

O/0547/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL
REGISTRATION NO. 1695437 BY
MARK BECKFORD**

AND

**IN THE MATTER OF UK TRADE MARK APPLICATION
NO. 3862533 BY
MARK BECKFORD**

AND

**IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NOS. 440567 & 440569 BY
LAKESHIA FORD**

BACKGROUND AND PLEADINGS

1. Mark Beckford (“the applicant”) is the holder of International Registration (IR) No. 1695437 (“the contested IR”). It has a registration date of 30 September 2022 and it was designated for protection in the United Kingdom on the same date. The IR is shown below:

PINE_xGINJA

2. The designation was accepted and published on 3 February 2023 in respect of the following services:

Class 41

Conducting entertainment exhibitions in the nature of parties, and panel discussions; consultation in the field of special event planning for social entertainment purposes; entertainment and educational services, namely, the presentation of seminars, lectures, workshops and panel discussions, and ongoing television and radio talk shows all in the field of public interest concerning culture and lifestyle; hosting social entertainment events, namely, parties, and panel discussions, for others; special event planning for social entertainment purposes; ticket reservation and booking services for recreational and leisure events, namely, parties and panel discussions.

3. On 25 December 2022, the applicant applied to register **Pine and Ginjer** and **PINE AND GINJER** (“the contested mark”) as a series of two trade marks in the United Kingdom. It was accepted and published on 3 February 2023 in respect of the following goods and services:

Class 15

Musical instruments; Music rests for musical instruments; Music stands adapted for use with musical instruments; Musical synthesizers; Percussion instruments [musical]; Percussion musical instruments; Electronic musical instruments; Musical accessories.

Class 35

Promotion of musical concerts; Promotion [advertising] of concerts; Organisation of exhibitions and events for commercial or advertising purposes; Production of video recordings for marketing purposes; Online retail services for downloadable and pre-recorded music and movies; Business management of musical performers; Business management of entertainers.

Class 36

Financing of investments; Financial sponsorship of theater events; Financial sponsorship of dance events; Advisory services relating to investments and finance; Venture capital funding services for companies; Financial sponsorship of visual arts events; Financial sponsorship of entertainment activities; Investment fund services; Fund investment services; International fund investment; Venture capital funding services for universities; Financial planning services relating to building projects; Crowdfunding services in the nature of providing financing from money collected from individuals; Retail financing services; Financial investment advisory services; Fundraising and financial sponsorship; Financing services relating to hotels; Financing of building projects; Arranging of finance for sporting, cultural and entertainment projects.

Class 38

Broadcasting of television programs via the Internet; Internet radio broadcasting services; Video, audio and television streaming services; Transmission of digital audio and video broadcasts over a global computer network; Provision of communication access to films and television programmes via an on-demand service; Broadcasting of audiovisual and multimedia content via the Internet; Audio broadcasting; Streaming audio and video material on the Internet; Digital audio broadcasting; Music broadcasting; Streaming of audio material on the internet; Delivery of digital music by telecommunications.

Class 41

Music performances; Conducting of film festivals; Production of music; Presentation of musical concerts; Musical entertainment; Band performances (Live -); Tuition in music; Music composition services; Live performances by a musical bands [sic]; Entertainment in the nature of live performances by musical

bands; Presentation of live Christmas musical productions; Music mixing services; Arranging of festivals for entertainment purposes; Composition of music for others; Film studios; Radio entertainment production; Entertainment in the nature of theater productions; Circus performances; Education and training in the field of music and entertainment; Presentation of musical performances; Performance of dance, music and drama; Entertainment in the nature of live dance performances; Theatre performances; Musical performances; Presentation of concerts; Ticket reservation and booking services for music concerts; Entertainment services in the form of television programmes; Aerial photography; Audio, video and multimedia production, and photography; Digital video, audio and multimedia entertainment publishing services; Ticket procurement services for entertainment events; Organization of entertainment events; Organisation of entertainment events; Provision and management of sporting events; Production of entertainment in the form of a television series; Production of television entertainment programmes; Consultancy on film and music production; Services for the production of entertainment in the form of film; Production of video films; Entertainment booking services; Ticket agency services [entertainment]; Music entertainment services; On-line ticket agency services for entertainment purposes; Musical group entertainment services; Administration [organisation] of entertainment services; Live entertainment production services; Booking of entertainment; Provision of entertainment services through the media of television; Popular entertainment services; Camp services (Holiday -) [entertainment]; Live musical concerts; Music concerts; Organisation of musical concerts; Presentation of live performances by a musical group.

Class 42

Digital watermarking; Encryption of digital images; Design of software for digital signal processing; Cross-platform conversion of digital content into other forms of digital content; Rental of entertainment software.

Class 45

Licensing of rights to films, television and video productions; Concierge services; Hotel concierge services; Licensing of musical shows; Legal consultancy relating to television advertising, television entertainment and sports.

4. On 2 May 2023, both the designation and the application were opposed by Lakeshia Ford ("the opponent") under sections 5(2)(b) and 3(6) of the Trade Marks Act 1994 ("the Act"). In addition, the contested designation is also opposed under sections 5(1) and 5(2)(a) of the Act. The oppositions are directed against all the goods and services listed above. Under section 5(2)(b) in both oppositions and sections 5(1) and 5(2)(a) in the opposition to contested mark, the opponent relies on UK Trade Mark No. 3834623, which is shown below. It has an application date of 29 September 2022 and a registration date of 27 January 2023.



5. The services for which the earlier mark is registered are as follows:

Class 35

Event marketing; Conducting of commercial events; Promotion of special events; Marketing services relating to esports events; Arranging and conducting of commercial events; Arranging and conducting of marketing events; Arranging and conducting of promotional events; Advertising services relating to esports events; Promotion of sports competitions and events; Arranging and conducting of advertising events; Promotion services relating to esports events; Arranging promotion of charitable fundraising events; Organisation of events for commercial and advertising purposes.

Class 41

Cultural activities; Cultural services; Providing cultural activities; Organization of cultural shows; Organisation of cultural events; Conducting of cultural events; Workshops for cultural purposes; Arranging of cultural events; Conducting of

cultural activities; Organising community cultural events; Sporting and cultural activities; Cultural and sporting activities; Organizing cultural and arts events; Exhibitions (Conducting -) for cultural purposes; Entertainment, sporting and cultural activities; Organising events for cultural purposes; Information relating to cultural activities; Exhibitions (Arranging -) for cultural purposes; Ticket reservation for cultural events; Providing information about cultural activities; Administration [organisation] of cultural activities; Arranging of festivals for cultural purposes; Organization of events for cultural purposes; Organization of shows for cultural purposes; Arranging of demonstrations for cultural purposes; Arranging of conventions for cultural purposes; Festivals (Organisation of -) for cultural purposes; Arranging of competitions for cultural purposes; Arranging and conducting of cultural activities; Organizing community sporting and cultural events; Arranging of presentations for cultural purposes; Arranging of displays for cultural purposes; Arranging of exhibitions for cultural purposes; Fetes (Organisation of -) for cultural purposes; Organisation of entertainment and cultural events; Arranging of seminars relating to cultural activities; Provision of visitor attractions for cultural purposes; Arranging of conferences relating to cultural activities; Organisation of cultural activities for summer camps; Exhibitions (Organization of -) for cultural or educational purposes; Arranging of exhibitions for cultural or educational purposes; Providing user ratings for entertainment or cultural purposes; Organization of exhibitions for cultural or educational purposes; Organisation of exhibitions for cultural and educational purposes; Organisation of exhibitions for cultural or educational purposes; Ticket reservation and booking services for cultural events; Organization of exhibitions for cultural and educational purposes; Providing user reviews for entertainment or cultural purposes; Providing user rankings for entertainment or cultural purposes; Organisation of events for cultural, entertainment and sporting purposes; Conducting guided tours of cultural sites for educational purposes; Cultural, educational or entertainment services provided by art galleries; Organisation of animal exhibitions for cultural or educational purposes; Organisation of congresses and conferences for cultural and educational purposes; Organisation and holding of fairs for cultural or educational purposes; Providing will-call ticket services for entertainment, sporting and cultural events;

Rental services relating to equipment and facilities for education, entertainment, sports and culture.

6. The opponent claims that the contested IR is identical to the earlier mark, while the services are also identical. In the event that the marks are not considered to be identical, the opponent claims that they are highly similar and that, given the identity of the services, there is a likelihood of confusion on the part of the public.

7. The opponent claims that the contested mark is highly similar to the earlier mark, with both being a play on “Pine and Ginger”, which is the name of a Caribbean cocktail and, the opponent states, *“a phrase which describes something as sweet and spicy”*.¹ It claims that the services in Classes 35 and 41 are identical, while the applicant’s remaining goods and services are similar or complementary to its own services. Consequently, there is a likelihood of confusion on the part of the public.

8. The claim under section 3(6) is the same in both oppositions. The opponent claims that she came up with the idea for the PINExGINJA events and owned earlier trade marks in Jamaica, Nigeria and Ghana. The applicant had previously worked for her company, Ford Communications, and so was fully aware of the mark and the opponent’s intentions to launch PINExGINJA events and related activities in the UK. She claims that he only made the applications in dispute to prevent the opponent from using the mark in the UK and securing further registered rights and to convince third parties of his ownership of the name.

9. The applications were defended by the applicant. He asserts that his goods and services are not identical or similar to the opponent’s services, as the opponent’s services are broad and the services he offers are particularly focused on music. He also claims that the marks are visually dissimilar. In addition, the applicant asserts that the contested mark is aurally dissimilar to the earlier mark. The applicant denies all the opponent’s claims under section 3(6). He claims that he came up with the name PINExGINJA and commissioned the creation of the logo design.

¹ Form TM7, answer to Q9.

10. The applicant also applied on 15 February 2023 for the opponent's earlier mark to be declared invalid on the grounds of bad faith and passing off, but this application was deemed withdrawn after the applicant failed to file admissible evidence.

EVIDENCE & SUBMISSIONS

11. A document signed by the applicant's representative was filed on 11 September 2023. The document was not in the form of a witness statement and the applicant was asked to resubmit it in the correct format and file a request for a retrospective extension of time. This was not done and the document was admitted as submissions.

12. The opponent filed evidence in the form of a witness statement from Ms Ford dated 11 September 2023. It is accompanied by eight exhibits and goes to the claims that the applicant acted in bad faith.

13. Neither side requested a hearing and so I have taken this decision following a careful consideration of the papers. I note here that neither side filed written submissions in lieu of a hearing.

REPRESENTATION

14. The opponent was initially represented by Elkington & Fife LLP and then represented herself. The applicant is represented by Fractional IP Consulting.

RELEVANCE OF EU LAW

15. 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.

PRELIMINARY ISSUE

16. In its counterstatements, the applicant refers to the mark relied upon by the opponent as "*the alleged earlier mark*". He claims that his contested IR has a priority date of 18 February 2020 through US Trademark No. 6473870, the application for

which was filed on that date. However, under the Paris Convention for the Protection of Industrial Property and the Madrid Protocol, the period allowed for making an application that enjoys the right of priority is six months from the date of filing of the first application. This period expired on 19 August 2020. The contested IR therefore has no priority date and the mark relied on by the opponent is an earlier mark, as it was applied for the day before the registration of the contested IR.

DECISION

Legislation

17. Section 5(1) of the Act is as follows:

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

18. Section 5(2) of the Act is as follows:

“A trade mark shall not be registered if because-

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

(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.”

19. Section 3(6) of the Act is as follows:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.

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Section 5(1)

20. In *SA Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54. ... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

21. The respective marks are shown below

Contested IR	Earlier mark
	

22. The contested IR is a stylised word mark. The two words “PINE” and “GINJA” are presented in large italic upper-case letters, separated by a small italic letter “x”. The mark is in black.

23. The earlier mark consists of the same words, with “PINE” and “GINJA” also presented in large italic upper-case letters, separated by a small italic “x”. Each of the letters is shown in yellow and red, with the colours forming what the applicant describes as “*an ombre effect*”.² At the end of the mark are the letters “TM” in superscript. In my view, these two letters will be disregarded by the average consumer, as they merely serve to indicate that the phrase is being used as a trade mark. The verbal element of the mark is presented as an upwards diagonal on a black background.

² Written submissions of the applicant, page 3.

24. A black and white version of a mark should normally be considered on the basis that it could be used in any colour: see *Specsavers International Healthcare Ltd & Ors v Asda Stores Ltd* [2014] EWCA Civ 1294, paragraph 5; *J.W. Spear & Sons Ltd & Ors v Zynga Inc.* [2015] EWCA Civ 290, paragraph 47. However, it is not appropriate notionally to apply complex colour arrangements to a mark registered in black and white. In my view, the colours used in the earlier mark constitute a complex colour arrangement. They represent a point of difference between the marks that would not go unnoticed by an average consumer. I find that the marks are not identical.

25. The opposition fails under section 5(1). It will also fail under section 5(2)(a) for the same reason.

Section 5(2)(b)

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

- 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 they have kept in their mind, and whose attention varies according to the category of goods or services in question;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and
- k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

27. It is settled case law that I must make my comparison of the services on the basis of all relevant factors. These include the nature of the services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the General Court (“GC”) said in *Boston Scientific Ltd v Office for*

Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-325/06, services are complementary when

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

28. The applicant's services are as follows:

Class 41

Conducting entertainment exhibitions in the nature of parties, and panel discussions; consultation in the field of special event planning for social entertainment purposes; entertainment and educational services, namely, the presentation of seminars, lectures, workshops and panel discussions, and ongoing television and radio talk shows all in the field of public interest concerning culture and lifestyle; hosting social entertainment events, namely, parties and panel discussions, for others; special event planning for social entertainment purposes; ticket reservation and booking services for recreational and leisure events, namely, parties and panel discussions.

29. Where services in the specification of one party's mark are included in a broader term from the other party's specification, those services are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29. I also bear in mind that it is permissible for the purposes of my assessment to group services together where they are “*sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons*”: see *SEPARODE Trade Mark*, BL O-399-10, paragraph 5.

30. I do not have any detailed submissions from either party on the comparison of services. The applicant notes that the opponent's earlier mark covers general services in Class 41 related to education, entertainment, sports and cultural events, but that his own services are focused on music, film and entertainment events. The opponent does not expand on her claim made in the notice of opposition that the services are identical or, if not identical, highly similar.

31. In the context of registering or protecting a new mark, it is necessary to consider all the circumstances in which the mark applied for might fairly be used, should it be registered: see *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66. Differences between the parties' current services are therefore irrelevant to the assessment I am required to make, except to the extent that those differences are apparent from the lists of services included in their respective specifications. Furthermore, consideration of a likelihood of confusion is prospective and should not be restricted to the current marketing or trading patterns of the parties: see *Oakley v OHIM*, Case T-116/06.

32. The applicant's *Conducting entertainment exhibitions in the nature of parties, and panel discussions; consultation in the field of special event planning for social entertainment purposes; hosting social entertainment events, namely, parties and panel discussions, for others; special event planning for social entertainment purposes* are covered by the opponent's broader term *Entertainment ... activities*. I find them to be identical per *Meric*.

33. I shall compare the applicant's *Entertainment and educational services, namely, the presentation of seminars, lectures, workshops and panel discussions and ongoing television and radio talk shows all in the field of public interest concerning culture and lifestyle* to the opponent's *Entertainment ... and cultural activities*. In so far as the applicant's services relate to *Entertainment*, they are identical per *Meric*. In my view, the *educational services* would be *Meric* identical to *Cultural activities*. This is because I consider that the average consumer would understand *Cultural activities* to include not only arts such as opera, ballet and theatre, but also activities relating to the traditions and practices of a particular group or society. A duality of function is possible, as noted by Mr Philip Harris, sitting as the Appointed Person, in *AZTEC Trade Mark*, BL O/0055/25, paragraph 28. However, if I am wrong in this, I find that the services are highly similar. The users are the same, as is the method of use. I consider that there is an overlap in purpose, as the users will attend the events or watch or listen to the talk shows in order to find out information. There may be an overlap in trade channels and if the services do not have a dual function there will be some competition, as the average consumer could choose a more overtly educational or entertaining service.

34. I shall compare the applicant's *Ticket reservation and booking services for recreational and leisure events, namely, parties and panel discussions* to the opponent's *Providing will-call ticket services for entertainment, sporting and cultural events*. I understand that the opponent's services are ticket reservation and booking services for a wide variety of types of event that require the customer to collect their tickets before the performance or the match. Therefore, I find that they are identical to the applicant's services per *Meric*.

Average consumer and the purchasing process

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

“16. First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and customers.

17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They represent consumers who have a spectrum of attributes such as gender, age, ethnicity and social group. ... It follows that assessment from the perspective of the average consumer does not involve the imposition of a single meaning rule akin to that applied in defamation law (but not malicious falsehood). ... if having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, then a finding of infringement may properly be made.

18. Thirdly, assessing from the perspective of the average consumer is designed to facilitate adjudication of trade mark disputes by providing an

objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence. ...

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

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

36. The average consumer of the parties' services is a member of the general public. The price of the services will vary but, in my view, the level of attention paid is likely to be medium. The purchasing process is likely to be largely visual. The average consumer will see the mark used on promotional literature, website and on signage or advertisements in the street. There may also be a role for word-of-mouth recommendations and advertising on radio or podcasts.

Comparison of marks

37. It is clear from *SABEL BV v Puma AG*, Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: see, in particular, paragraph 23 of that judgment. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-519/12 P, that:

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

38. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

39. For the convenience of the reader, I shall reproduce the marks again:

Contested IR	Earlier mark
	

40. I have already described the marks in paragraphs 22-23 above.

Overall impression of the marks

41. I consider that both “PINE” and “GINJA” make an equal contribution to the overall impression of the contested IR. In the context of brands and trade marks, the letter “x” will be understood by a significant proportion of consumers to indicate a collaboration. Its role is therefore smaller than those of the two words. The italicised form of the letters will make a still smaller contribution.

42. Turning now to the earlier mark, I also consider that “PINE” and “GINJA” make equal contributions to the overall impression of this mark, and that the parts played by the other elements of the mark are smaller. The colour makes a greater contribution than the italics of the letters and their diagonal presentation, and, in my view, a roughly equal contribution to that made by the small “x”. As I have already found, the letters “TM” are not distinctive and will be disregarded by the average consumer.

Visual comparison

43. The only differences between the marks are the colours of the letters, the diagonal presentation of the letters in the earlier mark and the non-distinctive letters “TM”, also

in the earlier mark. The most distinctive elements of the mark are identical. Taking all these factors into account, I find that the marks are visually highly similar.

Aural comparison

44. As the verbal elements of the marks, which are the only ones that will be articulated, are identical, I find the marks to be aurally identical.

Conceptual comparison

45. I have already referred to the opponent's claims that both marks are a play on "Pine and Ginger", a Caribbean cocktail with pineapple and ginger as ingredients, or that they will be understood to mean "sweet and spicy". There may be some consumers who are aware of either, or both, of these meanings, but I consider that a significant proportion of consumers will not know about either of them. I accept that "GINJA" is likely to be perceived to be a misspelling of "ginger", but "PINE" could refer to the tree or the wood that comes from it or be understood as a verb that means "to long for something". Some may also see it as a shortened version of "pineapple". However, whatever meaning the average consumer attaches to the words, it will, in my view, be the same for both marks. I consider that the colours used in the earlier mark suggest heat. I find that the marks are conceptually highly similar.

Distinctive character of the earlier mark

46. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, Case C-39/97:

"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).”

47. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of the mark can be enhanced by the use that has been made of it. The opponent has filed no evidence that it has used the mark in the UK and so I have only the inherent position to consider.

48. “PINE” is a standard English word and is not descriptive or allusive of the services for which the earlier mark is registered. I have already found that “GINJA” is likely to be understood to be a misspelling of “GINGER”, and that misspelling increases the distinctive character of that word. As with “PINE”, this word has no descriptive or allusive quality. The combination of the two words with the letter “x” has a fairly high degree of distinctive character, although I would not put it at the very highest level. I do not consider that the colours and stylisation raise this any further.

Conclusions on likelihood of confusion

49. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the services at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. Because this is a global assessment, there is some interdependence between the factors and so a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services or vice versa.

50. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different but assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

51. Earlier in my decision, I found that:

- a) The services are identical but, if I am wrong in my assessment of the educational services, those services are highly similar to services in the opponent's specification;
- b) The average consumer is a member of the general public who will pay a medium degree of attention in what is largely a visual purchasing process;
- c) The marks are visually and conceptually highly similar and aurally identical; and
- d) The earlier mark has a fairly high degree of inherent distinctive character.

52. Taking all these factors into account, I am of the view that the average consumer, who recalls marks only imperfectly, will not remember the colours used or whether the words are presented diagonally or not, and so will be directly confused.

53. The opposition is successful under section 5(2)(b).

Section 3(6)

54. In *Skykick UK Ltd & Anor v Sky Ltd & Ors (Rev1)*, [2024] UKSC 36, the Supreme Court considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, *Sky plc & Ors v Skykick UK Limited & Anor*, Case C-371/18, *AS v Deutsches Patent- und Markenamt*, Case C-541/18, *Malaysia Dairy Industries Pte. Ltd v Ankenævnet for Patenter Varemærker* Case C-320/12, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, *Hasbro, Inc. v European Union Intellectual Property Office (EUIPO)*, Case T-663/19, *pelicantravel.com s.r.o. v OHIM*, Case T-136/11, and *Psytech International Ltd v OHIM*, Case T-507/08. Lord

Kitchin explained that the categories of bad faith and the circumstances which may constitute bad faith are not “closed” and continued:

“152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”), paras 46 and 47 [...]”

55. Later in the same judgment, he set out a series of general principles applying to bad faith cases and I consider that the ones that are relevant in these proceedings are the following:

“240. The general principles are these:

(i) ...

(ii) The date for assessing whether an application to register an EU trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation in the European Union, and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*Malaysia Dairy*, para 29; *Sky CJEU*, para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the EU law of trade marks, namely the establishment and functioning of the internal market, and a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; *Koton*, para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent

administrative or judicial authorities having regard to the objective circumstances of the case (*Hasbro*, paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

...”

56. In *Alexander Trade Mark*, BL O/036/18, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, identified the following as the key questions to be addressed under this ground:

- a) What, in concrete terms, was the objective that the party alleged to have acted in bad faith has been accused of pursuing?
- b) Was that an objective for the purposes of which the contested application could not properly be filed?
- c) Has it been established that the contested application was filed in pursuit of that objective?

57. The opponent alleges that the applicant was aware of her intention to use the earlier mark in the UK and made the application in order to prevent her from so doing and to convince third parties that he owned the name.

58. Although it may be a relevant factor, the mere fact that the applicant knew that another party was using the trade mark in another territory does not establish bad faith: see *Malaysia Dairy Industries*, paragraph 36. In *Wright v Dell Enterprises Inc* (HOGS

AND HEIFERS Trade Mark), BL O/580/16, Professor Ruth Annand, sitting as the Appointed Person, noted that, given the territorial nature of intellectual property rights, the mere appropriation of a name registered or used abroad was not enough under UK law, and that there needed to be something else involved before a finding of bad faith could be justified: see paragraph 45 of that decision.

59. Ms Ford states that in 2018 her company, Ford Communications, produced an event in Ghana under the name “PinexGinja”. According to her evidence, the name was inspired by a popular Jamaican song called “Pine and Ginger” and was decided on in a brainstorming session between her and the applicant. The intention was to run pop-up events in different cities and Ms Ford says that she asked the applicant to file an application for a trademark in the US in the name of Ford Communications, her own name or both their names. In fact, he filed the application in his own name. Ms Ford says this forms a pattern of deceptive behaviour, which has continued with the promotion in July 2023 by the applicant of a PinexGinja event in the UK.³

60. The difficulty for Ms Ford is that she does not give any evidence of specific plans to use the mark in the UK. While she refers to an intention to organise pop-up events in different cities, none of these cities is mentioned. I have noted the evidence filed in relation to the applicant’s application for the US Trademark, but that is not the subject of this action. Furthermore, there is no documentary evidence setting out the exact instructions given to the applicant with regard to the filing of the application for the US Trademark. I remind myself that an allegation of bad faith is a serious one that must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies. However, Arnold J (as he then was) said that “*cogent evidence is required due to the seriousness of the allegation*”: see *Red Bull GmbH v Sun Mark Limited & Anor* [2012] EWHC 1929 (Ch), paragraph 133. In my view, the opponent has failed to establish a *prima facie* case that the designation of the IR for protection in the UK was made in bad faith.

61. The opposition to the contested designation fails under section 3(6), but it has fully succeeded under section 5(2)(b).

³ Exhibit LF8.

The Opposition to Trade Mark Application No. 3862533

Section 5(2)(b)

62. The principles to be applied in assessing the likelihood of confusion have already been set out in paragraph 26 above.

Comparison of goods and services

63. The specification of the contested mark includes goods and services in Classes 15, 35, 36, 38, 41, 42 and 45 of the Nice Classification. Neither party has provided detailed submissions on the degree of similarity between the applicant's and the opponent's terms.

64. In his decision in *Smart X Trade Mark*, BL O/0911/24, Mr Iain Purvis KC, sitting as the Appointed Person, said:

“28. ... it is for the Opponent to put forward the combination 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. The approach ... 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. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent.”

65. Later, he said:

“31(v) In fact (as I have pointed out) the Hearing Officer went beyond the written submissions in making findings of similarity in respect of a number of groups of goods on the basis of arguments which had not been raised by the Opponent. If the Applicant had complained about this by way of an Appeal, there would probably have been a good argument that he had been the victim of procedural unfairness. ...”

66. The specifications of both the contested mark and the earlier mark are fairly long and the applicant seeks registration in respect of goods and services in classes not covered by the earlier mark. Therefore, in some instances, the opponent's best case is not particularly clear. I do not consider that the case law I have cited means that in those circumstances I have to find that the parties' goods and services are dissimilar. There is a balance to be struck. In the light of *SmartX*, it would be unfair for me to go through all the opponent's terms and assess every possible comparison with the applicant's goods and services. Instead, I consider that it is reasonable that, where possible, I will identify the closest terms and carry out the comparison on that basis. In doing so, I will remain mindful of the comments of the Appointed Person regarding the danger of procedural unfairness.

Class 15

67. The applicant's goods are *Musical instruments; Music rests for musical instruments; Music stands adapted for use with musical instruments; Musical synthesizers; Percussion instruments [musical]; Percussion musical instruments; Electronic musical instruments; Musical accessories*. The purpose of these goods is the performance of music and the users are people who play those instruments. I shall compare them to the opponent's *Entertainment ... and cultural activities*, as this is a broader term that includes musical performances. The purpose of the services is to provide entertainment to the listener. While there is an overlap in the user of the goods and services, this is simply because the users of the applicant's goods are members of the general public who will also attend musical performances. The nature of the goods and services is different, as is their method of use. I do not consider that there will be any shared trade channels, as the applicant's goods will be bought from retailers of musical instruments, while the opponent's services will be distributed through concert halls and other venues. There is no competition between the services. Neither do I consider there to be any complementarity. Although the instruments are essential for the performance of the music, and music stands and music rests may also be used in performance, it is not in my view likely that the average consumer will assume that the goods and services are the responsibility of the same undertakings. I find that these goods are dissimilar to the opponent's services.

Class 35

68. In my view, the opponent's *Event marketing* is a broader term that includes the applicant's *Promotion of musical concerts; Promotion [advertising] of concerts*. I find them identical per *Meric*.

69. The applicant's *Organisation of exhibitions and events for commercial or advertising purposes* includes the opponent's *Organisation of events for commercial and advertising purposes*. If I am wrong in this, and the use of "or" or "and" makes a difference in the construction of the term, they are highly similar.

70. I now turn to the applicant's *production of video recordings for marketing purposes*. I consider that the closest comparison is the opponent's *Marketing services relating to esports events*. The applicant's term does not specify what is being marketed, so it could include esports events. Consequently, I find that they are identical per *Meric*.

71. The next services I shall consider are *Online retail services for downloadable and pre-recorded music and movies*. It is settled case law that retail services may be complementary to the goods that are the subject of those services, share the same trade channels and therefore be similar to a degree: see *Oakley, Inc v OHIM*, Case T-116/06, paragraphs 46-57. However, the goods do not appear in the opponent's specification. I do not consider that there is any similarity between these services and the opponent's Class 35 event marketing and promotional services or its Class 41 entertainment and cultural services. I find them to be dissimilar.

72. The purpose of the applicant's *Business management of musical performers* and *Business management of entertainers* is to manage the day-to-day business of a musician or entertainer. This would encompass negotiating contracts, arranging bookings and diaries, managing payroll, record keeping, tax filing, and so on. The users are the musicians and entertainers. I do not see that there is any similarity between these services and those of the opponent. I find them to be dissimilar.

Class 36

73. The applicant's services in this class are as follows:

Financing of investments; Financial sponsorship of theater events; Financial sponsorship of dance events; Advisory services relating to investments and finance; Venture capital funding services for companies; Financial sponsorship of visual arts events; Financial sponsorship of entertainment activities; Investment fund services; Fund investment services; International fund investment; Venture capital funding services for universities; Financial planning services relating to building projects; Crowdfunding services in the nature of providing financing from money collected from individuals; Retail financing services; Financial investment advisory services; Fundraising and financial sponsorship; Financing services relating to hotels; Financing of building projects; Arranging of finance for sporting, cultural and entertainment projects.

74. All the applicant's services in this class are financial services. I note that some of them are related to entertainment, such as *Financial sponsorship of entertainment activities* and *Arranging of finance for sporting, cultural and entertainment projects*. I note that the opponent's specification includes *Organisation of events for cultural, entertainment and sporting purposes* in Class 41. However, I remind myself that, when construing terms used in a specification of services, those terms should be confined to the core of the possible meanings attributable to the term: see *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, paragraph 365. In my view, the opponent's services consist of the planning, programming and administrative tasks required to put on an event. I do not consider that there is an overlap in end user: the opponent's events are targeted towards the general public, while the applicant's Class 36 services are targeted towards the businesses and other organisations putting on the events. The services differ in nature and method of use and would be delivered through different trade channels. There is no competition between them. While financial sponsorship may be necessary to put on some entertainment and cultural events, I do not consider that the average consumer would assume that the services are the responsibility of the same undertaking. Consequently, I find that they are not complementary. In my view, the opponent's Class 35 services do not put it in a better position. The applicant's Class 36 services are dissimilar to the opponent's services.

Class 38

75. The applicant's services are:

Broadcasting of television programs via the Internet; Internet radio broadcasting services; Video, audio and television streaming services; Transmission of digital audio and video broadcasts over a global computer network; Provision of communication access to films and television programmes via an on-demand service; Broadcasting of audiovisual and multimedia content via the Internet; Audio broadcasting; Streaming audio and video material on the Internet; Digital audio broadcasting; Music broadcasting; Streaming of audio material on the internet; Delivery of digital music by telecommunications.

76. The opponent's broad *Entertainment* services would include the online provision of music and videos. The applicant's Class 38 services are essentially communications services but both are targeted towards the same users and are similar in purpose, namely, enabling users to watch and/or listen to content that will entertain them. There is some similarity in nature and method of use of the services and there are likely to be some shared trade channels. I consider that there is a degree of competition between them and find them to be highly similar.

Class 41

77. The following services appear in both parties' specifications and so are self-evidently identical: *Organization of entertainment events; Organisation of entertainment events.*

78. The following services in the applicant's specification are included in the opponent's *Entertainment, sporting and cultural activities*:

Music performances; Conducting of film festivals; Production of music; Presentation of musical concerts; Musical entertainment; Band performances (Live -); Music composition services; Live performances by a musical bands [sic]; Entertainment in the nature of live performances by musical bands; Presentation of live Christmas musical productions; Music mixing services; Arranging of festivals for entertainment purposes; Composition of music for others; Film studios; Radio entertainment production; Entertainment in the nature of theater productions; Circus performances; Presentation of musical performances; Performance of dance, music and drama; Entertainment in the nature of live dance performances; Theatre performances; Musical performances;

Presentation of concerts; Entertainment services in the form of television programmes; Audio, video and multimedia production ...; Digital video, audio and multimedia entertainment publishing services; Provision and management of sporting events; Production of entertainment in the form of a television series; Production of television entertainment programmes; Consultancy on film and music production; Services for the production of entertainment in the form of film; Production of video films; Music entertainment services; Musical group entertainment services; Administration [organisation] of entertainment services; Live entertainment production services; Provision of entertainment services through the media of television; Popular entertainment services; Camp services (Holiday -) [entertainment]; Live musical concerts; Music concerts; Organisation of musical concerts; Presentation of live performances by a musical group.

79. The next group of opposed services consists of *Tuition in music* and *Education and training in the field of music and entertainment*. These are educational services. However, I consider that these particular services are likely to be perceived by the average consumer as pertaining, in some degree, to cultural activities and entertainment. The applicant's services are targeted towards the same users as the opponent's *Entertainment ... and cultural activities*. There will be an overlap in purpose and some shared trade channels. It would not be unreasonable for the average consumer to expect the competing services to be provided by the same or related undertakings. I find that the services are similar to at least a medium degree.

80. I now turn to the applicant's *Ticket reservation and booking services for music concerts; Ticket procurement services for entertainment events; Entertainment booking services; Ticket agency services [entertainment]; On-line ticket agency services for entertainment purposes; Booking of entertainment*. In paragraph 34 above, I found the applicant's *Ticket reservation and booking services for recreational and leisure events, namely, parties and panel discussions* to be identical to the opponent's *Providing will-call ticket services for entertainment, sporting and cultural events*. For the same reasons, I make the same finding here.

81. The final services in this class are *Aerial photography* and *Photography*. In my view, *Photography* would fall under the broader term of *Cultural activities*. It is not uncommon for photographs to be exhibited in art galleries. Consequently, I find them

to be identical per *Meric*. While I understand that *Aerial photography* may have a number of uses, such as cartography, it may also be used to create works of art. Consequently, I consider that *Aerial photography* is also *Meric* identical to the opponent's *Cultural activities*.

Class 42

82. I shall divide the services in this class into two groups. The first comprises *Digital watermarking; Encryption of digital images; Design of software for digital signal processing; Cross-platform conversion of digital content into other forms of digital content*. I can see no similarity between these and any of the opponent's services. They are dissimilar.

83. I now come to *Rental of entertainment software*. In the absence of any submissions from either party on these services, it is my view that the average consumer would understand that these services involve the provision of software that is intended to provide amusement through a rental contract or subscription. The user gains access to the software for a fixed period. I shall compare the term to the opponent's broad *Entertainment ... activities*, which would include, for example, the provision of online gaming. There is an overlap in user and purpose and there may be some trade channels in common. There is a degree of similarity in the nature of the services, as both involve providing access to software. I also consider that there is a degree of competition as the user may decide to rent the entertainment software or to access an online gaming service. Overall, I consider that there is a medium degree of similarity between the services.

Class 45

84. The applicant's *Licensing of rights to films, television and video productions; Licensing of musical shows; Legal consultancy relating to television advertising, television entertainment and sports* are legal services. These are services that will be provided by specialists to businesses within the entertainment, sport and advertising industries. The opponent's broad *Entertainment ... activities* would include the production of films, television, videos and music shows, but the purpose of the parties' respective services differs. They would be targeted towards different users. I see no similarity in their nature or method of use and do not consider that they would be

distributed through the same trade channels. I consider that they are dissimilar to the opponent's services.

85. The applicant's *Concierge services; Hotel concierge services* are personal services that help clients with a range of practical tasks, such as arranging travel, making reservations for events and services, and running errands. The opponent's Class 41 services include *Ticket reservation and booking services for cultural events* and I shall use this for my comparison. The purpose of the opponent's services is to enable customers to attend cultural events. I appreciate that concierge services may also make ticket reservations, but, to my mind, the primary purpose of these services is to save time for the client. There is an overlap in user, but only to the extent that both parties' services are used by members of the general public. The nature and method of use of the services are different. There may be some shared trade channels but only to the extent that concierge services may also reserve tickets for their clients. There is a degree of competition as a user may reserve the tickets themselves or ask a concierge to do so. In my view, there is a low degree of similarity between the services.

Final remarks on the comparison of goods and services

86. If there is no similarity between the goods and services, there can be no likelihood of confusion under section 5(2)(b): see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA, paragraph 49. The opposition under this ground therefore fails in respect of the following goods and services:

Class 15

Musical instruments; Music rests for musical instruments; Music stands adapted for use with musical instruments; Musical synthesizers; Percussion instruments [musical]; Percussion musical instruments; Electronic musical instruments; Musical accessories.

Class 35

Online retail services for downloadable and pre-recorded music and movies; Business management of musical performers; Business management of entertainers.

Class 36

Financing of investments; Financial sponsorship of theater events; Financial sponsorship of dance events; Advisory services relating to investments and finance; Venture capital funding services for companies; Financial sponsorship of visual arts events; Financial sponsorship of entertainment activities; Investment fund services; Fund investment services; International fund investment; Venture capital funding services for universities; Financial planning services relating to building projects; Crowdfunding services in the nature of providing financing from money collected from individuals; Retail financing services; Financial investment advisory services; Fundraising and financial sponsorship; Financing services relating to hotels; Financing of building projects; Arranging of finance for sporting, cultural and entertainment projects.

Class 42

Digital watermarking; Encryption of digital images; Design of software for digital signal processing; Cross-platform conversion of digital content into other forms of digital content.

Class 45

Licensing of rights to films, television and video productions; Licensing of musical shows; Legal consultancy relating to television advertising, television entertainment and sports.

Average consumer and the purchasing process

87. The relevant case law is set out in paragraph 35 of this decision.

88. The average consumer of the parties' Class 38, 42 and 45 and the majority of the Class 41 services is a member of the general public. However, I consider that the average consumer of the following Class 41 services is likely to be a business or other organisation: *Music composition services; Music mixing services; Composition of music for others; Film studios; Radio entertainment production; Audio, video and multimedia production ...; Digital video, audio and multimedia entertainment publishing services; Production of entertainment in the form of a television series; Production of television entertainment programmes; Consultancy on film and music production; Services for the production of entertainment in the form of film; Production of video*

films. The average consumer of the Class 35 services would also be a business or other organisation.

89. Where the average consumer is a member of the general public, the level of attention paid will, in my view, be medium. The purchasing process is likely to be visual. The average consumer will see the mark used on promotional literature, websites and on signage or advertisements in the street. There may also be a role for word-of-mouth recommendations and advertising on radio or podcasts, so the aural element of the mark is may also be relevant.

90. Where the average consumer is a business or organisation, I consider that the level of attention paid will be higher than medium. The services are likely to have an impact on the quality of the consumer's service or the impression that they make on the market. I consider that the purchasing process will be a largely visual one, as the consumer will choose a supplier after looking through printed promotional literature or websites. As they may also receive word-of-mouth recommendations, I shall not ignore the aural element of the mark.

Comparison of the marks

91. The relevant case law is set out and discussed in paragraphs 37-38 of this decision.

92. The respective marks are shown below

Contested mark	Earlier mark
Pine and Ginjer PINE AND GINJER	

93. The contested mark is a series of two plain word marks. In *LA Superquimica v EUIPO*, Case T-24/17, the GC held that such marks protected the word or words contained within them and that they may be used in any form, colour or typeface: see

paragraph 39 of that judgment. Consequently, nothing turns on the differences between the two marks in the series in terms of capitalisation and so I shall refer to them in the singular. I consider that the words “Pine” and “Ginjer” will make equal contributions to the overall impression of the mark. The word “and” simply joins them together and its contribution is smaller.

94. I have already discussed the overall impression of the earlier mark in paragraph 42 above.

Visual comparison

95. The contested mark contains three words, of four, three and six letters. The verbal element of the earlier mark contains two words, of four and five letters, separated by a smaller letter “x” and ending with the non-distinctive superscript “TM”. The first word of both marks is identical and the last word in each mark begins with the same four letters. I keep in mind that the average consumer tends to pay greater attention to the beginning of words than to the end, while acknowledging that this is not a hard and fast rule: see *El Corte Inglés, SA v OHIM*, Joined cases T-183/02 and T-184/02, paragraphs 81 and 82. The colour arrangement used in the earlier mark is a point of difference and I have already found that this is a complex colour arrangement that it would not be appropriate to apply notionally to a mark registered (or sought to be registered) in black and white: see paragraph 24 above. The presentation of the letters as an upward left-to-right diagonal is another difference, as is the inclusion of a letter “x” in the earlier mark and the word “and” in the contested mark. Taking all these factors into account, I find that the contested mark is visually highly similar to the earlier mark.

Aural comparison

96. The applicant submits that the earlier mark would be spoken as “Pine-ex-Ginger” or “Pine-Ginger”. In my view, some consumers may also say “Pine by Ginger” or “Pine and Ginger”. However, they articulate the “x”, though, the other words will be pronounced as the common English words. The average consumer would say the contested mark as “Pine and Ginger”, with the words pronounced in the usual way. For a group of consumers, therefore, the marks would be aurally identical, while for the remaining consumers they are aurally highly similar.

Conceptual comparison

97. I consider that “GINJER” would also be perceived by the average consumer as a play on “GINGER”. Consequently, I adopt the analysis and findings in paragraph 45 of my decision and find the marks to be conceptually highly similar.

Distinctive character of the earlier mark

98. I adopt the analysis and findings made in paragraphs 46-48 above. The earlier mark has a fairly high degree of distinctive character.

Conclusions on likelihood of confusion

99. The approach to the global assessment of a likelihood of confusion is set out in paragraph 49 of this decision. Paragraph 50 explains the difference between direct and indirect confusion. Both these paragraphs are relevant here.

100. Earlier in my decision, I found that:

- a) The applicant’s goods are dissimilar to the opponent’s services;
- b) The applicant’s services are identical and similar to the opponent’s services;⁴
- c) The average consumer is either a member of the general public or a business or organisation. The member of the general public will pay a medium degree of attention; business consumer would pay a degree of attention that is higher than medium. The purchasing process of largely visual;
- d) The marks are visually, aurally and conceptually highly similar; and
- e) The earlier mark has a fairly high degree of distinctive character.

101. In my view, the average consumer is unlikely to remember whether the last word in the mark is “GINJA” or “GINJER”, given that they will both be perceived as plays on the standard English word “GINGER”, or whether the mark contains an “x” or the word “AND”. I also take the view that the colour arrangement of the earlier mark will not be accurately recalled. I consider that this will be the case even where there is a low

⁴ I have already found that the opponent’s dissimilar services survive this ground of opposition.

degree of similarity between the services. These factors lead me to find that there is a likelihood of direct confusion if the contested mark were to be used for any of the services I found to be similar to the opponent's services.

102. The section 5(2)(b) ground is partially successful.

Section 3(6)

103. The opponent's claim under section 3(6) is the same as in the opposition to the IR. I therefore adopt the analysis and findings of paragraphs 54-61. The opposition to the contested mark fails under section 3(6).

OUTCOME

104. The opposition to the designation of IR 1695437 for protection in the UK is successful. Subject to a successful appeal, protection is refused.

105. The opposition to Application No. 3862533 is partially successful. Subject to a successful appeal, the application may proceed to registration for the following goods and services:

Class 15

Musical instruments; Music rests for musical instruments; Music stands adapted for use with musical instruments; Musical synthesizers; Percussion instruments [musical]; Percussion musical instruments; Electronic musical instruments; Musical accessories.

Class 35

Online retail services for downloadable and pre-recorded music and movies; Business management of musical performers; Business management of entertainers.

Class 36

Financing of investments; Financial sponsorship of theater events; Financial sponsorship of dance events; Advisory services relating to investments and finance; Venture capital funding services for companies; Financial sponsorship of visual arts events; Financial sponsorship of entertainment activities;

Investment fund services; Fund investment services; International fund investment; Venture capital funding services for universities; Financial planning services relating to building projects; Crowdfunding services in the nature of providing financing from money collected from individuals; Retail financing services; Financial investment advisory services; Fundraising and financial sponsorship; Financing services relating to hotels; Financing of building projects; Arranging of finance for sporting, cultural and entertainment projects.

Class 42

Digital watermarking; Encryption of digital images; Design of software for digital signal processing; Cross-platform conversion of digital content into other forms of digital content.

Class 45

Licensing of rights to films, television and video productions; Licensing of musical shows; Legal consultancy relating to television advertising, television entertainment and sports.

106. Registration is refused for the following services:

Class 35

Promotion of musical concerts; Promotion [advertising] of concerts; Organisation of exhibitions and events for commercial or advertising purposes; Production of video recordings for marketing purposes.

Class 38

Broadcasting of television programs via the Internet; Internet radio broadcasting services; Video, audio and television streaming services; Transmission of digital audio and video broadcasts over a global computer network; Provision of communication access to films and television programmes via an on-demand service; Broadcasting of audiovisual and multimedia content via the Internet; Audio broadcasting; Streaming audio and video material on the Internet; Digital audio broadcasting; Music broadcasting; Streaming of audio material on the internet; Delivery of digital music by telecommunications.

Class 41

Music performances; Conducting of film festivals; Production of music; Presentation of musical concerts; Musical entertainment; Band performances (Live -); Tuition in music; Music composition services; Live performances by a musical bands [sic]; Entertainment in the nature of live performances by musical bands; Presentation of live Christmas musical productions; Music mixing services; Arranging of festivals for entertainment purposes; Composition of music for others; Film studios; Radio entertainment production; Entertainment in the nature of theater productions; Circus performances; Education and training in the field of music and entertainment; Presentation of musical performances; Performance of dance, music and drama; Entertainment in the nature of live dance performances; Theatre performances; Musical performances; Presentation of concerts; Ticket reservation and booking services for music concerts; Entertainment services in the form of television programmes; Aerial photography; Audio, video and multimedia production, and photography; Digital video, audio and multimedia entertainment publishing services; Ticket procurement services for entertainment events; Organization of entertainment events; Organisation of entertainment events; Provision and management of sporting events; Production of entertainment in the form of a television series; Production of television entertainment programmes; Consultancy on film and music production; Services for the production of entertainment in the form of film; Production of video films; Entertainment booking services; Ticket agency services [entertainment]; Music entertainment services; On-line ticket agency services for entertainment purposes; Musical group entertainment services; Administration [organisation] of entertainment services; Live entertainment production services; Booking of entertainment; Provision of entertainment services through the media of television; Popular entertainment services; Camp services (Holiday -) [entertainment]; Live musical concerts; Music concerts; Organisation of musical concerts; Presentation of live performances by a musical group.

Class 42

Rental of entertainment software.

Class 45

Concierge services; Hotel concierge services.

COSTS

107. Both parties have enjoyed some success in these proceedings, with the greater share going to the opponent. In the circumstances, I consider that the opponent is entitled to a contribution to its costs that reflects its share in the success.

108. The opponent was represented at the stage of filing the oppositions but filed its evidence and written submissions without representation. At the close of the evidence rounds, the opponent was advised that, if she wished to claim costs, she should complete a proforma detailing the amount of time spent on each stage of the proceedings. She was told that if a completed proforma was not received then costs may not be awarded, other than the official fees incurred. A completed proforma was not received. However, as the opponent was represented at the point of filing the notices of opposition, I shall make an award for this part of the process.

109. The award has been calculated as follows:

£350 for preparing statements and considering the other side's statements;

£200 official fees

£550 in total

110. I therefore order Mark Beckford to pay Lakeshia Ford the sum of £550. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful.

Dated this 30th day of June 2026

Clare Boucher

For the Registrar,

The Comptroller-General