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content, fixed line telephony services, mobile telephony services, broadband services, hardware and software for broadband services, mobile phones, tablets, mobile phone cases and chargers, headphones and audio, visual and/or audio visual content.

### Class 38

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<sup>17</sup> This term appears in the TM7 as “room, office and/or venue automation control devices for controlling room, office and/or venue automation systems, heating, lighting, air conditioning, security and monitoring systems” clearly this is a typographical error. I have recorded and relied upon the term that appears in the specification as noted on the UK trade mark register.

Telecommunication services; broadcasting services; providing audio, visual and/or audio visual content broadcasting services; providing audio, visual and/or audio visual content streaming services, including television, radio and music streaming services; internet protocol television services (IPTV); interactive television services; providing video on demand services; provision of access to news, sports, current affairs and environmental information; providing notification alerts via the internet; providing fixed line telephony services; providing call screening services; providing mobile telephony services; providing broadband services; providing email services; providing access to the internet; providing wireless local area network services; providing wireless internet access services; providing internet access services via ethernet; providing telecommunications modification services of wireless local area networks; providing an online electronic message board for the transmission of messages; providing automated emergency messages, alerts and notifications; hosted voice services; broadband back-up services, including via 4G technology and/or via 5G technology; providing local area network and wide area network management services; providing software defined networking services (SDN); providing streaming of audio, visual and/or audio visual content relating to physical fitness, including streaming of physical exercise classes, workshops and seminars; computer services for accessing and retrieving audio, visual and/or audio-visual content data and information via a computer or computer network; providing on-line chat rooms and electronic bulletin board services; transmission of podcasts; providing access to platforms on the internet, including e-commerce platforms; internet portal services; voice over internet protocol (VOIP) call, phone call, video call, audio, visual and/or audio visual conference, text message, instant message and web message services; providing audio, video and/or audio visual conference communication services, including through camera; providing access to electronic and online databases for social networking; providing online community sharing of audio, visual and/or audio content, data and information among users including photo sharing and video sharing services; providing internet access facilities equipped with telecommunications equipment; provision of access and/or connectivity to broadband networks whether fixed, portable or wireless; information, advice and customer support services relating to all the aforesaid services.