

O-0799-23

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3671194
BY
RICHARD JACKSON
TO REGISTER



AS A TRADE MARK IN CLASSES 35 & 41
AND
OPPOSITION THERETO (UNDER NO. 430974)
BY
TIKTOK INFORMATION TECHNOLOGIES UK LIMITED

BACKGROUND

1) On 20 July 2021, Richard Jackson ('the applicant') applied to register the following mark in respect of the services shown below:



Class 35: Arranging of competitions for advertising purposes; Administration of competitions for advertising purposes.

Class 41: Organising competitions; Organization of competitions; Organisation of competitions; Competitions provided by telephone; Competitions (Organising of entertainment -); Arranging and conducting competitions; Organising of entertainment competitions; Organisation of recreational competitions; Organization of entertainment competitions; Organization of esports competitions; Organisation of entertainment competitions; Administration [organisation] of competitions; Organising of esports competitions; Organization of electronic game competitions; Organising of games and competitions; Entertainment services relating to competitions; Conducting of phone-in competitions; Arranging of competitions for entertainment purposes; Organisation of sporting events and competitions; Organising of sporting activities or competitions; Organising of sports competitions and events; Services for the organisation of competitions; Organisation of competitions [education or entertainment]; Organisation of games and competitions; Organisation of competitions and awards; Organising of competitions for entertainment; Organisation of e-sports competitions; Organization of sporting events and competitions; Arranging of competitions via the Internet; Organisation of quizzes, games and competitions; Organization of competitions [education or entertainment]; Organisation of competitions (education or entertainment); Conducting of competitions on the Internet; Entertainment services in the nature of competitions; Organization of

competitions relating to motor vehicles; Arranging and conducting of competitions [education or entertainment]; Electronic game services and competitions provided by means of the internet.

2) The application was published in the Trade Marks Journal on 12 November 2021 and notice of opposition was later filed by TikTok Information Technologies UK Limited ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act').

3) In support of its ground under section 5(2)(b) of the Act, the opponent relies upon the following trade mark registrations and some of the services covered by the same, as shown below:

- **UKTM 3469550 (series of 2) ('mark 1')**

TikTok

Tik Tok

Class 35: Advertising agency services; on-line advertising on computer networks; pay per click advertising; preparing advertisements for others; dissemination of advertising matter; advertising through all public communication means; provision and rental of advertising space on the internet.

Class 41: Educational services; training services; presentation of music videos via mobile device online; provision of online electronic publications (not downloadable), via mobile devices; multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps, graphics, photographs, videos, music and electronic publications; electronic publication of information on-line; entertainment and amusement information via the internet; entertainment services; organization and presentation of shows, competitions, games, concerts and entertainment events; arranging, organizing, conducting, and hosting social entertainment events; conducting

educational conferences; user generated content and online advertising strategy services.

Filing date: 24 February 2020

Date of entry in register: 09 August 2020

- **UKTM 917913208¹ ('mark 2')**

TIK TOK

Class 35: Advertising and advertisement services; advertising agencies; on-line advertising on computer networks; pay per click advertising; preparing advertisements for others; dissemination of advertising matter; advertising through all public communication means; providing and rental of advertising space on the internet.

Filing date: 06 June 2018

Date of entry in register: 20 October 2018

4) It is claimed that the respective services are either identical or highly similar and that the respective marks are similar, such that there exists a likelihood of confusion under Section 5(2)(b).

5) In support of its ground under section 5(3) of the Act, the opponent relies upon Mark 1 in relation to certain goods and services covered by that registration, namely, 'Application software; Application software for mobile phones' in class 09 and 'Online social networking services' in class 45. It is claimed that the earlier mark has a substantial reputation in the UK in relation to those goods and services and that use

¹ This is a comparable mark (EU). Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

of the contested mark will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier mark.

6) The trade marks relied upon by the opponent are earlier marks, in accordance with section 6 of the Act². As neither completed its registration procedure more than five years prior to the application date of the contested mark, they are not subject to the proof of use conditions, as per section 6A of the Act.

7) The applicant filed a counterstatement. Much of the applicant's comments are about how the parties use their marks and the different nature of their businesses. The applicant denies that there is any likelihood of confusion or any link being made between the marks. Particular attention is drawn, by the applicant, to the visual and conceptual differences, which it considers exist, between the respective marks. It is also disputed that the respective goods and services are identical or similar. The applicant concedes that the opponent's earlier mark is 'renowned as a video-sharing and music-sharing social media app' and that the earlier mark is 'well-known in the social media space' and 'is very distinctive and globally well-known among its target audience'. It is, however, claimed that the respective businesses and trade marks will not be associated with each other.

8) The opponent is represented by Taylor Wessing LLP. The applicant is without legal representation. Only the opponent filed evidence. The opponent's evidence consists of a witness statement from Maya Muchemwa with Exhibits A - P thereto. That evidence was also accompanied by written submissions³. Neither party requested a hearing nor filed written submissions in lieu. I now make this decision after careful consideration of the papers before me.

² Mark 2 is a comparable mark (EU). Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

³ Dated 22 August 2022

DECISION

9) Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. As the provisions of the Act relied upon in these proceedings are derived from an EU Directive, I will, therefore, take account of trade mark case law of the EU courts.

Section 5(2)(b)

10) This section of the Act states:

“5. - (2) A trade mark shall not be registered if because –

(a)...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

5A. Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

11) The leading authorities which guide me are from the Court of Justice of the European Union (‘CJEU’): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-

120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

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

The correct approach

12) In the light of the applicant's comments in the counterstatement about the way in which both parties currently use their marks and the nature of their businesses, it is necessary for me to explain what the correct approach is that I must take when assessing the similarity between the parties' services and the overall likelihood of confusion.

13) The first point to make is that, as I noted earlier, the opponent's marks are not subject to the 'proof of use' requirement. The opponent is therefore entitled to rely upon all of the services covered by its registrations without having to show that it has actually used its mark in relation to any of those services. The second point is that I am required to make the assessment of the likelihood of confusion notionally and objectively based on the opponent's services, as registered, and the applicant's services, as applied for, in accordance with the relevant case law. That assessment requires that I must not take into account the actual way that either party has used their marks in the marketplace or the kinds of services (or goods) that those marks have been used in relation to thus far. Further, I must consider all of the

circumstances in which the mark applied for might be used if it were registered⁴. This is because trade mark registrations are items of property which may be sold by the applicant and/or opponent to third parties in the future and may therefore be used in a different way, or upon/in relation to different services, than those used by the current proprietors of those marks. Further, even if the trade marks are not sold to third parties, the applicant and/or opponent themselves may decide to change/adapt the way they market their services in the future. In this connection, in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

The actual services (or goods) which either party may currently be providing in the marketplace is therefore not relevant to my assessment.

The opponent's best case

14) There is no material difference between any of the marks covered by the two registrations relied upon by the opponent. Further, mark 1 covers essentially the same services in class 35 as those covered by the same class in mark 2. Mark 1 also covers additional services in class 41 which are not covered by mark 2. It follows that the opponent can be in no stronger position under Section 5(2)(b) in respect of mark 2 than it is in respect of mark 1. I will therefore use mark 1 for the purposes of the assessment of a likelihood of confusion.

⁴ As per *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, [66]

Comparison of services

15) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*'Meric'*), where the General Court held that:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

16) The services to be compared are:

Opponent's services	Applicant's services
<p>Class 35: Advertising agency services; on-line advertising on computer networks; pay per click advertising; preparing advertisements for others; dissemination of advertising matter; advertising through all public communication means; provision and rental of advertising space on the internet. (my emphasis)</p> <p>Class 41: Educational services; training services; presentation of music</p>	<p>Class 35: Arranging of competitions for advertising purposes; Administration of competitions for advertising purposes.</p> <p>Class 41: Organising competitions; Organization of competitions; Organisation of competitions; Competitions provided by telephone; Competitions (Organising of entertainment -);Arranging and conducting competitions; Organising of entertainment competitions; Organisation</p>

videos via mobile device online; provision of online electronic publications (not downloadable), via mobile devices; multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps, graphics, photographs, videos, music and electronic publications; electronic publication of information on-line; entertainment and amusement information via the internet; **entertainment services; organization and presentation of shows, competitions, games, concerts and entertainment events;** arranging, organizing, conducting, and hosting social entertainment events; conducting educational conferences; user generated content and online advertising strategy services.

(my emphasis)

of recreational competitions; Organization of entertainment competitions; Organization of esports competitions; Organisation of entertainment competitions; Administration [organisation] of competitions; Organising of esports competitions; Organization of electronic game competitions; Organising of games and competitions; Entertainment services relating to competitions; Conducting of phone-in competitions; Arranging of competitions for entertainment purposes; Organisation of sporting events and competitions; Organising of sporting activities or competitions; Organising of sports competitions and events; Services for the organisation of competitions; Organisation of competitions [education or entertainment]; Organisation of games and competitions; Organisation of competitions and awards; Organising of competitions for entertainment; Organisation of e-sports competitions; Organization of sporting events and competitions; Arranging of competitions via the Internet; Organisation of quizzes, games and competitions; Organization of competitions [education or entertainment]; Organisation of competitions (education or entertainment); Conducting of competitions on the Internet;

	Entertainment services in the nature of competitions; Organization of competitions relating to motor vehicles; Arranging and conducting of competitions [education or entertainment]; Electronic game services and competitions provided by means of the internet.
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17) All of the applicant’s services in class 35 are for ‘advertising purposes’. They fall within the opponent’s broad term ‘advertising through all public communication means’. Those services are therefore identical in accordance with the *Meric* case law referred to above.

18) All of the applicant’s services in class 41 fall within the opponent’s broad term ‘entertainment services’ and ‘organization and presentation of shows, competitions, games, concerts and entertainment events’. They are, therefore, also identical as per *Meric*.

Average consumer and the purchasing process

19) It is necessary to determine who the average consumer is for the respective services and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The

words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

20) The average consumer for the relevant services in class 35 is likely to consist of businesses and the general public. As for the services in class 41, the average consumer is likely to be the general public but may also include business users. The purchasing act will be primarily visual with all of the services being sought out on the Internet, for example. That is not to say though that the aural aspect should be ignored since the services may sometimes be the subject of discussions with sales representatives and/or word of mouth recommendations. The cost of all of the services is likely to vary. I would expect the average consumer (whether a business user or member of the general public) to take into account various factors to ensure that the services meet their specific needs and requirements, even where the cost may be at the lower end of the spectrum. Generally speaking, I find a medium degree of attention is likely to be paid during the purchase for all of the relevant services.

Comparison of marks

21) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take account of 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.

22) In the counterstatement, the applicant compares his mark to the following mark which is said to be used by the opponent:



However, the mark shown above is not relied upon in this opposition. I must make my assessment of the likelihood of confusion on the basis of the earlier mark, as registered, which is for the plain words 'Tik Tok' and 'TikTok'.

23) There is no material difference between the two marks in the series covered by the earlier registration. I will use 'TikTok' for the basis of the comparison. The marks to be compared are, therefore, as follows:



The opponent's mark consists of 'TikTok' in plain letters, absent any stylisation. The overall impression lies in the mark, as a whole. The applicant's mark naturally breaks down into three identifiable elements. The first element is the words 'TickTock Tickets' in plain white letters. The second element is the device of a clock face presented in red. The third element is the black square background. I find that the first element has the greatest weight in the overall impression of the mark. The second element has substantial visual impact and plays an important, but lesser, role

than the first element. The third element, which merely acts as a backdrop for the other two elements, carries the least weight.

24) The point of visual similarity between the marks arises due to the presence of the respective words 'TikTok' and 'TickTock'. Those elements differ only to the extent that there is an additional letter 'c' before each letter 'K' in the applicant's mark; those elements are, otherwise, identical and, overall, visually highly similar. However, the contested mark also contains the word 'Tickets', a clock face and the black background which are absent from the earlier mark, creating points of visual difference between the marks. Bearing in mind those differences, I find a low-medium degree of visual similarity between the marks overall.

25) Aurally, the opponent's mark will be pronounced in the same way as the well-known phrase, 'tick tock'. The opponent's mark is, plainly, aurally identical to the 'TickTock' part of the contested mark. The applicant's mark also contains the well-known two-syllable word 'Tickets' which is absent from the earlier mark. Overall, I find a medium degree of aural similarity between the marks.

26) Conceptually, the earlier mark is likely to be perceived, immediately, as a misspelling and conjoining of the well-known phrase 'tick tock', given the very strong visual and aural resemblance between the opponent's mark and that well-known phrase. The concept resulting from that immediate impression is the sound of a clock. The same concept will be perceived by the average consumer upon encountering the first part of the contested mark, 'TickTock'. The concept of 'tickets' present in the contested mark is absent from the earlier marks but, in the context of many, if not all, of the relevant services, that is unlikely to be perceived as a distinctive concept. Overall, the respective marks are clearly conceptually very highly similar, if not identical.

Distinctive character of the earlier mark

27) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of

confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

Although the earlier mark, ‘Tik Tok’, strongly resembles the well-known phrase, ‘tick tock’, that phrase has no obvious relevance to the earlier services. The misspelling also adds to its distinctiveness. I find that it has a high degree of inherent distinctiveness.

28) There is nothing in the opponent’s evidence to show that the earlier mark has been used in relation to the following relevant earlier services: ‘entertainment services; organization and presentation of shows, competitions, games, concerts and entertainment events’. I therefore find no enhanced distinctiveness in relation to those. Turning to the opponent’s ‘advertising through all public communication

means', there is some evidence before me to show that the opponent has used its mark in relation to such services. In the witness statement, Maya Muchema states:

- 'Additionally, in a 2021 survey, 68% of brand marketers indicated that they were planning to use the TikTok app in order to market their products (see **Exhibit G**). This represents a 325% increase on the 16% that indicated they would use the app in 2020. The report found that TikTok had become the second most popular social media platform for marketing.'⁵
- 'A number of case studies are published in relation to advertising campaigns undertaken by major brands on the TikTok platform. Major brands trust it to deliver high quality and impactful advertising campaigns; for example, Balenciaga's campaign to raise awareness in France and the UK received a total of 23 million impressions and 25 million views (see **Exhibit H**).'⁶

This is the extent of the evidence before me which relates, specifically, to 'advertising through all public communication means'. As regards the information in the first bullet point, I note from the content of exhibit G that the report was compiled by an entity based in San Francisco. It is not clear whether the 'brand marketers' who were consulted for that report were based solely in the US or from other countries too. On the face of it, there is nothing in that report to satisfy me that the 'brand marketers' included those based in the UK.

29) As regards the information in the second bullet point, although reference is made to a number of major brands using the 'TikTok platform' to conduct advertising campaigns, only one such example is provided in support of this statement. That said, the statement has not been challenged and the number of 'impressions' and 'views', for the one example provided, is very substantial. Further, although those figures refer to France and the UK collectively, I consider it likely that a substantial proportion relate solely to the UK. The campaign also appears to have taken place before the relevant date, bearing in mind that the report is dated August 2021 but

⁵ Witness statement of Maya Muchemwa, paragraph 11

⁶ Witness statement of Maya Muchemwa, paragraph 12

refers to the campaign having taken place over Christmas (presumably meaning Christmas 2020). Taking into account that specific evidence in conjunction with the rest of the evidence before me which clearly demonstrates the huge success of the opponent's applications and enormous social media presence, I am prepared to accept that the inherent distinctiveness of the earlier mark had, more likely than not, been enhanced beyond a high level to a very high level, in relation to 'advertising through all public communication means' at the relevant date.

Likelihood of confusion

30) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

31) The respective services are identical. The marks are visually similar to a low-medium degree, aurally similar to a medium degree and conceptually very highly similar, if not identical. The opponent's mark also has a high degree of inherent distinctiveness for the earlier services in class 41 and a very high degree of enhanced distinctiveness for the services in class 35. The average consumer, whether a member of the general public or a business user, is likely to pay a medium degree of attention. Weighing all these factors, I find that the visual differences between the marks, in particular, weigh against the average consumer mistaking one mark for the other, even allowing for imperfect recollection. There is no likelihood of direct confusion.

32) I will now consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A.*

Sugar), Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

33) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James

Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

34) I bear in mind that the categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

35) In the instant case, I consider that the average consumer is likely to believe that the respective services come from the same or linked undertaking(s), bearing in mind, in particular, the very high degree of conceptual similarity (if not identity) between the marks, the identical services at issue and that the earlier mark has a high/very high degree of distinctiveness. In reaching this conclusion, I have borne in mind that the respective words ‘TikTok’ and ‘TickTock’ may be mis-remembered in such a way that the average consumer believes that the spellings are the same. In such circumstances, the average consumer is likely to believe that the later mark, with its additional device elements, is merely a brand extension, or variant, of the earlier mark. Further, even if the consumer recalls the different spellings of the word elements, they are still likely to believe that the later mark, as a whole, is a variant or brand extension of the earlier mark when used on the identical services at issue. For the avoidance of doubt, I would have come to the same conclusion even if I had not found any enhanced distinctiveness through use; the already high degree of inherent distinctiveness means that the outcome would have been the same. **The opposition under Section 5(2)(b) of the Act succeeds in full.**

Section 5(3)

36) Section 5(3) of the Act provides:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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.”

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

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

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *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 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

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

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

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

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

Reputation

38) The opponent must show that it had the requisite reputation at the time of filing of the contested mark i.e. on 20 July 2021. The applicant's comments in the counterstatement clearly indicate that it accepts that the opponent has a strong reputation in relation to the particular goods and services relied upon under this ground, as per Case C-375/97, *General Motors* [1999] ETMR 950. This concession means that it is unnecessary to summarise the opponent's evidence on this point and, suffice it to say, I consider this to be a sensible concession.

Link

39) Whether the public will make the required mental 'link' between the applicant's mark and the earlier mark must take account of all relevant factors. The relevant factors identified in Case C-252/07, *Intel* [2009] ETMR 13 are:

i) *The degree of similarity between the conflicting marks*

I have already assessed this factor under section 5(2)(b). The respective marks are visually similar to a low-medium degree, aurally similar to a medium degree and conceptually very highly similar, if not identical.

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

The relevant public includes the general public and businesses.

The relevant goods and services of the opponent are 'Application software; Application software for mobile phones' in class 09 and 'Online social networking services' in class 45.

As regards the contested services in class 41, I find that they are not obviously similar to any of the opponent's goods and services and the evidence before me does not satisfy me otherwise. Their respective nature, intended purpose and methods of use differ and they are not in competition nor complementary in the sense described in the case law.⁷ If I am wrong about that, any similarity must be low.

Turning to the contested services in class 35, which are all for advertising purposes, I find that there is a low degree of similarity between those services and the opponent's goods and services. This is because the respective goods and services may, as indicated by the opponent's evidence, be offered through the same channels and the opponent's goods and services may be important for the applicant's services in such a way that the consumer believes that they come from the same undertaking.

iii) The strength of the earlier mark's reputation

The earlier mark has a strong reputation for the goods and services relied upon under this ground.

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

The earlier services relied upon under this ground differ to those considered under section 5(2)(b). However, I find that the earlier mark is also inherently highly distinctive in relation to the goods and services relied upon under section 5(3) for essentially the same reasons as

⁷ See, for example, T-116/06, T-363/08 and T-435/17

given in paragraph 27 of this decision. I note that the applicant also concedes, in any event, in its counterstatement, that the earlier mark is 'very distinctive' in relation to the goods and services relied upon under this ground.

Conclusions on link

40) Bearing in mind the degree of similarity between the marks (particularly the degree of conceptual similarity), the degree of distinctiveness of the earlier mark and the strong reputation it enjoys, I find that it is likely to be brought to mind by the relevant public when encountering the applicant's mark on the contested services. I reach this conclusion in relation to all of the contested services, notwithstanding the low degree of similarity/lack of similarity that exists between the respective goods and/or services. The strength of the earlier mark's reputation and its degree of distinctiveness, coupled with the similarity between the marks (particularly the conceptual similarity), is sufficient, in my judgment, to bridge the gap between the goods and services. The requisite link is therefore established in relation to all of the contested services.

Damage

Unfair advantage

41) I find that there is a non-hypothetical risk that the link that is made between the contested mark and the earlier mark will result in the latter appearing instantly familiar and is also likely to result in the popular image of the earlier mark transferring to the later mark. This association with the opponent's reputed mark is likely to make the applicant's job of marketing all of its services easier, thereby giving the applicant more custom than it otherwise would have enjoyed had that association not been made. As this would come without paying any compensation to the opponent, and without the applicant expending the money necessary to create a market for its own services in the UK, I find that this constitutes unfair advantage.

The ground under section 5(3) of the Act succeeds.

Other heads of damage

42) I do not consider it necessary to consider the other pleaded heads of damage given that the opponent has already been wholly successful under all of the other pleaded grounds under Sections 5(2)(b) and 5(3).

OVERALL OUTCOME

43) **The opposition succeeds.**

COSTS

44) As the opponent has been successful, it is entitled to a contribution towards its costs. In approaching the award, I bear in mind that the applicant conceded in its counterstatement that the earlier mark was 'very distinctive' and 'renowned' for certain of the goods and services relied upon, including all of those relied upon under Section 5(3) of the Act. As such, much of the evidence subsequently filed by the opponent was, in my view, unnecessary. I have therefore reduced the amount awarded to the opponent for the filing of its evidence than would have, otherwise, been appropriate. Using the guidance in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement	£300
Official fee (Form TM7)	£200
Preparing and filing evidence and submissions	£500
Total:	£1000

45) I order Richard Jackson to pay TikTok Information Technologies UK Limited the sum of **£1000**. This sum is to be paid within 21 days of the expiry of the appeal

period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of August 2023

**Beverley Hedley
For the Registrar,
the Comptroller-General**