O/0972/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003773601
BY JASON CLARKE
TO REGISTER THE FOLLOWING TRADE MARK

Rank

IN CLASS 45

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 434244
BY RANK LEISURE HOLDINGS LIMITED.

Background and pleadings

1. On 04 April 2022, Jason Clarke ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 15 April 2022 and registration is sought for the following services:

> **Class 45:** *Dating services; Computer dating services; Agency services (Dating -); Dating agency services; Video dating services; Internet dating services; Dating services provided through social networking; Internet based dating, matchmaking and personal introduction services; Social escorting; Social work service; Social introduction agencies; Escort agencies [social]; Social escort agency services; Online social networking services; social introduction agency services; Social introduction agency services; On-line social networking services; Internet-based social networking services; Legal services relating to social insurance claims; Online social networking services accessible by means of downloadable mobile applications.*

2. On 15 June 2022, Rank Leisure Holdings Limited ("the opponent") opposed the application based upon Sections 5(2)(a), 5(3) and 3(6) of the Trade Marks Act 1994 ("the Act").

3. Under Sections 5(2)(a), the opponent relies upon the following earlier trade mark:

UK00003764225 ("the first earlier mark") RANK Filing date: 10 March 2022 Registration date: 22 July 2022 The opponent relies upon some of the services for which the mark is registered, namely those in class 38:

Class 9: *Computer software including downloadable computer software; downloadable games; downloadable poker games; downloadable bingo games; interactive software; computer software for online payment and transaction processing; gaming software; betting software; sports betting software; electronic bingo pens; apparatus and instruments for recording, transmission or reproduction of audio, visual and audio visual data; data carriers, discs, cards, CD-ROMs, DVDs, laser discs, mini discs, tapes and other data storage media; electronic apparatus and instruments for the delivery, receipt, recordal, processing, logging, storage, searching, retrieval, transmission and/or exchange of data and information; electronic publications and information provided online from databases or the Internet (downloadable); electronic publications and information provided by electronic mail (downloadable); mobile applications; telecommunications equipment, hardware and software; television apparatus and instruments; electronic devices for receiving television and/or global communication network transmissions and transmitting them to a television or other display device and computer programs for use therewith; interactive computer systems; interactive electronic apparatus and instruments for the delivery, receipt, recordal, processing, logging, storage, searching, retrieval, transmission and/or exchange of data and information, included in this class; all the aforesaid goods in relation to gaming, gambling, betting, bingo, competition, casino, amusement and entertainment services; credit cards; encoded prepaid cards, magnetic, charge, discount and encoded cards; encoded loyalty scheme cards; encoded cards for use in connection with promotion schemes; game cards (downloadable); hand held electronic apparatus for providing internet access to selected web sites; parts, fittings and accessories for all of the aforesaid.*

Class 28: *Electronic games; electronic arcade games (coin or counter operated); amusement games and machines (automatic and coin operated); interactive electronic apparatus for use in games, gaming, gambling and competitions; electronic games and gaming apparatus adapted for use with a television receiver; interactive electronic apparatus adapted for use with a*

television receiver for use in gaming services; amusement machines and apparatus adapted for use with a television receiver; parts and fittings for all of the aforesaid.

Class 35: *Administration of entertainment, amusement, competition, gaming, gambling, betting, bingo and casino services; provision of the aforesaid services in electronic or computerised form, from a computer database, via computer networks, by telephony or the Internet; business management; business management of retail outlets; loyalty card services; loyalty scheme services; loyalty, incentive and bonus program services; organization, operation and supervision of customer loyalty schemes and incentive schemes; management of customer loyalty, incentive or promotional schemes; customer loyalty services for commercial, promotional and/or advertising purposes; promoting the sale of payment card accounts through the administration of incentive award programmes, awarding purchase points, discounts, rebates, valued added offers and coupons; hotel management services; information, consultancy and advisory services in relation to all of the aforesaid.*

Class 38: *Telecommunication services; telecommunication services relating to the Internet; providing telecommunications connection and access to the Internet and databases; data transmission services; subscription data transmission services; electronic mail services; operation of TV channels; broadcasting, Internet, transmission and communication services; interactive broadcasting, transmission and communication services; communication by means of computers and/or the Internet; transmission of messages, text, sound, images and data; computer-aided transmission of messages, text, sound, images and data; instant messaging; message sending and receiving services; electronic data exchange; broadcasting and transmission of interactive events; Internet portal services; web portal services; provision of broadband services; all the aforesaid services in relation to gaming, gambling, betting, bingo, competition, casino, sporting, amusement and*

entertainment services; provision of information, consultancy and advisory services in relation to all the aforesaid.

Class 41: *Casino services; gaming and gambling services; amusement services; entertainment services; competition, betting and bingo services; interactive entertainment, amusement, competition, gaming, gambling, betting, bingo and casino services; recreational services; arranging, organising, presenting, conducting, production, provision and management of entertainment, amusement, competition, gaming, gambling, betting, sporting, bingo and casino services; video game entertainment services; club entertainment services; provision of live and recorded musical entertainment, cabarets and dances; nightclub, discotheque, music hall, concert, dance hall, ballroom, cabaret, cinema and theatre services; organisation, production and presentation of competitions, poker tournaments and gaming events; organisation, production and presentation of competitions, contests, games and events including the provision of all the aforesaid services rendered live or through the medium of television or provided online from a computer database or via the Internet; online bingo games; online gambling programs; online betting programs; online sports betting programs; online game programs; all the aforesaid services also provided online from a computer database, via computer networks, by telephony or the Internet; provision of facilities for bingo, games, betting, sports betting, gaming, gambling, entertainment and leisure; betting and sports betting facilities; services for the operation of computerised betting and sports betting; hosting and arranging of corporate hospitality, private functions and parties (entertainment); hosting and arranging of award ceremonies and parties; amusement park, arcade and centre services; leisure centre, boating lake, water park, and water-shute complex services; funfair, circus and bingo hall services; provision of public baths, aquatic recreation, swimming, windsurfing, water skiing and outdoor recreation facilities, services and amenities; health and fitness club services; tenpin bowling alley and bowling green services; sports instruction services; organisation of recreational activities, quizzes, games and competitions; production of shows and of cabarets; organisation of beauty competitions;*

conference services; lending libraries; education and information services relating to gaming and poker; holiday camp services; holiday camp amusement centre services; provision of information, consultancy and advisory services in relation to all the aforesaid.

Class 43: *Provision of food and drink; bar, café, cafeteria, canteen, coffee shop, snack bar and restaurant services; catering services; corporate hospitality, private functions and parties (room hire and provision of food and drink); hotel, motel and boarding house services; provision of tourist house and accommodation services; provision of holiday camp and camp ground services, facilities and amenities; provision of exhibition facilities and amenities; provision of facilities and amenities all for conferences, seminars and banquets; booking and reservation services; provision of temporary accommodation; provision of information, consultancy and advisory services in relation to all the aforesaid.*

4. The opponent claims that the marks are identical and that the services are similar, leading to a likelihood of confusion. In particular, the opponent claims that the competing services in classes 38 and 45 are highly similar because they are both services to socialise and communicate with others.

5. Under Section 5(3), the opponent relies on the mark shown above claiming that the mark has acquired a reputation in relation to all of the goods and services for which it is registered. It also relies upon the following trade marks:[1]

UK00900193169 **("the second earlier mark")**
RANK
Filing date: 01 April 1996
Registration date: 13 August 1999

[1] 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.

The opponent claims that the mark has acquired a reputation in relation to all of the services for which it is registered, namely: **Class 41:** *Entertainment; amusements and recreation; organisation of competitions; amusement parks; entertainer services; instruction and tuition; lending libraries; nightclub, discotheque, dance hall, music hall, concert services, water chute complexes; production of shows and cabarets; provision of entertainment, amusement and recreation and sporting facilities; theatre productions; arranging group recreation activities; health and fitness club services; and all other services related or auxiliary to the foregoing and falling in class 41; saunas and swimming facilities.* **Class 42:** *Hotel; boarding houses; tourist homes; holiday accommodation; provision of hotel, motel and holiday camp facilities and amenities; cafes, cafeterias; bars and restaurants; catering; holiday camp and camp ground facilities and amenities; providing facilities for exhibitions; hotel management; bookings and reservations; beauty salons and other personal services; health and fitness clubs and solariums; tour and tourist services; conference centres; valeting services; consultancy services relating to the planning of conferences, seminars and banquets.*
UK00916935082 **("the third earlier mark")** RANK Filing date: 29 June 2017 Registration date: 30 January 2018 The opponent claims that the mark has acquired a reputation in relation to all of the goods for which it is registered, namely: **Class 9:** *Downloadable games; downloadable bingo games; downloadable poker games; computer software and downloadable software, including downloadable software in the nature of a mobile application, all for use in bingo, poker, games, gaming, gambling, betting, sports betting, lotteries and competitions; downloadable casino games; downloadable electronic game*

programs and computer software platforms that may be accessed via the Internet, computers and wireless devices, all for use in the fields of bingo games, gaming, gambling, lotteries and competitions; computer and video game cassettes, cartridges, discs and programs, including interactive programs; gambling software; gaming software; betting software; sports betting software; electronic bingo pens; hand held electronic apparatus for providing internet access to selected web sites; parts and fittings for the aforesaid.

6. The opponent claims that its marks enjoy a reputation in the UK, and that use of the applicant's mark without due cause would result in the applicant enjoying an unfair advantage. The opponent also claims that use of the applicant's mark would cause detriment to the reputation of the opponent's marks, particularly if the services offered by the applicant are of lower quality than the goods and services offered by the opponent.

7. The opponent's marks qualify as "earlier trade marks" in accordance with Section 6 of the Act, as their filing dates are earlier than the filing date of the applicant's mark. As the second earlier mark had completed its registration process more than five years before the filing date of the contested mark, it is subject to the use provisions specified in Section 6A of the Act, however, the applicant elected not to put the opponent to proof of use.

8. Under Section 3(6) the opponent claims that the contested mark was filed in bad faith. It states:

> *"Following a communication to the Applicant in relation to its UK trade mark application for another mark on 9 March 2022, on behalf of the Opponent, we contacted the Applicant alerting them to the Opponent's earlier and existing trade mark rights in the mark RANK, which was acknowledged by the Applicant. Following this communication, despite being well aware of the Opponent's existing and earlier rights, on 4 April 2022, the Applicant sought registration for the identical mark RANK, in order to benefit from its longstanding reputation. Therefore, the Opponent submits that the Applicant's Mark should be refused*

in accordance with the provisions of Sections 3(6) of the Trade Marks Act 1994."

9. The applicant filed a counterstatement denying the claims made. In particular, the applicant states that:

- The competing services in classes 38 and 45 are dissimilar as the opponent is a gambling company and its services are not used to socialise or communicate with others;

- The opponent uses the brands 'Grosvenor Casino' and 'Mecca Bingo'. The applicant has never heard of the brand 'RANK' being used by the opponent and does not believe that the opponent has any reputation associated with the brand 'RANK';

- The opponent contacted the applicant about an application for the mark 'TRANSPARENT RANK'. However, filing for 'Rank' was always part of the strategy for the applicant's business. As a start-up company with a product soon to be launch, the applicant already uses features, which are patent-pending, that will use the words 'Rank' and 'TRANSPARENT RANK'. The patents for these features were filed in September 2021 and October 2021, and now filed again in both the USA and UK in September 2022.

10. The opponent filed evidence and both parties filed written submissions. I shall refer to the evidence and submissions to the extent that I consider necessary.

11. The opponent is represented by Potter Clarkson LLP. The applicant is without legal representation. Neither party asked to be heard, but they both filed submissions in lieu. This decision is taken following a careful perusal of the papers.

EU Law

12. 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. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

The evidence

13. The opponent's evidence consists of two witness statements; one by Hannah Burrows and one by Sarah Appleyard.

14. Ms Burrows is a Trade Mark Attorney at Potter Clarkson LLP, the opponent's representatives in these proceedings. Her witness statement is dated 20 December 2022 and is accompanied by one exhibit (HB1). Ms Burrows' evidence is aimed at showing that the applicant's mark was filed in bad faith.

15. Ms Appleyard is the Senior Commercial and Property Counsel at the opponent's company. Her witness statement is dated 20 December 2022 and is accompanied by seven exhibits (SA1 – SA7). Ms Appleyard's evidence goes to the reputation and goodwill of the opponent's business.

16. Along with its evidence the opponent filed written submissions dated 20 December 2022. The applicant also filed written submissions which were received on 14 March 2023.

DECISION

Section 5(2)(b)

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

"5(2) 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, [...]

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

Section 5A of the Act is as follows:

"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."

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

19. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union ("CJEU") stated that:

> "23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary."

20. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

21. The General Court ("GC") confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods (though it equally applies to services) are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 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."

23. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

24. Whilst on the other hand:

> ".......it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

25. The services to be compared are as follows:

The applicant's services	The opponent's services
Class 45: *Dating services; Computer dating services; Agency services (Dating -); Dating agency services; Video dating services; Internet dating services; Dating services provided through social networking; Internet based dating, matchmaking and personal introduction services; Social escorting; Social work service; Social introduction agencies; Escort agencies [social]; Social escort agency services; Online social networking services; social introduction agency services; Social introduction agency services; On-line social networking services; Internet-based social networking services; Legal services relating to social insurance claims; Online social networking services accessible by means of downloadable mobile applications.*	**Class 38:** *Telecommunication services; telecommunication services relating to the Internet; providing telecommunications connection and access to the Internet and databases; data transmission services; subscription data transmission services; electronic mail services; operation of TV channels; broadcasting, Internet, transmission and communication services; interactive broadcasting, transmission and communication services; communication by means of computers and/or the Internet; transmission of messages, text, sound, images and data; computer-aided transmission of messages, text, sound, images and data; instant messaging; message sending and receiving services; electronic data exchange; broadcasting and transmission of interactive events; Internet portal services; web portal services; provision of broadband services; all the aforesaid services in relation to gaming, gambling, betting, bingo, competition, casino, sporting, amusement and entertainment services; provision of information, consultancy and advisory services in relation to all the aforesaid.*

26. The opponent submits that the respective services are similar given that all of the services covered by the specification of the applicant's mark (in class 45) would require transmission through telecommunication services, instant messaging services and internet services, all of which are covered by the opponent's services in class 38. According to the opponent, the competing services are of the same nature, and target the same end consumers being services to socialise and communicate with others.

27. The first thing to be noted about the opponent's services in class 38 is that they are subject to the limitation "*all the aforesaid services in relation to gaming, gambling, betting, bingo, competition, casino, sporting, amusement and entertainment services".* It follows that the opponent has no protection for (and cannot rely on) telecommunication services provided in relation to the applicant's dating services or in order to support users' access to the applicant's dating services. Consequently, the opponent's submission that the applied-for services in class 45 would require transmission through the opponent's telecommunication services, instant messaging services and internet services is factually wrong, because the opponent's services are limited to telecommunication services provided in relation to gaming, gambling, betting, bingo, competition, casino, sporting, amusement and entertainment services, and do not cover telecommunication services provided in relation to dating services, which means that the competing services cannot be complementary. In any event, even without the limitation, if the opponent's argument was correct then, essentially, any service that is provided via telecommunication would be similar to that service. I therefore reject the opponent's argument.

28. The second thing I would observe is that, contrary to the line of argument advanced by the opponent, providing dating services is not the same as providing entertainment services. Dating services are personal and social services rendered by specialised providers to meet the needs of individuals who wish to find a partner. Whilst it is possible that consumers who use the opponent's telecommunication services in the context of accessing gaming, gambling, betting, bingo, competition, casino, sporting, amusement and entertainment services might communicate and socialise with other users of the services, they do not communicate or socialise with the purpose of dating someone. Consequently, any socialising that might take place among users of the opponent's services in class 38 is an incidental advantage occasionally available, but

it is not a key part of the normal provision of telecommunication services which enable consumers to access gaming, gambling, betting, bingo, competition, casino, sporting, amusement and entertainment services.

29. The services have a different nature (dating services *versus* telecommunication services) and purpose (finding a partner *versus* accessing gaming, gambling, betting, bingo, competition, casino, sporting, amusement and entertainment services), are neither complementary nor in competition, and do not share trade channels. Although the users of the services might be the same, this is not sufficient to justify a finding of similarity, otherwise all the goods and services that target members of the general public would be similar, which of course is not the case. Hence, I find that the applicant's services in class 45 and the opponent's services in class 38 are dissimilar.

30. Finally, the opponent submits that in the event that the services are considered not to be similar, the interdependency principle - whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa - would tip the balance in the opponent's favour because the competing marks are identical. I reject the submission. The interdependency principle implies the existence of a minimum degree of similarity between the goods and services and the fact that the marks are identical cannot compensate for the absence of any similarity between the respective services.

31. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

> "49........... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

32. As I found that the services at issue are dissimilar, the opponent's claim under Section 5(2)(a) is bound to fail.

Section 5(3)

33. Section 5(3) states:

> "(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 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".

34. Section 5(3A) states:

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

35. 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; G*eneral 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).*

36. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 04 April 2022.

Reputation

37. In *General Motors,* Case C-375/97, the CJEU held that:

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence

of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

38. I now turn to the evidence of Ms Appleyard, in more detail.

39. Ms Appleyard states that the opponent’s company is an entertainment, gaming and gambling company and has been operating throughout the UK since 1937. She states that the opponent has been a publicly traded company on the London Stock Exchange since 1996 and that the name ‘RANK’ is what the opponent is known as to the public and other businesses. Ms Appleyard says that the opponent (i.e. Rank Leisure Limited), has more than 100 venues throughout the UK and operates a UK digital business through UK online gaming licences.

40. In order to support these statements, Ms Appleyard produced an online article from the BBC News website. Although Ms Appleyard is correct in saying that the article refers to the Rank Group (of which, she explains, the opponent is part), her declarations misrepresent what the evidence actually shows insofar as Rank Group is the name under which the company trades on the London Stock exchange, but it is not the brand under which the services are provided to the end-consumers. The BBC article refers, in fact, to the Rank Group as the *“Mecca Bingo-owner Rank Group”* and the *“Bingo-owner”* as shown below:

6:21 16 Aug 2018

Profits plunge at bingo-owner Rank Group

41. The rest of the evidence Ms Appleyard produced consistently corroborates this conclusion.

42. A promotional document refers to ‘RANK’ operating casino and bingo venues under the brands ‘Grosvenor Casinos’ and ‘Mecca’. The document states that *“Rank*

operates venues under its Mecca and Grosvenor Casinos brands across Great Britain”. Referring to *“our branded venues and digital channels”* the document explains that in the UK there are 52 Grosvenor branded casino venues, and 64 Mecca branded bingo venues, with the trade marks used in relation to the venues being those shown below:

43. The same document provides a list of websites and apps operated by the Rank Group PLC. Significantly, none of the websites or apps listed incorporate the name ‘RANK’:

THE RANK GROUP PLC

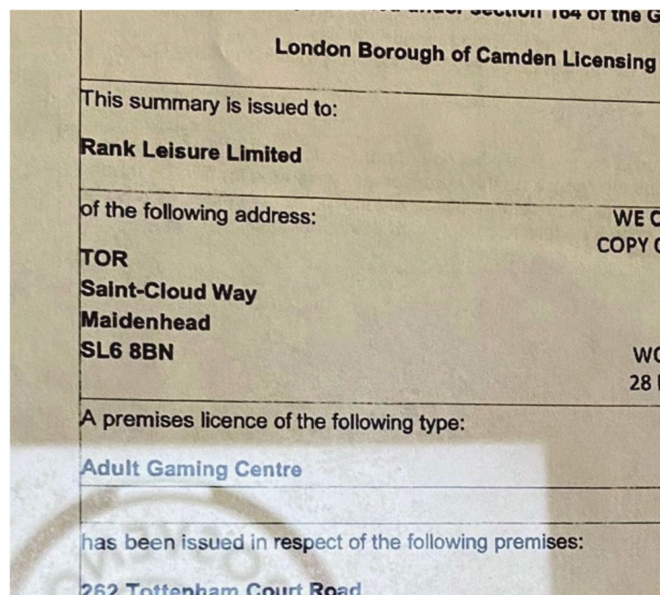
SITE SERVICES	WEBSITES	APPS	RANK'S SOCIAL MEDIA
Sitemap	grosvenorcasinos.com	Bingo	Twitter
Accessibility	gukpt.com	Slots and games	LinkedIn
Legal information	meccabingo.com	Casino	
Modern Slavery Policy Statement	bellacasino.com	Live casinos	
Rank Digital Services Gibraltar Limited and 8Ball Games Limited Privacy Notice	enracha.es		
Affordability profiling	yobingo.es		
Useful links			
Cookie information			
Email alerts			

44. The document also refers to the Rank Group’s digital only brands and states as follows: *“In addition to its established brands, the Group also operates multiple digital brands using a combination of proprietary and non-proprietary licensed software providing online bingo, casino and slot gaming”*. Ten digital-only brands are then listed,

including ‘YoCasino’, ‘Spin and Win’, ‘Kitty Bingo’, ‘Lucky Pants’, ‘Rummy Passion’, ‘Regal Win’, ‘Bella Casino’, ‘Mecca Games’ and ‘Magical Vegas’ which appear in the logo form shown below:

45. Ms Appleyard also says that in the opponent’s adult gaming venues throughout the UK, there are regulatory posters displayed and that the posters include the ‘RANK’ branding, examples of which are shown below:

Photos taken on 16 November 2022



section 164 of the G

London Borough of Camden Licensing

This summary is issued to:

Rank Leisure Limited

of the following address:

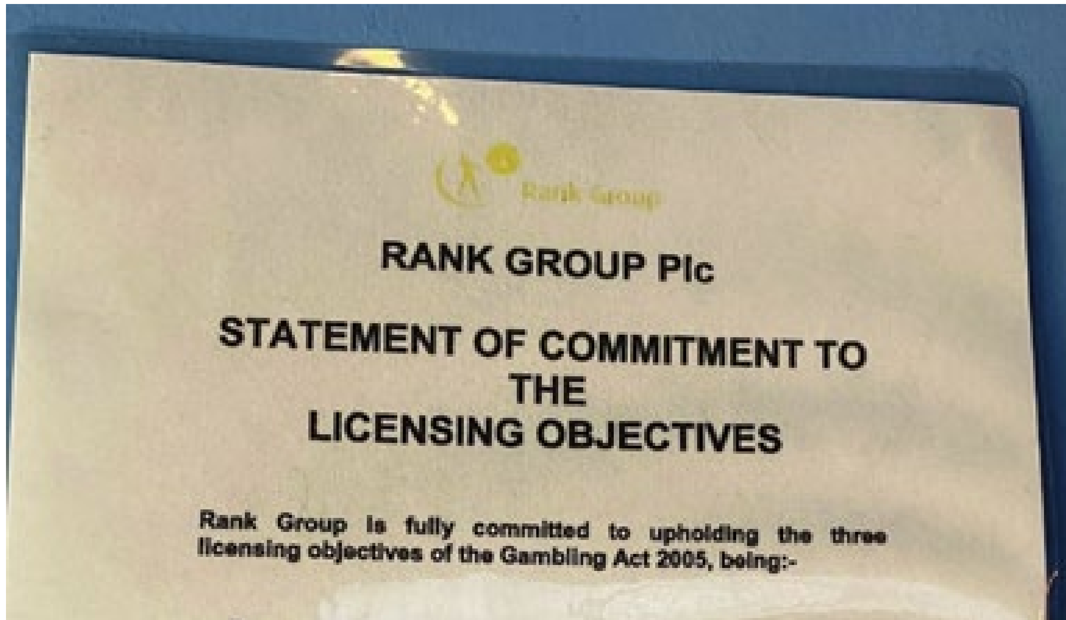
TOR
Saint-Cloud Way
Maidenhead
SL6 8BN

A premises licence of the following type:

Adult Gaming Centre

has been issued in respect of the following premises:

262 Tottenham Court Road



46. Ms Appleyard also provides copy of a 2022 Rank Group's Annual Report saying that the opponent is required to publicise its annual business reports. In the section *'About us'* the report states:

> *"Rank has been entertaining Britain since 1937. Today we still love bringing excitement to millions around the world with <u>our gaming-based entertainment brands</u>."*

47. Notably, in the section *'Our business'* (reproduced below) the report refers, again, to the 'Mecca' and 'Grosvenor' brands - there is also a third brand called 'Enracha' but it appears to target the Spanish market:

Our business

A unique blend of experiences, branded venues and digital channels in the UK and Spain.

Our branded venues and digital channels

64 Mecca branded venues
Mecca is Rank's community-gaming brand for the British market. A national portfolio of 64 venues offering bingo, slot machine games, great value food and drink, and live entertainment.

Mecca digital channels
The digital channels offer a range of popular games like bingo, a wide range of slot games and table games.

64

52 Grosvenor branded venues
The UK's largest multi-channel casino operator with 52 venues. The brand offers a range of casino table games, including roulette, blackjack, baccarat and poker as well as electronic roulette and slot machine games.

Grosvenor digital channels
The brand's complementary digital channels offer many popular games, including its successful live casino, in addition to a sports betting offer.

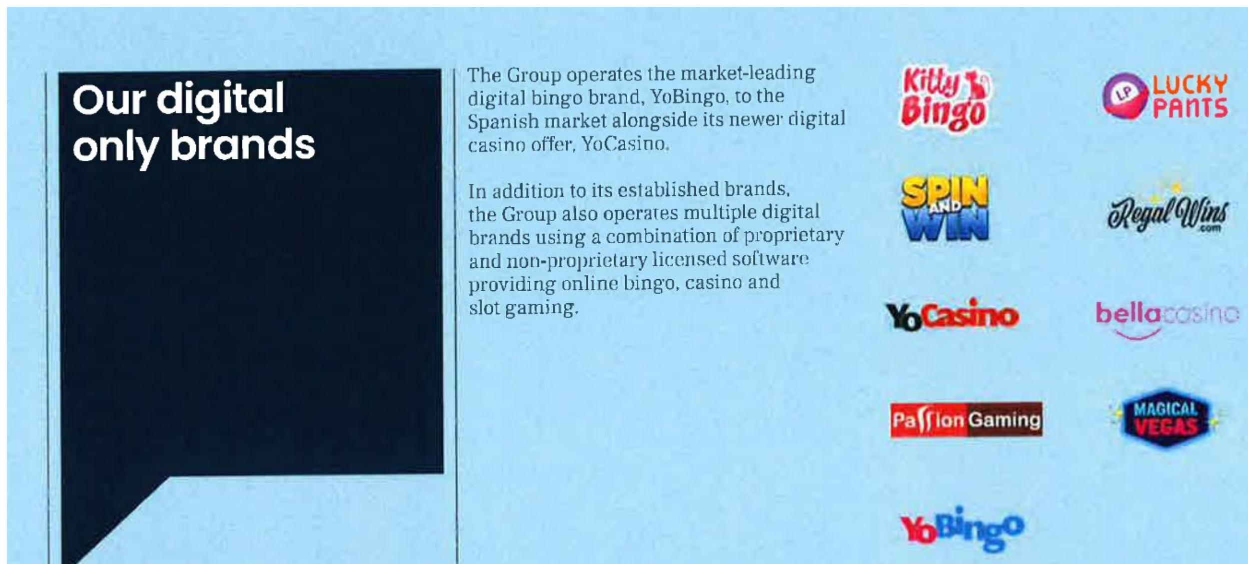
52

9 Enracha branded venues
Enracha is Rank's community-gaming business for the Spanish market. Nine venues offering a range of popular community games like bingo and poker as well as electronic casino and slot games, great value food and drink, and live entertainment.

Enracha digital channels
Enracha also has a small complementary digital offer.

9

48. The report also refers to digital brands which appears to be the same as those shown in the marketing document mentioned above (shown below):



49. Ms Appleyard also says that the Rank Group has a large following on social media and provides the following extracts from the Rank Group's Twitter and LinkedIn pages:

Follow

The Rank Group Plc
@therankgroup

The UK's largest multi-channel casino operator with Grosvenor Casinos & the second largest multi-channel bingo operator with Mecca. begambleaware.org

United Kingdom rank.com Joined April 2010

2,187 Following **1,660** Followers

Tweets Tweets & replies Media Likes

The Rank Group Plc @therankgroup · 23 Nov
THE fashion item of the year has arrived...
To promote @MeccaBingo's in club party packages & digital Merry Cashmas campaign, Mecca has taken on the nation's top designers with their own spectacular and unique festive knitwear. Proceeds to @CarersTrust.
bit.ly/3tSc4aY

in Home My Network Jobs

Rank Group

The Rank Group plc

To excite and to entertain

Gambling Facilities and Casinos · Maidenhead, Berkshire · 36,035 followers

7 people from your school work here · 1,511 employees

Follow Visit website More

Home **About** Posts Jobs Life People Videos

Overview

Rank is one of the great names in British entertainment. Since 1937, we've stayed true to our founding mission – to excite and to entertain.

Today, our brands include Grosvenor Casinos, Mecca Bingo, Enracha, with licensed venues that bring people together for fun and laughter in more than 100 communities. And our digital-only brands bring all that good stuff to our players at home and on the move.

Our long experience brings with it a sense of responsibility. Rather than just reacting to changes in the law, we want to help guide the gaming industry forwards so that everyone can enjoy themselves safely. That's why we take great care to inform our customers about every aspect of our games.

We also feel a sense of responsibility to the planet. We're inspiring our people through environmental, social and governance initiatives that will take us to where we want to be as a business. And we include the communities in which we operate in everything we do. That's where we started and where we belong still – at the heart of the community.

Website

http://www.rank.com

50. Once again, both pages refer to 'Grosvenor Casino' and 'Mecca Bingo' as Rank Group's brands.

51. Finally, Ms Appleyard provides the following revenue for the Rank Group: £644million (2022), £329million (2021), £629million (2020), £695million (2019) and £691million (2018).

52. I will now draw conclusions from those facts. I find as follows. The opponent is part of the Rank Group PLC, a publicly quoted company on the London Stock Exchange. The Rank Group PLC is the largest casino operator and bingo operator in the UK. Whilst the names Rank Group or Rank Group PLC are used on the company's annual reports and when the company trades on the London Stock Exchange, the services are provided to end-consumers under different brands, namely 'Grosvenor Casino' and 'Mecca Bingo'. The opponent's position is that consumers *"are well-educated to [the opponent's] business operating under the name RANK in connection with entertainment services".* In summary, the opponent's submits the following: (a) that the Rank Group trades on the London Stock Exchange, and therefore, the general public as well as other businesses know the opponent by the name 'RANK'; (b) that the Rank Group's gaming venues display regulatory posters which include the 'RANK' branding (c) that the Rank Group is also required to publicise its annual business reports and (d) that the opponent has a large following on social media with over 36,000 followers on LinkedIn.

53. In my view, the evidence does not establish that the opponent has a reputation in the mark 'RANK' in connection with the goods and services for which the earlier marks are registered. I have reached that conclusion for the following reasons.

54. As regards the points at (a) and (c), the test for a qualifying 'reputation' was set out by the CJEU in *General Motors*. The earlier mark must be known by **'a significant part'** of the relevant public. In *Iron & Smith kft v Unilever NV*, Case C-125/14, the CJEU was asked whether a CTM (now an EUTM) with a reputation 'in the Community' (now the EU), but not in the Member State where infringement was alleged, was capable of being infringed under provisions of the Community Trade Mark Regulation (now the European Union Trade Mark Regulation) broadly equivalent to Section 5(3) of the Act. The court answered that:

> "If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3)

of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future."

55. The distinction between the requirement for a reputation in the EU, i.e. known to *"a significant part of the [EU] public concerned by the products or services covered by that trade mark",* and the level of awareness of the EU trade mark required amongst relevant consumers in the Member State where the issue arises, i.e. known to *"a commercially significant part of*' that relevant public, is clearer in the French version of the same judgment, which refers to a *"commercially non-negligible"* part of the relevant public in the Member State. An EU trade mark may therefore be entitled to protection in the UK where it is known to *"a significant part of the [EU] public concerned by the products or services covered by that trade mark"* including a *"commercially non-negligible"* part of the relevant public in the UK. The same applies to UK trade marks.

56. The relevant public in this case is made up of members of the UK general public who use the opponent's casino, bingo, gaming and gambling services. Those consumers will access the services by visiting the opponent's venues or digitally, through the opponent's online apps and websites. However, because the services are provided under various brands, namely 'Grosvenor Casino' and 'Mecca Bingo' (for services offered through the opponent's venues) and 'YoCasino', 'Spin and Win', 'Kitty Bingo', 'Lucky Pants', 'Rummy Passion', 'Regal Win', 'Bella Casino', 'Mecca Games' and 'Magical Vegas' (for services offered online), the average consumer will be familiar with those brands rather than with the names Rank Group, or Rank Group PLC, or Rank Leisure Holdings Limited. Further, whilst the name Rank Group PLC might be used on the London Stock Exchange and on Annual reports, the only public who will be exposed to those names are investors and shareholders for which annual reports are drafted. The copy of the annual report produced by Ms Appleyard proves this, as it starts with the Chair's letter to the company's shareholders. In those circumstances, I feel confident in concluding that the average consumer of the opponent's services will <u>not</u> be aware of the fact that the name of the company behind the business offering the goods and services is 'RANK'. For those average consumers (who are neither

investors on the London Stock Exchange nor readers of the opponent's annual reports) the brands 'Grosvenor Casinos', 'Mecca bingo', 'YoCasino', 'Spin and Win', 'Kitty Bingo', 'Lucky Pants', 'Rummy Passion', 'Regal Win', 'Bella Casino', 'Mecca Games' and 'Magical Vegas' will be the only indication of trade marks with the result that those marks are the only signs that provide an indication of the commercial origin of the goods and services in question. For the sake of completeness, I should also say that even if the opponent's investors and shareholders (who are familiar with the company name Rank Group PLC) were to be considered as consumers of the relevant goods and services, they would not represent a commercially significant part of the relevant public.

57. As regards the point at (c), the photos of the regulatory posters displayed at the Rank Group's gaming venues are dated after the relevant date, so they do not assist. In any event, even if I were to accept at face value that these posters were displayed prior to the relevant date, there is no evidence as to where they were displayed and for how long, and it is impossible to establish how many customers were actually exposed to these posters. More significantly, one of the posters produced in evidence is a premise license which authorises a premise located at an address in London to be used as an adult gaming centre; whilst the license names Rank Leisure Limited as the company to which the licence is issued, I am not convinced that the average consumer will pay any attention to it. Even less do I consider that the average consumer will extrapolate the word RANK from the company name Rank Leisure Limited and attribute any trade mark significance to it, or assume, without anything more, that RANK is the trade mark of the umbrella company under which the venues providing the services under the brands 'Grosvenor Casinos' and 'Mecca bingo' are operated. The same goes for the other poster which is a statement of commitment to the licensing objectives of the Gaming Act 2005 by the opponent's parent company Rank Group PLC.

58. As regards the point at (d) firstly, the fact that the opponent has a large following on LinkedIn and Twitter does not mean that the average consumer of the goods and services provided under the brands 'Grosvenor Casinos' and 'Mecca bingo' (or the other online brands) is also part of the opponent's followers. Secondly, I am not prepared to assume that the opponent's 36,000 LinkedIn followers and 1,660 Twitter

followers constitute a commercially significant part of the relevant public who uses (and purchases) the goods and services provided under the brands ‘Grosvenor Casinos’ and ‘Mecca bingo’ (or the other online brands). In this connection, it is important to note that LinkedIn (which, in this case, has the highest number of followers) is a social network aimed at professionals; this means that the follower count may simply be made up of employees, partners, shareholders or investors. As such, it cannot really be said to indicate a following in terms of consumers of the goods and services provided under the ‘Grosvenor Casinos’ and ‘Mecca bingo’ brands (or the other digital brands).

59. Finally, it seems to me that the opponent’s argument attempts to equate the rights deriving from the registration (and use) of a company name to the rights deriving from the registration (and use) of a trade mark. Whilst in some circumstances a business might use a sign concomitantly as a trade mark and as part of a company’s name, one needs to be more cautious when the goods and services are offered under a totally different sign from the business’ company name, as it is in this case. Section 5(3) protects reputation deriving from use of a trade mark in relation to the goods and services, whereas use of a company name is not (or not necessarily) trade mark use. In *Aegon UK Property Fund Limited v The Light Aparthotel LLP,* BL O/472/11, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

> “17. ..... unless is it obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.
>
> 18. In *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of “use in relation to” goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a situation where the mark is not physically affixed to the goods, the court said at [23]:
>
>> “…even where the sign is not affixed, there is use “in relation to goods or services” within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign

> which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party."

19. The General Court has, on more than one occasion, proceeded on the basis that a similar approach applies to the non-use provisions in what is now Article 42 of the European Union Trade Mark Regulation. For example, in *Strategi Group*, Case T-92/091, the General Court said:

> "23. In that regard, the Court of Justice has stated, with regard to Article 5(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989, L 40, p. 1), that the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being 'in relation to goods or services' (*Céline*, paragraph 21).
>
> 24. Conversely, there is use 'in relation to goods' where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. In addition, even where the sign is not affixed, there is use 'in relation to goods or services' within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party (see *Céline*, paragraphs 22 and 23).

20. Those passages must be read together with the general requirements of proof of use in *Ansul* at [43] that there is genuine use of a trade mark where the mark is used in accordance with its essential function namely to guarantee the

identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services".

60. In *Euromarket Designs Inc. v Peters* [2001] F.S.R. Jacob J. (as he then was) stated that:

> "56. That is not all on the question of non-use. If one looks at the advertisements they are essentially for the shops. True it is that some of the goods mentioned in the advertisements fall within the specification, but I doubt whether the reader would regard the use of the shop name as really being "in relation" to the goods. I think this is an issue worthy of trial in itself. The argument is that there is an insufficient nexus between "Crate & Barrel" and the goods; that only a trade mark obsessed lawyer would contend that the use of "Crate & Barrel" was in relation to the goods shown in the advertisement.
>
> 57. In this connection it should be borne in mind that the Directive does not include an all-bracing definition of "use", still less of "use in relation to goods". There is a list of what may *inter alia* be specified as infringement (Article 5(3), corresponding to section 10(4)) and a different list of what may, *inter alia*, constitute use of a trade mark for the purpose of defeating a non-use attack (Article 10(2), equivalent to section 46(2)). It may well be that the concept of "use in relation to goods" is different for different purposes. Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled "Boots", only a trade mark lawyer might say that that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign "in relation to" the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel United States shops to the United Kingdom in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence."

61. In *Cactus SA v OHIM,* Case T-24/13, EU:T:2015:494, the GC held that the owner of what was then a CTM (now an EUTM) who used the mark only as the name of a shop had used the mark "in relation to" the natural plants, flowers and grains sold in the shop (as well as in relation to retail services for those goods). This is because it had demonstrated that the public would link the (otherwise unbranded) goods to the mark used for the shop and regard the user of that mark as being responsible for the quality of the goods. The court stated that:

> "69 Accordingly, in view of the context of the present case, as described in paragraphs 66 to 68 above, and, in particular, the applicant's specific expertise in the plants and flowers sector, which it publicises, it must be considered that the documents submitted by the applicant which show the earlier marks establish to the requisite standard that there is a link between those marks and plants, flowers and seeds which bear no mark. Those documents show that the applicant offers for sale or sells those goods with the earlier marks as the only indication of a trade mark, with the result that those marks are the only signs that provide an indication of the commercial origin of the goods in question.
>
> 70 That conclusion is not affected by the consideration referred to by the Board of Appeal and OHIM that, in the light of the registration of the earlier marks in relation to retail services in Class 35, the earlier marks must be regarded as designating the applicant's stores which retail plants, flowers and seeds, not those goods themselves. Although the earlier marks are also registered to designate retail services in respect of the sale of plants, flowers and seeds, as is apparent from paragraphs 31 to 39 above, that does not mean, given the context of the present case described in paragraphs 66 to 68 above, that those same marks may not also designate plants, flowers and seeds which bear no mark and which are offered for sale in shops operated by the applicant.
>
> 71 In those circumstances, it must be concluded that the Board of Appeal erred in deciding that the applicant had not proved genuine use of the earlier marks in relation to 'natural flowers and plants, grains' in Class 31."

62. In this case I consider that (a) the use of the companies names ‘Rank Group PLC’ and ‘Rank Leisure Holdings Limited’ is limited to identifying the companies or designating the businesses which are carried out and cannot be considered as being use ‘in relation to goods or services’; (b) there is no evidence of the opponent publicising the company names ‘Rank Group PLC’ and ‘Rank Leisure Holdings Limited’ with marketing material targeting the average consumer of the goods services in a way which would create a link between the trade mark ‘RANK’ and the goods and services bearing other trade marks, (c) the opponent offers the goods and services under the brands ‘Grosvenor Casinos’ and ‘Mecca bingo’ (or the other online brands) which will be perceived by the relevant public as the only indication of trade marks, with the result that those marks are the only signs that provide an indication of the commercial origin of the goods and services in question.

63. Overall, I am not satisfied that the opponent has demonstrated that the earlier mark ‘RANK’ is known by ‘a significant part’ of the relevant public in relation to the registered goods and services. Without a reputation, the opponent’s claim under Section 5(3) fails.

Section 3(6)

64. Section 3(6) of the Act states:

> “(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

65. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ,* Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening,* Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening),* Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v*

OHIM, Institute for Personality & Ability Testing, Inc (intervening), Case T-507/08, EU:T:2011:46. It summarised the law as follows:

> "68. The following points of relevance to this case can be gleaned from these CJEU authorities:
>
> 1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].
>
> 2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].
>
> 3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, 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 the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacilik* at [45].
>
> 4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].
>
> 5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacilik* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]."

66. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

67. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16). The relevant date in this case is 4 April 2022.

68. The only evidence of bad faith consists in a copy of an email Ms Burrows received by the applicant in response to an email sent in relation to application no. 3735536 for the mark 'TRANSPARENT RANK'. The applicant responded to the email as follows:

> *"Hi Hannah*
> *I received your letter today.*
> *I was unaware of your client's existence until your letter although I am aware of their brands.*
> *I would be more than happy to discuss removing some of the classifications that are causing concern.*
> *We are a start-up company seeking investment. Please ask your client if they would (sic) interested in supporting our growth."*

69. As it can be seen, the applicant stated that when he filed first application no. 3735536 for the mark 'TRANSPARENT RANK' he did not have any knowledge, or

certainly no bad faith knowledge, in relation to the opponent's company or its parent company 'Rank Group PLC'. There is no reason for me to disbelieve the applicant's submission that when he applied to register 'TRANSPARENT RANK' he had never heard of the opponent; consequently, there was not, and could not have been at that stage, bad faith. This is all of the more so since I found that the opponent did not use the mark 'RANK' outwardly in relation to any of the registered goods and services, and the mark did not benefit from the required reputation at the relevant date.

70. However, by the time he filed the contested mark, the applicant had got to know of the existence of the opponent's trade mark 'RANK' and the opponent had wrote to the applicant objecting to his use of what the opponent regarded as its name and/or trade mark. Does this mean that the applicant's subsequent application for the contested mark was filed in bad faith? I do not think so. As I have said, I accept that when the applicant filed the first application for 'TRANSPARENT RANK' he had never heard of the opponent and that there was no bad faith at that stage. In his submissions the applicant provided the following reasons for his subsequent actions stating as follows:

> *"As already highlighted in previous correspondence, the opponent contacted me with what I perceived to be threatening letters telling me to remove the mark Transparent Rank in Dating Services, when they had no legal case to do so or to oppose. They did not oppose the mark. I believe that the opponent, who are experienced litigants, premeditated any further mark applications from myself and initiated these communications early in order to have case build a bad faith case should I proceed with marks for my business which they would try to defend more strongly. I believe the opponents behaviour now proves this to be true. The opponent should never have been in contact with me at that time if they were acting in good faith. Clear bad faith behaviour with the act of demanding the removal of Transparent Rank was demonstrated in this instance. The opponent makes comment that an application for both Transparent Rank and Rank would be done at the same time if my claims were to be honest. This is complete speculation. The opponent has no knowledge of the business' working conditions, scheduling, development plan and budget. A multitude of factors affect the timing of trademark applications of which the*

opponent has no knowledge of. This comment should be struck out in its entirety."

71. Although the applicant did not file these comments in the form of evidence, he denied the opponent's claim that the application was filed in bad faith. Further the applicant challenged the opponent's evidence, claims and allegations of bad faith in the form of written submissions.

72. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

73. In this case, even if I were to ignore the explanation provided by the applicant in its written submissions because these facts were not introduced in the form of evidence, my conclusion is that the applicant's behaviour is consistent with good faith. This is because I do not need evidence to consider reasonable the possibility that the applicant's subsequent filing of the contested application for the mark 'RANK' could be explained by his reaction to the opponent's request in the sense that if the applicant did not believe that the opponent had any legal case to oppose his first application, he did not act in bad faith when he proceeded with filing the contested mark as part of a filing strategy aimed at registering a variant mark of the prior application. The fact that the applicant jumped at the opportunity by offering the opponent an option to invest in his company does not mean that it acted in bad faith when he filed the second application because it did not proactively try to extort money from the opponent but only reacted to the opponent's email. Finally, the word 'RANK' has clear allusive connotation in relation to the contested dating services, alluding to the candidates' positions within a scale of matching preferences, so I am not surprised the name was selected for such types of services and I believe that the choice was pure coincidence rather than bad faith. The opposition based on Section 3(6) also fails.

CONCLUSIONS

74. The opposition fails in its entirety. Subject to appeal the applications may proceed to registration.

COSTS

75. The applicant has been successful, and ordinarily he would be entitled to an award of costs. As the applicant has not instructed professional representatives, he was invited by the Tribunal by email dated 2 April 2023 to indicate whether he intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities. The applicant was informed of the consequences of not filing a completed cost proforma (i.e. no costs award would be made) and was provided with a cost proforma and given a deadline of 2 May 2023 to respond. However, as the applicant did not file a completed copy of the costs proforma before the deadline given, or indeed at all, I make no order as to costs.

Dated this 12th day of October 2023

Teresa Perks
For the Registrar