

O/299/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3418967
IN THE NAME OF EATBAY LTD FOR THE TRADE MARK



IN CLASSES 35, 38, 39 & 43

AND

OPPOSITION THERETO UNDER NO. 418507

BY EBAY INC.

Background and pleadings

1. EATBAY LTD (the applicant) applied to register the trade mark application no. 3418967 for the mark  in the UK on 5 August 2019. It was accepted and published in the Trade Marks Journal on 23 August 2019 in respect of the following services:


Class 35: Advertising; business management; business administration; office functions; advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet; restaurant and take away restaurant directory and search services; conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics; advertising services for restaurants and take away restaurants via the internet; consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; order procurement services for restaurants and take away restaurants; market research services for restaurants and takeaway restaurants.

Class 38: Telecommunications; transmission of consumer generated reviews for restaurants and take away restaurants online; provision of on-line forums and chat rooms.

Class 39: Transport; packaging and storage of goods; travel arrangement; food delivery services; provision of the delivery of takeaway, restaurant and restaurant meals via a website.

Class 43: Services for providing food and drink; services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants; restaurant and take away restaurant services.


2. eBay Inc. (the opponent) opposes the trade mark on the basis of section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). The opposition on section 5(2)(b) relies upon the five earlier trade mark registrations¹ in the table below. The classes opposed and relied upon under each mark are indicated for reference, and the full list of services relied upon and opposed under each mark is provided at paragraph 74 of this decision.

Earlier Mark	Territory	Registration date	Registration no	Classes relied upon	Classes opposed
EBAY	UK	03/11/2000	2221802	Class 38	Class 38
EBAY	EU	22/06/2000	1029198	Class 35	Class 35 Class 39 Class 43
EBAY	EU	27/06/2019	18011767	Class 36 Class 42	Class 39 Class 43
BAY	EU	07/05/2019	17978982	Class 35 Class 36 Class 38 Class 42	All classes
	EU	20/08/2013	11576865	Class 35 Class 42	All classes

3. The opponent argues that the respective services are identical or similar and that the marks are highly similar, particularly in consideration of the distinctive element of the applicant's mark "BAY". The opponent argues that consumer confusion between its earlier marks and the application is inevitable.

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

4. The opposition based on Section 5(3) of the Act relies on two earlier marks only. These are set out in the table below, and a full list of the services for which a reputation is claimed is set out at paragraph 154 of this decision:

Mark	Territory	Registration date	Registration no	Services relied upon	Services opposed
	EU	20/08/2013	11576865	Services in class 35	All services
EBAY	EU	22/06/2000	1029198	Services in class 35	All services

5. The opponent claims it holds a vast reputation in respect of the marks for the services relied upon, and that the consumer would believe that there is an economic connection between the opponent's mark and the application. The opponent submits this is particularly due to the enhanced reputation and the high similarity of the signs. The opponent claims that the link the consumer will make between the marks will result in an unfair advantage for the applicant, who will feed off the fame of the earlier marks, riding on its coattails and freeriding on the substantial investment that has been made by the opponent. The opponent claims the applicant will benefit from the power of attraction, reputation and prestige of the earlier marks without compensating the opponent for its marketing effort. The opponent claims the applicant would be able to enter a "ready-made market" without needing to incur its own advertising costs.
6. The opponent further claims that the use of the applicant's later mark would cause detriment to the distinctive character of its eBay marks. The opponent submits this would cause the dispersion of the marks identity and hold upon the public mind resulting in erosion, blurring and/or dilution, and weakening the ability of the opponent's marks to identify goods and services as coming from the opponent. The opponent states there is a real risk that the use of the applicant's mark, over which the opponent would have no control, would damage the image of the opponent's mark, and that the public perception of

the marks as unique will be eroded, blurred and/or diluted, reducing its power of attraction and affecting the economic behaviour of the public.

7. The opponent has also based the opposition on Section 5(4)(a) of the Act, relying upon unregistered rights in the mark EBAY, which the opponent claims has been used throughout the UK since March 1996, and has been used in respect of the following services:

Advertising; Business administration; online-trading services; operating on-line marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale and purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith; providing a searchable online database for buyers and sellers; Telecommunications.

8. The opponent claims that the applicant's mark so closely resembles the opponent's that it is likely to deceive consumers or cause confusion in respect of all the services filed. Further, the opponent claims the close similarity of the marks will result in an immediate association between the marks, and would mislead or lead the public to believe that the applicant's services are those of the opponent or that they are otherwise associated with, authorised or endorsed by the opponent. The opponent states that the result of this is that the opponent is likely to suffer damage and thus the mark is liable to be prevented under passing off Section 5(4)(a).

9. The applicant filed a counterstatement denying the claims made. The applicant denies "infringing" on the opponent's rights and requested that the opponent provide proof there will be confusion. The applicant states the opponent cannot claim ownership of the word 'eat' for a food business, when

its marks only use a single 'e'. The applicant requested proof of use is provided in respect of the opponent's UK trade mark number 2221802 for EBAY in respect of all of the services relied upon.

10. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
11. The opponent is represented by CMS Cameron Mckenna Nabarro Olswang LLP. The applicant is not represented professionally in these proceedings.
12. Although the UK has left the EU, section 6(3)(a) of the European (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.

Evidence

13. The opponent's evidence comprises a witness statement in the name of Patricia Svilik in her position as "Head of the IP Product & Commercial Counseling Group at eBay". The 10-page witness statement provides details about the use of the 'eBay' marks, and introduces 22 exhibits, namely Exhibit AL-01 to Exhibit AL-22. The evidence received is substantial, and so whilst I have considered it in full, I have summarised the facts as I see appropriate below.

eBay website

14. The eBay sites such as eBay.com provide an online marketplace for the sale of a wide variety of goods at local, national and international level.² Users were first registered on the UK specific site, www.ebay.co.uk, in July 1999.³ Financial reports are provided at Exhibit AL-01, which describe revenue and growth being generated via the charging of fees for listing and featuring items on the “Classified platforms”, and “promoted listing fees”. In the UK, eBay generated the following net revenue in the years 2017 to 2019:⁴

- (a) 2019 = US\$ 1,441,000,000
- (b) 2018 = US\$ 1,481,000,000
- (c) 2017 = US\$ 1,368,000,000

15. The web traffic for the UK eBay website was as follows:⁵

Site	2015	2016	2017	2018
eBay.co.uk	4 billion	4 billion	4 billion	4 billion

16. As of 11 June 2019, there were 1.2 billion listings on eBay.com.⁶ On 1 August 2019, the UK site www.ebay.co.uk was listed as the 9th most visited website in the UK on website statistics site alexa.com.⁷ A screenshot of the website as of August 2019 is provided at Exhibit AL-03, and shows the site offering features such as “today's deals” and “featured sales and events”. The first page shows the mark in both stylised format and in black and white text as below:

² Svilik, paragraph 6

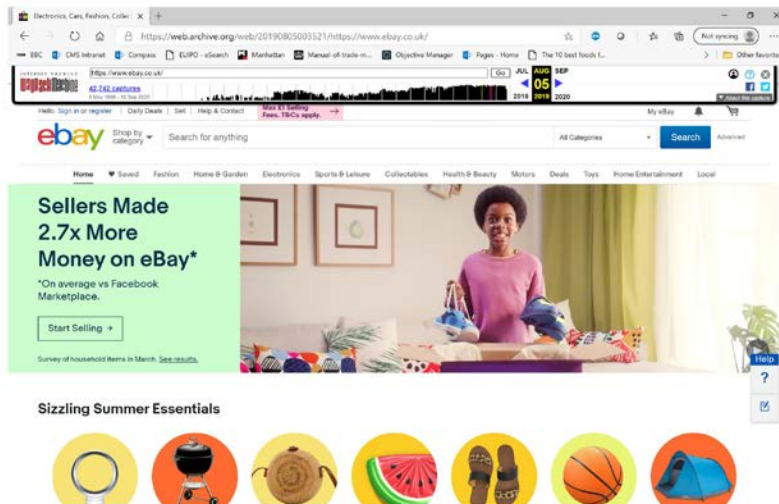
³ Svilik, paragraph 13

⁴ Svilik, paragraph 13 & Exhibit AL-01 page 7

⁵ Svilik, paragraph 18

⁶ Svilik, paragraph 19 & Exhibit AL-02

⁷ Svilik, paragraph 19 & Exhibit AL-04



17. Registered users of eBay may take advantage of the following services offered:⁸

- Purchasing goods;
- Selling goods;
- Monitoring bids and prices;
- A “watch service” for less common goods;
- Maintaining virtual storefronts for selling products;
- Chat rooms and discussion boards;
- Education and training tools for buying and selling on eBay

eBay application

18. The eBay application (‘the app’) offers eBay’s services above in the form of an app suitable for the iPhone, iPad and Android devices.⁹ As of 11th June 2019 there were 459 million app downloads.¹⁰ The application market intelligence company “App Annie” found that as of 12 June 2018 the app was the no. 32 app in the UK overall, and was the no. 2 app for shopping on the iPhone, no. 30 overall and no. 2 for shopping on the iPad and no. 26 overall and no. 3 for shopping on “Google Play”.¹¹ The same rankings show the app reaching

⁸ Svilik, paragraph 16

⁹ Svilik, paragraph 20

¹⁰ Svilik, paragraph 19 & Exhibit AL-02

¹¹ Svilik, paragraph 20 & Exhibit AL-05

highs as the no. 1 most downloaded shopping app in the UK on the iPhone on 6 November 2015, and the no. 1 most downloaded app overall on the iPad store in the UK on 9 September 2015, and the 8th most downloaded app overall on the iPhone on 24 February 2015.¹² For a short time the opponent offered an app called “Watch with eBay”, enabling consumers to shop for items they have seen on TV shows.¹³

eBay radio

19. eBay offers a US based radio show covering topics including eBay developments, instruction and advice. The radio show is available for online streaming by UK consumers.¹⁴ Exhibit AL-08 is dated 16 November 2019 and shows the show advertised as being run between 2003-2018, with reference to a broadcast of 26 July 2018.

eBay feedback and communication tools

20. On its trading platform, including in the UK, eBay offers the following:¹⁵

- Feedback profiles and forums where ratings and comments may be left;
- Tools through which buyers and sellers can communicate to discuss products and purchases;
- Services for connecting users to allow conversation, the transmitting of files and the sending of electronic messages.

21. eBay Messages has allowed users to communicate with each other via the eBay platform since 1999.¹⁶

¹² Svilik, paragraph 22 & Exhibit AL-05

¹³ Svilik, paragraph 23

¹⁴ Svilik, paragraph 24

¹⁵ Svilik, paragraphs 29 - 31

¹⁶ Svilik, paragraph 52(a) & Exhibit AL-18

22. eBay Community has been available since September 2010 and provides users with forums and online discussion boards where information can be shared.¹⁷

23. eBay API (Application Programming Interface) permits third party software developers to “make software calls”, including to generate EPN tracking links and retrieve listings.¹⁸ The ‘API FAQ’ page is provided within Exhibit AL-18 within the evidence, dated 22 February 2018.

24. Evidence of a messaging board is provided by the internet archiving site “Wayback Machine” dated 15 March 2015, and the evidence provides a page referencing the “eBay email forwarding service” dated the 26 March 2015.¹⁹ Also provided via the Wayback Machine is a screenshot dated 17 January 2016 displaying the “business seller board” under the eBay mark, and a question centre under the mark dated 18 November 2016, where messages can be left. Screenshots of the same tools captured on 22 February 2018 are also provided.²⁰

Additional eBay services

25. ‘eBay’ provides advice to sellers on the best way to package goods and suggested postage prices and postage options,²¹ and provides “a click and collect service from over 3500 eBay collection point locations across the UK” as well as services for buyers to buy and print pre-paid postage labels.²² Exhibit AL-19 is dated 9 October 2020 and lists the following postage services

available under the  mark:

- Advice on postage prices;
- Advice on postage options;

¹⁷ Svilik, paragraph 52(b) & Exhibit AL-18

¹⁸ Svilik, paragraph 52(b) & Exhibit AL-18

¹⁹ Exhibit AL-18

²⁰ Exhibit AL-18

²¹ Svilik, paragraph 54

²² Svilik, paragraph 54

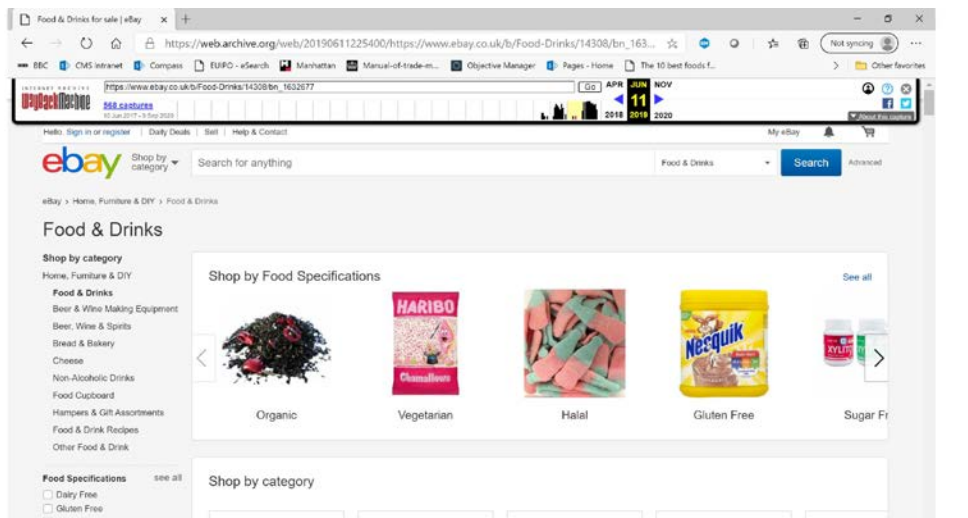
- eBay click and collect stations;
- Buying and printing postage labels;

26. Exhibit AL-20 also dated 9 October 2020 describes the international shipping services offered under the mark, including:

- Duty payment;
- Customs clearance;
- Parcel tracking

Food and drink

27. There is a specific section on the eBay website for the sale of food and drink.²³ Exhibit AL-21 provides the following screenshot from ebay.co.uk dated 11 June 2019:



Advertisement and press

28. Exhibit AL-01 shows the total advertising spend as \$1.3 billion in 2017, \$1.4 billion in 2018 and \$1.4 billion in 2019 (USD). The proportion allocated to advertising spend in the UK is not confirmed. At paragraph 33 of her witness

²³ Paragraph 56

statement, Ms Svilik states “It is safe to assume that, of that amount, a substantial proportion was spent in the UK.”

29. A significant number of press articles have been provided at Exhibits AL-12 and AL-13 spanning from 1999 to 2019. The press articles are spread throughout this timeframe and come from a wide variety of what appear to be British publications. A summary of several of the articles picking up on some of the key information is provided below.

30. Included within Exhibit AL-12 is an article dated 30 January 2005 from Times Online. This refers to the British arm of “Ebay” signing its 10 millionth user. An article from the Daily Mirror dated 28 April 2006 refers to 15 million users buying and selling on eBay in the context of the UK.²⁴ One article published by The Independent on 8 August 2009 refers to the 10th anniversary of eBay’s operation in the UK, and refers to eBay as “the online auction giant”. An article from The Telegraph dated 20 February 2012 refers to ‘Britain’ as eBay’s fastest growing market and confirms the UK site was up to 17 million users at that time. An article in the Guardian dated 19 August 2014 refers to 15 years of eBay in Britain and includes a quote from a ‘retail analyst’ stating “Ebay is one of the main reasons we are all happy to shop online..”, and an article in The Express dated 3 September 2015 refers to “eBay at 20” and offers a summary of the history of eBay since its global launch 20 years earlier. The final paragraph of the article refers to eBay as a “global shopping destination with approximately 25 million sellers, 157 million buyers and 800 million listings ...”.

31. Exhibit AL-13 includes an article from the Daily Telegraph dated 23 May 2016 entitled “Giant retailers dominating world of online shopping as internet sales continue to soar” and goes on to state that “online auction site eBay” receives 333 million British visits per month. An article from the Evening Chronicle dated 10 August 2017 refers to eBay as “the globe’s biggest online

²⁴ The article refers to three in five UK households now containing a member of the “eBay community”.

marketplace” and promotes the “eBay for business awards 2017”. An article dated 11 January 2017 from M2 FinancialWire discusses UK consumer online shopping habits, and states that eBay and Amazon are the most popular online clothing outlets. An article from the same publication on 28 September 2018 announces eBay’s program in partnership with the City of Wolverhampton to help small retailers “get online”. An article from March 2018 from Euromonitor International describes Amazon and eBay as the most popular online marketplaces when discussing internet retailing in the UK.

Social media

32. The evidence shows the opponent’s presence on various social media platforms. On 18 September 2020, the Facebook page entitled ‘eBay.co.uk’ showed 2,147,218 people followed the page and that 2,199,676 people had liked the page.²⁵ At the same date, the twitter page eBay.co.uk showed 141.8 thousand “Followers”,²⁶ and its Instagram page showed 62.9 thousand “followers”.²⁷ Its ‘eBayUKofficial’ page on YouTube showed 10.7 thousand subscribers within Exhibit AL-11, but a date does not appear to be shown.²⁸

Awards

33. Within her witness statement, Ms Svilik has referenced global awards, stating that eBay ranked 44th in an Interbrand survey of the best 100 global brands in 2019, and as the 10th most valuable retail brand in the Brandz Global Top 100 Brand Report, also in 2019.²⁹ The evidence also shows eBay in 38th place on the Interbrand Best Global Brand list by Interbrand in 2018, 34th in 2017 and 32nd in 2016 and in 2015. In 2014 eBay ranked 28th and in 2013 it ranked

36th. The mark shown on all of the rankings is  .³⁰ The evidence

²⁵ Exhibit AL-11, page 1


²⁶ Exhibit AL-11, page 2

²⁷ Exhibit AL-11, page 3

²⁸ Exhibit AL-11, page 4

²⁹ Svilik, paragraph 37 & Exhibits AL-14/AL-15

³⁰ Exhibit AL-14

also shows  as no. 88 on the “BrandZ Top 100 Most Valuable Global Brands 2018”, and as the 8th most valuable retail brand that year.³¹ On the same chart the mark was listed as 86th overall in 2017 and 91st in 2016, and 73rd in 2015, and as no. 10 on the retail brands list in 2016 and no. 6 in 2015.³² Results back to 2013 have also been provided and considered.

Other

34. As part of the evidence provided, the opponent has directed me to several decisions issued by the UK Intellectual Property Office (IPO) Tribunal, and the opposition division at the European Union Intellectual Property Office (EU IPO), which the opponent states have held that “the mark EBAY is a famous trade mark and has refused registration of a BAY formative mark”. Whilst these earlier decisions are noted, I am not bound by the findings of other Hearing Officers, and I will assess this matter on the evidence and the facts before me in these proceedings.

Preliminary issues

35. At paragraph 45 of her witness statement, Ms Svilik refers to the results of a survey as carried out “among the British public in 2013 to prove the recognition attributed to the eBay brand and in particular the “Bay” element.” Tribunal Practice Notice (2/2012) requires parties wishing to submit survey evidence into proceedings to seek permission from the Tribunal to do so. This must be accompanied with detailed information about the survey that took place. I do not believe that permission was sought by the opponent to introduce the results of the survey referred to into evidence, and so I will not consider this within this decision.

³¹ Exhibit AL-15

³² Exhibit AL-15

36. I also note that the evidence as provided by the opponent, namely the witness statement of Patricia Svilik, includes some statements that are more akin to submission, particularly in respect of the section entitled “The eBay Marks and Inherent Distinctiveness”. To the extent that the witness statement includes submission and the opinion of Patricia Svilik on matters that are clearly to be determined by the Tribunal, this will not be considered as evidence of fact within these proceedings.

37. I also wish to address at the outset of this decision, the applicant’s apparent lack of denial of the opponent’s reputation, as raised by the opponent. It is the case that whilst the applicant addresses (and denies) the claim of unfair advantage as well as denying “infringing”, it does not specifically deny the reputation of eBay per se. In its submissions filed during the evidence rounds, the opponent states:

Reputation

- 38. In its Counterstatement, the Applicant does not deny that the Opponent’s Marks have a reputation in the UK. It would be implausible for it to do so given the size of the Opponent’s business and its significant reputation.
- 39. The Opponent has acquired over many years and held at the Application Date a very substantial reputation in its EBAY trade marks in the UK. This reputation is evidenced by the Witness Statement of Patricia Svilik and the documents and other materials exhibited to it.
- 40. In addition, the UKIPO has consistently recognised the reputation and distinctiveness of the EBAY trade mark in its decisions. For example, at paragraph 127 of the GAMERSBAY decision at Annex 3, the Hearing Officer, Allan James, said “*I find that EBAY has a huge reputation for provision of an online marketplace for the buying and selling of goods; provision of advertising space; provision of online tools for advertising purposes*”.

38. I acknowledge that the applicant had an opportunity to file submissions in reply to this both during the evidence rounds, and after the evidence rounds had closed, but no additional submissions were received. I agree with the opponent that there is no specific denial of the reputation as claimed by the opponent. However, I also note that the applicant is unrepresented, and there is plainly an attempt to deny the elements of the ground under section 5(3). It is my view that the lack of a specific denial of this element of section 5(3) by the applicant does not, in this instance, amount to a concession from the applicant of a vast reputation as pleaded by the opponent.

39. I also feel it is best to address one line of argument put forward by the applicant within its counterstatement at this stage. The applicant has stated that there are “plenty of sites ... ending with “Bay” which are selling similar products to eBay and they are still trading on the market”. The applicant goes on to list several website addresses all of which end with the three letters “BAY” before the “.com” element. The statements made by the applicant are not backed up by any evidence. I find the statements made to be irrelevant to the current proceedings, as the decision I must make is concerned with the particular set of facts and marks before me. In addition, even if use of the common element by a number of third parties was to be considered, the list of domain names provided by the applicant leaves too many questions unanswered to form a convincing argument, not least on the basis that:

- The applicant provides details and domain names only, along with claims that the sites are selling “similar products like eBay”. There is no evidence of the actual trade mark being used on the sites, or of the activities the sites are undertaking;
- The domain names provided (with the exception of “recentlyebuygumm.co.uk, which the applicant claims is “clearly a copycat website”) are all .com domain names. There is no evidence that the websites are aimed at the UK consumer.

40. Finally, I note the applicant’s statement in its TM8 as follows:

“Regardless of the size of the organization, fairness required eBay to provide documents and evidences of how EATBAY of a food industry directly create confusions to eBay business. eBay cannot claim the ownership of the word “EAT” of a restaurant food related business as they have a single “e” on the word EAT.”

41. I will briefly address the issues with the statement above. Firstly, for the applicant’s benefit I note here that evidence of actual confusion is not required for success within an opposition. Secondly, there is no claim to the ownership of the word “EAT” by the opponent, and the decision in this instance will

consider the likelihood of confusion in respect of the earlier marks and the application as filed. The fact that the word EAT may relate to some of the services at issue is a relevant consideration, but this will not necessarily reduce the likelihood of confusion between the marks in this instance. This will be considered in more detail later on in this decision.

Proof of use

42. The applicant has requested proof of use in these proceedings in respect of the opponent's UK EBAY mark no. 2221802 only, in respect of all of the services relied upon. The services relied upon under this mark are as follows:

Class 38: Telecommunications services; electronic transmission of data and information; providing user access to the Internet; providing telecommunications connections to the Internet or data bases; telecommunications access services; electronic mail services.

43. Although the applicant also requested proof of use be provided in respect of this registration in class 41, these services have not been relied upon by the opponent under the same, and so proof of use is not relevant for class 41.

Relevant statutory provision: Section 6A:

44. "(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

45. The mark for which proof of use has been requested was registered on 3 November 2000, meaning the registration was over five years old on 5 August 2019 when the application was filed. This means the registration is subject to the use provisions as set out above. The relevant timeframe within which the opponent must prove use of this mark is between 6 August 2014 and 5 August 2019.

Proof of Use case law

46. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU³³ has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundesvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV*

³³ Court of Justice of the European Union

[EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form

of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial

justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

47. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

48. The burden is on the opponent to show that the earlier mark has been used within the relevant territory of the UK, within the relevant timeframe, and in respect of the services relied upon within this opposition.

Form of the mark

49. The mark for which use has been requested is the word mark EBAY. As the mark filed is a word mark, it may be used in a range of standard fonts and colours, as well as upper and lowercase lettering. Where the mark is used by the opponent in black text or single colour word format throughout the evidence, this clearly constitutes use of the word mark as registered. I note the use of the upper case ‘B’ where the mark is used in word format, but I do not find this to alter the distinctive character of the mark in this instance.

Use of the mark

50. It is very clear from the evidence filed that there has been considerable use of the mark within the UK and within the relevant timeframe. A very large net revenue under the mark, in excess of 1 billion USD a year has been provided for UK activities carried out under the mark for 2017, 2018 and 2019, of which the full amount for 2017 and 2018 will fall within the relevant timeframe. It

appears very likely that at least a significant portion of the figures provided for 2019 will also fall before the end of the relevant period in August 2019. In addition to this, a figure of 4 billion is provided in respect of the traffic to UK website each year, which as can be seen from the evidence clearly makes use of the mark as registered, and there is a significant amount of press provided which documents the growth of the site.

51. What is slightly less clear from the evidence is the extent to which the mark has been used in respect of the services in class 38 for which use must be shown. The bulk of the opponent's core services relate to services providing an online marketplace. However, although the class 38 services are not the core focus of the opponent, I cannot assume that the services in class 38 are not in use.

52. I have firstly considered the services listed below:

providing user access to the Internet; providing telecommunications connections to the Internet or data bases; telecommunications access services

53. It is my view that the ordinary and natural meaning of the above terms is to be construed as the provision as a service of the means by which consumers may connect up to the virtual world or gain access to a network in order to make use of telecommunication apparatus and connect virtually with others or with databases. Whilst I note the opponent may offer to the consumer use of a platform for communicating within that virtual world, it is my view that there is no evidence positioning the opponent as a telecommunications or internet provider as such, insofar as being the provider of the access and network connections to the consumer. I therefore find no use of the above services within class 38.

54. In respect of the general terms covered by the opponent comprising of *Telecommunications services; electronic transmission of data and information; electronic mail services*, I note there is some evidence of use of

the mark within the UK that falls within these categories. It is my view that the evidence provided at paragraphs 16 & 52 of the witness statement of Patricia Svilik, and supported by the evidence provided at Exhibits AL-18 show the provision of a direct messaging and email service between user accounts as part of the online marketplace offering under the eBay mark in the UK and within the relevant timeframe. Further, I note the use of the mark in respect of online discussion forums and various bulletin boards within its UK offering. I also note the provision of an application, but I do not find this to fall within the meaning of these services outside its ability to offer the same communication services as previously mentioned. Whilst I note the opponent's insistence that eBay Radio is available to UK consumers, being that it is clearly defined as a US based offering, and that it is available via a '.com' site, I see no reason to find that the radio offering is being directed or targeted to consumers in the relevant market of the UK. It is clearly established that being *accessible* to UK consumers is not sufficient to find that the use is within the UK.³⁴

Genuine use

55. Now that I have established whether there has been use of the mark in respect of the services, I will consider if I find the use that has been made to be genuine use, for the purpose of securing a share of the relevant market in respect of the services. Where I have found no use of the services, namely *providing user access to the Internet; providing telecommunications connections to the Internet or data bases; telecommunications access services*, it follows that there is no evidence of genuine use of the same.

56. In respect of the opponent's use in relation to *Telecommunications services; electronic transmission of data and information; electronic mail services*, to the extent that these services are offered by the opponent, they are clearly offered as ancillary services to the opponent's core service offering as an

³⁴ See joined Cases C-585/08 and C-144/09 *Pammer v Reederei Karl Schlüter GmbH & Co. KG and Hotel Alpenhof GesmbH v Heller* in which the CJEU held that it was not sufficient for this purpose that a website was accessible from the consumer's Member State. Rather, "the trader must have manifested its intention to establish commercial relations with consumers from one or more other Member States, including that of the consumer's domicile"

online marketplace. However, with consideration to the size of the opponent's operation within the UK, it appears likely that the use of these services in the UK will be significant. Whilst the opponent has not clarified whether or not these services convert into revenue, it appears likely that any revenue is generated primarily in respect of listings and the promotion of such, and that these services are not charged separately. If the opponent charges any fee for the use of its messaging and communication services, this is not clear. However, the fact that these services do not appear to be generating revenue in addition to or separate from the opponent's marketplace offering does not necessarily mean that the use of the mark in respect of these services is not genuine.

57. In *Antartica Srl v OHIM The Nasdaq Stock Market, Inc.* (Case C-320/07P) the CJEU dismissed a complaint by an appellant that there was no genuine use of an earlier mark because certain services provided under it were not charged. The court stated that:

“29. It is sufficient to note in that respect that, even if part of the services for which the earlier mark is registered are offered by The Nasdaq Stock Market free of charge, that does not of itself mean that that commercial company will not seek, by such use of its trade mark, to create or maintain an outlet for those services in the Community, as against the services of other undertakings.”

58. With consideration to the evidence provided, and the fact that the operation of these services within the relevant territory and within the relevant timeframe appears to be both consistent and considerable, it is my view that the use of the opponent's mark in respect of the messaging and mail services and online discussion forums and bulletin boards is use in accordance with the commercial *raison d'être* of the mark and that it is real commercial exploitation of the mark for the purpose of maintaining a market share for these services as a part of its commercial offering. I therefore find the use of the mark in respect of these services to be genuine.

Fair specification

59. Of the services for which proof of use was requested, I found the opponent had shown genuine use of services falling within the following categories:

Telecommunications services; electronic transmission of data and information; electronic mail services.

60. I must now consider the extent to which I find the cancellation applicant's use as described justifies the enforcement of the earlier mark within these opposition proceedings in relation to the above services covered by the registration.

61. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

62. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

63. It is evident that the wording *telecommunication services* covers a broad range of services. The term may be broken down into many subcategories, including several which, as I have already discussed, the opponent does appear to offer. In addition, the wording *electronic transmission of data and information* also encompasses a wide range of possible services. Although *electronic mail services* are somewhat narrower than the other services for which use has been found, it still conveys a much broader meaning to the consumer than I believe would be understood from the use made of the services. Whilst it would not be correct to allow protection only for each specific service offered by the opponent, I must consider what the average consumer would view as a fair description. It is my view that the consumer would find *the provision of online communication services and platforms for use with e-commerce; electronic transmission of data and information in relation to e-commerce* to be a fair description of the services offered by the opponent in class 38. The opponent's UK mark EBAY with the registration no. 2221802 will therefore be considered in relation to these goods in class 38 in respect of this opposition.

DECISION

Section 5(2)(b)

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

"5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

Section 5A

65. 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.”

Case Law

66. 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.

The principles

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the

same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

67. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

68. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

69. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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 are complementary”.

70. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

71. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC that goods may be considered “complementary” where:

“...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”.

72. The case law provides further guidance on how the wording of goods and services as registered and filed should be interpreted within the comparison. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

73. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general

term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.


(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

74. With these factors in mind, the goods and services for comparison are below:

Earlier services	Contested services
<p>Registration no. 2221802 (EBA Y) <i>Class 38: The provision of online communication services and platforms for use with e-commerce; electronic transmission of data and information in relation to e-commerce (following the findings of the proof of use)</i></p>	<p><i>Class 38: Telecommunications; transmission of consumer generated reviews for restaurants and take away restaurants online; provision of on-line forums and chat rooms.</i></p>
<p>Registration no. 1029198 (EBA Y) <i>Class 35: Advertising services; business information and administration services; on-line trading services.</i></p>	<p><i>Class 35: Advertising; business management; business administration; office functions; advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet; restaurant and take away restaurant directory and search services; conducting of restaurant and take away</i></p>

	<p><i>restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics; advertising services for restaurants and take away restaurants via the internet; consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; order procurement services for restaurants and take away restaurants; market research services for restaurants and takeaway restaurants.</i></p> <p><i>Class 39: provision of the delivery of takeaway, restaurant and restaurant meals via a website</i></p> <p><i>Class 43: services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website</i></p>
<p>Registration no. 18011767 (EBA Y)</p> <p><i>Class 36: electronic payment services involving electronic processing and subsequent transmission of payment data, all conducted via a global communications network; credit card and debit card transaction processing services;</i></p> <p><i>Class 42: Providing temporary use of on-line non-downloadable software for processing electronic payments;</i></p>	<p><i>Class 39: food delivery services; provision of delivery of takeaway, restaurant and restaurant meals via a website</i></p> <p><i>Class 43: services for providing food and drink enabling customers to place orders for food and drink online; ordering takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants; restaurant and take away restaurant services</i></p>
<p>Registration no. 17978982 (BAY)</p> <p><i>Class 35: Online trading services, namely, operating online marketplaces for sellers and buyers of goods and services; providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith; providing a searchable online advertising guide featuring the goods and services of online vendors; providing a searchable online evaluation</i></p>	<p><i>Class 35: Advertising; business management; business administration; office functions; advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet; restaurant and take away restaurant directory and search services; conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics; advertising services for restaurants and take away restaurants via the internet; consumer research, namely collection and collation of consumer generated reviews for</i></p>

<p>database for buyers and sellers; advertising and advertisement services.</p> <p>Class 36: electronic payment services involving electronic processing and subsequent transmission of payment data, all conducted via a global communications network; credit card and debit card transaction processing services;</p> <p>Class 38: Telecommunications services, namely, the electronic transmission of data and information; electronic messaging; providing an online, interactive bulletin board for the transmission of messages among computer users concerning hobbies, collectibles, trading, and the sale of goods and services via a global computer network.</p> <p>Class 42: providing temporary use of online, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network; providing temporary use of on-line non-downloadable software for processing electronic payments.</p>	<p>restaurants and take away restaurants; order procurement services for restaurants and take away restaurants; market research services for restaurants and takeaway restaurants.</p> <p>Class 38: Telecommunications; transmission of consumer generated reviews for restaurants and take away restaurants online; provision of on-line forums and chat rooms.</p> <p>Class 39: Transport; packaging and storage of goods; travel arrangement; food delivery services; provision of the delivery of takeaway, restaurant and restaurant meals via a website.</p> <p>Class 43: Services for providing food and drink; services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants; restaurant and take away restaurant services.</p>
<p>Registration no. 11576865 ()</p> <p>Class 35: Advertising; business management; business administration; office functions; On-line trading services, namely, operating on-line marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale and purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith; providing a searchable online</p>	<p>Class 35: Advertising; business management; business administration; office functions; advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet; restaurant and take away restaurant directory and search services; conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics; advertising services for restaurants and take away restaurants via the internet; consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; order procurement services for restaurants and take</p>

<p><i>advertising guide featuring the goods and services of online vendors; providing a searchable online evaluation database for buyers and sellers; advertising and advertisement services.</i></p> <p><i>Class 38: Telecommunications; providing user access to the Internet; providing telecommunications connections to the Internet or data bases; telecommunications gateway services; electronic mail services;</i></p> <p><i>Telecommunications services, namely, the electronic transmission of data and information; electronic messaging; providing an online, interactive bulletin board for the transmission of messages among computer users concerning hobbies, collectibles, trading, and the sale of goods and services via a global computer network.</i></p> <p><i>Class 42: providing temporary use of online, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network;</i></p>	<p><i>away restaurants; market research services for restaurants and takeaway restaurants.</i></p> <p><i>Class 38: Telecommunications; transmission of consumer generated reviews for restaurants and take away restaurants online; provision of on-line forums and chat rooms.</i></p> <p><i>Class 39: Transport; packaging and storage of goods; travel arrangement; food delivery services; provision of the delivery of takeaway, restaurant and restaurant meals via a website.</i></p> <p><i>Class 43: Services for providing food and drink; services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants; restaurant and take away restaurant services.</i></p>
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75. As you can see from the table above, the opponent has directed the opposition against different services, and based on different services, depending on the mark relied upon. As I consider in this instance that the marks relied upon by the opponent all have their strengths, I do not find it appropriate to identify a best case scenario for the opponent, and I will conduct the services comparison considering the different services under all three of the earlier marks.

Contested services in Class 38: Telecommunications; transmission of consumer generated reviews for restaurants and take away restaurants online; provision of on-line forums and chat rooms.

Registration no. 2221802 (EBAY)


The services relied upon by the opponent in class 38 in respect of this mark are those as limited by the proof of use assessment within this decision. However, the applicant has the broad services *Telecommunications*, which encompass the opponent's services namely *the provision of online communication services and platforms for use with e-commerce*. The applicant's *provision of on-line forums and chat rooms* falls within the opponent's services for *the provision of online communication services and platforms for use with e-commerce*. The applicant's aforementioned services are therefore identical to the opponent's services in class 38 under *Meric*.

76. The applicant's *transmission of consumer generated reviews for restaurants and take away restaurants online* share a similar nature and intended purpose opponent's services *electronic transmission of data and information in relation to e-commerce*, being that both are for the transmission of data and information electronically. In addition, e-commerce will cover the sale of food and drink online, and so there is a potential for these services to be providing the transmission of data and information, including reviews, in relation to food and beverages. I also find it likely that the same parties would offer data transmission services in relation to different areas. I find these services similar to a high degree.

Registration no. 17978982 (BAY)

77. The opponent relies upon the services *Telecommunications services, namely, the electronic transmission of data and information*; in respect of this mark. These services are identical within the meaning of *Meric* to the applicant's *Telecommunications* and *transmission of consumer generated reviews for restaurants and take away restaurants online*. In addition, the opponent covers the class 38 services *providing an online, interactive bulletin board for the transmission of messages among computer users concerning hobbies, collectibles, trading, and the sale of goods and services via a global computer network* under this mark, which are identical to the applicant's *provision of on-line forums and chat rooms*. If I am wrong about the identity of these services,

I still find these identical to the opponent's *telecommunications services, namely, the electronic transmission of data and information* also under this mark.

Registration no. 11576865 ()

78. The opponent relies upon the services *telecommunications* as well as *telecommunications services, namely, the electronic transmission of data and information*; under this mark. *Telecommunications* under the opponent's mark are evidently identical to telecommunications in the applicant's mark. Further, *telecommunications services, namely, the electronic transmission of data and information*; clearly encompass the services *transmission of consumer generated reviews for restaurants and take away restaurants online* under the applicant's mark. Again, it is my view that *providing an online, interactive bulletin board for the transmission of messages among computer users concerning hobbies, collectibles, trading, and the sale of goods and services via a global computer network* is identical to the applicant's *provision of on-line forums and chat rooms*, and if I am wrong about the identity of these services, I still find these identical to the opponent's *telecommunications services, namely, the electronic transmission of data and information* also under this mark.

Contested services in Class 35: Advertising; business management; business administration; office functions; advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet; restaurant and take away restaurant directory and search services; conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics; advertising services for restaurants and take away restaurants via the internet; consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; order procurement services for restaurants and take away restaurants; market research services for restaurants and takeaway restaurants.

Relying on Registration no. 1029198 (EBAY)

79. The opponent has protection for *advertising services* in class 35 under this mark. These are clearly identical to the applicant's *advertising* as well as identical under *Meric* to *advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet and advertising services for restaurants and take away restaurants via the internet*. Further, I find the applicant's *restaurant and take away restaurant directory and search services* will consist of listing advertisements for the consumers perusal and is therefore a form of advertising and identical under *Meric*. If I am wrong in this respect, I find these to be highly similar to advertising, with the intended purpose being to increase exposure and generate custom for businesses, as well as to create a convenient place for consumers to view their options for engaging with the services. Further, I find these searches will be aimed at the same businesses as advertising, as well as the general public, and it is my view they will often be offered by the same entities as those offering various advertising services.

80. The applicant's *business administration* is evidently identical to the opponent's earlier *business information and administration services*. I find that the applicant's services *office functions*, will likely be offered to the same consumer, via the same trade channels, and from the same entities as the opponent's *business [...] administration services*, and there is an overlap in the broader intended purpose, that being for assisting with the logistics of running a business for the purpose of improving its performance. I find the applicant's *office functions* to be highly similar to business administration services protected under the opponent's mark above.

81. It is my view that the applicant's *order procurement services for restaurants and take away restaurants* will fall within the meaning of the opponent's *business [...] administration services* and are therefore identical within the meaning of *Meric*. If I am wrong about identity of these services, I find that order procurement services share the same broad purpose as business

administration, in that they are again both for the purpose of assisting with the logistics of running a business for the purpose of improving its performance, and I also find that order procurement services and business administration services will be offered by the same entities, and will share intended consumers. If they are not identical, I find them to be highly similar.

82. It is my view that the applicant's services *conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics; consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; market research services for restaurants and takeaway restaurants* fall within the meaning of *business information [...] services* covered by the opponent, and are therefore identical within the meaning of *Meric*.

83. I find the applicant's *business management* and the opponent's *business information and administration services* to be similar in nature and intended purpose, as both are external services offered to businesses for the purpose of increasing or maintaining success will be the same. However, whilst on the one hand the business management services will involve the managing of a business for others, business information services will provide information and advice on business management so that businesses may improve this internally, and business administration services may assist with the running of everyday individual tasks for that business. I find it likely the services will likely be offered by the same trade channels specialising in business services and will be aimed at the same business consumers. As the services will all be for the purpose of improving the management of a business or increasing the performance of the business, I find it likely there will be an element of competition between the same. Overall, I find the services to be similar to at least a medium degree.


Relying on Registration no. 17978982 (BAY)

84. The opponent also bases its opposition against the applicant's class 35 services on services covered by the above mark. Again, advertising services under this mark will be identical to the applicant's *advertising*, and it will be identical within the meaning of *Meric* to the applicant's *advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet and advertising services for restaurants and take away restaurants via the internet*. Again, the applicant's *restaurant and take away restaurant directory and search services* are identical under *Meric* or are at least highly similar to the opponent's advertising.
85. It is my view that the applicant's *business management* services are similar to the opponent's *providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith*. Whilst the applicant's services for business management will involve the running of a business for others, the provision of evaluative feedback to businesses on their output will assist businesses with their own internal management. Both sets of services will be broadly for the same intended purpose of improving the businesses performance. In addition, the services will both be aimed at business consumers, and it is my view they will likely be offered by the same entities. There may be an element of competition between the offering of evaluative feedback to businesses to help them improve their own management, and the offering of the management services themselves. Overall, I find these services to be similar to a medium degree.
86. Whilst I acknowledge that the applicant's *order procurement services for restaurants and take away restaurants* may share a broadly similar intended purpose with the opponent's *online trading services, namely, operating online marketplaces for sellers and buyers of goods and services* under this mark in that they may both be for the purpose of assisting third parties with securing

orders, I find the services are of a different nature, and will likely be offered by different entities. I find these services similar only to a low degree at best.

87. I find the applicant's *consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics and market research services for restaurants and takeaway restaurants* to be complementary to the opponent's services *providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith* as the collation of the consumer and industry information will be at least important to the provision of the same, and I find the consumer will likely believe the collation and provision of such will be offered by the same entities. These services will have the same ultimate intended purpose, for improving the success of a business, and they will both be aimed at the same business consumers. I find these services to be highly similar.

88. I find the applicant's *business administration and office functions* to both be for the purpose of assisting with the logistical running of a business. Whilst I note that these services may have a very broadly similar intended purpose to the opponent's services in class 35, in that the running of an online marketplace will also assist businesses, as well as a very general cross over with the intended user, I do not find this sufficient to render these services similar to those relied upon by the opponent under this mark.

Relying on Registration no. 11576865 ()


89. Again, there is identity between the opponent's advertising and advertisement services and the applicant's *advertising; advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet; advertising services for restaurants and take away restaurants via the internet* under this mark. The applicant's *restaurant and take away restaurant directory*

and search services will be identical or at least highly similar to advertising. The applicant's *business management; business administration; office functions;* are all included identically within the opponent's specification under this mark, and again business administration services will include the applicant's *order procurement services for restaurants and take away restaurants,* or at least be highly similar to the same.

90. I find the applicant's services *consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics and market research services for restaurants and takeaway restaurants* to be highly similar to the opponent's *providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith* for the reasons previously outlined.

Contested services in Class 39: provision of the delivery of takeaway, restaurant and restaurant meals via a website.

91. It is my view that the above services are, at their core, food delivery services which may be obtained via a website. I note the opponent covers *online trading services and online trading services namely, operating online marketplaces for sellers and buyers of goods and services* under its marks in class 35, and these may include online marketplaces in relation to the trading of food. In addition, I note that food delivery may be offered as a service separate to the provision of food and drink. However, it is my view that the provision of a delivery service for meals, even one available via online booking, is fundamentally different to the offering of a platform for buying and selling services online, under which food products are sold. I find the nature and the intended purpose of the services to differ, and I do not find them to be complimentary or in competition. I find it unlikely the channels of trade would be shared, and whilst there may be a common user, this will only be at a very

general level. For these reasons, I do not find these services to be similar to those relied upon under Registration no. 1029198 (EBAY), Registration no. 17978982 (BAY) or Registration no. 11576865 ().

Contested services in Class 39: food delivery services;


Relying on Registration no. 18011767 (EBAY)

92. Whilst I note payment services as covered by the opponent's mark above may be used when obtaining food delivery services, I find this may be applied in respect of any goods or services, and I do not find this alone sufficient for a finding of similarity with the applicant's *food delivery services*. I do not find that the consumer would expect these to be provided by the same entity. Further, I find the nature, intended purpose, method of use and trade channels will differ. I find the services relied upon by the opponent under this mark to be dissimilar to the applicant's services above.

Relying on Registration no.17978982 (BAY) and Registration no.11576865 ()

93. For the reasons given in respect of the applicant's *provision of the delivery of takeaway, restaurant and restaurant meals via a website*, I do not find these services to be similar to services relied on by the opponent under the above marks.

Contested services in Class 39: Transport; packaging and storage of goods; travel arrangement;

Relying on Registration no. 17978982 (BAY) and Registration no. 11576865 ()
)

94. I find the applicant's services *travel arrangement* to be services for arranging travel for people. Whilst I note the opponent's services covers the provision of online marketplaces for buying and selling services, it is my view that the provision of an online market place under which one may purchase services in relation to travel is different in nature and intended purpose to the arrangement of the travel itself. One is the provision of a platform as a service so that others may engage in the buying and selling of services, and the other is offering as a service to take over the burden of the logistical arrangement of travel from the consumer. Whilst both may have consumers amongst the general public as well as business consumers, I do not find this sufficient for a finding of similarity between the same. In addition, I do not find these are likely to be offered through the same trade channels, and I do not find there will be competition between them. I find these services to be dissimilar to the opponent's services.


95. Whilst I note the evidence regarding the opponent offering various postal services under its mark, I find the applicant's *packaging and storage of goods* as a service to be dissimilar to the opponent's online trading services as registered. I note from the opponent's evidence that in some instances the provider of online trading services may also offer the packaging and storage of goods as an additional service, but I do not find the consumer would view this as the norm, and I do not find the possibility of an overlap in trade channels to be sufficient for a finding of similarity between these services and those of the opponent. Further, I do not find transport to be similar to the opponent's services. Whilst again, I note that transport may be used to move goods from place to place following the sale of those goods from an online marketplace, I do not find this sufficient for a finding of similarity between these services.

96. Overall, I find these services to be dissimilar to those covered by the above marks relied upon by the opponent.

Contested services in Class 43: Services for providing food and drink; services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants; restaurant and take away restaurant services.

Relying on Registration no. 18011767 (EBAY)

97. The above mark relied upon by the opponent covers electronic payment services and electronic payment software services. Whilst I note that as with other services, electronic payment services may be used for making payment for the contested services, I find this to be true for a huge range of goods and services, due to the nature of electronic payment services and software services. I do not find that the consumer will view these as generally coming from the same undertaking. Overall, I find the applicant's services to be dissimilar to the opponent's services under this mark.

Relying on Registration no. 17978982 (BAY) and Registration no. 11576865 ())

98. I find the applicant's services *Services for providing food and drink* as well as *restaurant and take away restaurant services* to be dissimilar to the opponent's earlier services relied upon under the above marks. I note the opponent has provided evidence that the trading of food is undertaken via its online marketplace services. However, it is my view that providing an online platform under which others may sell prepackaged food items is not similar to the actual provision of food and drink itself. The nature of online market place services is clearly different to those for providing food and drink, and I do not find it would be the case that the trade channels through which these services are offered would be shared, nor do I find they will be in competition or complementary. I find these services to be dissimilar to those relied upon by the opponent.

99. I have considered the applicant's *services for providing food and drink enabling customers to place orders for food and drink online*. I find these to primarily concern the provision of food and drink which may be ordered online, rather than the provision of an online platform under which other businesses will list food and drink offerings. Although these services allow the consumer to order online, I do not find they are akin to online trading services or searchable database services covered by the opponent in class 35. Overall, I find these services to be dissimilar to those relied upon by the opponent.

100. The applicant covers the services *ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants*. I find the meaning of these services must be construed slightly differently to the provision of food and drink services above. It appears to me that these services will involve taking an order or booking from a customer and placing that order or booking with a restaurant on behalf of the customer, in this instance, both via a website and generally.

101. In respect of both of these types of service, it is my view that they may be offered by third parties that are not responsible for the provision of the food and drink themselves. I find these services to share at a very general level some similarity in nature and intended purpose to the opponents *on-line trading services, namely, operating online marketplaces for sellers and buyers of goods and services* as relied upon by the opponent in class 35, with both being middleman services of sorts, between the end customer and the provider of the goods or services. However, at a less general level the applicant's services for arranging restaurant orders and bookings clearly differ to the operating of an online marketplace services through which orders may be placed by others. It is possible these services may share trade channels, but this is not obvious, and I am unable to reach this conclusion without evidence on this point.

102. Overall, I find the applicant's services *ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants* to be dissimilar to those covered by the opponent under these marks.

Relying on Registration no. 1029198 (EBAY)

103. The opponent relies upon the above mark to oppose a part of the applicant's class 43 services, namely *services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website*. This earlier mark includes *online trading services* broadly. I note it would be possible to interpret these services as covering a huge range of services for trading goods and services online. However, considering the guidance from Lord Justice Arnold in *Skykick*, I note broad services should be interpreted narrowly and confined to their core meaning. It is my view the core meaning of these services within the context of class 35 is the provision of services which allow others to trade goods and services online. For the reasons as set out previously, I find; *services for providing food and drink enabling customers to place orders for food and drink online*; dissimilar to the opponent's services, and for the reasons given in relation to the provision of online market places, I find *ordering of takeaway restaurant and restaurant meals via a website* to be dissimilar to the opponents *online trading services*.

104. For clarity, I have set out my findings in relation to each of the opponent's marks in the table at Annex A to this decision.

Comparison of marks


105. 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 Court of Justice of the European Union (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.”

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


107. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
EBAY BAY eBay	

108. The first of the earlier marks comprises the single word EBAY. I find the full mark contributes to its overall impression. Where services covered by the mark relate to electronic or online services, or services for ‘e-commerce’, it is my view that a portion of consumers will find the ‘e’ to be at least allusive of those services, and will on that basis find the suffix BAY plays a greater role in

the mark as a whole. However, I find there will be a further portion of consumers that will not register the 'e' as allusive. These consumers will view the mark as a made-up word with no relation to the services and will therefore not place a greater emphasis on 'bay' alone.

109. In respect of the second mark BAY, the overall impression of the mark resides in the combination of the three letters creating the mark BAY. The overall impression therefore lies in the mark as a whole.


110. The final earlier mark, namely , comprises the word ebay, with each of the letters displayed in a different colour, namely red, blue, yellow and green. The word ebay plays the greatest role in the overall impression of the mark, followed by the use of colour. I find the font, and the use of lowercase lettering are both fairly unremarkable, and these elements play a significantly lesser role in the overall impression. Again, there will be a group of consumers that will place a greater emphasis on the 'bay' portion of the mark due to the allusive nature of the 'e', but there will be a further group of consumers that will not register this meaning, and will not find 'bay' will play a role that is distinct from or of greater importance than the letter 'e'. In both instances, the mark as a whole contributes to its overall impression on the consumer.

111. The contested mark comprises the two English words EAT and BAY, set together to make a single word EatBay. Although the words are set together, I find the consumer will recognise these as two words, which is assisted by, but not reliant upon the capitalisation of the letters 'E' and 'B'. However, I do not find the consumer will entirely disregard that the applicant is using the two words set together as one. Particularly where the services relate to food, the word EAT will play a lesser role than BAY in the marks' overall impression. The use of one word split into two colours is fairly notable, although arguably less so due to the colour change occurring at the natural ending of what will be perceived as one of the two words forming the whole.

Nonetheless, the use of colour in this way will not be ignored by the consumer and contributes towards the overall impression of the mark as a whole.

112. Where multiple marks are relied upon within opposition proceedings, it can be appropriate to focus the comparison on the opponent's best case from these marks. However, in this instance I find that each of the marks have elements that may assist the opponent's case, and the opponent has not relied upon the same services under each of the marks. I therefore find it appropriate to consider the similarity of each earlier mark to the contested mark in this instance.

Visual comparison

113. The mark EBAY and the contested mark  both begin with the letter 'E' and end with the identical word 'BAY'. They differ by the letters 'at' in the middle of the contested mark. The contested mark is visually longer than the earlier mark, consisting of 6 letters, whereas the earlier mark only contains 4. The addition of two extra letters is more noticeable due to the earlier mark being relatively short. The earlier mark is filed as a word mark, meaning it may be used in a variety of fonts and colours, including both red and green. However, I find that changing the colour half way through a mark would seem to fall outside of the fair and notional use of that mark, meaning this creates an additional point of visual difference between the marks. Overall, considering the similarities and the differences between the marks, I find them visually similar to between a medium and high degree.

114. The earlier mark  also shares the 'e' and the word 'bay' with the contested mark, albeit stylised differently. The earlier mark uses all lowercase lettering, and the contested mark uses a combination of the two. Again, the length of the marks differs, and the contested mark includes the additional letters 'at' following the 'e'. The use of colour in both marks is fairly unusual, and whilst the combinations differ, both marks start in a similar shade of red, and end in a similar shade of green, and vary colours throughout the marks.

Considering the points of visual similarity as well as the visual differences, I find the marks visually similar to between a medium and high degree.

115. The final earlier mark BAY is considerably shorter than the contested mark, being only three letters in length, although it is included within the contested mark in its entirety. The differences are found at the beginning of the contested mark, where they make more visual impact. The additional use of colour in the later mark, which I found to be outside the scope of notional and fair use, also helps to create a point of visual difference, although I acknowledge the opponent could make use of the mark BAY in a similar stylisation and using the colour green, which would render the second element of the contested mark visually highly similar to the earlier mark. Overall, I find the earlier mark BAY to be visually similar to the contested mark to between a low to medium degree.

Aural comparison

116. The first and third earlier marks are aurally identical, and it is my view that they will be pronounced by the consumer as eee-bay. I find the contested mark will be pronounced as the two recognisable words 'eat' and 'bay'. Both marks will be split into two syllables. The 'eee' sound in the first syllable of the earlier mark is similar to the 'eet' sound made in the contested mark. Both will end with the identical 'bay' sound. I find the first and third earlier marks aurally similar to the contested mark to a high degree.

117. The second earlier mark consists of a single syllable, namely the word 'BAY'. This is aurally identical to the second syllable of the contested mark, but the marks differ through the use of the first syllable EAT in the contested mark. Overall, I find the second earlier mark to be aurally similar to the contested mark to a medium degree.

Conceptual comparison

118. The second earlier mark consists of the word BAY only. This conveys the concept of an area of coast where the land meets the sea, or alternatively, the concept of an assigned space for temporary use by a vehicle, such as a parking bay or a loading bay. For some, this may conjure the concept of a bay as a type of tree.

119. For some consumers, the 'e' within the first and third of the earlier marks will indicate that the opponent's services are related to e-commerce, or alternatively simply that they are electronic or online services. Where the 'e' is identified as having this meaning, the BAY element will be viewed as distinct from the 'e' conceptually and will also convey the concept of a bay as outlined above. However, I recognise that for some consumers, the meaning of 'e' will not be construed in this way, and the word EBAY will be viewed as a made-up word with no identifiable concept.

120. The contested mark is made up of two English words, each with distinct concepts of their own. The word 'eat' will be understood by the consumer as referring to the process of consuming food, and 'bay' will be understood as described above. The opponent makes the following comments within its submissions:

"Irrespective of the services for which the Applicant's Mark is used, consumers will immediately understand that those services are for or in some way connected to eating, food and/or restaurants. Consumers will immediately know that the purpose of the word "eat" is to describe the subject of the services being offered. Conversely, the BAY element has no meaning in relation to any of the services at issue and is distinctive. The BAY element is therefore the dominant and most distinctive element of the sign EATBAY."

121. Whilst the above comments concern the distinctiveness of each element of the contested mark, I note the comments are also relevant in

respect of the marks concept. I agree with the opponent to an extent, and I find the consumer may construe from the element 'eat' that the services covered by the mark relate, to varying extents, to eating or to food.

122. I do not find an alternative meaning is construed by the use of the words EAT and BAY together, and I find these will continue to convey the meaning of consuming food and services relating to such, and an area of land adjacent to the water, or an area set aside for the temporary use of vehicles, or a type of tree. For some, this may connote a bay where food services are provided.

123. Overall, I find the earlier mark 'BAY' to be conceptually similar to the contested mark to a medium degree, on the basis that the identical concept of a 'bay' is present in both marks and it is only concept in the earlier mark. Where the consumer identifies the element 'BAY' as having a meaning in the earlier 'ebay' marks, I find the marks to be conceptually similar to between a low to medium degree to the contested mark, as although the concept of 'bay' is recreated identically, the different concepts of electronic or online services or e-commerce vs food and eating will both create different concepts in the consumers mind. Where 'ebay' is not assigned a conceptual meaning by the consumer, I find the marks are conceptually dissimilar.

Average consumer and the purchasing act

124. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

125. 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.”

126. Before deciding on the likelihood of confusion, I must first identify the relevant consumer of the services. In this instance, I find the average consumer and their degree of attention will vary between the services offered under the marks.

127. In respect of the class 35 services, particularly those such as the advertising, market research and business services, these will be aimed at the professional consumer. Where these services are defined in respect of restaurants or food establishments, it is clear these will be aimed at professionals either owning, running, or employed by these establishments. Generally, the professional consumer will pay a higher degree of attention when engaging these types of services, due to the increased importance on choosing the right services for the business. Engaging advertising services, business services and market research services may have a direct result on the success of the business, and it is my view that the professional consumer will pay an above average degree of attention in respect of the same. Some class 35 services, such as the directory and search services will also be offered to the general public. It is my view that the general public will pay no more than an average degree of attention in respect of these services. Although they may wish to ensure that the services are provided impartially and that they can trust the listings, a large portion of their attention may be given to the restaurant itself rather than the directory provider.

128. Again, the class 38 services including the telecommunication services, the transmission of reviews, and the provision of on-line forums may be engaged by both professional consumers and the general public. For the reasons given above, it is my view that the professional consumer will pay above average level of attention when engaging these services. In respect of the general public, it is my view that they will also pay an above average degree of attention when engaging many types of telecommunication services, as these are often offered on a long-term contract and will play an important role in the running of the consumers everyday life. However, this will not be the case for the full category of services, and there will be some services for which the attention level paid is no more than average. When it comes to the provision of online forums, and the transmission of data, the general public will likely pay an average level of attention, in order to ensure that the services they are engaging with are safe, and their information and data remains secure.

129. It is my view the services will primarily be engaged with visually, generally via websites offering the services. However, I note that verbal recommendations may also play a role, with both professionals recommending services to other professionals, as well as the general public recommending services to others, and so I cannot completely disregard the aural comparison.

Distinctive character of the earlier trade mark

130. 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).”

131. The earlier mark ‘BAY’ comprises of a single, three letter word, that will be easily understood by the consumer as referring to a section of land where the water meets the sea, or alternatively, as a temporary space for parking a vehicle, or a type of tree. This mark is neither allusive nor descriptive of the services for which it is registered, and it is my view that it holds an average degree of inherent distinctive character.


132. The opponent submits that the earlier marks hold a high degree of inherent distinctive character, on the basis that ‘EBAY’ is “entirely fanciful” in relation to the services.

133. For consumers that do not identify the ‘e’ in the earlier mark EBAY as alluding to the services, I found this mark will be viewed as a made-up word with no meaning. To these consumers, the mark will appear to hold an inherently high level of distinctive character. For consumers who view EBAY as containing the two elements, ‘e’ and ‘bay’, rather than as a single, entirely made up word with no meaning, the initial letter ‘e’ will be viewed as a reference to e-commerce, or at least electronic or online services, and so this

element ranges from descriptive to allusive of the services listed under the mark, rendering it of limited distinctiveness. The 'bay' element will appear as an English word which is neither allusive nor descriptive of the services. Despite the allusive or descriptive nature of 'e', the combination of this element with the mark non-allusive/descriptive 'bay' element adds to the inherent distinctiveness as a whole, and I find it to be inherently distinctive to an above average degree to these consumers.

134. I find the use of a different colour for each letter in the mark  adds again to its inherent distinctive character, and I find this mark to be inherently distinctive to a high degree.

135. I find no evidence that the mark BAY has been used by the opponent, and so its inherent distinctive character has not been enhanced through use.

136. On the contrary, extensive use of the marks  and EBAY has been evidenced. Although the stylised mark is perhaps used more prominently by the opponent, the word mark EBAY is also often used and referred to interchangeably. The intensity of the use is evidenced via the website traffic and user figures in the UK, and the evidence shows extensive press coverage and use of the mark EBAY spanning over 20 years. It is clear that the opponent holds a significant share of the market for the provision of its core services, particularly the provision of online marketplace services, in the UK. This all plays a part in increasing the marks distinctive character in respect of its online marketplace services in class 35, and those services associated with the same in class 35, class 38 and class 42. It is my view the distinctive character of the marks has been enhanced to a high degree in all circumstances in respect of the following services relied upon under each mark:



Class 35: On-line trading services, namely, operating on-line marketplaces for sellers and buyers of goods and services; online

trading services in which sellers post products or services to be offered for sale and purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith; advertising

Class 38: providing an online, interactive bulletin board for the transmission of messages among computer users concerning hobbies, collectibles, trading, and the sale of goods and services via a global computer network.

Class 42: providing temporary use of online, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network;

EBAY

Class 35: advertising; on-line trading services

Class 38: The provision of online communication services and platforms for use with e-commerce; electronic transmission of data and information in relation to e-commerce

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

137. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 66 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held in the earlier marks will have an impact on the likelihood of confusion. I must consider that the likelihood of confusion may be increased where the distinctive character held in the earlier mark is high and may be less likely where it is low. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be enhanced through use, and that the distinctiveness of the common elements is key.³⁵ I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods or services are obtained will have a bearing on how likely the average consumer is to be confused.

138. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.³⁶

139. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient

³⁵ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.



³⁶ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10



that a mark merely calls to mind another mark. This is mere association not indirect confusion.


140. In order for success under section 5(2)(b), some similarity between the services is essential. For this reason, where no similarity has been found between the services relied upon under the earlier marks and those filed by the applicant, the opposition must fail under this ground. These services are as follows:

Class 39: Transport; packaging and storage of goods; travel arrangement; food delivery services; provision of the delivery of takeaway, restaurant and restaurant meals via a website.

Class 43: Services for providing food and drink; services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants; restaurant and take away restaurant services.


141. In respect of the remaining services, covered by the applicant, I found these to be either identical to those covered by the opponent, or similar to varying degrees dependent on the services relied upon under each earlier mark. I found the earlier marks  and EBAY to be visually similar to the contested mark to between a medium and high degree, and I found the mark BAY to be visually similar to the contested mark to between a low and medium degree. I found EBAY and  to be aurally similar to the earlier mark to a high degree, and BAY to be aurally similar to a medium degree. I found the earlier mark BAY to be conceptually similar to the contested mark to a medium degree, and 'ebay' to be conceptually similar to either a low to medium degree, or conceptually dissimilar, depending on the consumer's perception of the mark.

142. I found the earlier mark BAY to hold an average degree of inherent distinctive character, and I found the earlier mark EBAY to hold either an above average or high degree of inherent distinctive character depending on the consumer's perception of the mark. I found  to hold a high degree of distinctive character. I found that in respect of the services listed falling within classes 35, 38 and 42 that the distinctive character in the earlier marks  and EBAY had been enhanced through use in the UK to a high degree in all circumstances, but that the distinctiveness of BAY alone had not been enhanced. I found that the average consumer will vary dependent on the services covered under the marks, and may consist of the general public, professionals, or both. I also found the degree of attention paid will also vary dependent on the consumer and the services, ranging from average to above average. I found that the services will generally be engaged with visually, but that verbal recommendations may also play a part in the decision-making process, and so verbal considerations cannot be ignored.

143. I have considered whether the culmination of the above factors will result in a likelihood of direct confusion. I have considered that, where the services are identical, it is the case that there may be less similarity between the marks in order for a likelihood of consumer confusion to be found. Further, I note that the earlier marks EBAY and  both hold a high degree of distinctive character. However, even with consideration to these factors, it is my view that the differences between the marks are such that they will be noticed by the consumer, even when they are paying only an average degree of attention towards the services themselves. I find that, whilst the meaning of EAT may be descriptive or allusive of the services covered under the contested mark, it will still be remembered by the consumer as the first element of the same, and its conceptual meaning will help this to stick in the consumers mind and differentiate it from the earlier marks. In addition, I find the combination of the visual and aural differences are such that the consumer will not confuse one of the earlier marks for the contested mark or vice versa. I therefore find no likelihood of direct confusion.

144. In respect of indirect confusion, I note that the element 'BAY' is present in all three of the marks relied upon by the opponent, as well as in the contested mark. In respect of one of the earlier marks, BAY comprises the whole mark, and I remind myself at this stage that I found the earlier mark BAY to hold a medium level of distinctive character. I consider whether I find the use of BAY in the contested mark would lead the consumer to believe that it originates from the same economic undertaking as the marks upon which the opponent has relied.

145. I note my finding that, for at least a portion of consumers, the element 'e' in the earlier marks will indicate a relationship to 'e-commerce', or to online or electronic services, and that EAT will indicate the applicant's services are concerned in some way with food. For some of the similar and identical services this connection will be direct, and for some it will be more tenuous. In addition, I remind myself that there will be a portion of consumers that will not assign a descriptive or allusive meaning to the letter 'E' in the earlier marks.

146. I have found identity and/or high similarity between the applicant's services in class 38 and services covered under the opponent's earlier marks. I remind myself that mere association is not sufficient for indirect confusion, and I find that for a portion of consumers, particularly those to whom 'ebay' appears to be an entirely made up word with no meaning, this will be where the connection between the marks ends. However, with consideration of all of the factors above, it is my view in respect of the mark BAY, which may be used in a similar colour and stylisation to the applicant's BAY element, a significant portion of consumers may easily assume that the addition of EAT indicates a sub brand of the offering under the mark, which is related in some way to food in particular. In addition, I also find this will be the case in respect of the mark EBAY and , for those consumers to whom the letter 'e' will be viewed as allusive or descriptive of the services covered by class 38. This is helped by the use of 'EAT' rather than 'E' appearing to be a playful choice for a sub brand, as well as the use of the red and green in both the colour marks. Overall, I find a likelihood of indirect confusion with all three earlier

marks, in respect of at least a portion of consumers in respect of all the applicant's services in class 38.

147. In respect of the services under class 35, again I have found identity between many of the services, although I have also found varying levels of similarity in respect of some of the services filed. With consideration to all of the factors, I find in respect of all of the identical and highly similar services, as well as in respect of those services I have found to be similar to a medium degree, the same outcome will apply as did to class 38, and there will be a likelihood of indirect confusion in respect of these services.

148. The opposition in respect of section 5(2)(b) therefore succeeds in respect of the following services:

Class 35: Advertising; business management; business administration; office functions; advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet; restaurant and take away restaurant directory and search services; conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics; advertising services for restaurants and take away restaurants via the internet; consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; order procurement services for restaurants and take away restaurants; market research services for restaurants and takeaway restaurants.

Class 38: Telecommunications; transmission of consumer generated reviews for restaurants and take away restaurants online; provision of on-line forums and chat rooms.

149. The opposition under section 5(2)(b) fails in respect of the following services:

Class 39: Transport; packaging and storage of goods; travel arrangement; food delivery services; provision of the delivery of takeaway, restaurant and restaurant meals via a website.

Class 43: Services for providing food and drink; services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants; restaurant and take away restaurant services.

Section 5(3)

Legislation

150. 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 (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.

151. 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.”

Case Law

152. 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, *Addidas-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*).


153. An opposition under section 5(3) of the Act can only be successful via the establishment of several individual factors, the culmination of which must satisfy all elements of the claim. To be successful on this ground, firstly the opponent must establish that the marks are similar. Should this be shown, the opponent must go on to prove that they hold a reputation for the earlier mark(s) in respect of a significant part of the public. If it is found both that the marks are similar, and that the earlier mark(s) hold(s) a qualifying reputation, it must then be shown that the result of this reputation, combined with the similarity between the earlier mark(s) and the applied for mark will result in the public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark(s) to mind. Importantly, if all three of these elements have been established, it must then be shown that the result of the link made by the public will manifest in one of the pleaded types of damage. In this instance, the opponent has pleaded that the application will take unfair advantage of the investment made in respect of the earlier mark, and cause detriment to the distinctive character of the same.

154. The relevant date for establishing if the opponent held a reputation in the marks relied upon is the filing date of the contested application, namely 5 August 2019, and the marks upon which the opponent relies as set out in the table below:

Mark	Territory	Registration date	Registration no	Services relied upon	Services opposed
	EU	20/08/2013	11576865	Class 35: Advertising; business management; business administration; office functions; On-line trading services, namely, operating on-line marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale and purchasing or bidding is done via the Internet in order to	All services

				facilitate the sale of goods and services by others via a computer network; providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith; providing a searchable online advertising guide featuring the goods and services of online vendors; providing a searchable online evaluation database for buyers and sellers; advertising and advertisement services.	
EBAY	EU	22/06/2000	1029198	Class 35: Advertising services; business information and administration services; on-line trading services.	All services

Similarity of the marks

155. As set out under section 5(2)(b) of this decision, I have found a medium to high level of visual similarity and a high level of aural similarity between the marks EBAY and , and the contested mark. I found the marks to be conceptually similar to between a low to medium degree for a portion of consumers, and dissimilar to a further portion of consumers.

Reputation

156. For the reasons set out in the Preliminary Issues section of this decision, I do not find the applicant has conceded to the opponent holding a

vast reputation. I have therefore considered if I find a reputation to be held by the opponent in the EU as claimed.

157. The courts have provided guidance on the factors to consider when assessing if a reputation has been established for a trade mark. 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.”

158. It is clear from the evidence provided that the opponent’s core services for which the majority of the use of the marks has been made are its *on-line trading services*, including its *on-line trading services, namely, operating on-line marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale and*

purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; falling under this category. Further, I find the opponent's services providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith; providing a searchable online advertising guide featuring the goods and services of online vendors; and advertising services to have been used by the opponent and have been offered as part of, or are connected closely with the core services offered by the opponent under the mark.

159. The opponent has provided substantial evidence of its services offered within the UK, as well as evidence of its position as a global brand. The opponent has shown huge net revenue figures in the UK in excess of 1 billion US dollars a year between 2017 – 2019, and web traffic numbers of 4 billion a year from 2015 – 2018 for its UK site. Further, the opponent has provided a large number of press articles showing its increasing presence in the UK market dating back to 1999. The evidence shows the opponent's UK website using the mark placed as the 9th most visited website in the UK in 2019. It is clear from the sum of the evidence provided that the opponent's reputation in the UK is very large. Although the opposition under section 5(3) has been based on two earlier rights registered in the European Union, I note that the evidence of use in relation to the rest of the EU territory is limited. That said, Exhibit AL-01 does show that the combination of "net revenue and long-lived tangible assets" is higher in Germany than the UK in 2017, 2018 & 2019, with Germany and the UK placing second and third in the world after the US. It is clear to me that the reputation for the mark in Germany is also likely to be very large in respect of its core and related services. I find the UK and Germany equate to a substantial part of the territory.³⁷ Considering the evidence as a whole, I find the opponent to hold a very large reputation within

³⁷ See footnote 1, although the UK is no longer a part of the European Union, it continues to be a relevant part of the European Union for the purpose of these proceedings.

the European Union in respect the services outlined within paragraph 158 above.

Link

160. In order to determine if a link will be established between the marks, I must consider the position globally, taking into account all the factors as set out in the case law, including the degree of similarity between the marks and the services, the extent of the overlap between the relevant consumers, and the strength of the reputation and distinctiveness of the earlier marks.

161. Overall, I found the marks are similar to the extent set out above. I found the reputation for the earlier marks to be very large, including amongst the UK public. In respect of the services covered by the reputation of the earlier marks, I have found these range from identical to dissimilar to those for which the applicant has applied. Where the services are identical, I find the relevant consumers will obviously coincide. In respect of the services which are dissimilar, I find there still may be an overlap in relevant consumers, but this will usually only be at a general level, to the extent that the services may be offered to the general public and/or professional public. I found the earlier marks to hold a high degree of distinctive character in respect of the services outlined under 5(2)(b) of this decision, in part due to the extensive and longstanding use made of the same. I have found a likelihood of confusion exists between the marks where the services are identical or highly similar. I have found some of the class 39 and 43 services covered by the applicant to be dissimilar to those for which I have found the earlier marks to hold a reputation, but I remind myself that it is not a requirement for success under this ground for similarity to be found between the services, although it is one of the cumulative factors that will weigh into my decision.

162. I also note at this stage that where I have found the services in class 39 to be dissimilar to the opponent's services they often remain related to an extent, in that transport, packaging and storage of goods as well as online services for food delivery and food delivery per se may all be used in

connection with the opponent's provision of online marketplaces in which they hold a reputation. The evidence shows that the opponent itself does engage in services relating to the transport and packaging of goods. Although I do not find "travel arrangement" to be used in connection with the opponent's services in this way, I do find that the services for travel arrangement may be offered in conjunction with online searchable databases, and so whilst I find these to be dissimilar to the opponent's services they are not worlds apart.

163. I find this also to be true in respect of the class 43 services, and although they are dissimilar for the purposes of section 5(2)(b), I do not find services for providing food and drink to be extensively removed from the provision of online market place services under which food is sold, which is covered under the opponent's services for which it holds a reputation.

164. Having considered all of the factors, it is my view that with consideration to the very large reputation held amongst the relevant public in the UK, the high degree of distinctive character held by the earlier mark, and the similarities between the marks including the use of the identical element BAY and high level of aural similarity, the use of the contested mark would bring the earlier mark to mind in respect of all of the applied for services, even where the services have been found to be dissimilar.

Damage

165. The opponent has claimed that the use of the applicant's mark will cause detriment to the distinctive character of its mark, as well as take unfair advantage of the same. I will begin by considering the opponent's claim to detriment.

166. Within its statement of grounds, the opponent submits:

“5.3.3 The close similarity of the Application to the Opponent’s eBay Marks is such that use of the Applicant’s sign would lead to dispersion of the identity and hold upon the public mind of the Opponent’s eBay Marks since such use is likely to cause erosion, blurring, and/or dilution, with the result that the ability of the Opponent’s eBay Marks to identify the services provided thereunder as coming from the Opponent would be weakened.

5.3.4 There is a real risk that the manner in which the Applicant’s Sign will be used, along with the way it will conduct its activities in relation to Applicant’s Service (over which the Opponent will have no control) will damage the unique image of the Opponent in the provision of the services for which the Opponent’s eBay Mark are registered.”

167. It is well established that a claim of detriment to the distinctive character of a mark must be clearly made out, and although evidence of actual detriment is not necessarily required, I should not find for the opponent based on suppositions alone.³⁸ I consider that in order for detriment of distinctive character to be found, I must establish either that there has been a change in the consumers economic behaviour in respect of the earlier marks, or that there will very likely be one in future. It is my view that on the basis of the evidence filed and the submission made, there is no reason for me to find that the use of the applicant’s mark will result in the consumer changing their economic behaviour towards the opponent’s marks based on the supposed eroding or dilution of its distinctive character. I do not find that detriment to distinctive character has been established in this instance.

168. The opponent also claims the applicant will gain an unfair advantage in respect of the contested mark. The opponent submits the mark will, without

³⁸ See paragraph 43 of CJEU decision *Environmental Manufacturing LLP v OHIM*, Case C-383/12P

due cause, feed off the fame of the earlier eBay marks, ride on the coattails of the reputation held and freeride off the investment made by the opponent. From the evidence, including the press articles provided, it appears to me that the opponent's reputation is held in respect of safe and simple to use services under which nearly anything can be bought or sold, offering to the consumer a huge range of choice, and to the sellers, a huge number of potential consumers. I consider that I have found under Section 5(2)(b) that there will be a likelihood of indirect confusion between the marks where there is identity or a high or medium level of similarity between the services. This finding indicates that the contested mark will take unfair advantage of the earlier marks reputation where this arises. Where consumers assume the services come from the same undertaking as the opponent, I find the applicant will instantly benefit from the consumers assumption that services offered will be safe and simple to use, and where applicable, that they may offer the perks of a large customer base or a wide variety of choice.

169. I note that the transfer of safe and simple to use services will not necessarily be the most desirable attributes in respect of the services as filed. For example, this may be the case in respect of the applicant's provision of food and drink, where the consumer will be primarily concerned with other qualities. However, it is my view that in these instances, the applicant's mark would nonetheless benefit from the huge reputation held under the EBAY marks and the link between them, as significantly less investment would be required on behalf of the applicant to advertise its own marks at the outset, and that this is likely to continue as long as the opponent continues to invest heavily in the promotion of the earlier marks. It is my view that investment made by the opponent will make the use of the applicant's mark in respect of the services filed instantly more recognisable and memorable.

170. Although it is not necessary to find that the applicant intended to gain an unfair advantage when choosing its mark in order for the opponent to be

successful, it is nonetheless relevant.³⁹ Within its TM8 and counterstatement, the applicant submits:

“EatBay is a food ordering platform that is going to help restaurants get more sales and by listing their menu. Our model is 100% commission free to connect our clients with customers hence empowering all the restaurants to get on board on our platform. Our business model, mission or trademark of EatBay does not represent that of the eBay in sign, design, colour and/or expression.”

171. Whilst this statement from the applicant does not express an intention to take advantage of the reputation of the EBAY marks, it gives no explanation as to why the applicant would choose the mark EatBay for an online trading platform upon which restaurants list their services, when there is already a successful online trading platform operating in the UK used in relation to e-commerce under the EBAY marks. Considering the very large reputation held by EBAY marks in the UK, I find it implausible that the choice of mark for the UK market would be entirely coincidental. In addition, whilst not conclusive, I find the applicant’s choice to begin its mark using the colour red and end it using the colour green adds another element that is unlikely, with consideration to all of the factors of this case, to be a coincidence. In any event, even if it is not the applicant’s intention to gain an unfair advantage, I do not find the applicant has pleaded or established any due cause to use the mark.

172. As I have found that the use of the applicant’s mark would, without due cause, take unfair advantage of the opponent’s reputation in its earlier marks due to the link made by the consumers, the opposition will succeed under section 5(3).

³⁹ *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch)

Section 5(4)(a)

173. The final ground of opposition is under section 5(4)(a). Under this ground, the opponent has relied upon the word mark EBAY, which it pleads has been in use throughout the UK in respect of the services set out at paragraph 7 in this decision since March 1996. These services are set out again below for ease of reference:

Advertising; Business administration; online-trading services; operating on-line marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale and purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith; providing a searchable online database for buyers and sellers; Telecommunications.

174. I note that the witness statement of Patricia Svilik confirms that this is the date at which the opponent started registering users on its global site, and that users were not registered on the UK specific site until July 1999.

Legislation

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

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

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

(aa)

(b)

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

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

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

General principles of Section 5(4)(a)

177. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

56. In relation to deception, the court must assess whether “a *substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of

them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

178. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

179. Considering the substantial evidence of use provided by the opponent in relation to the extensive and longstanding use in the UK of the EBAY mark, I am satisfied that the opponent will hold goodwill in the mark in respect of at least a portion of the services for which use has been claimed, as follows:

Advertising; operating on-line marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale and purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; providing evaluative feedback and ratings of sellers' goods and services by others via a computer network; providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods and services, buyers' and sellers' performance, delivery, and overall trading experience in connection therewith; providing a searchable online advertising guide featuring the goods and services of online vendors; telecommunications, namely the provision of online communication services and platforms for use with e-commerce, electronic transmission of data and information in relation to e-commerce and providing an online, interactive bulletin board for the transmission of messages among computer users concerning hobbies, collectibles,

*trading, and the sale of goods and services via a global computer network;*⁴⁰

180. Under section 5(2)(b), I have found a likelihood of confusion with the earlier EBAY mark in respect of some of the services covered by the applicant. This included a likelihood of confusion based on some of the services for which I have found goodwill to be held by the opponent. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

181. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

182. Despite the doubt as to whether the relevant test for misrepresentation may produce a different result to that under 5(2)(b), I have nonetheless

⁴⁰ Limited from *telecommunications* as claimed.

considered if I find there will be misrepresentation amongst a substantial number of the opponent's consumers in respect of the services filed by the applicant. With consideration to all of the factors of the case, including the similarities of the marks, the shared distinctive element of BAY and the descriptive and/or allusive nature of the 'Eat' element of the contested mark and 'E' in the earlier mark to a portion of consumers, it is my view that there will be a misrepresentation amongst a substantial number of consumers in respect of the following services covered by the applicant:

Class 35: Advertising; advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet; restaurant and take away restaurant directory and search services; conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics; advertising services for restaurants and take away restaurants via the internet; consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; market research services for restaurants and takeaway restaurants; business management.

Class 38: Telecommunications; transmission of consumer generated reviews for restaurants and take away restaurants online; provision of on-line forums and chat rooms.

183. Although I find the consumer may bring the earlier marks to mind, I do not find there will be a misrepresentation that the following services covered by the applicant's mark derive from, or are connected to the undertaking responsible for the eBay mark, based on the claim under Section 5(4)(a):

Class 35: business administration; office functions; order procurement services for restaurants and take away restaurants.

Class 39: Transport; packaging and storage of goods; travel arrangement; food delivery services; provision of the delivery of takeaway, restaurant and restaurant meals via a website.

Class 43: Services for providing food and drink; services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants; restaurant and take away restaurant services.

184. Where there is no misrepresentation, the opposition under section 5(4)(a) must fail. Where there is a misrepresentation, I consider if damage will follow. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

185. Where the services covered by the applicant's mark are identical to those for which the opponent holds goodwill, there will be a risk of substitution. More prominently, I find there is a likelihood of damage to the

opponent's goodwill should consumers be dissatisfied with the services offered under the applicant's mark, where a misrepresentation has been found. I therefore find that the opposition under section 5(4)(a) succeeds in respect of those services set out in paragraph 181.

Final Remarks

186. As the opposition is successful in its entirety based upon section 5(3) of the Act, the partial success of the opponent under section 5(2)(b) and section 5(4) of the Act makes no material difference to the outcome of these proceedings. Subject to appeal, the application will be refused in its entirety.

COSTS

187. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £2150 as a contribution towards the cost of the proceedings. The sum is calculated as follows:


Official fee:	£200
Preparing and filing the opposition and considering the TM8 and counterstatement:	£500
Preparing and filing the evidence:	£1100
Preparing and filing written submissions:	£350

188. I therefore order EATBAY LTD to pay eBay Inc. the sum of £2150. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 23rd day of April 2021

**Rosie Le Breton
For the Registrar**

Annex A

Earlier mark	EBAY	BAY	
<p>Services opposed which are identical to those relied upon by the opponent</p>	<p><i>Class 35: Advertising; advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet and advertising services for restaurants and take away restaurants via the internet; restaurant and take away restaurant directory and search services; business administration; order procurement services for restaurants and take away restaurants;</i></p> <p><i>Class 38: Telecommunications; provision of on-line forums and chat rooms.</i></p> <p><i>Class 35: conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics; consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; market research services for restaurants and takeaway restaurants</i></p>	<p><i>Class 35: advertising; advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet and advertising services for restaurants and take away restaurants via the internet; restaurant and take away restaurant directory and search services;</i></p> <p><i>Class 38: Telecommunications; transmission of consumer generated reviews for restaurants and take away restaurants online; provision of on-line forums and chat rooms.</i></p>	<p><i>Class 35: Advertising; advertising services, namely listing restaurant and take away restaurant particulars and menus on the internet; advertising services for restaurants and take away restaurants via the internet restaurant and take away restaurant directory and search services business management; business administration; office functions; order procurement services for restaurants and take away restaurants;</i></p> <p><i>Class 38: Telecommunications; transmission of consumer generated reviews for restaurants and take away restaurants online; provision of on-line forums and chat rooms.</i></p>
<p>Services opposed which are highly similar to those relied upon by the opponent</p>	<p><i>Class 35: office functions;</i></p> <p><i>Class 38: transmission of consumer generated reviews for restaurants and take away restaurants online;</i></p>	<p><i>Class 35: consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics and market research services for restaurants and takeaway restaurants;</i></p>	<p><i>Class 35: consumer research, namely collection and collation of consumer generated reviews for restaurants and take away restaurants; conducting of restaurant and take away restaurant opinion polling; compilation of restaurant and take away restaurant industry statistics and market research services for restaurants and takeaway restaurants</i></p>

<p>Services opposed which are similar to those relied upon by the opponent to a medium degree.</p>	<p>Class 35: business management</p>	<p>Class 35: business management</p>	
<p>Services opposed which are similar to a low degree to those relied upon by the opponent</p>		<p>Class 35: order procurement services for restaurants and take away restaurants;</p>	
<p>Services opposed which are dissimilar to those relied upon by the opponent</p>	<p>Class 39: provision of the delivery of takeaway, restaurant and restaurant meals via a website; food delivery services;</p> <p>Class 43: Services for providing food and drink; services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants; restaurant and take away restaurant services.</p>	<p>Class 35: business administration office functions</p> <p>Class 39: Transport; packaging and storage of goods; travel arrangement; provision of the delivery of takeaway, restaurant and restaurant meals via a website; food delivery services;</p> <p>Class 43: Services for providing food and drink; services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants; restaurant and take away restaurant services.</p>	<p>Class 39: Transport; packaging and storage of goods; travel arrangement; provision of the delivery of takeaway, restaurant and restaurant meals via a website; food delivery services;</p> <p>Class 43: Services for providing food and drink; services for providing food and drink enabling customers to place orders for food and drink online; ordering of takeaway restaurant and restaurant meals via a website; ordering and booking services for restaurants and takeaway restaurants; restaurant and take away restaurant services.</p>