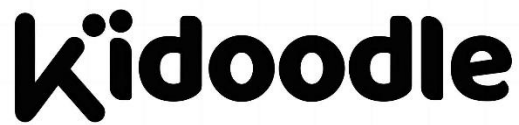


O/0386/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 4003003
IN THE NAME OF HAINAN SANLAN TECHNOLOGY HOLDINGS CO., LTD.
FOR THE TRADE MARK**



kidoodle

IN CLASSES 7 AND 17

AND

**THE OPPOSITION THERETO UNDER NUMBER 447272
BY A PARENT MEDIA CO. INC.**

Background and pleadings

1. Hainan Sanlan Technology Holdings Co., Ltd. (“the applicant”) filed an application for the trade mark shown on the cover page of this decision (number 4003003) on 17 January 2024 (“the relevant date”) for the following goods:

Class 7: 3D printers; Machines for processing plastics.

Class 17: Semi-worked thermoplastic filaments used for 3D printing; Plastic filaments for 3D printing; Soldering threads of plastic; Threads of plastic for soldering; Plastic rods and bars; Semi-worked ABS filaments for use in 3D printing.

2. A Parent Media Co. Inc. (“the opponent”) opposes the application under sections 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following six earlier trade mark registrations for its section 5(3) ground:¹

(i) 3396397

KIDOODLE

Filing date: 2 May 2019; registration date: 26 July 2019

Relying on all services in classes 35, 38 and 41.

(ii) 3396400

KIDOODLETV

Filing date: 2 May 2019; registration date: 26 July 2019

Relying on all services in classes 35, 38 and 41.

¹ The full list of services for the earlier marks is set out in the annex to this decision

(iii) 3396408

KIDOODLETV SAFE STREAMING

Filing date: 2 May 2019; priority date 20 December 2018 (Canada); registration date:
26 July 2019

Relying on all services in classes 38 and 41.

(iv) 3396420



Filing date: 2 May 2019; priority date 20 December 2018 (Canada); registration date:
26 July 2019

Relying on all services in classes 38 and 41.

(v) 3396422



Filing date: 2 May 2019; priority date 20 December 2018 (Canada); registration date:
26 July 2019

Relying on all services in classes 35, 38 and 41.

(vi) 3482866

KIDOODLE.TV

Filing date: 20 April 2020; priority date 6 April 2020 (Canada); registration date: 10
August 2020

Relying on all services in classes 38 and 41.

3. The opponent claims a reputation in its marks for the services relied upon, and that the parties' marks are highly similar, with the result that the relevant public will believe that the parties' goods and services are used by the same undertaking or an

economically connected undertaking. It claims that there will also be unfair advantage because the contested mark will ride on the coat-tails of the opponent's reputation, unfairly benefitting from the opponent's marketing and advertising efforts.

4. In relation to detriment to repute, the opponent claims the following:

“The image and reputation of the earlier mark[s] would be damaged if the Applicant offered any goods that were seen to be linked to or endorsed by the Opponent – such as for example, 3D printed toy characters – and if these were of an inferior quality of nature that would have a negative impact on the image and power of attraction of the earlier mark.

The opponent would have no control over the quality of the Applicant's goods. The trust gained by the Opponent amongst relevant consumers would be tarnished if the goods of the Applicant did not meet the same standards.”

5. The third type of damage claimed is that the use of the applicant's mark would damage the distinctive character of the opponent's marks because the relevant public would mistakenly consider that there is a connection with the opponent, leading to a loss of sales and damage to the value and origin functions of the marks.

6. Under section 5(4)(a) of the Act, the opponent claims that it has used the sign KIDDOODLE throughout the UK since May 2016 in relation to the following:

Promoting the goods of others, namely, providing online discount information and purchasing services of vouchers, gift certificates, coupons and other discounts for the promotion and sale of goods and services of others; promotional services, namely, promoting the goods of others by means of providing digital coupons, rebates and vouchers distributed electronically to computers, mobile phones and other electronic devices; On-line electronic transmission of information and data, namely, transmission of music, movies, games and television programs for children; audio broadcasting and transmission of educational and entertainment digital media for children, namely, streaming of video via the Internet featuring music, movies, games and

television programs for children for educational and entertainment purposes; distribution of educational and entertainment television and motion picture programming by means of digital transmission over the Internet; video-on-demand transmission services; video broadcasting via the Internet, namely, streaming of audio and video via the Internet featuring music, movies, games and television programs for children; transmission and distribution of voice, audio, video, images, signals, messages and information relating to children's television programs; Entertainment and educational services, namely, distribution of educational and entertainment television and motion picture programming for others by means of digital transmission over the Internet; entertainment services, namely, providing portions of prerecorded audio, visual and audiovisual works via the Internet; making available at a time and place selected by the user of reviewed and curated information and data, namely, music, movies, games and television programs appropriate for viewing by children.

7. The opponent claims goodwill in the business distinguished by its sign and claims that use of the application is contrary to the law of passing off because its use would cause misrepresentation and damage to the opponent's goodwill.

8. The applicant filed a defence and counterstatement, denying the grounds of opposition and stating that the opponent's claim to reputation and goodwill is unsubstantiated.

9. The opponent is represented by Kilburn & Strode LLP and the applicant by Paweł Wowra. Only the opponent filed evidence. Neither party requested to be heard and only the opponent filed written submissions in lieu of attending a hearing. I make this decision after careful consideration of all the papers on file, referring to them as necessary.

Evidence

10. The opponent's evidence comes from Neil Gruninger, its President and CEO.² He explains that KIDOODLE.TV is a video-on-demand online and downloadable streaming service for children, available to watch via a paid advertisement-free subscription or via free access (with or without an account). The KIDOODLE.TV licensed library contains over 45,000 episodes of e.g. PAW Patrol, Peppa Pig, SpongeBob Squarepants, My Little Pony and Doggyland, plus movies, games and music. Exhibits NDG2 and NDG3 comprise extracts from the KIDOODLE.TV website, but they are undated. Mr Gruninger states that Exhibit NDG4 comprises screenshots from the Google UK Play store in relation to the KIDOODLE.TV app. These were downloaded on 8 October 2024. The content of the exhibit is undated, but it says that the app was updated on 7 August 2024, which is after the relevant date, as are the three reviews. Also in this exhibit are pages from the Apple app store, but the URL shows that this is a US version. It is not clear where the reviews shown on pages 35 to 37 come from, but these pages follow directly from the US Apple app store pages. Undated screenshots about lesson plans are shown in Exhibit NDG5, which refers to 'grades' and 'kinder'. My understanding is that these are the names of US educational years in schools. Certainly, 'kinder' is not used as the name of an age-group in UK schools (such as reception class, infants and juniors). Mr Gruninger states that the geography lesson plan shown in Exhibit NDG6 is for children in Year 2 of the UK education system; however, it is headed "Grade 1 Geography" (and is undated).

11. Mr Gruninger states:

"15. In 2024, APMC and VIDAA USA, Inc launched KIDOODLE.TV as the new Kids & Family Hub on over 25 million VIDAA-powered Smart TVs worldwide, including those by the world's second largest TV manufacturer Hisense. Being able to offer the KIDOODLE.TV platform across multiple streaming services in the UK has significantly broadened our consumer reach. Exhibit NDG7 contains

² Witness statement dated 23 October 2024 and exhibits

independent articles and press releases about KIDOODLE.TV being available on Samsung TV Plus, VIDAA-powered Smart TVs, Hisense TVs, LG TVs, Amazon, Roku and such like.”

12. Exhibit NDG7 comprises articles about this. The first article is attributed to “CALGARY, Alberta, May 19, 2021 /PRNewswire. The second extract is from the website of VIDAA, showing KIDOODLE.TV as a partner, but it is undated. The third article is a blog about VIDAA U on the website of Hisense UK, dated 7 May 2020, but there is no mention of KIDOODLE.TV, in contrast to there being specific mentions of “Netflix, Prime Video, Rakuten TV, Freeview Play, YouTube, ITV Hub, BBC iPlayer and more”. The fourth article, from “wifihifi”, refers to KIDOODLE.TV being available globally on Hisense and Toshiba TVs which are powered by the VIDAA smart TV operating system. Although the article is undated, it refers to the spring of 2020 as being in the future. There is no reference to the UK. The fifth article is from “Accesswire” and is dated 31 January 2024, which is two weeks after the relevant date. It announces that the opponent and VIDAA USA plan to launch a new Kids & Family Hub on over 25 million VIDAA-powered smart TVs worldwide. KIDOODLE.TV had been selected to power the hub which was targeted to go live on TVs in the spring of 2024. Screenshots from the UK version of the LG app store refer to the Kidoodle.TV version as being 1.0.2, dated 21/08/24. However, I also note that a screenshot of the app’s availability on Amazon says that the date first available on Amazon.co.uk was 21 July 2016. There are also seven reviews on Amazon.co.uk from purchasers in the UK in 2020 and 2021.

13. Mr Gruninger states that the opponent raises revenue in relation to KIDOODLE.TV by paying Roku, Amazon, Fire TV and such like for a preferred app placement on those platforms and channels to encourage users to add the KIDOODLE.TV app to their smart TVs and/or to direct users to click through to the KIDOODLE.TV app. Mr Gruninger states that in 2023 to 2024 the opponent spent in excess of £550,000 in marketing of the KIDOODLE.TV app on these platforms for the UK market. He states that these figures are separate to the global advertising spend which “still has an impact on the UK consumer and industry.” It is not explained how non-UK advertising has an impact on the UK consumer. Exhibit NDG8 comprises three invoices headed

Amazon Advertising issued by Amazon Online UK Limited to Kidoodle, Inc (presumably a subsidiary of the opponent: this is not explained):

- invoice dated 4 October 2023 for the period 1 September 2023 to 30 September 2023: £95,973.89 for “Amazon UK Fire TV Auction Bundle (Subscriptions) and Sponsored Tiles (ie. KIDOODLE.TV app icon)”;
- invoice dated 3 November 2023 for the period 1 October 2023 to 31 October 2023: £192,641.02 for “Amazon UK Fire TV Auction Bundle (Subscriptions) and Sponsored Tiles (ie. KIDOODLE.TV app icon)”;
- invoice dated 5 December 2023 for the period 1 November 2023 to 30 November 2023: £41,902.91 for “Amazon UK Fire TV Auction Bundle (Subscriptions)”.

14. Mr Gruninger asserts that the opponent has a worldwide and UK reputation in the KIDOODLE.TV brand, having achieved industry awards and rankings. He states that the awards include a Gold Stevie Award in the Family & Kids category at the 2020 International Business Awards (IBA). Mr Groninger states that the IBA is known and recognised as the world’s premier business awards program which considers worldwide nominations. Exhibit NDG9 contains a press release on Newswire.com about this award, dated “CALGARY, Alberta, November 2, 2020”. Another extract from “Animation UK” reports that KIDOODLE.TV was nominated for Best Kids-Only Streaming Service at the Kidscreen Awards 2024. These awards are described as for the global kids’ entertainment industry. The extract is dated 5 December 2023, which is about 6 weeks prior to the relevant date.

15. The final piece of evidence from Mr Gruninger gives details about activities which he believes to be by the applicant. He states the following:

“18. Applicant use: APMC [the opponent] has become aware of a website <https://kidoodle3d.com/> which explains and promotes that a company Guangdong Dale Technology Co., Ltd has created and is offering for sale (currently available in the United States and China) a 3D printing device which specifically [sic] designed for children between the ages of 6 – 14. The 3D

printing device is called Kidoodle and a logo **Kidoodle** appears on the device itself. The Kidoodle branded 3D printing device appears to be advertised as to enable children to make their own toys, including cartoon toys and the website shows images of various toys / toy figurines. We believe this company and the 3D printing device originate from and/or are commercially linked to the Applicant because the Application covers identical goods (3D printing devices) and the mark of the Application - **Kidoodle** is identical to the mark which appears on the 3D printing device(s) and on the website. Extracts taken from the website <https://kidoodle3d.com/> showing images of the Kidoodle branded 3D printing device are provided at Exhibit NDG10.”

Section 5(3) of the Act

16. Section 5(3) states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

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

17. Section 5A states:

“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.”³

18. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.⁴

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

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

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

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

³ This section also applies to the ground raised under section 5(4)(a) of the Act.

⁴ 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.

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

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

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in

order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

19. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public, as stated in *General Motors*:

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

20. Reputation is a knowledge threshold.⁵ The reputation must be amongst the UK relevant public. The evidence only shows use in relation to children’s entertainment on TV for the services registered in classes 38 and 41. The evidence is very thin with

⁵ *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) at paragraph 69

regards to use of the earlier marks in the UK and their exposure to the UK relevant public before the relevant date. The opponent has filed undated evidence from its website, but this does not refer to the UK. The Google UK Play store evidence appears to be dated after the relevant date because the reviews are all after the relevant date and the screenshot refers to the app having been updated on 7 August 2024. The opponent submits that the “app has an average rating of 3.8 stars from over 29,000 reviews and has been downloaded over 10 million times to Android devices from the Google UK Play Store.” That may have been the position as of the date of the extract, 8 October 2024, but the evidence does not tell me the position as of 17 January 2024. Given that there is no evidence of any UK advertising prior to September 2023, and that the articles in Exhibit NDG7 largely post-date the relevant date, are not UK-specific and/or are undated, it is not possible to take the figures of 10 million downloads and 29,000 reviews as pre-dating the relevant date. The Apple app store evidence is from the US, as is the evidence about lesson plans. The opponent submits that the Apple App store is “global but which also applies to the UK” and that the lesson plans are accessible to users in the UK. This does not mean that UK users accessed the US Apple App store or the lesson plans and comes nowhere near to the standard required for a reputation under section 5(3), as explained in *General Motors*. The article about the launch of KIDOODLE.TV on VIDAA-powered smart TVs and Mr Gruninger’s narrative about that strongly suggest that this took place in 2024, bearing in mind that the relevant date is 17 January 2024.

21. In the opponent’s favour are the seven reviews on Amazon.co.uk from 2020 and 2021 and the advertising spend to Amazon. Mr Gruninger states that the opponent spent in excess of £550,000 on advertising for the UK market in 2023 to 2024. Again, only 2023 is pertinent because the relevant date is 17 January 2024. However, Mr Gruninger does not give particularised figures for 2023. There are three invoices from 2023. They cover only the last quarter of 2023 and amount to about 60% of the £550,000 figure. I surmise that the evidence only shows that the advertising of the opponent’s marks in the UK commenced in September 2023, and this was only three months before the relevant date. I do not accept without explanation Mr Gruninger’s assertion that global advertising still has an impact upon the UK relevant public.

22. Seven reviews from UK consumers in 2020 and 2021 and three months of advertising via Amazon Fire TVs is nowhere near enough to establish that the earlier marks had a reputation amongst a significant part of the UK relevant public as of 17 January 2024. The opponent could have provided evidence as to how many UK downloads or accounts had been created prior to the relevant date, but these details are absent. There is also no evidence about the reach of its Amazon advertising or what it looked like. I have not forgotten about the awards. The Gold Stevie Award was made to the opponent in 2020. In the absence of corroborating evidence beyond seven UK reviews, I cannot tell how far this reflects the knowledge of the UK relevant public about the earlier marks. The other award dates from only about six weeks prior to the relevant date. There is simply not enough evidence prior to the relevant date, however successful the opponent's marks may have subsequently become in the UK after the relevant date, and the evidence does not cast sufficient light backwards to make a finding that there was a UK reputation at the relevant date.

23. Without a qualifying reputation, the section 5(3) ground fails. However, in case I am wrong about that, I will make a finding about whether the relevant public would make a link between the earlier marks and the applicant's mark. I will make this finding in relation to earlier marks (i), (ii), (v) and (vi) in relation to the class 38 and 41 TV services for children. Although the evidence shows that the use has been in relation to earlier marks (v) and (vi) (the KIDOODLE.TV stylised and word-only marks) I consider that this evidence also shows use in respect of earlier marks (i) and (ii), earlier mark (i) (KIDOODLE word-only) providing the opponent with its best case.⁶

24. In considering whether a link will be made between the parties' marks, I bear in mind the five factors set out by the CJEU in *Intel*: the degree of similarity between the conflicting marks; the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public; the strength of the earlier mark's reputation; the degree of the earlier mark's distinctive character, whether inherent or acquired through use; and, the existence of the likelihood of confusion on the part of the public.

⁶ See *adidas AG v EUIPO*, Case T-307/17, [2019] E.T.M.R. 44., paragraphs 54 to 59, General Court

25. Earlier mark (i) and the applicant's mark are highly similar visually, if not identical visually. They are aurally identical. Both marks comprise a portmanteau word, consisting of a blend of Kid and doodle. To the extent that Kidoodle evokes the concept of 'kid' (a child) and 'doodle' (a casual or absentminded drawing), both marks are conceptually identical.

26. In its written submissions in lieu of a hearing, the opponent says:

“Whilst on paper the goods of Contested Application and the services for which the Earlier Trade Marks are registered are dissimilar, the reality of the marketplace is such that there is real potential to see overlap between these goods and services. As evidenced in Exhibit NDG10, a 3D printing device can specifically be aimed at children to spark creativity, entertainment and fun. The Exhibit further demonstrates the use of the Contested Mark on such goods, and which are designed and created for children of the same age as those who used the KIDOODLE.TV platform. This evidence further emphasises the overlap. There is also significant potential for scenarios in which a children's television channel, platform, film or program, expand and diversify their goods and service offering to branded clothing, toys, equipment and other merchandise. It is more than reasonable to believe that, in the marketplace, the public will make a connection between the Opponent's KIDOODLE branded services and the Applicant's KIDOODLE branded goods.”

27. I agree that there is no similarity on paper between the applicant's goods and the opponent's services in classes 38 and 41 (there is no use of services in class 35). They are clearly of a different nature. The opponent submits that the purpose of the parties' goods and services is to provide entertainment, creativity and education for children. I disagree. The purpose of the opponent's services is to broadcast and to provide TV entertainment for children, whereas the purpose of the applicant's goods is to facilitate 3-D printing of items. Further, the applicant's 3D printers are in class 7;

if they were toys, class 28 would seem to be the appropriate class.⁷ Even if children's 3D printers are in class 7, there would only be a shared purpose on the generalised basis of both being for children's amusement. The specific purpose of the goods and services differs, as set out above. The goods and services will not share trade channels, are not in competition because one cannot be substituted for the other, and are in no way complementary within the meaning of *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*.⁸ The opponent claims that there is potential for overlap if the opponent diversifies its offerings to branded clothing, toys, equipment and other merchandise. I can only consider what is in the opponent's specifications, which do not cover such goods, and I can only consider those registered services for which there is a reputation.⁹

28. It follows from my earlier finding that any reputation will be modest. Although the mark is invented, it is a fairly obvious blend of 'kid' and 'doodle', which are dictionary words, the first of which is low in distinctive character for the opponent's services. The mark is inherently distinctive to a medium degree. Again, it follows from my earlier finding that any enhancement to the earlier mark's distinctive character which has been acquired through its use will be modest.

29. There will not be a likelihood of confusion on the part of the public. Although the marks are highly similar/almost identical, the goods and services are far apart and there is only a modest reputation/enhancement to the earlier mark's distinctive character. The earlier mark is not sufficiently distinctive or well-known to overcome the large gulf between the goods and services. The publicity in evidence in the three Amazon advertising invoices took place only three months prior to the relevant date and is insufficient in terms of length of time to build a strong enough reputation to bridge the gap between the goods and services.

30. Although it is not necessary for there to be a likelihood of confusion for there to be a link made between the marks, the absence of a likelihood of confusion is not

⁷ Although I note that the Nice Classification database puts them only in Class 7, at the time of writing (accessed via the website of the World Intellectual Property Organization)

⁸ Case T-325/06, General Court

⁹ *Tulliallan Burlington Ltd v EUIPO*, Case T-123/16, General Court

irrelevant either. The reputation is simply not strong enough and is of insufficient longevity, even if it creeps over the line of being sufficient to get the ground off the starting blocks, for the relevant public, despite the gap between the goods and services, nevertheless to make a link between the parties' marks. If I am wrong about that, it will be too fleeting a link to have any of the commercial consequences provided for under the heads of damage. It follows that the opponent will not be any better a position in respect of earlier marks (ii), (v) and (vi) because I have made this assessment in relation to its best case, earlier mark (i). The section 5(3) ground is not made out.

31. The section 5(3) ground fails.

Section 5(4)(a)

32. Section 5(4)(a) states:

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

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

(aa) [...]

(b) [...]

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

33. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.”

34. The three elements which the opponent must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

35. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217, at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

36. There is no evidence that the applicant has used its mark, so the relevant date is the date on which the application was filed: 17 January 2024. The opponent must show that it had sufficient goodwill at this date in its business in the UK, distinguished by the sign KIDOODLE, to bring the claim. I have already outlined the problems with

the opponent's evidence in terms of lack of dating, dating close to and after the relevant date, and lack of UK specificity. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

37. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie,

that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

38. The high point of the opponent's evidence is the Amazon advertising. This is because it can be clearly dated prior to the relevant date. There are also seven reviews from UK customers on Amazon.co.uk which pre-date the relevant date, but a total of seven reviews represents a trivial goodwill for the services relied upon, even if they do indicate custom prior to the relevant date. The Amazon advertising does not represent sales and, as discussed earlier, the 10 million downloads from the UK Google Play store cannot be dated prior to the relevant date. There is no other evidence pre-relevant date which corroborates that number of downloads and there are no figures and dates showing the creation of UK customer accounts. It is not clear whether an advertising campaign featuring a mark can create a protectable goodwill without any actual sales to UK customers. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 66 of the judgment) that:

“Finally, a point which I would leave open is that discussed in the judgment of Sundaresh Menon CJ in *Staywell* (see para 46 above), namely whether a passing off claim can be brought by a claimant who has not yet attracted goodwill in the UK, but has launched a substantial advertising campaign within the UK making it clear that it will imminently be marketing its goods or services in the UK under the mark in question. It may be that such a conclusion would not so much be an exception, as an extension, to the “hard line”, in that public advertising with an actual and publicised imminent intention to market, coupled with a reputation thereby established may be sufficient to generate a protectable goodwill. On any view, the conclusion would involve overruling *Maxwell v Hogg*, and, if it would be an exception rather than an extension to the “hard line”, it would have to be justified by commercial fairness rather than principle. However, it is unnecessary to rule on the point, which, as explained in para 46, has some limited support in this jurisdiction and clear support in Singapore. Modern developments might seem

to argue against such an exception (see para 63 above), but it may be said that it would be cheap and easy, particularly for a large competitor, to “spike” a pre-marketing advertising campaign in the age of the internet. It would, I think, be better to decide the point in a case where it arises. Assuming that such an exception exists, I do not consider that the existence of such a limited, pragmatic exception to the “hard line” could begin to justify the major and fundamental departure from the clear, well-established and realistic principles which PCCM's case would involve. In this case, PCCM's plans for extending its service into the UK under the NOW TV mark were apparently pretty well advanced when Sky launched their NOW TV service, but the plans were still not in the public domain, and therefore, even if the exception to the “hard line” is accepted, it would not assist PCCM.”

39. It appears to be clear that advertising under a mark is not sufficient to create an actionable goodwill where was no imminent prospect of trade commencing at the time: *Bernadin (Alain) et Cie v Pavilion Properties Ltd* [1967] RPC 581. Pre-launch publicity appears to have been accepted as sufficient to create an actionable goodwill in the cases of *Allen v Brown Watson* [1965] RPC 191 and *BBC v Talbot* [1981] FSR 228, but as explained in paragraph 3-156 of *Wadlow on the Law of Passing Off*, 6th Ed., the plaintiffs in these cases had long established businesses and goodwills in the UK. The real issue was whether their new marks had become distinctive of those businesses to their UK customers through advertising alone. There is no evidence in the present case that the opponent had long-established businesses and goodwills in the UK and seven Amazon reviews are not enough to show the same. Until the law is clarified, it is therefore doubtful whether a business with no sales to UK customers can establish a passing off right based solely on advertising.

40. I am unconvinced that the burst of advertising shortly before the relevant date takes the opponent over the line from trivial to small, but protectable, goodwill.¹⁰ The UK trade mark system is based on first to file. If a party wishes to show that it has antecedent rights, it must prove that it had goodwill in the UK in relation to the sign at

¹⁰ *Hart v Relentless Records* [2002] EWHC 1984 (Ch) and *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC, sitting as the Appointed Person

the filing date of the applied for mark. It is not enough for a party to show that its trade in the UK took off soon after that date, however rapidly. The opponent has not shown that it had a protectable goodwill in the UK at the relevant date. Without that, its opposition fails.

41. If the opponent did have a protectable goodwill in its broadcasting and TV entertainment services for children at the relevant date, I would nevertheless still find that the opposition fails. The level of goodwill would be small and by no means sufficient to bridge the distance between the goods and services of the parties and lead to the conclusion that, on a *quia timet* basis, there would be misrepresentation and damage to the opponent's limited level of goodwill.¹¹ Even if, contrary to my finding earlier, the opponent's sign was brought to mind, it would still not be sufficient for deception to arise. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited*, [2013] EWPC 18 (PCC), Mr Iain Purvis QC, as a Recorder of the Court stated that:

“54. Mr Aikens stressed in his argument the difference between ‘mere wondering’ on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at 16–17 Jacob LJ stressed that the former was not sufficient for passing off. He concluded at 17:

‘This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former’.”

42. I find that there would not have been a substantial number of the opponent's customers and potential customers who would have been deceived at the relevant date into believing that the applicant's goods were connected to the opponent.¹² As of 17 January 2024, the opponent was not entitled to restrain the use of the applicant's mark under the law of passing off. The section 5(4)(a) ground fails.

¹¹ *Harrods Limited v Harrodian School Limited* [1996] RPC 697

¹² *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473

43. The section 5(4)(a) ground fails.

Overall outcome

44. The opposition fails under both grounds. The application may proceed to registration.

Costs

45. The applicant has been successful and is entitled to an award of costs, based on the scale published in Tribunal Practice Notice 1/2023, as follows:

Considering the notice of opposition and preparing the counterstatement	£400
Considering the opponent's evidence (without commenting upon it, hence a reduction to the scale minimum)	£300
Total	£700

46. I order A Parent Media Co. Inc. to pay to Hainan Sanlan Technology Holdings Co., Ltd. the sum of £700. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of May 2026

**Judi Pike
For the Registrar**

Annex

Earlier mark (i) 3396397

Class 35: Promoting the goods of others, namely, providing online discount information and purchasing services of vouchers, gift certificates, coupons and other discounts for the promotion and sale of goods and services of others; promotional services, namely, promoting the goods of others by means of providing digital coupons, rebates and vouchers distributed electronically to computers, mobile phones and other electronic devices.

Class 38: On-line electronic transmission of information and data, namely, transmission of music, movies, games and television programs for children; audio broadcasting and transmission of educational and entertainment digital media for children, namely, streaming of video via the Internet featuring music, movies, games and television programs for children for educational and entertainment purposes; distribution of educational and entertainment television and motion picture programming by means of digital transmission over the Internet; video-on-demand transmission services; video broadcasting via the Internet, namely, streaming of audio and video via the Internet featuring music, movies, games and television programs for children; transmission and distribution of voice, audio, video, images, signals, messages and information relating to children's television programs.

Class 41: Entertainment and educational services, namely, distribution of educational and entertainment television and motion picture programming for others by means of digital transmission over the Internet; entertainment services, namely, providing portions of prerecorded audio, visual and audiovisual works via the Internet; making available at a time and place selected by the user of reviewed and curated information and data, namely, music, movies, games and television programs appropriate for viewing by children.

Earlier mark (ii) 3396400

Class 35: Promoting the goods of others, namely, providing online discount information and purchasing services of vouchers, gift certificates, coupons and other discounts for the promotion and sale of goods and services of others; promotional services, namely, promoting the goods of others by means of providing digital coupons, rebates and vouchers distributed electronically to computers, mobile phones and other electronic devices.

Class 38: On-line electronic transmission of information and data, namely, transmission of music, movies, games and television programs for children; audio broadcasting and transmission of educational and entertainment digital media for children, namely, streaming of video via the Internet featuring music, movies, games and television programs for children for educational and entertainment purposes; distribution of educational and entertainment television and motion picture programming by means of digital transmission over the Internet; video-on-demand transmission services; video broadcasting via the Internet, namely, streaming of audio and video via the Internet featuring music, movies, games and television programs for children; transmission and distribution of voice, audio, video, images, signals, messages and information relating to children's television programs.

Class 41: Entertainment and educational services, namely, distribution of educational and entertainment television and motion picture programming for others by means of digital transmission over the Internet; entertainment services, namely, providing portions of prerecorded audio, visual and audiovisual works via the Internet; making available at a time and place selected by the user of reviewed and curated information and data, namely, music, movies, games and television programs appropriate for viewing by children.

Earlier mark (iii) 3396408

Class 38: On-line electronic transmission of information and data, namely, transmission of music, movies, games and television programs for children; audio broadcasting and transmission of educational and entertainment digital media for children, namely, streaming of video via the Internet featuring music, movies, games and television programs for children for educational and entertainment purposes; distribution of educational and entertainment television and motion picture programming by means of digital transmission over the Internet; video-on-demand transmission services; video broadcasting via the Internet, namely, streaming of audio and video via the Internet featuring music, movies, games and television programs for children; transmission and distribution of voice, audio, video, images, signals, messages and information relating to children's television programs.

Class 41: Entertainment and educational services, namely, distribution of educational and entertainment television and motion picture programming for others by means of digital transmission over the Internet; entertainment services, namely, providing portions of prerecorded audio, visual and audiovisual works via the Internet; making available at a time and place selected by the user of reviewed and curated information and data, namely, music, movies, games and television programs appropriate for viewing by children.

Earlier mark (iv) 3396420

Class 38: On-line electronic transmission of information and data, namely, transmission of music, movies, games and television programs for children; audio broadcasting and transmission of educational and entertainment digital media for children, namely, streaming of video via the Internet featuring music, movies, games and television programs for children for educational and entertainment purposes; distribution of educational and entertainment television and motion picture programming by means of digital transmission over the Internet; video-on-demand transmission services; video broadcasting via the Internet, namely, streaming of audio

and video via the Internet featuring music, movies, games and television programs for children; transmission and distribution of voice, audio, video, images, signals, messages and information relating to children's television programs.

Class 41: Entertainment and educational services, namely, distribution of educational and entertainment television and motion picture programming for others by means of digital transmission over the Internet; entertainment services, namely, providing portions of prerecorded audio, visual and audiovisual works via the Internet; making available at a time and place selected by the user of reviewed and curated information and data, namely, music, movies, games and television programs appropriate for viewing by children.

Earlier mark (v) 3396422

Class 35: Promoting the goods of others, namely, providing online discount information and purchasing services of vouchers, gift certificates, coupons and other discounts for the promotion and sale of goods and services of others; promotional services, namely, promoting the goods of others by means of providing digital coupons, rebates and vouchers distributed electronically to computers, mobile phones and other electronic devices.

Class 38: On-line electronic transmission of information and data, namely, transmission of music, movies, games and television programs for children; audio broadcasting and transmission of educational and entertainment digital media for children, namely, streaming of video via the Internet featuring music, movies, games and television programs for children for educational and entertainment purposes; distribution of educational and entertainment television and motion picture programming by means of digital transmission over the Internet; video-on-demand transmission services; video broadcasting via the Internet, namely, streaming of audio and video via the Internet featuring music, movies, games and television programs for children; transmission and distribution of voice, audio, video, images, signals, messages and information relating to children's television programs.

Class 41: Entertainment and educational services, namely, distribution of educational and entertainment television and motion picture programming for others by means of digital transmission over the Internet; entertainment services, namely, providing portions of prerecorded audio, visual and audiovisual works via the Internet; making available at a time and place selected by the user of reviewed and curated information and data, namely, music, movies, games and television programs appropriate for viewing by children.

Earlier mark (vi) 3482866

Class 38: On-line electronic transmission of information and data; transmission of music, movies, games and television programs for children; Audio broadcasting and transmission of educational and entertainment digital media for children; streaming of video via the Internet featuring music, movies, games and television programs for children for educational and entertainment purposes; Distribution of educational and entertainment television and motion picture programming by means of digital transmission over the internet; Video-on-demand transmission services; Video broadcasting via the Internet; streaming of audio and video via the Internet featuring music, movies, games and television programs for children; Transmission and distribution of voice, audio, video, images, signals, messages and information relating to children's television programs.

Class 41: Entertainment and educational services; distribution of educational and entertainment television and motion picture programming for others by means of digital transmission over the internet; Entertainment services; providing portions of prerecorded audio, visual and audiovisual works via the internet.