O/0004/25

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. UK00003757199, UK00003756606, UK00003757125 & UK00003757177 BY ORWO LIMITED TO REGISTER:

(SERIES OF TWO)

AND

ORWO

AND

AND

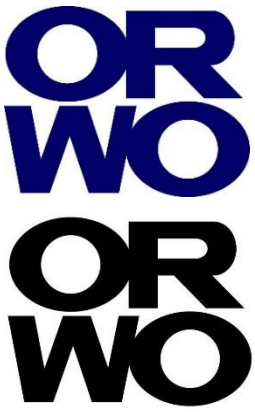
AS TRADE MARKS IN CLASSES 1, 9, 16, 39, 40, 41 & 42

AND

IN THE MATTER OF THE OPPOSITIONS THERETO UNDER NO. 435548, 435550, 435553 & 435600 BY ORWO NET GESELLSCHAFT MIT BESCHRÄNKTER HAFTUNG

BACKGROUND AND PLEADINGS

1. Orwo Limited ("the applicant") applied to register the following trade marks in the UK:



(Series of two)
UK registration no. 3757199
Filing date: 21 February 2022
Priority date: 18 February 2022 (USA)
("the first application");

ORWO
UK registration no. 3756606
Filing date: 18 February 2022
("the second application");

UK registration no. 3757125
Filing date: 21 February 2022
Priority date: 18 February 2022 (USA)
("the third application"); and

UK registration no. 3757177
Filing date: 21 February 2022
Priority date: 18 February 2022 (USA)
("the fourth application").

2. The applications were all published for opposition purposes on 13 May 2022. The applicant seeks to protect all of its applications for the same set of goods and services, being those in classes 1, 9, 16, 39, 40, 41 and 42. These are set out in **Annex 1** of this decision.

3. On 12 August 2022, ORWO Net Gesellschaft mit beschränkter Haftung ("the opponent") filed oppositions against the first, second and third applications. The opponent also opposed the fourth application on 15 August 2022.

4. The oppositions are brought in reliance upon sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 3(6) of the Trade Marks Act 1994 ("the Act"). I will summarise how these grounds apply to the relevant oppositions further below. As for the earlier marks relied upon under the section 5 grounds, I note that each opposition relies on all of the following marks:

ORWO
UK registration no. 902146967
Filing date 26 March 2001; registration date 19 August 2002
("the opponent's first mark");

OR WO
UK registration no. 902147379

Filing date 26 March 2001; registration date 27 August 2002
("the opponent's second mark");

UK registration no. 909788282
Filing date 21 February 2011; registration date 15 September 2011
("the opponent's third mark"); and

International Registration designating the UK under no. 1689075[1]
International registration date: 17 February 2022
Date designated for protection in the UK: 17 February 2022
Date protection granted in the UK: 28 March 2023
Priority date: 10 September 2021 (Germany)
("the opponent's fourth mark").

5. The opponent relies on all of the goods and services for which the above marks are registered and these are set out in **Annex 2** of this decision. It is noted that the opponent's first through third marks are all comparable marks based on earlier EUTMs owned by the opponent. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK

[1] In respect of this mark, I note that the owner is listed as ORWO Net GmbH. It is my understanding that 'GmbH' is the initialism of 'Gesellschaft mit beschränkter Haftung'. Therefore, I do not consider the difference in the names of the owners of these marks is of any issue and, clearly, they refer to the same legal entity. In addition, I note that the applicant has not taken issue with this point.

IPO created comparable UK trade marks for all right holders with existing EUTMs. The consequence of this was that the comparable marks created all enjoy the same filing and registration dates as their European counterparts.

6. As above, all of the opponent's marks are relied upon for the purpose of each opposition. However, the nature of the oppositions and the grounds upon which they rely are set out in the table below:

Opposition no.	**Application opposed**	**Grounds relied upon**
435548	The first application	s. 5(1), 5(2)(a), 5(2)(b), 5(3) and 3(6)
435550	The second application	s. 5(1), 5(2)(a), 5(2)(b), 5(3) and 3(6)
435553	The third application	s. 5(2)(b), 5(3) and 3(6)
435600	The fourth application	s. 5(2)(b), 5(3) and 3(6)

7. Having considered the notices of oppositions filed in these proceedings, I note that they total approximately 220 pages in length. I do not intend to discuss each opposition's pleaded grounds in full detail and will, instead, endeavour to succinctly summarise the relevant grounds below.

8. In respect of the section 5(1) and 5(2)(a) grounds aimed against the first application, the opponent relies on its first and fourth marks. As for the opposition under these grounds aimed at the second application, the opponent relies on its first and second marks. Under the 5(1) ground, the opponent claims that the applications should be refused on the basis that both the marks and the goods and services at issue are identical. Under the section 5(2)(a) ground, the opponent claims that there exists a likelihood of confusion between the marks on the basis that (1) the marks at issue are identical and (2) that the goods and services are similar.

9. In respect of the section 5(2)(b) grounds, the below table reflects which of the opponent's marks are relied upon against which application:

Opposition no.	Application opposed	Marks relied upon under s. 5(2)(b)
435548	The first application	First, second and third marks
435550	The second application	First, third and fourth marks
435553	The third application	All marks
435600	The fourth application	All marks

10. Under the section 5(2)(b) grounds, the opponent claims that the marks at issue are all similar and that the goods and services covered are all identical and/or similar. As such, the opponent claims that there exists a likelihood of confusion between them.

11. Under the section 5(3) ground, the opponent relies on all of its earlier marks and claims that they enjoy a reputation in respect of all of the goods and services relied upon. As a result of the identity and similarity of the marks at issue and the claimed reputation, the opponent argues that use of the applications would, without due cause, result in an unfair advantage in favour of the applicant and, further, would be detrimental to the reputation and/or distinctive character of the earlier marks.

12. Lastly, in respect of the section 3(6) ground, the opponent claims that the applicant knew of the opponent's marks' reputations and that, by filing its applications, has made a deliberate attempt to disrupt the opponent's business for gain or intended to use the resultant trade marks to gain an unfair advantage by exploiting the reputation of the opponent. Further, the opponent claims that in making its applications, the applicant fell short of the standards of acceptable behaviour. It is also noted that the opponent has raised a question under section 32(3) of the Act as to whether the applicant has the requisite *bona fide* intention to use the marks applied for in relation to the goods and services for which protection is sought, or at all.

13. The applicant filed a counterstatement denying the claims made and requested that the opponent provide proof of use in respect of its first through third marks.

14. Upon the filing of the counterstatements in the oppositions, the Tribunal utilised the powers granted to it under Rule 62 of the Trade Mark Rules 2008 and consolidated the proceedings. This was communicated to the parties in writing on 13 June 2023.

15. The opponent is represented by Edwin Coe LLP and the applicant is represented by Harper James Ltd. Only the opponent filed evidence, which I note was accompanied by separate written submissions. No hearing was requested and neither party filed written submissions in lieu. This decision is taken after careful consideration of the papers.

16. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

17. The opponent's evidence in chief came in the form of the witness statement of Ms Claudia Snehotta. While the statement is undated, there is confirmation provided via DocuSign that sets out that the statement was executed on 14 September 2023. Ms Snehotta is the Managing Director of the opponent, a position she has held since 1 June 2016. Ms Snehotta's statement is accompanied by 19 exhibits, being those labelled CS1 to CS19, and was adduced to demonstrate the opponent's use of its marks and to prove that the applicant has acted in bad faith.

18. I do not intend to summarise the opponent's evidence (or its submissions, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

19. As set out above, the applicant has elected to put the opponent to proof of use for its first through third marks. Regardless of whether the opponent has proven that it has used these marks, its opposition will proceed in reliance upon its fourth mark. That being said, I still consider it appropriate to conduct a proof of use assessment.

20. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> (aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;
>
> (ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.
>
> […]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

21. Section 6A is also relevant. It reads:

"(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), (aa) 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)-(5A) [Repealed]

(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."

22. Section 100 of the Act is also relevant. It reads:

"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."

23. As the opponent's first through third marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union".

24. Given their filing dates, all of the opponent's marks qualify as earlier trade mark under the above provisions. Aside from the opponent's fourth mark, they had all completed their registration processes over five years prior to the filing dates of priority dates of the applications. As set out above, the applicant requested that the opponent provide proof of use in respect of its first through third marks. So while the opponent's first through third marks are subject to the proof of use assessment, its fourth is not.

25. In *easyGroup Ltd v* Nuclei *Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology*

Inc v Laboratories Goemar SA [2004] ECR I-1159, 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 Bundervsvereinigung 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* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(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]; *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]."

26. Section 6A of the Act (cited above) confirms that the relevant period for the present assessment is the five-year period prior to the priority dates or filing dates of the applications. These are all 18 February 2022. The relevant period is, therefore, 19 February 2017 to 18 February 2022 ("the relevant period").

27. As the opponent's first through third marks are comparable marks based upon earlier EUTMs, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment.[2] As a result, the relevant territory between 19 February 2017 and 31 December 2020 is the EU (which includes the UK as, at that time, it was a Member State) and between 1 January 2021 and 18 February 2022, the relevant territory is the UK only. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union ("CJEU") noted that:

"It should, however, be observed that … the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use."

And

[2] See paragraph 4 of Tribunal Practice Notice 2/2020

"50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark."

28. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[3] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

29. The narrative evidence of Ms Snehotta begins with a detailed breakdown of the business's history. I do not intend to repeat this in full but note that the opponent's history goes back to 1909. However, it is noted that the company underwent a series of overhauls in the years since, including being closed down a number of times. The current iteration of the company was founded in 2002 and, since then, Ms Snehotta claims that it has generated double-digit sales increases over several years and has continued to expand by acquiring a number of other businesses.

30. In respect of sales in the UK, I note that the evidence begins by explaining how the opponent's goods and services reach the market. This is primarily via the opponent's website, being 'orwo.de' and also via Amazon, eBay and Etsy. Screenshots of the opponent's website as well as those taken from the aforementioned third-party retailers are provided showing the goods and services the opponent offers.[4] I note that the printouts show a range of goods (such as mugs, clothing and pillows) upon which the consumer can elect to have various images printed on to. Further, the opponent's website makes mention of the

[3] *Jumpman* BL O/222/16
[4] CS1

offering of a number of services such as analog film development and advice regarding the art of photography. While the websites are provided in English and I note that the Amazon printout shows goods that are deliverable to the UK, the websites are '.de' domains meaning that they are German websites. In addition, the printouts are all dated 5 September 2023, being approximately a year and a half after the end of relevant period. Further, the fact that the evidence post-dates IP Completion Day means that the existence of the German websites is not relevant to the present assessment.

31. Social media evidence is then discussed and I note that printouts are provided showing the opponent's Facebook, YouTube and Instagram accounts.[5] In terms of the following of these accounts, I note that the Facebook account has 140 likes and 167 followers, the YouTube account has 97 subscribers and the Instagram account has just 2,084 followers. While the YouTube account is in the English language, the accounts appear to be aimed at the German market.[6] Further, the accounts are provided on printouts that are dated 5 September 2023. Taking all of this into account, I do not consider it possible to determine how many followers the opponent had for these accounts during the relevant period or how many of them were UK customers.[7] As such, I consider that this evidence is of no assistance.

32. Turning to actual sales of goods in the UK, the evidence sets out that the opponent has been selling goods to UK customers since 2008.[8] On this point, the opponent has provided an invoice from 20 July 2008 showing the sale of 558 photo prints to a customer in Newbury. Having considered the invoice (and the certified translation of the same, which is also provided in Exhibit CS3), I note that it is branded as PixelNet. I appreciate that it does make reference to ORWO in that the invoice confirms that PixelNet is a photo service of ORWO Net GmbH. However, this is just a reference to the corporate structure of the company and I am not convinced that this is use of the opponent's fourth mark in a trade mark sense. Firstly, there

[5] CS2
[6] It is noted that the description of the YouTube account refers to it being one of the first German online-picture services.
[7] As was the case above, this evidence is dated after IP Completion Day meaning that use in the EU is not relevant as at the date of this printout.
[8] CS3

is nothing to suggest how the goods were ordered and whether the customer was confronted with the opponent's fourth mark prior to the purchase. Secondly, the references on the invoice all relate to PixelNet (with a reference to a website address, seemingly where the goods were selected, being pixelnet.de). Without anything to suggest whether the consumer was aware they were buying ORWO goods, I am not willing to infer that they were.

33. In addition to the above, the opponent has provided an additional six invoices addressed to locations in the UK, being London and Sutton.[9] The invoices are dated between 24 August 2009 and 5 February 2017. These are noted but, again, they are PixelNet invoices. As a result, the same issues discussed in the preceding paragraph are also applicable here in that, essentially, there is nothing to demonstrate that this covers use of 'ORWO' branded goods.

34. In light of what I have said above regarding these invoices, I am not willing to find that they are of any assistance in demonstrating use of the opponent's fourth mark.

35. The opponent's evidence discusses sales to business clients in the UK. It sets out that since 2005, one of the opponent's primary UK-based clients is Medion Electronics Limited. This company is described as a leading manufacturer of consumer electronics including laptops, PCs, smartphones and household technology. The narrative evidence explains that Medion is a supplier of goods to Aldi, being the well-known supermarket chain. An invoice dated 30 June 2015 is provided regarding an order from Medion (but is headed as 'orders for Aldi Great Britain').[10] This shows the sale of units in the tens of thousands of items (mainly being photographs) for a total sum of £3,004.89. Unlike the invoices discussed above, this one does include ORWO branding (although it is not the opponent's fourth mark).

[9] CS4, CS6 and CS7
[10] CS5

36. In respect of sales to Medion, I note that the opponent has provided a number of additional invoices from between 2018 and 2021.[11] There are a considerable number of pages covered by these invoices but I note that they are all branded as 'ORWO' (though, again, not in the form of the opponent's fourth mark). The invoices cover a large number of products being sold and while no breakdown of the invoices has been provided, I note that the turnover generated by Medion sales has been provided further on in the evidence so I will discuss that below. On the point of these invoices, I wish to discuss the goods actually covered. Firstly, I note that they cover a very wide range of goods but, for the most part, they are printed materials such as photographs, photo books, photo booklets, stickers, canvas prints, wall prints and postcards. I appreciate that there are additional goods such as clothing, mugs, snow globes and lunch boxes. However, these goods are not at issue here.[12] While on the topic of the goods, I wish to also discuss the unit price of the same. I note that while some of the goods covered are of a higher value (generally being no more than around €20), the majority of them are for photograph prints that are of a low cost and, in some instances, sell for as little as a number of cents per unit.

37. Alongside all of the Medion invoices discussed in the preceding paragraph, the opponent has included a limited number of invoices from these years of what it refers to as invoices to 'individual customers'. These invoices are noted but all bar one of them[13] are headed PixelNet and the issues discussed above regarding the other PixelNet invoices are applicable here.

38. The opponent has provided a number of updated catalogues in evidence that show images of its end products.[14] The updates are for each year between 2017 and 2020. While they are noted, they are in the German language. On this point, there is no further information or figures regarding their circulation or availability to UK

[11] See CS9, CS11, CS13 and CS15, respectively.
[12] I appreciate that clothing goods are relied upon but they have not been found to be similar to any of the applicant's goods and services that survived the goods and services comparison above.
[13] Being an ORWO invoice that covers the sale of one 'MagicCup' on 3 December 2021. This can be found at page 29 of CS14
[14] CS8, CS10, CS12 and CS14

consumers or whether they were ever available in the English language.[15] While it has not been expressly argued, I have given consideration as to whether the catalogues were provided in order to demonstrate that the goods shown within them are those covered by the PixelNet invoices. In short, I am not convinced that they are. I say this because there is nothing to suggest that these catalogues are how the recipients of the 'PixelNet' invoices selected their goods. Again, there is nothing before me by way of explanation or other evidence to suggest how the goods covered by these invoices were selected.

39. A number of invoices have been provided from after the relevant period,[16] however, these are not relevant to the assessment I must make so I will not discuss them any further.

40. As alluded to above, the opponent has provided its turnover in respect of ORWO sales to Medion between 2015 and 2022. It is noted that the narrative evidence discussing these figures confirms that they do not include the sales to individual customers. While the turnover figures provided extend beyond the relevant period, I will reproduce them in full. The turnover is as follows:

Year	Sales (£)
2015	224,000
2016	370,000
2017	500,000
2018	441,000
2019	635,000
2020	360,000
2021	150,000
2022	4,000
Total	2,684,000

[15] I appreciate that my assessment of genuine use may take into account EU use prior to IP Completion Day. However, the PixelNet invoices that I go on to discuss here cover sales to the UK so the issue as to whether these catalogues were available in the UK is relevant to that issue.
[16] CS16

41. In respect of the 2022 figures, it is not clear what period they cover. On this point, I note that in the table provided, the opponent explains that it is included to demonstrate ongoing use of ORWO marks in 2022. While noted, it is not clear whether this covers up to the end of the relevant period, being 18 February 2022, or whether it goes beyond it. Given how limited the sales for 2022 are, I do not consider it has much impact on the opponent if I simply discount them outright so this is what I will do. As such, I will proceed as if the turnover provided for during the relevant period is £2,086,000.

42. While on the topic of the invoices, I wish to clarify that a number of them include goods that are not at issue in the present proceedings (such as snow globes and mugs, for example). While it has not been possible for me to go through each invoice (of which there are hundreds) to remove such goods from the overall turnover figures, I remind myself that the majority of the invoices cover printed matter (which are covered by the specifications at issue).

43. There is additional evidence provided in respect of services offered, however, this is via narrative explanation by Ms Snehotta only. While Ms Snehotta discusses the history of the services the opponent provides, there is nothing to demonstrate any actual use for the claimed services. I, therefore, do not consider that this part of the evidence is of any assistance.

44. This concludes my summary of the relevant evidence. My primary concern with the evidence of use is that the sales to individual UK customers all comes under the PixelNet branding. As such, it is of no assistance to the present assessment (and neither is it of assistance to the entirety of the present case, for that matter). This leaves the only evidence in support of genuine use being sales to just one undertaking. The total turnover for the relevant period of goods sold by the opponent's stands at just over £2 million. In the context of the market for the goods sold as a whole, this is likely to be a low level of turnover. That being said, I remind myself that use does not need to be quantitively significant in order for it to be deemed genuine. On the contrary, use may be deemed genuine so long as it demonstrates a genuine attempt by a proprietor to create and preserve a market

share for the goods or services sold. While the opponent's evidence covers sales to just one customer, they are of a volume that, in my view, is high enough to cross the threshold for proving genuine use. I say this because the use shown before me is sufficient to demonstrate that the opponent has attempted to create and preserve a market share for its goods during the relevant period. That being said, the use before me clearly does not cover the entirety of the goods or services that the opponent has relied on. Instead, as explained above, the majority of the goods sold under the invoices relates to a wide range of printed materials. On this point, I note that the opponent's marks are all registered for the term "printed matter". In considering, briefly, the issue of a fair specification, I am of the view that when a consumer is confronted with the use shown by the opponent, they would fairly categorise it as covering "printed matter" at large.[17] As a result, I am prepared, for present purposes, to proceed on the basis that there has been genuine use of the opponent's first through third marks for "printed matter".

45. Despite concluding that the opponent has demonstrated genuine use of its marks, I will, for reasons that will become apparent throughout the course of the section 5(1) and 5(2) grounds of this opposition, proceed on the basis of the opponent's fourth mark only. I do so because (1) the opponent's fourth mark is not subject to the use assessment so the opponent may rely on all goods and services in that mark's specification (which are significantly wider than simply "printed matter") and (2) it includes "printed matter" in any event so any comparison of the goods and services in reliance upon that mark will inevitably cover any comparison reliant upon the opponent's first through third marks. If necessary, I will return to discuss this point at the conclusion of the section 5(1) and 5(2) grounds on this opposition.

My approach to the section 5(1) and 5(2) grounds

46. It is noted that the oppositions in reliance upon the opponent's fourth mark are brought under sections 5(1), 5(2)(a) and 5(2)(b) of the Act. The opposition against

[17] See the case of *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) for guidance on assessing fair specifications when considering the issue of genuine use.

the first application is the only one that is reliant upon section 5(1) and 5(2)(a) grounds. The other applications are opposed under the section 5(2)(b) ground only. As it is a prerequisite of section 5(1) and 5(2)(a) grounds that the marks at issue are identical, I will consider this issue first. Regardless of the outcome, I will move to consider the goods and services comparison.[18]

47. If I am satisfied as to identity between the opponent's fourth mark and the marks in the first application then in order for the section 5(1) ground to succeed, it is necessary that the goods and services are also identical. Where they are, the opposition against the first application will succeed at that point. However, if the goods and services are not identical then the section 5(1) ground will fail but the section 5(2)(a) ground may still proceed so long as the goods and services are similar. This is on the basis that section 5(2)(a) of the Act requires only that the goods and services are similar. Lastly, in the event that the goods and services are dissimilar, the opposition under the section 5(2) grounds will fail regardless of any identity or similarity between the marks at issue. I will discuss this issue further at the conclusion of my goods and services comparison.

Section 5(1) and 5(2): legislation and case law

48. Section 5(1) of the Act reads as follows:

> "(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

49. Section 5(2) of the Act reads as follows:

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

[18] Although if the opponent's fourth mark and the marks in the first application are not deemed identical, the section 5(1) and 5(2)(a) grounds will fail at the first hurdle. As no section 5(2)(b) ground is relied upon between these marks, the reliance upon the fourth mark in respect of the first application will fail outright. If it comes to it, I will discuss this matter further below.

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

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

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

50. Section 5A of the Act states as follows:

"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."

51. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"(6)(1) In this Act an "earlier trade mark" means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

52. The opponent's fourth mark qualifies as an earlier trade mark under the above provisions. As set out above, the opponent's fourth mark had not completed its registration process more than five years before the filing or priority dates of the applications. Therefore, it is not subject to proof of use pursuant to section 6A of

the Act. Consequently, the opponent may rely on all of the goods and services for which this mark is registered.

53. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Identity of the marks

54. As I have set out above, it is a pre-requisite of both section 5(1) and 5(2)(a) of the Act that the trade marks at issue are identical. Plainly, the second mark in the first application is identical to the opponent's fourth mark. As for the first mark in the first application, I note that this is presented in blue. However, the opponent's fourth mark is registered in black and white, meaning that it is protected for use in any colour (including the same shade of blue as used by the applicant). Consequently, the different use of colour is not a point of visual distinction between the marks. As

such, these marks are also to be considered identical. The opposition in respect of these grounds against the first application may, therefore, proceed.

Comparison of the goods and services

55. The applicant's goods and services are identical across all four of its applications and these are set out at Annex 1 of this decision. As for the opponent's fourth mark, the goods and services for which it is registered are set out at Annex 2 of this decision.

56. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "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".

57. 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.

58. 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."

59. 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 stated that "complementary" means:

> "...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."

60. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that

responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL-O-255-13*:*

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

61. Whilst on the other hand:

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

62. I have submissions in respect of the goods and services comparison from the opponent. These submissions consist of a table of the goods and services at issue that is preceded by the comment that the table advances the best case of identity or similarity between the specifications at issue. As for the applicant, I note that it did make a series of bare denials wherein it argued that the goods and services at issue are dissimilar. I do not intend to repeat the comments from either party in full here but will, where necessary, discuss them further below. On this point, I can confirm that, for the avoidance of doubt, I have given both parties' comments due consideration.

Class 1

Chemicals used in industry, science and photography.

63. The above term of the applicant is sufficiently broad so as to cover several terms in the opponent's specification, namely "inorganic chemicals for use in industry", "chemicals used in science", "chemicals for use in coating film". As a result, I find that these goods are identical under the principle outlined in *Meric*.

Sensitized unexposed papers, films, plates, foils, offset printing plates, cinematographic films; cinematographic film, sensitized but not exposed; cinematographic films, sensitized but not exposed; sensitized photographic film; unexposed camera film; unexposed cinematographic film; unexposed cinematographic films; unexposed photographic film; unexposed photographic films.

64. As far as I am aware, the above goods are all types of goods used in the process of developing films. I note that the opponent's specification includes terms such as "sensitized films, unexposed", "sensitized photographic plates", "sensitized plates for offset printing", "unexposed sensitised paper" and "chemical preparations and materials for film, photography and printing". In my view, all of the above goods of the applicant fall within the aforementioned goods of the opponent. As such, I find that these goods are identical under the principle outlined in *Meric*.

Unexposed x-ray films.

65. The above term of the applicant is one that is either self-evidently identical or identical under the principle of *Meric* with "x-ray films, sensitized but not exposed" in the opponent's specification. Regardless, the goods are identical.

Sensitized cloth for photography; adhesives used in industry; self-toning paper.

66. The above terms all appear in the opponent's specification, although I note that the latter two terms are described as "adhesives for use in industry" and "self-toning paper [photography]" in the opponent's specification, respectively. Regardless of how the terms are worded, they are self-evidently identical.

Photographic emulsions.

67. While I have nothing to indicate what goods the above term covers, I am of the view that it is a chemical preparation used for use in photography. Therefore, I find that the above term of the applicant falls within the opponent's term of "chemical

preparations and materials for film, photography and printing". Such goods are, therefore, identical under the principle outlined in *Meric*.

Photographic developers.

68. By virtue of being goods in class 1, I consider that the above term of the applicant covers chemicals used as developers and not physical machines used for developing film. As such, it is my view that the above term is a chemical used in the process of developing photographs. It, therefore, falls within the opponent's term of "chemical preparations for use in photography" meaning that these goods are identical under the principle outlined in *Meric*.

Chemicals for photographic and graphic systems, purposes and films.

69. Clearly, chemicals for photographs and films are chemical preparations for use in photography and film. Insofar as the above term covers such goods, it is plainly identical to the opponent's "chemical preparations and materials for film, photography and printing". As for the addition of 'graphic systems', I note that the opponent's specification includes the term "chemicals used for printing or the printing of texts, images, words or graphics." Such a term is likely to cover chemicals for graphic systems and, therefore, I find that the 'graphic system' aspect of the applicant's term is identical under the principle outlined in *Meric* with the aforementioned term of the opponent.

Class 9

Image and sound recording films, apparatus and instruments.

70. The above term is, in my view, worded so that it covers apparatus and instruments for recording image and sound. As such, the term falls within the opponent's broader terms of "multimedia apparatus and instruments" and "recording apparatus". As such, I find that these goods are identical under the principle outlined in *Meric*.

Electronic apparatus and instruments.

71. I am of the view that the opponent's terms of "multimedia apparatus and instruments" and "recording apparatus" can be said to be types of electronic apparatus. As a result, and given that there is no limitation to the type of apparatus or instrument covered by the applicant's term, I find that the opponent's goods fall within it meaning that these goods are identical under the principle outlined in *Meric*.

Audio recordings.

72. The above term is capable of covering audio recordings provided digitally via a downloadable file or physically via a CD or cassette. I note that the opponent's specification includes the term "digital recordings" and "optic discs carrying audio recordings". I consider the former term of the opponent encompasses the applicant's term (as a digital recording can be an audio file) whereas the latter term falls within it. Therefore, I find that the applicant's goods are identical under the principle outlined in *Meric* with both terms of the opponent.

Holograms.

73. As far as I understand it, the above term describes a digital recording (be that a video or still image) that is projected in to a room or space with the intention that the subject of the recording is present in that room/space. The opponent's specification includes the term "digital recordings" at large and I see no reason why this cannot include hologram recordings. As a result, I am of the view that the applicant's term falls within the opponent's meaning that these goods are identical under the principle outlined in *Meric*.

Cinematographic films; slides (photography), exposed films; filters (photography).

74. The opponent's specification includes "cinematographic films", "exposed photographic slides" and "filters for use in photography". Despite the latter two terms being expressed in a slightly different way, I consider these terms all describe the same goods. As such, I find that they are self-evidently identical.

Optical plates, editing appliances for cinematographic films.

75. While expressed as one term, the above covers two different goods, the first being optical plates with the second being editing appliances for cinematographic films. In respect of the first type of goods, I note that the opponent's specification includes the term "photographic plates [exposed]". As far as I am aware, a photographic plate was used as a method of taking photographs prior to the advancement of the technology. It is my understanding that it is light-sensitive plate that is covered in a type of chemical which, when exposed to light, captures an image. Given the broad meaning of *optical plates,* I see no reason why the applicant's term does not encompass the opponent's on the basis that it is a type of optical plate (being one used for photography). As such, I find that these goods are identical under the principle outlined in *Meric*. As for the second types of goods covered by the applicant's term, I note that the opponent's specification includes the term "apparatus for editing cinematographic film". While worded slightly differently, I consider that they describe the same goods. Therefore, they are self-evidently identical.

Reproduction and enlarging apparatus.

76. In considering the above term, I note that the opponent's specification includes "enlarging apparatus [photography]" and "photographic duplicating apparatus", the latter of which being an alternately worded term for an apparatus that reproduces photographs. While spread over two terms, I consider that the goods of the opponent both fall within the applicant's term meaning that they are identical under the principle outlined in *Meric*.

Video tapes, animated cartoons.

77. The above term of the applicant is expressly reserved for analog goods (namely video tapes) that display animated cartoons. I note that the opponent's specification includes the term "animated cartoons" which can cover cartoons in any format. The opponent's goods can, therefore, include the applicant's and I hereby find that they are identical under the principle outlined in *Meric*. Alternatively, if the above term of the applicant is to be construed as two separate goods, being "video tapes" and "animated cartoons" then I find that, plainly, the latter part of the term is self-evidently identical to the opponent's "animated cartoons". As for "video tapes", I note that the opponent's specification includes the same term, albeit described as "videotapes". These goods are, therefore, self-evidently identical.

Photographic, cinematographic and electric, optical and opto-electronic data carriers.

78. Goods that are described as data carriers include those such as CDs and memory sticks, both of which carry various types of data. I note that the opponent's specification includes the term "secure digital (sd) memory cards", "optical discs" and "optical data media". All of these goods can carry photographic and cinematographic data. As such, I find that they fall within the applicant's broader term. I, therefore, find that these goods are identical under the principle outlined in *Meric*.

Photovoltaic cells.

79. In its submissions, the opponent's position in respect of this term was that it simply grouped it together with all of the applicant's other class 9 goods and claimed it to be identical with a range of its own class 9 goods, such as "images and sound recording films", "video tapes, animated cartoons" and "optical plates, editing appliances for cinematographic films", amongst others. No explanation has been provided as to why I should find similarity in respect of this specific term. I consider

this to be an issue for the opponent because, as far as I understand it, the above term is very technical in nature in that it describes a type of cell that is used to convert sunlight into energy, such as those used in solar panels. In short, I see no reason why the above term shares any degree of overlap with the opponent's class 9 goods highlighted in its submissions.

80. Having considered the specifications at issue, I note that the opponent's specification includes the term "scientific apparatus and instruments". On the face of it, this term appears that it may offer the opponent a better case in respect of similarity with the above term. That being said, I do not consider that it is of any actual assistance to the opponent. I say this because the opponent's term is likely to cover laboratory equipment such as Bunsen burners, barometers or other products used for the measuring and recording of scientific experiments. A photovoltaic cell does not fall within this category of goods. Even when it comes to similarity, I see no obvious reason why these goods would overlap in nature, method of use, purpose, trade channels or user. On this point, I am of the view that the goods here are technical in nature and it was for the opponent to provide evidence demonstrating any level of similarity between the goods. Without such, I am not willing to reach a conclusion that these goods are similar.

81. Lastly, I have, for the avoidance of doubt, given consideration as to whether the applicant's term here bears any similarity with "scientific and technological services" or "scientific research" in class 42 of the opponent's specification. Again, I remind myself that these terms are all technical in nature and without anything guiding me on any overlaps between the goods or services, I see no obvious reason why I should find that any exist. In short, the natures, methods of use and purposes all differ. In respect of trade channels and user, I have nothing to suggest that an undertaking that offers the applicant's goods would also offer the opponent's services to consumers or whether the consumers selecting the goods/services would be the same. As a result, I consider that these goods are dissimilar to any of the goods and services of the opponent.

Class 16

Printed matter; mimeograph apparatus and machines; printing blocks;[19] *stencils.*

82. The above terms appear in both parties' specifications, although I note that the latter term is expressed as "stencil [stationery]" in the opponent's specification. I find that these goods are self-evidently identical.

Paper, cardboard, photographs, prints.

83. The above goods are various types of printed matter and, therefore, fall within the opponent's broader term of "printer matter". These goods are identical under the principle outlined in *Meric*.

Developed films.

84. I note that I have nothing before me from the applicant explaining what goods the above term covers in the context of class 16 goods. While class 16 can include various types of films, those are ordinarily reserved for packaging or wrapping. Clearly, this is not the type of film described by the above term. In my view, the above term covers photographic negatives that are used to develop photographs. These goods are reserved for class 9, not class 16. Therefore, I consider that the above term has been misclassified. On this point, it is established case law that a trade mark is not to be treated as not covering clearly described goods simply because it may have been registered in a class in which those goods are not usually classified.[20] As a result, and for the sake of this comparison, I consider that I am entitled to treat the above term as covering the goods that I have described above (being class 9 goods). In doing so, I note that the opponent's specification includes the term "photographic negatives" which, while worded differently,

[19] It is noted that this term appears twice in the applicant's specification.
[20] See *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited),* [2018] EWHC 3608 (Ch) and *Multi-Access Limited v Guanghzhou Wong Lo Kat Great Health Business Development Co Limited* [2019] EWHC 3357 (Ch)

describes the same goods as the applicant's term. As a result, these goods are identical.

85. In the event that I am wrong to treat the applicant's term in the above way, I find that it is similar to the opponent's term of "photographic film development" in its class 42 list of services. To my knowledge, users who seek to obtain a developed film will commonly do so by giving their undeveloped film to a photograph development service. That service will then develop the film and, along with the printed photographs from the film, return the developed film to the user. Such a finding leads me to conclude that the goods and services share the same user and trade channels. Further, the development service is plainly important to the end product of a developed film and the consumers will believe that the goods and the service itself are provided by the same user. For the avoidance of doubt, I consider this to be the case even if the undeveloped film is provided by an unrelated third party and not the provider of the development service itself. I say this because the comparison here relates to the end product of a developed film and not the undeveloped film that the consumer initially purchases. While the goods and services differ in nature, method of use and purpose, and are not competitive in nature, I consider the strength of the aforementioned overlaps are such to warrant a conclusion that these goods and services are similar to a medium degree.

Masks.

86. In the context of class 16 goods, I consider that the above term can cover masks printed on paper or card. In such circumstances, the goods will be considered "printed matter". As this is a term in the opponent's specification, I consider that these goods are identical under the principle outlined in *Meric*.

Class 39

Handling, sorting and packaging of (unexposed) raw roll-film (master rolls, semi-finished).

87. Plainly, the packaging element of the above term falls within the opponent's service of "packaging and storage of goods". I say this because the opponent's term is not limited in any way and can, therefore, cover the packaging of the specific goods listed in the applicant's term. As for the *handling and sorting* aspect of the term, it is my understanding that these services are provided as part of transport services (which can include delivering goods to end consumers). This is on the basis that in order for a provider to transport goods, they will be required to sort and handle said goods.[21] Therefore, I consider that insofar as the above term relates to handling and sorting, it falls within the opponent's term of "transport of goods". As a result, these services are identical under the principle outlined in *Meric*. That being said, if I am wrong to find identity on this point, then I find that these services are similar. I say this because the services will clearly be provided by the same undertaking and sought by the same user. Further, they will be complementary to one another as sorting and handling of goods is important to their transport and the consumer will believe such services to be provided by the same undertaking. So while the nature, method of use and purpose may differ, the aforementioned overlaps are, in my view, sufficient to warrant a finding that these services are similar to a medium degree.

Class 40

Photographic laboratory services; image and film processing; development of fixed image and moving image films; photographic printing, processing, enlargement, reproduction, reduction and graphic reproduction; processing of unexposed raw film material (manufacture and protective sheathing); processing of (exposed) cinematographic films.

[21] I consider this to be the case as, when selecting goods online and paying for delivery, the 'delivery fees' are also sometimes referred to as 'handling fees'.

88. All of the above services can be said to cover different types of development services for a range of different types of films. While the opponent's specification also consists of a range of development services, I do not intend to list them all and make individual comparisons in respect of the above terms. Instead, I consider it sufficient to simply state that by virtue of either being self-evidently identical or because the terms encompass one another (thereby being *Meric* identical), the above terms are identical to the opponent's terms of "photographic laboratory services", "photographic film development" and "processing of cinematographic films".

Creating cinematographic film copies; photocomposing services.

89. Respectively, the above terms describe the same services as "duplicating of films" and "photographic laboratory services, namely […] photocomposing services" in the opponent's specifications. Such services are, therefore, identical.

Class 41

90. The applicant's list of class 41 services is of a significant length and consists of a number of seemingly disparate terms. While the opponent initially sought to oppose all of these services, I note that its written submissions in respect of the goods and services the opponent simply reproduced the entirety of the class 41 services but referred only to certain underlined services as being similar to its own goods and services on the basis that they are complementary. Those services the opponent underlined are as follows:

> "Film studios; recording of video tapes; education and training advice; training; information about leisure activities; information about events (entertainment); providing electronic publications, not downloadable; operation of recording studios; entertainer services; recreation services; sound and television studio services; digital picture service; education and instruction; television entertainment; film production; film production (in studios); film screenings in

cinemas; taking photos; editing of video tapes; production of shows; entertainment; video film production; compilation of radio and television programs; photography; film shooting."

91. There are two points that I consider it necessary to address in respect of the opponent's submissions. The first is that, as far as I am concerned, the opponent's submissions are such that they can be deemed as having abandoned its claims under the present grounds in respect of the services that it has not underlined. On this point, I wish to address the fact that, having considered the specification, there are a number of terms that were not underlined that could be said to cover the same services as those that were underlined or offer a greater degree of similarity to the opponent's terms. While this is noted, I consider it necessary to point out that it is not for me to seek to understand the rationale of the opponent in not underlining certain terms. As a result, I confirm that I will only give consideration to those terms that the opponent has actually underlined.

92. The second issue is that the opponent has not identified which of its own goods or services it considers similar to the underlined services of the applicant. On this point, I refer to the case of *SmartX TM* (BL O/0911/24) wherein Mr Iain Purvis K.C., sitting as the Appointed Person, addressed the issue of an opponent's failure to identify similarity in respect of long specifications. Mr Purvis K.C. said:

"28. […] it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identicality). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach […] would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent."

93. Further on in this decision, Mr Purvis K.C. stated:

> "31(v). In fact (as I have pointed out) the Hearing Officer went beyond the written submissions in making findings of similarity in respect of a number of groups of goods on the basis of arguments which had not been raised by the Opponent. If the Applicant had complained about this by way of an Appeal, there would probably have been a good argument that he had been the victim of procedural unfairness. But this has of course not happened and to this extent the Opponent has benefited from the Hearing Officer's generosity. However, it would obviously be perverse to say that the Hearing Officer ought therefore to have taken every other unpleaded and unargued point in the Opponent's favour."

94. While the highlighted class 41 services of the applicant are not particularly long, the opponent's specification is of a significant length. This issue is compounded by the fact that the opponent's specification does not includes any terms in class 41. Therefore, it is not particularly obvious as to what the opponent's best case is. What I will say at this point is that I do not consider that the case law cited above means that I must dismiss any level of similarity between the opponent's goods and services and the applicant's class 41 services. However, the takeaway from *SmartX* is that it would be unfair for me to go through all of the opponent's terms in order to assess each and every combination of goods and services. Instead, in the circumstances, I consider that a reasonable approach would be for me to identify what I reasonably consider to be the closest terms and carry out the comparison on that basis.[22] In doing so, I will remain mindful of the comments of Mr Purvis K.C. above regarding procedural unfairness.

95. I will now proceed to consider the services listed above.

[22] On this point, I also refer to the case of *MontyPay* (BL O/0924/24)

Operation of recording studios.

While the opponent's specification does not include any services that can be said to be similar to the above term, I note that it does include the term "recording apparatus". The natures, methods of use and purposes all clearly differ between these goods and services. That being said, I consider that an undertaking the operates a recording studio is also likely to offer recording apparatus as part of its overall service itself. While I have nothing to suggest that the operator of the recording studio actually produces the recording apparatus it uses, I am of the view that there is an overlap in distribution channels between them, though I appreciate that this does not necessarily represent a strong overlap. In addition, I consider that there is an overlap in user because someone looking to use and operate a recording studio is likely to require recording apparatus. The goods and services are not competitive in nature but I do consider that there is some degree of complementarity between them. I say this because someone seeking the operation of a recording studio is going to consider the recording apparatus is important to the same and is likely to expect it to be present within the studio. This relationship is such that, even taking into account what I have said about the producers being different, consumers are likely to believe that the goods and services are provided by the same undertaking. Taking all of this into account and bearing in mind the strength of the overlaps, I consider that the goods and services are similar to a low degree.

Film studios; recording of video tapes; sound and television studio services; film production; film production (in studios); editing of video tapes; production of shows; video film production; film shooting.

96. Without any indication as to what represents the opponent's best case in respect of these services, I have been left to determine this myself. In my view, the opponent's best case lies in the terms "cinematographic films" and "animated cartoons". I say this because the opponent's goods are both the end products of the services of the applicant. Plainly the nature, method of use and purposes all differ. As for user, I see no reason to find why someone buying a film or cartoon would also seek the services of the applicant. However, there is an overlap in trade

channels and a complementary relationship between these goods and services. I say this because the provider of the end product is also likely to be the undertaking that offers the above services. On this point, I will say that it is my understanding that film studios that offer the above services are also commonly the distributor of their own films. For example, companies like Netflix, Apple TV and Amazon Prime commonly offer production services for films or cartoons and those films or cartoons will then be distributed via those companies' streaming platforms. As for complementarity, I am of the view that, clearly, the end product of a film or a cartoon is important to the production process that the services cover. Further, I consider it common in the film or cartoon industry for the production company to be prominently featured on the end product, be that in the opening title cards or on any packaging or promotional material. As such, end consumers will believe the goods and services to have originated from a single undertaking. Taking all of this into account, I consider that these goods and services are similar to a low degree.

Film screenings in cinemas.

97. While not a part of the production of a film, the above service is one that is likely to be offered by production companies in order to promote their films. Following the same reasoning I have discussed in the preceding paragraph, I consider that these services are likely to overlap in trade channels and have a complementary relationship with the opponent's terms of "cinematographic films" and "animated cartoons". As a result, I find that these goods and services are similar to a low degree.

Digital picture service; taking photos; photography.

98. The above terms of the applicant are all terms wherein the undertaking offering them will provide the service of taking photographs on the user's behalf. This could include wedding photos, for example. The undertaking that offers these services will provide the photographs to the user either physically or digitally (the first service listed being exclusively reserved for digital pictures). I consider that the end product of the services will be provided to the end user alongside the negatives of the

photographs or via CD or USB drive. As a result, I consider that the best case for the opponent in respect of the above services lies in its goods of “photographic negatives”, “secure optical discs” and “digital (sd) memory cards”. For the avoidance of doubt, I consider that the latter two terms of the opponent are clearly capable of carrying photographs on them. While the natures, methods of use and purposes of the goods and services differ, I consider there is an overlap in trade channels and user. As above, the provider of the service is also going to provide physical goods to the user via negatives or other forms of digital media carriers. The goods and services are also clearly going to be provided to the same user. In addition, I consider that there is a degree of complementarity between the goods and services because the user is going to consider the physical or digital delivery of the photographs an important aspect of the services. Further, the consumer will believe that that the goods and services are provided by (or are the responsibility of) the same undertaking. Taking all of this into account, I consider that these goods and services are similar to between a low and medium degree.

Television entertainment; entertainment; compilation of radio and television programs.

99. The above services are for the provision of entertainment via different methods. I note that the opponent’s specification includes the terms “animated cartoons” and “digital recordings” in class 9. The former term is, clearly, an entertainment product whereas the latter term is sufficiently broad enough to cover recordings for entertainment purposes such as videos or music. Plainly, the purpose of such goods is to provide entertainment to the user. As such, I consider that there is an overlap in purpose between the goods and services. That being said, the nature and methods of use are plainly different. In respect of trade channels, it is my understanding that providers of the broad entertainment services of the applicant are likely to also provide entertainment in the form of cartoons or various types of digital recordings. In addition, I consider that a user looking for entertainment as a service is also likely to be a user of the opponent’s goods. I do not consider that the goods and services are complementary to one another but I am of the view that there is some degree of competition in that a user looking to be entertained may select the applicant’s services (which can include cinema services, for example)

over downloading a cartoon to watch at home, or vice versa. As a result, I consider that these goods and services are similar to a medium degree.

Information about events (entertainment).

100. While I have found similarity between various entertainment services and "animated cartoons" and "digital recordings" in the opponent's specification, I do not consider that the same finding automatically applies here. Firstly, I appreciate that the user may overlap in that someone looking to watch the opponent's goods will also seek information about other events that they may attend. However, I do not consider that the remaining factors overlap. Plainly, the nature, method of use and purpose of the goods and services differ. As for trade channels, as far as I am aware, providers of animated cartoons and digital records would not provide information about entertainment events or vice versa. On this point, I have nothing before me in evidence to suggest otherwise. Lastly, the goods and services are not complementary to one another and neither are they competitive. Taking all of this into account, I find that the goods and services are dissimilar.

Entertainer services.

101. In my view, the above term does not cover services that are provided via television, film or radio in the same way that the applicant's services at paragraph 99 above are. Instead, it is my understanding that the above term of the applicant covers services provided by an actual entertainer at an event, such as a host, an emcee, presenter or other type of entertainer. I appreciate that the entertainers may appear on TV in some capacity and that the opponent's specification consists of terms that may be considered as providing entertainment (such as "animated cartoons" and "digital recordings" in class 9) that are (1) likely to share the purpose of providing entertainment and (2) will be sought by the same user. However, I do not consider that goods or services that are for the provision of entertainment are automatically similar simply because they aim to entertain members of the general public at large. Such a finding would, in my view, offer far too broad a scope of protection for such terms. Instead, in considering the present terms, I find that they

differ in natures, methods of use and trade channels. Further, they are not complementary or competitive in nature. Therefore, I am of the view that, upon taking a step back and considering the overall question of similarity, these terms are clearly dissimilar.

Recreation services.

102. It is my understanding that the above term is very broad and will include the provision of services that relate to leisure such as children's parks/playgrounds, organising running events or organising other types of sporting events. I note that the opponent's specification includes, in class 28, goods such as "toys" and "sporting articles". Such goods may be used in the context of recreational events; however, I do not consider that this means that they are similar. The users may overlap but the natures, methods of use and purposes are all clearly different. As for trade channels, I have nothing to suggest that the goods and services would commonly be provided by the same undertakings and, without such, I am not willing to find that they do. Lastly, the goods and services are not complementary as while toys and sporting articles may be used during recreational activities, they are not important to the provision of such a service and the average consumer would not consider the provider of the respective goods and services to be the same or connected. I appreciate that I have found an overlap in user, however, this is not sufficient by itself to warrant a finding that the goods and services share any overlap in similarity. These services are, therefore, dissimilar.

Information about leisure activities.

103. The above term can cover information in respect of recreation services. Following the same logic as set out in the preceding paragraph, I am of the view that the above services do not share any obvious overlap in natures, method of use, purpose or trade channels with "toys" or "sporting articles" (or any other goods or services for that matter). The user may overlap but this is not sufficient by itself to give rise to an overlap in similarity. These services are, therefore, dissimilar.

Education and training advice; training; education and instruction.

104. In comparing the above term to the goods and services of the opponent, I have identified “digital recordings” in the opponent’s specification as its best case. I say this because “digital recordings” are so broad they can cover recordings for any purpose whatsoever. As such, the term can include digital recordings such as podcasts or videos for educational purposes. So while the natures and methods of use differ, there is a likelihood that the purposes overlap (being goods or services aimed at educating the user). Further, education providers often also provide recordings aimed at educating the user (be that on their own or as companions to educational services). As a result, the trade channels overlap. As for user, someone seeking educational services is also likely to seek education via recordings. Again, this may be as a companion recording to the service itself. Lastly, there is potential for complementarity between these goods and services because digital recordings may be provided alongside teaching and by the same provider so consumers are likely to consider them important to one another and believe them to originate from the same undertaking. As a result, I consider that these goods and services are similar to a medium degree.

Providing electronic publications, not downloadable.

105. It is my understanding that while the above service does not cover downloadable publications, it is one that allows users to access electronic publications via a web browser or other application. Given the broad nature of electronic publications, this can include a subscription service to a magazine that is accessed digitally but, again, is not downloadable. I note that the opponent’s specification includes the broad term “printed matter” in class 16 which can include goods such as magazines. It is my understanding that it is common in the trade for producers of magazines to also offer them digitally be that an electronic publication that is accessed via a subscription on a website or a downloadable publication (the former being relevant here). In my view, such goods and services are likely to overlap in trade channels. As for user, this is likely to overlap also on the basis that someone who buys a magazine may also seek a digital subscription of the same.

For example, a consumer may read the physical copy of a magazine at home but may wish to access the digital version when away from home, during a commute for example. On this point, it may be the case that a subscription to a physical magazine also include access to the digital copy via the provider's website (though being one that is not downloadable). In addition, I appreciate that the nature of a physical magazine and a digital one may also give rise to the fact that consumers may elect to choose one over the other. The goods and services are also, therefore, competitive in nature. So while the goods and services clearly differ in nature, method of use and purpose, the overlaps discussed here are sufficient to give rise to a finding that they are similar to a low degree.

Class 42

Scientific (photo) chemical research and development and chemistry services.

106. It is my view that the above services either cover, or are covered by, the opponent's terms of "scientific and technological services" and "scientific research". As such, I find that these services are identical under the principle outlined in *Meric*.

Photochemical laboratory services.

107. By virtue of being a service in class 42 and being one that relates to services provided in a laboratory, it is my view that the above term is a scientific or technological service. As such, I consider that it falls within the opponent's term of "scientific and technological services". As a result, I consider that these services are identical under the principle outlined in *Meric*.

Conclusion on the goods and services comparison

108. Given the points of identity I have found above, it follows that the section 5(1) opposition against the first application succeeds in respect of all of those goods and services, being the following:[23]

Class 1: Chemicals used in industry, science and photography; sensitized unexposed papers, films, plates, foils, offset printing plates, cinematographic films; sensitized cloth for photography; photographic emulsions; photographic developers; chemicals for photographic and graphic systems, purposes and films; unexposed x-ray films; self-toning paper; adhesives used in industry; Cinematographic film, sensitized but not exposed; Cinematographic films, sensitized but not exposed; Sensitized photographic film; Unexposed camera film; Unexposed cinematographic film; Unexposed cinematographic films; Unexposed photographic film; Unexposed photographic films.

Class 9: Image and sound recording films, apparatus and instruments; audio recordings; holograms; slides (photography), exposed films; optical plates, editing appliances for cinematographic films; filters (photography); reproduction and enlarging apparatus; video tapes, animated cartoons; photographic, cinematographic and electric, electronic apparatus and instruments; optical and opto-electronic data carriers; cinematographic films.

Class 16: Paper, cardboard, photographs, prints; printed matter; printing blocks, stencils, masks; mimeograph apparatus and machines; printing blocks.

[23] On this point, I note that I have found a term to be identical but have made backup findings of similarity in respect of the same. That term is listed here (and is underlined for reference) as it is my primary finding that it is identical to services in the opponent's specification. However, those services will remain at issue for the section 5(2) grounds in the event that it is held on appeal it is not identical.

Class 39: Handling, sorting and packaging of (unexposed) raw roll-film (master rolls, semi-finished).

Class 40: Photographic laboratory services; image and film processing; development of fixed image and moving image films; photographic printing, processing, enlargement, reproduction, reduction and graphic reproduction; processing of unexposed raw film material (manufacture and protective sheathing); processing of (exposed) cinematographic films; creating cinematographic film copies; photocomposing services.

Class 42: Scientific (photo) chemical research and development and chemistry services; photochemical laboratory services.

109. As for the similar goods and services (or dissimilar goods and services, for that matter), the opposition in respect of the first application under section 5(1) fails. However, the opposition may still proceed in reliance upon the section 5(2)(a) ground for all of the similar goods and services (including those I have underlined above in the event that I was wrong to deem it identical).

110. In respect of the oppositions against the other applications under the section 5(2)(b) ground, it follows that where the goods and services are identical or similar, they may proceed. However, where there is no similarity of goods or services, there can be no likelihood of confusion under section 5(2)(b) grounds (or section 5(2)(a) for that matter).[24] As a result, my findings above mean that the present grounds fail in respect of the following goods and services, being those that I have either found dissimilar or those that the opponent appears to have dropped its oppositions under the present ground for:

Class 9: Photovoltaic cells.

[24] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA.

Class 41: Entertainer services; recreation services; information about events (entertainment); information about leisure activities; preparation of translations; providing karaoke facilities; career counseling; operation of a discotheque; operating a club (entertainment or teaching); running a boarding school; operation of a gaming casino; operation of museums (performances, exhibitions); operation of night clubs; operation of amusement arcades; operation of sports facilities; operation of amusement parks; operation of zoological gardens; operation of holiday camps (entertainment); running health clubs; operation of golf courses; operation of kindergartens (education); operation of sports camps; operation of variety theaters; book lending (lending library); coaching; demonstration lessons in practical exercises; desktop publishing (creating publications using computers); fitness studio services; publishing services, except printing; newspaper reporting services; interpreting sign language; conducting educational exams; conducting games on the internet; conducting dance events; conducting live events; advance ticket sales (entertainment); creation of subtitles; creation of photo reports; education at academies; correspondence courses; distance learning; gambling; gymnastics classes; publication of texts, other than publicity texts; calligraphy services; composing music; layout services, except for advertising purposes; microfilming; musical performances (orchestras); music production; game services provided online (from a computer network); publication of electronic books and journals on-line; organization and implementation of cultural and sporting events; arranging and conducting conferences; organization and holding of congresses; organization and conducting of concerts; arranging and conducting fashion shows for entertainment purposes; organization and holding of symposiums; educational advice; party planning (entertainment); personnel development through basic and advanced training; seat reservations for

entertainment events; publication of printed matter (including in electronic form), other than for advertising purposes; publication of magazines and books in electronic form, including on the internet; religious education; radio entertainment; training; sporting and cultural activities; synchronization; theatrical performances; animal training; training; physical education; organization of sporting competitions; arranging and conducting seminars; arranging and conducting of workshops (training); arranging and conducting of colloquiums; organization of exhibitions for cultural or educational purposes; organization of balls; organization of lotteries; organization of beauty contests; organization of entertainment shows (artist agencies); organization of competitions (education or entertainment); writing of scripts; writing of texts, other than publicity texts; rental of audio equipment; rental of lighting apparatus for stage equipment and television studios; rental of stage sets; rental of camcorders; rental of film equipment and accessories; rental of motion pictures (film rental); rental of musical instruments; rental of radio and television sets; four rental of play equipment; rental of toys; rental of sports equipment, except vehicles; rental of scuba diving equipment; rental of tennis courts; rental of theatrical sets; rental of sound recordings; rental of video cameras; rental of stadiums; publication of books; video rental (tapes); video rental (cassettes); timing at sporting events; circus performances.

The average consumer and the nature of the purchasing act

111. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

112. The goods and services at issue are disparate and, therefore, they will be selected by a range of different average consumer groups. This will include members of the general public at large, professionals or members of the trade (for goods and services that relate to education and training, for example) and business users from a number of industries such as photography, film and television and, science and industry. The varying goods and services are likely to be available across a number of different providers, including general or specialist retailers and the provider of the goods/services directly. Regardless of who is selecting the goods or services, I consider that, for the most part, the visual component will play the greater role during the selection process. I say this because the goods are likely to be self-selected by the consumer either after taking them from shelves, seeing an image of them on a website or selecting them from a list of goods. As for the services, these are likely to be selected from lists or pamphlets or via menus viewed on websites. I appreciate that there may also be an aural component to the selection process for all goods and services in the form of word-of-mouth recommendations or advice from sales assistants. In respect of the latter point, I will say that the aural component may play a greater role for some of the more involved and expensive services (such as scientific research, for example), though it will still not be the dominant means of selection.

113. Given what I have said above, it should come as no surprise that the cost and frequency of selection for the goods and services at issue will vary quite considerably from free goods that are selected frequently such as digital recordings

(which can include downloadable podcasts) to expensive and infrequently selected goods such as scientific research.

114. In terms of the level of attention paid, I consider that this will vary quite considerably. I do not intend to go over each and every consideration for the various range of goods and services at issue, however, I will briefly discuss the lowest and highest ends. On the lower end of the scale, I consider that goods such as digital recordings can include goods such as free downloadable podcasts or short form videos that will be selected at a relatively low degree of attention. On the other end of the scale sits services such as scientific research. These are very broad services and can cover in depth services that, when selecting them, the user will consider factors relating to the expertise of the provider, the scientists involved, the level of testing that will be undertaken, any peer review statistics stemming from the laboratory and information surrounding previous research undertaken. These goods are likely to be expensive and, given the factors at play, I consider that they will be selected by the consumer after having paid a relatively high degree of attention. Between these two ends of the scale, I consider that the goods and services will range in the level of attention they attract but, for the most part, they will likely be at a medium degree on the basis that they are likely to be ordinary selections that are unlikely to be selected casually.

Comparison of the marks

115. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

116. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

117. 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.

118. While the issue of identity between the marks in the first application and the opponent's fourth mark is not relevant to the section 5(2)(b) grounds, I mention it here because it forms part of the consideration of confusion I must make below under the section 5(2)(a) ground. As a result, the only comparisons I am required to make at this point is in respect of the marks in the second through fourth applications only.

119. The respective trade marks are shown below:

The opponent's fourth mark	The applications
ORWO	ORWO ("the second application") ORWO ("the third application")

	 ("the fourth application")

120. I note that I have submissions from the opponent as to the similarity of the marks. As for the applicant, I note that it has denied that the marks at issue are similar. I will not reproduce those submissions here but confirm that I have taken them into account in making the following comparison.

Overall impression

121. The opponent's fourth mark is a figurative mark that consists of the letters 'OR' placed above the letters' WO'. The letters are presented in black and are presented in a standard bold typeface. The letters sit on a white background. In respect of the overall impression of the mark, this is dominated by the letters in the mark with the presentation (the 'OR' being above the 'WO') playing a much lesser role. As for the typeface of the letters, I do not consider that this has any impact on the overall impression of this mark.

122. The mark in the second application is a word only mark that consists solely of the letters 'ORWO'. There are no other elements in the mark so its overall impression is dominated by those letters. The mark in the third application is a figurative mark that consists of the letters 'OR' above 'WO'. The letters are presented in a standard white typeface and on a grey circular background. Given the banality of the background device, I find that the overall impression of this mark lies primarily in the letters 'OR-WO' with the presentation playing a lesser role. As for the device and typeface used, these will have a negligible impact. Lastly, the mark in the fourth application is a figurative mark that consists of the letters 'OR'

that sit above the letters ‘WO’. These letters are presented in a standard black typeface. Below these letters is the word ‘STUDIOS’ which is also presented in a standard black typeface, albeit a slightly different style. As the word ‘STUDIOS’ is indicative of a type of business endeavour, I find that it will have a lesser impact on the mark. In considering the mark as a whole, I consider that the letters ‘OR-WO’ will play the greatest role. The word ‘STUDIOS’ will play a lesser role along with the presentation of the mark (being the ‘OR’ above the ‘WO’).

Visual comparison

The opponent’s fourth mark and the second application.

123. Visually, these marks share the letters ‘ORWO’. However, these letters are presented differently on the basis that, in the opponent’s mark, ‘OR’ is above ‘WO’ whereas it is presented simply as one word in the applicant’s mark. Given that notional and fair use of word only marks means that they can be presented in any standard typeface, I find that the typeface used in the opponent’s mark is not a point of visual distinction because it is my view that the applicant’s word only mark may be presented in the same typeface. Taking all of this into account and despite the fact that the letters are presented in a stacked manner in the opponent’s mark, I consider that the marks are visually similar to a high degree.

The opponent’s fourth mark and the third application.

124. Both of these marks consist of the letters ‘OR’ that sit above the letters ‘WO’. As a black and white mark, the opponent’s mark is capable of being presented in a white typeface and on a grey background. Therefore, these presentational elements are not points of distinction between the marks. That being said, the marks cannot be said to be presented in the same typeface as the other, although I appreciate that both are standard typefaces. The marks also differ in the presence of the circular background in the applicant’s mark. Despite the role these elements play in their respective marks, they are still points of visual difference, albeit slight

ones. Taking all of this into account and bearing in mind the overall impressions of these marks, I find that they are visually similar to a very high degree.

The opponent's fourth mark and the fourth application.

125. Insofar as the 'OR-WO' element of these marks goes, they are identical. The marks differ only in the presence of the word 'STUDIOS' below the shared 'OR-WO' element. While this word plays a lesser role in the overall impression of the mark, it is still a point of visual difference. Taking into account the identity of the 'OR-WO' element and its role in both parties' marks, I find that these marks are similar to a high degree.

Aural comparison

The opponent's fourth mark and the second and third applications.

126. Regardless of whether these marks are pronounced as 'OR-WOH', 'OR-WOE' or as their individual letters, they are identical.

The opponent's fourth mark and the fourth application.

127. The shared 'OR-WO' element will be pronounced identically with the difference coming from the word 'STUDIOS' which, regardless of its role in the applicant's mark, will still be pronounced.[25] Taking into account the length of the point of aural difference (being three syllables) but also bearing in mind that the point of identity sits at the beginning of the marks,[26] I find that these marks are aurally similar to a medium degree.

[25] On this point, I refer to the case of *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22) wherein Mr Phillip Harris, sitting as the Appointed Person, stated that descriptiveness of an element does not render it aurally invisible.
[26] Being where consumers tend to focus. See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Conceptual comparison

The opponent's fourth mark and the second and third applications.

128. I consider that the element of 'ORWO' will, in all of the marks at issue, be perceived either as a single word or an initialism.[27] Regardless of whether it is viewed as one word or an initialism, I do not consider that it will have any immediately graspable concept to the average consumer in the UK.

129. As a result of the above, I do not consider that this element in either of the parties' marks attracts a known meaning. Therefore, I find that the marks are not capable of being compared from a conceptual standpoint. They are, therefore, conceptually neutral.

The opponent's fourth mark and the fourth application.

130. Following what I have said above, I find that the 'ORWO' element across these marks is conceptually neutral. That being said, the addition of the ordinary dictionary word 'STUDIOS' creates a conceptual difference between the marks. Despite the conceptual neutrality of the dominant elements of these marks, they are, technically, conceptually dissimilar.

Distinctive character of the opponent's fourth mark

131. 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

[27] I have given consideration as to whether it would, when presented as 'OR' above 'WO', be perceived as two words. While 'OR' may be seen as a word, 'WO' is clearly not. As such, I do not consider that a significant part of the relevant public would, when viewing the mark as a whole, see it as two words (i.e. 'OR' followed by two random letters).

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)."

132. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced through use and, on this point, I note that the opponent has filed evidence of use. I will, therefore, consider whether this evidence is sufficient to give rise to a finding that the distinctiveness of the opponents fourth mark has been enhanced through use. Before doing so, I will consider the inherent position.

133. As set out above, the opponent's fourth mark is a figurative mark that consists solely of the letters 'OR' above the letters 'WO'. While presented in a bold typeface, the standard typeface used will not contribute to the distinctiveness of the mark. I am of the view that there are two perceptions of this mark that will result in different

levels of distinctiveness.[28] Firstly, as I have mentioned above, the opponent's mark may be perceived as an initialism. In the event that it is, I consider that the inherent distinctiveness of the mark will be medium. While consumers are used to seeing trade marks that consist of initialisms (which would ordinarily point to a lesser degree of distinctiveness), I consider that the use of four-letters is somewhat unusual and, further, the repetition of the 'O' sound makes it more distinctive than, say, three random letters. Secondly, I consider that the mark may also be perceived as just one word, being 'ORWO'. If it is, it will be perceived as a made-up word with no obvious meaning and, as such, I consider that its inherent distinctiveness will be at a high level.

134. Turning to consider the issue of enhanced distinctiveness, I remind myself that I have summarised the opponent's evidence at paragraphs 29 to 43 above. While this evidence was discussed in relation to the opponent's first through third marks, I consider that it is equally relevant here as it represents the entirety of the opponent's use of any of its marks. While I do not consider it necessary to reproduce that summary here, I remind myself that it was sufficient to give rise to a finding that the opponent had genuinely used its marks during the relevant period. That being said, I also remind myself that the requirement for a finding of an enhanced distinctive character is considerably more onerous than that of genuine use. I say this on the basis that use need not be quantitatively significant in order for it to be genuine. On the contrary, a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods as originating from a particular undertaking.

135. As set out above, the bulk of the opponent's evidence stems from sales to just one undertaking (being Medion) in the UK. While these sales may be of a high volume (especially considering the very low cost of some of the goods covered by the invoices), I cannot overlook the fact that they cover sales to just one customer and, as set out above, they also include goods that are not at issue here. I

[28] For the avoidance of doubt, it is my view that each of the groups of consumers that perceive the marks in these different ways will constitute a significant proportion of average consumers.

appreciate that there is mention of some of the sales being for the supermarket chain, Aldi, but there is nothing to suggest what this means. In my view, it could realistically be said that the goods are either being bought in bulk and sold at Aldi stores (possibly being repurposed to be Aldi branded goods) or that they are printed goods that Aldi use in their stores or in their corporate offices (such as advertising banners or prints, for example). In short, there is nothing to suggest who the end consumer for these goods is and, regardless of who it is (be that Aldi or members of the general public at large), what their exposure to the ORWO brand is. While some catalogue evidence showing the goods has been provided, this offers nothing upon which I can categorically rely on to demonstrate how the goods sold here reach the end consumer. On this point, I remind myself that the catalogues are in the German language and there is nothing to suggest they are viewed by UK-based consumers.[29]

136. Taking all of the above in to account, I accept that the opponent has continued to sell a significant amount of goods in the UK since 2015. However, this is to just one customer and I do not consider that such use can be said to be sufficient to give rise to a finding that the opponent's fourth mark had become known to a significant part of the average consumer base in the UK by the relevant date. As a result, I do not consider that the distinctiveness of the opponent's fourth mark has become enhanced through the use made of it. Therefore, the inherent position applies.

Likelihood of confusion

137. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global

[29] It is worth pointing out here that while EU use prior to IP Completion Day may have been relevant for the issue of genuine use, it is not relevant for the issue of enhanced distinctiveness.

assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's fourth mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their minds.

138. In respect of indirect confusion, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This

may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

139. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

140. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

141. I have found the goods and services at issue to be either identical or similar to varying degrees, including low. The average consumer base is formed of members of the general public, professional users and business users operating in different trades/industries. The consumers will pay varying degrees of attention when selecting the goods and services at issue and this will range from low to relatively high. The selection process will be predominately visual but an aural component

will not be ignored and, in some instances, it may even play a fairly prominent role. In respect of the marks at issue, I have found the opponent's fourth mark to be:

a. Identical to the marks in the first application;
b. Visually similar to a high degree, aurally identical and conceptually neutral with the marks in the second application;
c. Visually similar to a very high degree, aurally identical and conceptually neutral with the marks in the third application; and
d. Visually similar to a high degree, aurally similar to a medium degree and conceptually dissimilar (albeit the dominant elements are conceptually neutral) with the mark in the fourth application.

142. Lastly, I have found that the opponent's fourth mark possesses either a medium or a high degree of inherent distinctiveness depending on how the mark is perceived by consumers in the UK. In terms of enhanced distinctiveness, I have found that the evidence provided is insufficient to give rise to a finding that this has been enhanced to any degree.

143. I will deal first with the opposition against the applicant various applications in turn.

The first application

144. Taking all of the above factors into account, particularly the identity of the marks at issue, I am satisfied that the average consumer would likely mistake the parties' marks for each other, even where the goods or services are only similar to a low degree and where the earlier mark is only viewed as distinctive to a medium degree. I am, therefore, satisfied that there will be a likelihood of direct confusion between the first application and the opponent's fourth mark. For the avoidance of doubt, I consider that the identity of the marks means that this finding applies regardless of (1) the level of similarity of the goods or services at issue and (2) the level of attention paid by the consumer.

145. As a result of the above, I hereby find that the opposition in reliance upon the section 5(2)(a) ground against the first application succeeds in respect of all of the goods and services that I have found to be similar.

The second application

146. In considering the second application, I remind myself that a significant proportion of average consumers will view the opponent's mark as one word, despite being spread across two lines. On this point, I refer to the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 wherein Kitchin LJ set out that if a significant proportion of consumers are confused then a court is entitled to find infringement.[30] As a result, in considering the second application, it is upon these consumers that I will focus.

147. As the mark in the second application is a word only mark, it is capable of being presented in the same standard typeface as that used by the opponent. While I appreciate that the opponent's mark presents the letters 'OR' above 'WO' and not alongside each other, I consider that the marks are likely to be mistaken for one another. This is on the basis that the marks share the identical element 'OR-WO' and regardless of how this is presented, I am of the view that consumers will misremember which mark consisted of the word presented simply as 'ORWO' and which had the letters 'OR' above 'WO'. Therefore, taking all of the above into account and bearing in mind the principle of imperfect recollection, I find that there exists a likelihood of direct confusion between the second application and the opponent's fourth mark. Given the higher levels of visual similarity and aural identity between the marks, I am of the view that this finding applies even in circumstances where the marks are viewed on goods or services that are similar to only a low degree and where the consumer pays a higher degree of attention.

148. Turning to consider the issue of indirect confusion, I am of the view that if the stacking of the letters on top of each other is sufficient to enable consumers to

[30] While this was an infringement case, the principle equally applies to section 5(2) oppositions.

accurately recall the marks for one another, then the consumer is still likely to consider that they originate from the same undertaking. I consider that this is the case because consumers will simply view the presentational differences between the 'OR-WO' and 'ORWO' elements as alternative presentations of the same trade mark. Consequently, I consider that there exists a likelihood of indirect confusion between these marks, even in circumstances where the goods/services are only similar to a low degree and where the consumer pays a higher degree of attention.

149. As a result of the above, I hereby find that the opposition in reliance upon the section 5(2)(b) ground against the second application succeeds in respect of all of the goods and services that I have found to be identical and similar.

The third application

150. The marks at issue here are both representations of the letters 'OR-WO' with 'OR' placed above 'WO'. The presentational differences are only minor and, on the basis of the principle of imperfect recollection, I find that consumers are likely to overlook them. As a result, consumers will seek to recall the marks by reference to the fact that they consist of the letters 'OR' above 'WO'. In my view, the consumers are likely to be unable to accurately recall which mark had a circular background and which did not. Consequently, I consider that there exists a likelihood of direct confusion between the marks at issue regardless of whether the marks are viewed on goods or services that are similar to only a low degree or the level of attention paid by the average consumer.

151. In respect of indirect confusion, I am of the view that if the presentational differences are noted, the marks will plainly be viewed as alternative marks for one another. Therefore, the marks will be viewed as sharing the same origin, meaning that there exists a likelihood of indirect confusion between them. As was the case above, this applies regardless of the level of similarity between the goods and services or the degree of attention paid by the consumer.

152. As a result of the above, I hereby find that the opposition in reliance upon the section 5(2)(b) ground against the third application succeeds in respect of all of the goods and services that I have found to be identical and similar.

The fourth application

153. The ‘OR-WO’ element across these marks is presented in an identical manner. The point of difference is the word ‘STUDIOS’ in the fourth application. It is my view that the consumer, in seeking to recall these marks, will focus on the ‘OR-WO’ element. As such, they will overlook which mark consisted of the word ‘STUDIOS’ and which did not. I say this particularly on the basis that this word plays a lesser role in the overall impression of the fourth application because it will be understood simply as a reference to the type of business endeavour offered. As a result and bearing in mind all of the above factors and the principle of imperfect recollection, I consider that there exists a likelihood of direct confusion between the marks at issue. Given the levels of similarity between the marks, I consider that this finding applies regardless of whether the marks are viewed on goods or services that are similar to only a low degree or the level of attention paid by the average consumer.

154. In the event that the consumer was able to recall the marks at issue for one another thanks to the inclusion of the word ‘STUDIOS’, I consider that these marks represent a paradigm example of indirect confusion. I say this because the ‘OR-WO’ element will plainly be the indicator of origin for the marks and given its identity across them, consumers will believe this to be a reference to the undertaking responsible. As for the word ‘STUDIOS’, when viewed after the highly distinctive ‘ORWO’ element, it will simply be viewed as a reference to the business, much like the word ‘COMPANY’ or ‘LIMITED’ would be. As such, I consider that consumers would believe that the marks are alternate marks used by the same undertaking. Consequently, I consider that there exists a likelihood of indirect confusion between the marks. As was the case above, this applies regardless of the level of similarity of the goods/services at issue or the level of attention paid by the average consumer.

155. As a result of the above, I hereby find that the opposition in reliance upon the section 5(2)(b) ground against the fourth application succeeds in respect of all of the goods and services that I have found to be identical and similar.

Final remarks in respect of the section 5(1) and 5(2) grounds

156. Where the opposition based on the opponent's fourth mark failed, it was due to the dissimilarity between the goods and services. In respect of the remaining marks of the opponent, I remind myself that the only term for which they were found to have been genuinely used was "printed matter". This term was at issue in my comparison of the goods and services. It follows that if I thought that this term offered any level of similarity with the goods or services that I found to be dissimilar, I would have mentioned this above. As I did not, it can be taken that I also consider them dissimilar. As a result, I do not consider that any reliance upon the first through third marks of the opponent would put the opponent in a better position than the conclusion I reached in relation to its reliance upon the fourth mark.

157. I will now proceed to consider the section 5(3) ground of the oppositions.

Section 5(3)

158. Section 5(3) of the Act states:

> "5(3) A trade mark which –
>
> > is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (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 repute of the earlier trade mark."

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

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

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

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, 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 holder 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).*

160. Under the present ground, I remind myself that the opponent relies on all four of its marks. Three of those are comparable marks based on earlier EUTMs owned by the opponent. As such, EU use prior to IP Completion Day may be relevant to the issue of reputation. Further, I also remind myself that the opponent claims to enjoy a reputation in all of the goods and services covered by those marks' specifications.

Reputation

161. I summarised the entirety of the opponent's use of its first through third marks at paragraphs 29 to 43 above. I remind myself that this evidence was considered in respect of genuine use and, therefore, my assessment there was limited to the relevant period. While use prior to the relevant period is relevant here, I do not consider it to be of any issue to my assessment of a reputation because the evidence discussed above represented the entirety of the opponent's evidence of use. In addition, when assessing the enhanced distinctiveness of the opponent's fourth mark, I confirmed that this same summary was applicable to the use of that mark. As such, my summary at paragraphs 29 to 43 is wholly relevant to the present ground. On this point, I will say that at paragraphs 29 and 30 of Ms Snehotta's witness statement there is a sub-heading entitled 'Reputation'. This is evidence that I did not discuss above but, having considered it here, I will say that it consists of merely narrative explanations regarding the history of the business as well as vague references to 'extensive sales in the UK and the EU'. While noted, there is nothing in support of these *extensive sales* in either the UK and the EU beyond the invoices and turnover figures in respect of sales to Medion. In addition, there is reference to the opponent becoming a 'cult' brand around the world but, again, there is nothing to support such a statement. Ordinarily, I would expect such claims to be bolstered by the provision of supporting evidence in the form of press coverage to that effect or wider sales beyond that to just one company in the UK.

162. In considering the opponent's evidence under the scope of a reputation, I appreciate that I have found genuine use of the opponent's first through third marks. While that may be the case, this is not relevant here. I say this because the assessment for the existence of a reputation is, like the assessment for enhanced distinctiveness, more onerous than the test for genuine use.[31] As a result, I consider that the same outcome reached when assessing enhanced

[31] A finding of a reputation requires that the marks relied upon are known by a significant part of the relevant public in the relevant territory. This is not the case for genuine use which requires only that the opponent's use be sufficient to demonstrate an attempt to create or preserve a market share for the goods sold.

distinctiveness (being that found at paragraphs 134 to 136 above) is applicable here. While I appreciate that the present assessment covers a wider scope as evidence of EU sales may be relevant, the only solid evidence I have before me that actually points to use of the opponent's marks stems from sales of £2,680,000 worth of goods in the UK. I accept that this represents sales of a large volume of low-cost goods, however, the sales were to just one customer in the UK and I remind myself that the invoices provided in support of these sales figures included goods that are not at issue in the present oppositions. Further, there is nothing to suggest whether (or how) such goods were eventually sold to end consumers under the 'ORWO' brand or how the 'ORWO' branding would appear to those consumers. As for the Aldi related invoices, I acknowledge that Aldi is a leading supermarket in the UK but I repeat my point from above in that there is nothing to demonstrate how these goods reached the market or how they were ultimately viewed by the end consumers.

163. As a result of the above, I find that the opponent has failed to demonstrate that any of its marks had achieved a reputation amongst a significant part of the relevant public in the UK by the relevant date (including as a result of use in the EU prior to IP Completion Day). The section 5(3) grounds of all the oppositions, therefore, fail in their entirety.

164. Even if I was wrong to find that there exists no reputation in any of the opponent's marks, I do not consider that this would advance the opponent's case beyond the success the opponent achieved under the section 5(1) and 5(2) grounds I have assessed above. I say this because if there was to exist any reputation in the opponent's marks, it would be of a limited strength and would only vest in a limited range of printed materials in class 16. As was the case for my genuine use assessment, the invoices provided all cover a vast range of printed goods such as printed photographs, photo books, canvas prints, postcards and photo booklets that would, in my view, be fairly categorised as "printed matter". Further, the limited strength of the reputation can be pinned on the fact that a turnover of £2.6 million over six year is likely to represent a small proportion of sales associated with the market for printed matter.

165. If the opponent's marks were to be said to enjoy a reputation, then I accept that there would be a link (based on the factors set out in *Intel*, cited above) between them and the applications. However, this would only extend to goods or services that were identical and/or similar to the reputed goods of the opponent, being those for which the opponent has already succeeded against under its section 5(1) and 5(2) grounds. On this point, I appreciate that the existence of a link under section 5(3) does not necessarily require goods or services to be the same or even similar. That being said, it is my view that the limited strength of the opponent's reputation would not be sufficient to overcome the differences between said goods and services, particularly given their vastly disparate nature (for example, I fail to see how there would be a link between the opponent's reputed mark for "printed matter" and "photovoltaic cells" in the applicant's specifications). Accordingly, the section 5(3) grounds take the matter no further than the section 5(1) or 5(2) grounds.

166. Given that the opponent has withdrawn its section 5(4)(a) grounds, I will now proceed to consider the last ground pleaded in all oppositions, being that under section 3(6).

Section 3(6): legislation and case law

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

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

168. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

> "(i) […]

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

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*"), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

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

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

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

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

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive

right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

169. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard

applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

170. The pleaded case of the opponent is that the applicant knew of the opponent's marks when making its applications and, in filing said applications, it acted with the intention to disrupt the opponent's business for its own gain or that it intended to use its marks to gain an unfair advantage by exploiting the opponent's reputation. Further, the opponent claims that applicant has no intention to use the marks it has applied for. If proven, these claims are capable of pointing to acts of bad faith.

171. Having considered the opponent's evidence in full, it is noted that the opponent relies solely on narrative evidence wherein Ms Snehotta discusses ongoing disputes with and complaints against Mr Jake Seal and a company called FilmoTec GmbH Bitterfeld-Wolfen ("FilmoTec"). For the avoidance of doubt, the only supporting evidence in respect of the present ground that has been filed is an organogram of the opponent's group of companies.[32] It is noted that the applicant does not appear on this organogram.

172. While the narrative evidence focuses on Mr Jake Seal and FilmoTec, there is no mention of any claim as to their connection with the applicant. The only noted connection to the applicant itself and a named individual is in relation to Mr Michael Seal who Ms Snehotta claims to be the sole director of the applicant. It is alleged that Mr Michael Seal is Jake Seal's father. While Mr Michael Seal is not a party to these proceedings, I remind myself that a claim of bad faith is not to be avoided if it is proven that a person who owned or otherwise controlled the company behind the application was acting in bad faith.[33] As a result, it follows that if Michael Seal is proven to be the director of the applicant and that he acted in bad faith, his actions are capable of being attributed to the applicant.

173. As above, the opponent has only filed narrative evidence regarding the actions of other parties. While supporting documentation would be helpful in order to prove

[32] CS19
[33] *Joseph Yu v Liaoning Light Industrial Products Import and Export Corporation*, BL O/013/05

the connection to Mr Michael Seal, the lack of the same is not fatal to the opponent's case. I say this because in the present case, the applicant has not responded to the opponent's evidence in order to dispute that Michael Seal is its sole director. As a result, I am of the view that Ms Snehotta's narrative evidence is to be believed. Therefore, I accept that Mr Michael Seal is the director of the applicant. That being said, I remind myself that the bulk of the opponent's evidence focuses on Mr Jake Seal and FilmoTec. Aside from Jake Seal being Michael Seal's son, there is nothing before me regarding whether either of these parties have any control over the applicant. On this point, the familial relationship between Mr Jake and Mr Michael Seal cannot be taken as evidence that Mr Jake Seal has any control over the applicant. As such, and without anything further, I do not consider that the action of Mr Jake Seal or FilmoTec can be said to be attributed to the applicant.

174. As a result of the above, I am of the view that the only relevant evidence to the opponent's claim of bad faith is that which relates to Mr Michael Seal or the applicant itself. Aside from mentioning Mr Michael Seal in brief, there is nothing further regarding his actions. The only relevant evidence, therefore, is that which can be found at paragraph 38 of Ms Snehotta's narrative evidence. This sets out that the opponent has brought infringement proceedings in Germany against the applicant to prevent it from using various 'ORWO' signs for the distribution of photochemical products and/or undertakings related thereto.

175. While this is noted, the existence of infringement proceedings in another jurisdiction cannot, without anything further, be said to point to the existence of bad faith on the applicant's part. I say this because there is nothing to suggest that there has been any actual infringement as the outcome of those proceedings has not been provided. In addition, there is nothing to suggest when the infringement proceedings were brought and whether the behaviour complained about was prior to the relevant date for these proceedings.[34] As such, the existence of those proceedings alone cannot be said to point to the intentions of the applicant as at the date of filing for its marks in the UK. As a result, I am of the view that despite

[34] On this point, I note that at paragraph 38 of Ms Snehotta's witness statement when referring to these proceedings, she simply states that they are ongoing 'presently'.

being satisfied that Mr Michael Seal is the director of the applicant, the opponent has failed to raise a *prima facie* case that either Mr Michael Seal or the applicant have acted in bad faith in filing the applications in the UK.

176. As a result of the above, I find that the opponent's claim under section 3(6) of the Act has failed in its entirety.

CONCLUSION

177. The oppositions have succeeded to some degree and in reliance upon the section 5(1) and 5(2) grounds only. The applications are all, subject to any successful appeal against my decision, refused for the following goods and services:

Class 1: Chemicals used in industry, science and photography; sensitized unexposed papers, films, plates, foils, offset printing plates, cinematographic films; sensitized cloth for photography; photographic emulsions; photographic developers; chemicals for photographic and graphic systems, purposes and films; unexposed x-ray films; self-toning paper; adhesives used in industry; Cinematographic film, sensitized but not exposed; Cinematographic films, sensitized but not exposed; Sensitized photographic film; Unexposed camera film; Unexposed cinematographic film; Unexposed cinematographic films; Unexposed photographic film; Unexposed photographic films.

Class 9: Image and sound recording films, apparatus and instruments; audio recordings; holograms; slides (photography), exposed films; optical plates, editing appliances for cinematographic films; filters (photography); reproduction and enlarging apparatus; video tapes, animated cartoons; photographic, cinematographic and electric, electronic apparatus and instruments; optical and opto-electronic data carriers; cinematographic films.

Class 16: Paper, cardboard, photographs, prints; developed films; printed matter; printing blocks, stencils, masks; mimeograph apparatus and machines; printing blocks.

Class 39: Handling, sorting and packaging of (unexposed) raw roll-film (master rolls, semi-finished).

Class 40: Photographic laboratory services; image and film processing; development of fixed image and moving image films; photographic printing, processing, enlargement, reproduction, reduction and graphic reproduction; processing of unexposed raw film material (manufacture and protective sheathing); processing of (exposed) cinematographic films; creating cinematographic film copies; photocomposing services.

Class 41: Television entertainment; entertainment; compilation of radio and television programs; education and training advice; training; education and instruction; operation of recording studios; film studios; recording of video tapes; sound and television studio services; film production; film production (in studios); editing of video tapes; production of shows; video film production; film shooting; film screenings in cinemas; digital picture service; taking photos; photography; providing electronic publications, not downloadable.

Class 42: Scientific (photo) chemical research and development and chemistry services; photochemical laboratory services.

178. However, the applications may proceed to registration for the following goods and services (again, subject to any successful appeal of my decision), being those that I have found to be dissimilar:

Class 9: Photovoltaic cells.

Class 41: Entertainer services; recreation services; information about events (entertainment); information about leisure activities; preparation of translations; providing karaoke facilities; career counseling; operation of a discotheque; operating a club (entertainment or teaching); running a boarding school; operation of a gaming casino; operation of museums (performances, exhibitions); operation of night clubs; operation of amusement arcades; operation of sports facilities; operation of amusement parks; operation of zoological gardens; operation of holiday camps (entertainment); running health clubs; operation of golf courses; operation of kindergartens (education); operation of sports camps; operation of variety theaters; book lending (lending library); coaching; demonstration lessons in practical exercises; desktop publishing (creating publications using computers); fitness studio services; publishing services, except printing; newspaper reporting services; interpreting sign language; conducting educational exams; conducting games on the internet; conducting dance events; conducting live events; advance ticket sales (entertainment); creation of subtitles; creation of photo reports; education at academies; correspondence courses; distance learning; gambling; gymnastics classes; publication of texts, other than publicity texts; calligraphy services; composing music; layout services, except for advertising purposes; microfilming; musical performances (orchestras); music production; game services provided online (from a computer network); publication of electronic books and journals on-line; organization and implementation of cultural and sporting events; arranging and conducting conferences; organization and holding of congresses; organization and conducting of concerts; arranging and conducting fashion shows for entertainment purposes; organization and holding of symposiums; educational advice; party planning (entertainment); personnel development

through basic and advanced training; seat reservations for entertainment events; publication of printed matter (including in electronic form), other than for advertising purposes; publication of magazines and books in electronic form, including on the internet; religious education; radio entertainment; training; sporting and cultural activities; synchronization; theatrical performances; animal training; training; physical education; organization of sporting competitions; arranging and conducting seminars; arranging and conducting of workshops (training); arranging and conducting of colloquiums; organization of exhibitions for cultural or educational purposes; organization of balls; organization of lotteries; organization of beauty contests; organization of entertainment shows (artist agencies); organization of competitions (education or entertainment); writing of scripts; writing of texts, other than publicity texts; rental of audio equipment; rental of lighting apparatus for stage equipment and television studios; rental of stage sets; rental of camcorders; rental of film equipment and accessories; rental of motion pictures (film rental); rental of musical instruments; rental of radio and television sets; four rental of play equipment; rental of toys; rental of sports equipment, except vehicles; rental of scuba diving equipment; rental of tennis courts; rental of theatrical sets; rental of sound recordings; rental of video cameras; rental of stadiums; publication of books; video rental (tapes); video rental (cassettes); timing at sporting events; circus performances.

COSTS

179. Despite the length of the class 41 services that are permitted to registration, I am of the view that the opponent has enjoyed the greater degree of success in opposing the applications. As such, I consider that it is the opponent that is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. That being said, I do consider it appropriate to make a

slight reduction to the opponent's costs award to reflect the applicant's degree of success.

180. In the circumstances, I award the opponent the sum of £2,400 as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering the counterstatement in response (£250 x 4):	£1,000
Preparing evidence and filing written submissions:	£800
Reduction:	*-£200*
Sub-total:	£1,600
Official fees (x4) (not subject to reduction)	£800
Total:	**£2,400**

181. I hereby order Orwo Limited to pay ORWO Net Gesellschaft mit beschränkter Haftung the sum of £2,400. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 7th day of January 2025

A COOPER
For the Registrar

ANNEX 1

Class 1

Chemicals used in industry, science and photography; sensitized unexposed papers, films, plates, foils, offset printing plates, cinematographic films; sensitized cloth for photography; photographic emulsions; photographic developers; chemicals for photographic and graphic systems, purposes and films; unexposed x-ray films; self-toning paper; adhesives used in industry; Cinematographic film, sensitized but not exposed; Cinematographic films, sensitized but not exposed; Sensitized photographic film; Unexposed camera film; Unexposed cinematographic film; Unexposed cinematographic films; Unexposed photographic film; Unexposed photographic films.

Class 9

Image and sound recording films, apparatus and instruments; audio recordings; holograms; slides (photography), exposed films; optical plates, editing appliances for cinematographic films; filters (photography); photovoltaic cells; reproduction and enlarging apparatus; video tapes, animated cartoons; photographic, cinematographic and electric, electronic apparatus and instruments; optical and opto-electronic data carriers; cinematographic films.

Class 16

Paper, cardboard, photographs, prints; developed films; printed matter; printing blocks, stencils, masks; mimeograph apparatus and machines; printing blocks.

Class 39

Handling, sorting and packaging of (unexposed) raw roll-film (master rolls, semi-finished).

Class 40

Photographic laboratory services; image and film processing; development of fixed image and moving image films; photographic printing, processing, enlargement, reproduction, reduction and graphic reproduction; processing of unexposed raw film material (manufacture and protective sheathing); processing of (exposed)

cinematographic films; creating cinematographic film copies; photocomposing services.

Class 41

Film studios; preparation of translations; recording of video tapes; education and training advice; training; information about leisure activities; information about events (entertainment); providing electronic publications, not downloadable; providing karaoke facilities; career counseling; operation of a discotheque; operating a club (entertainment or teaching); running a boarding school; operation of a gaming casino; operation of museums (performances, exhibitions); operation of night clubs; operation of amusement arcades; operation of sports facilities; operation of recording studios; operation of amusement parks; operation of zoological gardens; operation of holiday camps (entertainment); running health clubs; operation of golf courses; operation of kindergartens (education); operation of sports camps; operation of variety theaters; book lending (lending library); coaching; demonstration lessons in practical exercises; desktop publishing (creating publications using computers); entertainer services; recreation services; fitness studio services; sound and television studio services; publishing services, except printing; newspaper reporting services; digital picture service; interpreting sign language; conducting educational exams; conducting games on the internet; conducting dance events; conducting live events; advance ticket sales (entertainment); creation of subtitles; creation of photo reports; education at academies; education and instruction; correspondence courses; television entertainment; distance learning; film production; film production (in studios); film screenings in cinemas; taking photos; gambling; gymnastics classes; publication of texts, other than publicity texts; calligraphy services; composing music; layout services, except for advertising purposes; microfilming; editing of video tapes; musical performances (orchestras); music production; game services provided online (from a computer network); publication of electronic books and journals on-line; organization and implementation of cultural and sporting events; arranging and conducting conferences; organization and holding of congresses; organization and conducting of concerts; arranging and conducting fashion shows for entertainment purposes; organization and holding of symposiums; educational advice; party planning (entertainment); personnel development through basic and advanced training; seat

reservations for entertainment events; production of shows; publication of printed matter (including in electronic form), other than for advertising purposes; publication of magazines and books in electronic form, including on the internet; religious education; radio entertainment; training; sporting and cultural activities; synchronization; theatrical performances; animal training; training; physical education; entertainment; organization of sporting competitions; arranging and conducting seminars; arranging and conducting of workshops (training); arranging and conducting of colloquiums; organization of exhibitions for cultural or educational purposes; organization of balls; organization of lotteries; organization of beauty contests; organization of entertainment shows (artist agencies); organization of competitions (education or entertainment); writing of scripts; writing of texts, other than publicity texts; rental of audio equipment; rental of lighting apparatus for stage equipment and television studios; rental of stage sets; rental of camcorders; rental of film equipment and accessories; rental of motion pictures (film rental); rental of musical instruments; rental of radio and television sets; four rental of play equipment; rental of toys; rental of sports equipment, except vehicles; rental of scuba diving equipment; rental of tennis courts; rental of theatrical sets; rental of sound recordings; rental of video cameras; rental of stadiums; publication of books; video film production; video rental (tapes); video rental (cassettes); timing at sporting events; circus performances; compilation of radio and television programs; photography; film shooting.

Class 42

Scientific (photo) chemical research and development and chemistry services; photochemical laboratory services.

ANNEX 2

The opponent's first mark

Class 1

Chemicals used in industry, science and photography; Unexposed sensitised papers, films, plates, foils, Offset printing plates,Cinematic films, Sensitised cloth for photography; Photographic emulsions; Developers; Chemicals for photographic and graphic systems, Purposes and Films; Unexposed x-ray film; Self-toning paper; Adhesives used in industry.

Class 9

Image and sound recording films, apparatus and instruments; Exposed films and slides; Optical disks, Editing appliances for cinematographic films; Filters, for photography; Photovoltaic cells; Duplicating and and Magnifying apparatus; Animated films and videos; Photographic,Cinematographic and Electric, Electronic apparatus and instruments, Namely analog and digital cameras and video cameras and other devices for taking pictures; Optical apparatus and instruments and Optoelectronic data carriers.

Class 16

Paper, Cardboard, Cardboard, Photographs, Prints; Developed films and cinematographic films; Printed matter; Printing blocks, Stencils,Masks for reproductions; Duplicators and Photo-copying Machines, Printing blocks.

Class 40

Photographic laboratory services; Image and Processing of cinematographic films; Development of fixed image and moving image films; Photographic printing, processing, enlargement, reproduction, reduction and graphic reproduction; Processing of unexposed raw film material (manufacture and protective sheathing); Processing of (exposed) cinematographic films; Creating cinematographic film copies.

The opponent's second mark

Class 1

Chemicals used in industry, science and photography; sensitized unexposed papers, films, plates, foils, offset printing plates, cinematographic films; sensitized cloth for photography; photographic emulsions; photographic developers; chemicals for photographic and graphic systems, purposes and films; unexposed x-ray films; self-toning paper; adhesives used in industry.

Class 9

Image and sound recording films, apparatus and instruments; slides (photography), exposed films; developed films and cinematographic films; optical plates, editing appliances for cinematographic films; filters [photography]; photovoltaic cells; reproduction and enlarging apparatus; video tapes, animated cartoons; photographic, cinematographic and electric, electronic apparatus and instruments; optical and opto-electronic data carriers.

Class 16

Paper, cardboard, photographs, prints; printed matter; printing blocks, stencils, masks; mimeograph apparatus and machines, printing blocks.

Class 40

Photographic laboratory services; image and film processing; development of fixed image and moving image films; photographic printing, processing, enlargement, reproduction, reduction and graphic reproduction; processing of unexposed raw film material (manufacture and protective sheathing); processing of (exposed) cinematographic films; creating cinematographic film copies.

The opponent's third mark

Class 1

Chemicals used in industry, science and photography; sensitized unexposed papers, films, plates, foils, offset printing plates, cinematographic films; sensitized cloth for photography; photographic emulsions; photographic developers; chemicals for

photographic and graphic systems, purposes and films; unexposed x-ray films; self-toning paper; adhesives used in industry.

Class 9

Image and sound recording films, apparatus and instruments; slides (photography), exposed films; optical plates, editing appliances for cinematographic films; filters (photography); photovoltaic cells; reproduction and enlarging apparatus; video tapes, animated cartoons; photographic, cinematographic and electric, electronic apparatus and instruments; optical and opto-electronic data carriers.

Class 16

Paper, cardboard, photographs, prints; developed films and cinematographic films; printed matter; printing blocks, stencils, masks; mimeograph apparatus and machines, printing blocks.

Class 40

Photographic laboratory services; image and film processing; development of fixed image and moving image films; photographic printing, processing, enlargement, reproduction, reduction and graphic reproduction; processing of unexposed raw film material (manufacture and protective sheathing); processing of (exposed) cinematographic films; creating cinematographic film copies.

The opponent's fourth mark

Class 1

Unexposed sensitised paper; unexposed photographic paper; x-ray films, sensitized but not exposed; unexposed sensitized plates; sensitized microfilms, unexposed; sensitized films, unexposed; unexposed photographic plates; photographic film, not exposed; strips of sensitised photographic film [unexposed]; self-toning paper [photography]; film strength improving agents; films (sensitized, unexposed -) for use in photography; sensitized photographic plates; sensitized plates for offset printing; sensitized cloth for photography; sensitized photographic film; adhesives for use in photography; adhesives for use in industry; photographic media [films, unexposed];

photographic media [chemicals]; photographic emulsions; photographic developers; chemical preparations for use in photography; chemical products for the manufacture of photographic products; chemicals used in science; chemical preparations and materials for film, photography and printing; industrial chemicals; chemicals for use in coating film; chemicals for off-set presses; chemicals used for printing or the printing of texts, images, words or graphics; chemicals for use in electrophotography; chemicals for use in transfer printing; inorganic chemical for use in science; inorganic chemicals for use in industry.

Class 9

Animated cartoons; scientific apparatus and instruments; enlarging apparatus [photography]; telecommunications apparatus and instruments; videotapes; bags for cameras; secure digital (sd) memory cards; optic discs carrying audio recordings; optical discs; optical electronic components; optical data media; optical apparatus and instruments; digital optical transmission apparatus; multimedia apparatus and instruments; multi-media recordings; apparatus for editing cinematographic film; magnetic recording tapes; movie film developing machines; film cameras; cinematographic films; instruments for producing photographs; instruments for analysing photographs; information technology and audio-visual, multimedia and photographic devices; recording apparatus; apparatus and instruments for reproducing of data; radio apparatus and instruments; photographic equipment; photographic duplicating apparatus; photographic negatives; filters for use in photography; photographic developing apparatus; photographic apparatus and instruments; cameras [photography]; film lenses; cinematographic machines and apparatus; film recorders; pouches for photographic apparatus; darkroom lamps [photography]; digital recording media; digital recordings; transparencies [photography]; computer software to enable the transmission of photographs to mobile telephones; computer software for recording sound; chemistry apparatus and instruments; photographic plates [exposed]; photographic film [exposed]; films, exposed; exposed photographic slides; audio/visual and photographic devices; photographic print-making apparatus; photographic processing apparatus; apparatus for the processing of images; film developing apparatus; apparatus for the transmission of data; display devices, television receivers and film and video devices.

Class 14

Digital clocks; jewels; jewellery boxes; cabochons; ornaments [jewellery, jewelry (am.)]; clocks; cases for clock- and watchmaking; fittings for watches.

Class 16

Mimeograph apparatus and machines; photograph stands; stencils [stationery]; photographs [printed]; cardboard; cardboard; cardboard; paper; paper for printing photographs; paper; paper; canvas panels for artists; plastic pages with pockets for holding photographs; adhesive corners for photographs; cardboard packaging; calendars; calendar desk pads; photographic reproductions; photographic or art mounts; photographic albums; printing blocks; printed matter; prints; pictures; cardboard containers; photographic mounting boards.

Class 18

Briefcases [leather goods]; briefcases and attache cases; pocket wallets; purses; luggage, bags, wallets and carrying bags; luggage; handbags; card wallets [leatherware]; tie cases; art portfolios [cases]; umbrellas; bags; bags; key cases; rucksacks; trunks and suitcases; bags; bags [envelopes, pouches] of leather, for packaging.

Class 20

Disc cabinets [furniture]; clip frames; holders for photographs [frames]; photograph frames; picture and photograph frames; picture frames of precious metal; picture frames [not of precious metal]; picture frames; display stands [non-metallic]; non-metal picture hangers; boards for the display of printing materials; boards for the display of pictorial materials.

Class 25

Footwear; footwear; footwear; headgear; waist belts; clothing; clothing.

Class 28

Gloves made specifically for use in playing sports; jigsaw puzzles; playing cards; toys; sporting articles.

Class 35

Preparation of advertising material; compilation, production and dissemination of advertising matter; advertising; publication of publicity materials; graphic advertising services; demonstration of photographic equipment [for advertising purposes]; document reproduction [photocopying services]; distribution of advertising material; direct mail advertising; publication of printed matter for advertising purposes; electronic publication of printed matter for advertising purposes; employment agency services for booking film and television technicians; promoting the sale of goods and services of others through the distribution of printed material and promotional contests; document reproduction; production of advertising matter and commercials; production of video recordings for advertising purposes; wholesale services in relation to printed matter; business management consultancy and advisory services; preparation of custom advertisements for others; retail services in relation to printed matter; digital advertising services; data management services; data processing services [office functions].

Class 38

Transmission of graphics to mobile telephones; broadcasting services; transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the internet; packet transmission of electronic data and images; delivery of digital audio and/or video by telecommunications; transmission of data, audio, video and multimedia files; network transmission of sounds, images, signals and data; data transmission, namely video uploading services; data transmission, namely photo uploading services; data broadcasting services; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; data transmission and data broadcasting; provision of access to internet platforms for the purpose of exchanging digital photographs.

Class 39

Packaging and storage of goods; physical storage of electronically stored digital data, photographs, audio and image files; physical storage of electronically stored data, documents, digital photographs, music, images, video, and computer games; transport of goods.

Class 40

Reproduction of photographic prints; duplicating of films; duplicating of photographic film; duplicating of transparencies; rental of photographic processing equipment; enlarging of pictorial work; photographic slide and print processing; transfer printing of photographic transparencies; transfer printing of photographs on to compact disc; transfer printing of photographic prints; transfer printing of photographic films on to video tape; reproduction of photographic transparencies; remastering of films from one format to another; mounting of prints or transparencies; photographic image processing; photocomposing services; photographic duplicating; photographic reproduction; photographic developing; photographic preservation and conservation; processing of cinematographic films; information services relating to the processing of photographic film; photographic printing; photographic film development; printing of digitally stored pictures and photographs; printing of images on objects; digital enhancement of photographs; photographic laboratory services, namely photographic film development, photographic printing and photocomposing services; picture framing; photographic processing; providing information relating to the processing of cinematographic films; processing of photographic film.

Class 42

Scientific and technological services; scientific research relating to chemistry; scientific research; scientific research services; software as a service [saas]; hosting of memory space on the internet for storing digital photographs; hosting a website for the electronic storage of digital photographs and videos; research and development services in the field of chemistry; chemical research; research relating to speciality chemicals; electronic storage of videos; electronic storage of photographs; electronic storage of digital photographs; electronic storage of digital images; electronic data storage and data back-up services; advisory services relating to chemical reagents; digital restoration of photographs.