

O/0109/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATION NO. UK3808200

BY FHFB (HOSPITALITY) LTD

TO REGISTER THE TRADE MARK:

KINSFOLK

IN CLASSES 35, 36 AND 43

AND THE OPPOSITION THERETO UNDER NO. 437203

BY KINFOLK IP CO., LTD.

-AND-

IN THE MATTER OF TRADE MARK REGISTRATION NO. UK912052197

IN THE NAME OF KINFOLK IP CO., LTD.

FOR THE TRADE MARK:

KINFOLK

IN CLASSES 16, 25, 33, 35, 41 AND 42

AND AN APPLICATION FOR REVOCATION THEREOF UNDER NO. 505419

BY FHFB (HOSPITALITY) LTD

Background and pleadings

1. On 11 July 2022 FHHB (Hospitality) Ltd (“**FHHB**”) applied to register the word-only trade mark ‘KINSFOLK’ in the UK. The application was accepted and published for opposition purposes in the Trade Marks Journal on 29 July 2022. Registration is sought for services in Classes 35, 36 and 43. Following publication, FHHB applied to restrict its specification,¹ consequently registration is sought in respect of the following services only:

Class 35

Business management and administration; provision of commercial and business information; advertising services (relating to hotels); marketing services (relating to hotels); promotional services (relating to hotels); administrative hotel management; hotel management for others; business operation of commercial real estate, offices and office space, business operation of commercial real estate, offices and office space, namely, shared office venues with conference facilities; providing co-working facilities within a hotel, equipped with private offices, office equipment including stationary, mailroom, printing centre, receptionist, kitchen, meeting rooms, computer and internet facilities, telecommunications equipment; promotional services in relation to hotels; marketing services in relation to hotels; advertising services in relation to hotels; information, advisory and consultancy services in relation to the aforesaid.

Class 36

Real estate services; real estate acquisition services; arranging for ownership of real estate, including condominiums, apartments, vacation homes, and villas; leasing of real estate and real property, including condominiums, apartments, vacation homes, and villas; real estate time-sharing, including condominiums, apartments, vacation homes, and villas; incubation services, namely, rental of office space within a hotel to freelancers, start-ups, existing businesses and non-profit organisations; information, advisory and consultancy services in relation to the aforesaid; none of the aforesaid services shall relate to investment services or lending services.

¹ By the filing of Form TM21B ‘Change of details of an application’ on 13 September 2022, 29 September 2022 and 21 April 2023.

Class 43

Hotel services; resort services; providing food and beverage services; hotel reservation services; restaurant services; bar services; lounge services; provision of conference and meeting facilities; providing meeting room space; providing food and drink; providing food and beverage services; providing facilities for business meetings and business events; banqueting, cocktail lounge; providing facilities for exhibitions and conferences; cafes; snack bars; information, advisory and consultancy services in relation to the aforesaid.

2. On 28 October 2022 the application was opposed in its entirety by Kinfolk IP Co., Ltd. (“**KIP**”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). KIP relies on its following two trade mark registrations:

“Mark 1”	
Representation of the mark:	KINFOLK
Comparable UK trade mark (EU) registration No.: ²	912052197 ³
Filing date:	8 August 2013
Registration Date:	6 February 2014
Goods and services relied on:	
<u>Class 16</u> Printed materials.	
<u>Class 25</u> Clothing, footwear, headgear.	
<u>Class 33</u> Liquor.	

² On 1 January 2021, the UK left the EU after the expiry of the transition period – which came to an end on ‘IP Completion Day’ i.e. 31 December 2020 at 11:00 pm. Under Article 54 of the Withdrawal Agreement, the UK Registry created comparable UK trade marks for all holders with an existing EU trade mark (“EUTM”) registered before ‘IP Completion Day’. These comparable trade marks were recorded in the UK trade mark register and as a consequence, have the same legal status as if they had been applied for and registered under UK law. A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

³ Comparable UK trade mark registration No. 912052197 derives from EUTM registration No. 12052197.

Class 35

Brand concept and brand development services for corporate and individual clients; Brand imagery consulting services; Brand positioning services; Branding services, namely, consulting, development, management and marketing of brands for businesses; Corporate image consulting services; Creating and updating advertising material; Dissemination of advertising for others via public and private wireless networks for display on mobile devices; Preparing audiovisual presentations for use in advertising; Business development consulting services; Business development services; Business strategy development services.

Class 41

Publishing of on-line journals, namely, blogs featuring various subjects and forms of entertainment in the fields of bicycles, brand concept and brand development, creative services, clothing, bags, restaurant and bar services, alcoholic beverages, and lifestyle products and stories regarding the foregoing; Arranging, organizing, conducting, and hosting social entertainment events.

Class 42

Creative marketing design services; Design of advertising materials for others; Design of internet advertising; Product development for others; Product development consultation; Research and development of new products for others; Research and development of new products.

“Mark 2”	
Representation of the mark:	KINFOLK
Comparable UK trade mark (EU) registration No.:	918117238 ⁴
Filing date:	28 August 2019
Registration Date:	9 January 2020
Goods and services relied on:	
<u>Class 30</u> Coffee, tea, cocoa and artificial coffee; Rice, pasta and noodles; Tapioca and sago; Flour and preparations made from cereals; Bread, pastries and confectionery; Chocolate; Ice cream, sorbets and other edible ices; Sugar, honey, treacle; Yeast,	

⁴ Comparable UK trade mark registration No. 918117238 derives from EUTM registration No. 18117238.

baking-powder; Salt, seasonings, spices, preserved herbs; Vinegar, sauces and other condiments; Ice [frozen water].

Class 31

Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; Raw and unprocessed grains and seeds; Fresh fruits and vegetables, fresh herbs; Natural plants and flowers; Bulbs, seedlings and seeds for planting; Live animals; Foodstuffs and beverages for animals; Malt.

Class 43

Services for providing food and drink; Temporary accommodation.

3. By virtue of their earlier filing dates, the trade marks upon which KIP rely qualify as earlier trade marks pursuant to section 6 of the Act.

4. KIP claims that the applied-for trade mark is similar to its earlier marks and that the applied-for goods and services are similar or identical to the goods and services for which its earlier marks are registered, giving rise to a likelihood of confusion.

5. As Mark 1 had been registered for more than five years at the filing date of the contested application, it is subject to the use conditions pursuant to section 6A of the Act, and as it is a comparable trade mark (EU) it is additionally subject to the provisions set out in Schedule 2A, Part 1, paragraph 7 of the Act. Accordingly, KIP made a statement that it has used Mark 1 in relation to all of the goods and services for which the mark is registered.

6. FHFB filed a counterstatement denying the claims made and put KIP to proof of use of its Mark 1. The five year period for which use must be shown is 12 July 2017 to 11 July 2022.

7. On 6 October 2022, FHFB sought revocation of KIP's Mark 1 on the grounds of non-use based upon sections 46(1)(a) and 46(1)(b) of the Act. On 28 September 2022, prior to filing its application, FHFB notified KIP of its intention to revoke the mark.

8. Under section 46(1)(a) of the Act, FHFB claims non-use in the five-year period following the date on which KIP's mark was registered i.e. 7 February 2014 to 6 February 2019, with an effective date of revocation of 7 February 2019 ("**the First Relevant Period**").

9. Under section 46(1)(b) of the Act, FHFB claims non-use in respect of KIP's mark for the period 6 October 2017 to 5 October 2022, with an effective date of revocation of 6 October 2022 ("**the Second Relevant Period**").

10. KIP filed a counterstatement denying the grounds of revocation. The opposition and revocation proceedings were subsequently consolidated.

11. Only KIP filed evidence. Neither party requested a hearing, rather both parties elected to file written submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers before me.

12. KIP is represented by Venner Shipley LLP and FHFB is represented by Bird & Bird LLP.

Assimilated law

13. 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 FILED

14. KIP's evidence is provided in the witness statement of Chul-Joon Park. Mr Park identifies himself as the Chief Executive Officer of Kinfolk IP Co., Ltd (a company based in Seoul in the Republic of Korea), a position he has held since April 2020. His witness statement is dated 5 November 2023 and has twelve accompanying exhibits labelled CJP1 to CJP12.

DECISION

My approach

16. As KIP's ability to rely upon Mark 1 identified in the opposition is dependent upon the success (or failure) of the revocation action and the associated request for proof

of use, I will begin by considering the revocation, returning to the opposition once I have determined whether (or the extent to which) KIP's mark is liable to be revoked.

THE REVOCATION

Legislation and Case Law

15. The relevant provisions of 46 of the are as follows:

“46 (1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

16. As KIP's Mark 1 is a comparable mark (EU), KIP can rely upon use of the mark in the EU for any and all parts of the relevant periods which fall prior to IP Completion Day (i.e. 31 December 2020) pursuant to paragraph 8 of Part 1, Schedule 2A of the Act. In this case, this means that use in the EU, including the UK, is relevant for the entirety of the First Relevant Period; with regard to the Second Relevant Period, KIP can rely on use in the EU, including the UK, prior to IP Completion, whereas after IP Completion Day (i.e. from 1 January 2021 onwards) the use must relate solely to the UK.

17. Section 100 of the Act makes it clear that the trade mark proprietor bears the burden of proving genuine use of its trade mark.⁵

18. The law relating to genuine use of a registered trade mark was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*⁶ as follows:

⁵ Also see *Ferrari SpA v DU*, C-721/18, at paragraphs 73 to 83.

⁶ [2023] EWCA Civ 1247.

“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 Bunderversammlung 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. [...] 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].

107. [...] The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

“19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. ...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

19. In *Awareness Ltd*, the Appointed Person goes on to say that:

“28. [...] Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered [...].”

20. The genuine use provision is not there to assess economic success or large-scale commercial use.⁷ An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁸

21. As regards the territorial scope of the use of an EUTM, in *Walton International*,⁹ Arnold J (as he then was), after setting out the eight applicable principles when assessing genuine use (which are the same as the eight principles he subsequently set out in *easyGroup Ltd*),¹⁰ added the further three principles when assessing genuine use in the EU:

“118. *The law with respect to genuine use in the Union.* Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark “in the Union”. In this regard, the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:

(9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine,

⁷ *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

⁸ *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

⁹ *Walton International Ltd & Anor v Verweij Fashion BV*, [2018] EWHC 1608 (Ch), (which is also a decision by Arnold LJ, or Arnold J as he then was, that predates his decision in *easyGroup Ltd*).

¹⁰ *Ibid.*, paragraphs 114 and 115.

since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]–[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50].”

22. Details of KIP’s evidence are set out in the following paragraphs.

23. By way of background Mr Park states that KIP was incorporated on 8 April 2020 “to carry out the principal activities of the business of holding intellectual property, distributing products created for and sold with the Kinfolk name, as well as business consulting, for design, fashion, travel, cosmetics, magazines and books.” Prior to KIP’s incorporation, Mr Park states that the trade mark (my emphasis for clarity) “was owned by **Kinfolk Inc., a New York Corporation**, and it is a matter of public record that the trade marks owned by that company were assigned to [KIP] with full right and title on 24 April 2020. References to use of Kinfolk prior to that date are references to use by the predecessor in title, **Kinfolk Inc.**”¹¹. Mr Park has not provided copies of the transfer/ assignment documents.

24. Mr Park’s narrative evidence states that (again my emphasis for clarity) “**KINFOLK is the name of a quarterly magazine** which was founded in 2011 in the United States. It connects a global community of creative professionals and delves into home, work, style, and culture. The brand publishes a dynamic mix of print and online media, including its quarterly magazine, daily posts on the website kinfolk.com and best selling books.” He states that “the ethos of KINFOLK is to create a platform for people who live in a slow way and who cherish “essentialism” in life. KINFOLK seeks to guide readers to design their lives accordingly and to establish collaboration with a like-minded community of people.”

25. Mr Park states that the “magazine is sold in over one hundred countries and published in four languages, namely English, Japanese, Chinese and Korean” and

¹¹ Having checked the EUIPO trade mark register, I note that this transfer of ownership was recorded on 29 May 2020 and was assigned recordal number 017942718. The ownership was transferred from Kinfolk Inc., of 90 Wythe Avenue, New York, US to KIP.

that *“we have offices in South Korea, Japan, China and our Head Office is located in Denmark.”*

26. Mr Park makes reference to Exhibit CJP2 as *“an interview from one of the co-founders of the KINFOLK magazine, Nathan Williams, which was published in Vanity Fair on 19 March 2020 and which gives a brief history of the magazine.”* The Vanity Fair article is titled *“How Kinfolk Magazine Defined the Millennial Aesthetic... and Unravelled Behind the Scenes – The cult quarterly helped set the pace for the upwardly mobile, Instagram-perfect 2010s lifestyle. Off the page, its creators’ lives have been somewhat messier.”*

27. The Vanity Fair article refers to the ‘Kinfolk magazine’ as a lifestyle magazine, launched in 2011 as an outgrowth of a college project started by two of its founders (Nathan Williams and Katie Searle – a couple who met at university) for an e-commerce platform called *“Kinsfolk & Company”*, selling plates and glasses and *“other things you might need for a [...] dinner party”*. The article continues to tell the tale of how the idea morphed into a magazine and that Williams and Searle brought in the help of their friends, another couple – Doug and Paige Bischoff. The article states that *“from the start, Kinfolk pulled in millions of page views”* such that its founders signed with a San Francisco-based publisher to help with printing and distribution and that *“by September 2012, Kinfolk was selling tens of thousands of copies per issue at a cover price of \$18.”*

28. The article continues by saying that *“the two couples moved to Portland, Oregon, which in addition to being near Searle’s hometown had the added benefit of a large population of aesthetically minded millennials eager to express their creative identities through a well-curated table setting”* and that *“by 2014, the magazine had been syndicated in Russia, Japan, China and South Korea. The founders had launched ‘Ouur Media’, a creative agency, had started a video series, and had published a book: ‘The Kinfolk Table’. They also started a series of “gatherings” – dinners or other events designed to bring the Kinfolk-minded together for some IRL [‘in real life’] communing”*.

29. According to the article, *“when Kinfolk launched in 2011, Instagram was just nine months old. In many ways, the two media converged perfectly, each seemingly made for the other. It wasn’t long before millennial feeds were filled with the Kinfolk aesthetic; even with images of Kinfolk itself. [...] the magazine became popular for social media*

[with] photos of it on a coffee table, in a café, on the bookshelf [...]”; “Kinfolk immediately reflected – and championed – the earnest DIY aesthetic then in vogue with many millennials”; and that for the last decade, the ‘Kinfolk magazine’ “helped to codify, and in the process become shorthand for, a certain Instagram-ready millennial aesthetic” even to the point of parody, stating that “so ubiquitous a signifier did Kinfolk become that parodies popped up to satirize [it].” The article characterizes the ‘Kinfolk aesthetic’ as being ‘pared-down’, owing “a clear debt to Scandinavian style”.

30. According to the Vanity Fair reporter, “by around 2014 [...] Kinfolk was doing better than ever; its print run had soared to 75,000 for the U.S. edition alone”, but Williams (the magazine’s creative director) felt the magazine needed to move outside of Portland to “somewhere more cosmopolitan”, and the founders ended up agreeing on moving the headquarters to Copenhagen, completing their move by summer 2015. Following the move to Copenhagen, the article recounts various personal and financial stresses that led to the founders seeking an outside investor which eventually led to them selling their shares and stepping away from the business, although the article states that ‘Williams’ remains a partner at Kinfolk.

31. The Vanity Fair reporter ends by stating that “Kinfolk still publishes quarterly from its sleek gallery space in Copenhagen with a print circulation of 75,000 and 295,000 monthly online page views. The staff is smaller, though – three full-time and three part-time in Denmark, and another four elsewhere in the world.” Mr Park reiterates this information by stating the following in his witness statement (my emphasis for clarity):

“7. In 2015 Kinfolk's headquarters relocated from Portland Oregon in the US to Copenhagen in Denmark. At the time of publication of the Vanity Fair article the Copenhagen office employed **three full time and three part time staff** in Denmark and four people elsewhere in the world. Its print circulation was **seventy-five thousand** and there were **two hundred and ninety five thousand** monthly online page views.”

32. Mr Park states that the “Copenhagen headquarters has the facility to host events such as art exhibitions, social entertainment events, visiting pop-up shops, workshops, dinner gatherings and photoshoots”. The facility he refers to in Copenhagen is called

'The 'Kinfolk Gallery' in the evidence he exhibits to accompany this statement.¹² Details of four events held between June 2018 and September 2019 are provided. They relate to an event for a furniture and lifestyle brand; an event for a Copenhagen-based florist who exhibited their floral displays at the gallery; an exhibition at the gallery for the launch of a book by a Dutch bookmaker; and an event to exhibit a curated collection of "beautiful objects".¹³

33. The following list of 'Kinfolk magazine' issues are included in Exhibit CJP5 as part of undated screenshots obtained from the 'Wikipedia' website entry for 'Kinfolk (magazine)'. Mr Park states that the Wikipedia evidence "provides biographic details and lists each quarterly KINFOLK magazine [from] 1 January 2011 to 13 September 2022":

Issue Number	Date of release	Theme of Issue
1	1 January 2011	A Guide for Small Gatherings
2	7 February 2012	A Guide for Small Gatherings
3	27 March 2012	A Guide for Small Gatherings
4	3 July 2012	A Guide for Small Gatherings
5	2 October 2012	Senses
6	27 November 2012	A Guide for Small Gatherings
7	27 March 2012	Ice Cream
8	16 June 2013	Japan
9	10 September 2013	The Weekend Issue
10	3 December 2013	Aged
11	4 March 2014	Home
12	3 June 2014	Saltwater
13	2 September 2014	Imperfect
14	25 November 2014	Winter
15	3 Mar 2015	Entrepreneur
16	2 June 2015	Essentials
17	1 September 2015	Family
18	24 November 2015	Design
19	1 March 2016	Adrenaline
20	7 June 2016	Travel

21	16 September 2016	Home (II)
22	29 November 2016	Work Special
23	7 March 2017	Weekend Special
24	6 June 2017	Relationships
25	5 September 2017	The Food Issue
26	28 November 2017	The Sport Issue
27	6 March 2018	The Paris Issue
28	5 June 2018	Hair
29	4 September 2018	Print
30	28 November 2018	Hospitality
31	1 March 2019	Architecture
32	1 June 2019	Tokyo
33	10 Sep 2019	Education
34	12 December 2019	Intimacy
35	10 March 2020	Change
36	9 Jun 2020	Movement
37	8 September 2020	Nature
38	1 December 2020	Rituals
39	9 March 2021	Youth
40	8 June 2021	10th Anniversary Edition
41	7 September 2021	The Mediterranean
42	7 December 2021	Technology
43	15 March 2022	The Mind
44	14 June 2022	The Weather
45	13 September 2022	The Great Outdoors

¹² Exhibit CJP3.

¹³ See Exhibit CJP3.

34. I note that the ‘Wikipedia’ evidence also contains the following information and images:



WIKIPEDIA
The Free Encyclopedia

Kinfolk (magazine)

Kinfolk is an independent slow lifestyle magazine published by Ouur and based in Portland, Oregon.

“Kinfolk is an independent slow lifestyle magazine published by Ouur and based in Portland, Oregon. [...] Kinfolk was founded in July 2011 by two couples: Nathan Williams and Katie Searle-Williams, and Doug and Paige Bischoff. A lifestyle magazine aimed primarily at young professionals, it focuses on home, work, play, food and community through photo essays, recipes, interviews, profiles, personal stories and practical tips. [...] In addition to its print publication, Kinfolk organizes monthly "community gathering" events that take place around the world, each based on a seasonal theme such as flower potlucks, butcher's block parties and campfire cooking. These events take place concurrently and aim to unite the global community of Kinfolk readers while also offering practical advice and lessons. The company also produces international food-based workshops, cookbooks and a short film series.”¹⁴



Cover of issue 49, September 2023

Categories	Lifestyle
Frequency	Quarterly
Founder	Nathan Williams, Katie Searle-Williams, Doug Bischoff, Paige Bischoff
Founded	2011
First issue	July 2011
Country	United States
Based in	Portland, Oregon

¹⁴ See Exhibit CJP5.

35. The Wikipedia page for 'Kinfolk (magazine)' has a 'Books' sub-heading containing the following details:

Books

Since 2013, *Kinfolk* has produced several books:

- *The Kinfolk Table: Recipes for Small Gatherings* (Artisan Books, 2013), containing 85 traditional recipes contributed by its global readership.^[9]
- *The Kinfolk Home: Interiors for Slow Living* (Artisan Books, 2015), an interior design survey of international scope.^{[10][11]}
- *The Kinfolk Entrepreneur: Ideas for Meaningful Work* (Artisan Books, 2017).^[12]
- *The Kinfolk Garden: How to Live with Nature* (Artisan Books, 2020).^[13]
- *Kinfolk Travel: Slower Ways to See the World* (Artisan Books, 2021), a book of travel planning tips.^[14]

36. Mr Park states that in addition to the KINFOLK magazine, the brand has produced a series of books and includes the following list in his witness statement (I note that, with the exception of the 'magazine issues', the list in his witness statement transcribes the list contained in the Wikipedia evidence (see my paragraph 35 above). He states that *"these editions have been sold continuously throughout the world"*.¹⁵

- *The Kinfolk Table: Recipes for Small Gatherings* (Artisan Books, 2013), containing eighty five traditional recipes contributed by its global readership;
- *The Kinfolk Home: Interiors for Slow Living* (Artisan Books, 2015), an interior design survey of International scope;
- *The Kinfolk Entrepreneur: Ideas for Meaningful Work* (Artisan Books, 2017);
- *KINFOLK Magazine - Issue Thirty-Four* (printed in the United Kingdom, published December 2019)
- *KINFOLK Magazine - Issue Thirty-Six* (printed in the United Kingdom, published June 2020)
- *KINFOLK Magazine - Issue Thirty-Seven* (printed in the United Kingdom, published September 2020)
- *The Kinfolk Garden: How to Live with Nature* (Artisan Books, October 2020);
- *Kinfolk Travel: Slower Way to See the World* (Artisan Books, 2021), a book of travel planning kits.

37. Exhibit CJP4 contains undated website screenshots showing images of the above publications. This evidence shows the magazines priced at \$18 and the books circa

¹⁵ Witness Statement of Mr parks, paragraph 9.

\$40 (with one book – ‘The Kinfolk Home’ – being priced in pounds at £29.95). Some images taken from Exhibit CJP4 are below:

Books



Magazines

Issue 34



Issue 36



Issue 37



MAGAZINE

Issue 38
\$18



MAGAZINE

Issue 36
\$18



MAGAZINE

Issue 22
\$18



MAGAZINE

Issue 40
\$18



MAGAZINE

Issue 33
\$18



MAGAZINE

Issue 26
\$18

38. Details of a 'shipping update' (with a copyright notice of 2023, and the heading 'KINFOLK') are provided in Exhibit CJP1, which Mr Park asserts is obtained from the 'kinfolk.com' website and that those details have not changed since being updated in 2021. Referencing this evidence he states that *"I confirm that [KIP] has always shipped and continues to ship orders to the United Kingdom."*¹⁶ The shipping update includes the following information: *"Any order with a total value of more than \$18 will be sent via courier from our warehouse in the UK. When ordering goods for delivery to Europe, you will be subject to import duties and taxes once the package reaches the country of destination. [...] Additionally, orders for delivery in Europe are now subject to an additional \$6 shipping surcharge due to Brexit."*

39. Exhibit CJP1 contains FAQs ('frequently asked questions') in relation to various categories including 'subscriptions' for the 'Kinfolk magazine', confirming that the magazine is published quarterly; the 'shop' section of the FAQs states that 'Kinfolk' ships worldwide with orders being fulfilled from distribution centres in the UK and US, and that all returns are to be sent to 'Kinfolk' at an address in Copenhagen, Denmark. According to this evidence premium subscriptions are at a cost of \$80 per year and include four print issues of the 'Kinfolk magazine'; and digital subscriptions of the magazine are available at a cost of \$40 per year.

40. Images obtained from the retail websites of 'WH Smith' and 'Newsstand' are provided by Mr Park as evidence to demonstrate that the publications are sold in the UK.¹⁷ This evidence is all undated. The WH Smith evidence shows: 'Kinfolk' hardback books namely, the 'Islands' publication, 'The Kinfolk Garden', 'The Kinfolk Home', 'The Kinfolk Entrepreneur', 'The Art of Kinfolk' and 'The Kinfolk Table'; various paperback editions of the 'Kinfolk magazine'; and a 'Kinfolk' magazine subscription option. All products are listed for sale on the WH Smith website in pounds. The Newsstand web pages reference 'Newsstand' as *"the UK's largest online magazine store"* and shows various issues of the 'Kinfolk magazine' for sale (prices are in GBP) as well as 'subscription options' for the magazine.

41. Mr Park asserts that *"KINFOLK is advertised on a number of websites, publications and journals"*,¹⁸ and that Exhibit CJP9 contains *"examples of awareness of the*

¹⁶ Last sentence of paragraph 4 of the witness statement of Mr Park.

¹⁷ See paragraph 11 of Mr Park's Witness Statement and Exhibit CPJ6.

¹⁸ Paragraph 14 of Mr Park's witness statement.

*KINFOLK brand by third parties advertising, including an article written by writer Marshall Bright in the Architectural Digest in January 2020 discussing Kinfolk and why the magazine is 'everywhere'.*¹⁹ The 2020 article talks about the 'Kinfolk magazine' and that 'Kinfolk' is seen as part of a long line of minimalism responding to consumerism, it also talks about the adoption of the 'Kinfolk' aesthetic and lifestyle trends, stating that *"you don't have to have ever read Kinfolk to imitate the Kinfolk lifestyle"*, thus characterising 'Kinfolk' as a trendsetter by anticipating trends such as *"hygge or the joy of tidying up"*.²⁰

42. The other article included in Exhibit CJP9 is from 'Creative Supply' and is undated. It states that 'Kinfolk' is *"the face of the slow lifestyle trend"*. It says that certain styles of photographs posted on Instagram which have become cliché are *"testament to the influence Kinfolk had – not just on social media but on magazine photography and design to this day"*, and that *"Kinfolk helped spark a print magazine renaissance"*. It goes on to state that *"Kinfolk also expanded to create Ouur Media which, as well as the magazine itself, publishes books on homeware, cooking, and entrepreneurship"*.²¹

43. Mr Park asserts the following in his witness statement:

"8. My Company has considerable experience in the area of brand concept services, brand development services and related services. In 2021 my Company was engaged by the global electronics company Samsung to work on a joint venture branding campaign related to the use of technology to help individuals to live an 'essential' life, and to live in a slow way. This project included the creation of videos and promotional content and the concept design of spaces and rooms within a hotel. I now produce and mark as Exhibit CJP8 information on the Samsung project and articles related to "Kinfolk Hotel for London, Paris, New York, Los Angeles" published out of our Danish HQ and relating to concept design for spaces and rooms within a hotel dated October 2022."

¹⁹ Ibid.

²⁰ See Exhibit CJP9, pages 1 to 4.

²¹ See Exhibit CJP9, pages 5 to 9.

44. The Samsung evidence consists of screenshots of video thumbnails on topics such as *“How food creates communities”* and *“A mini lesson in meditation”*.²² The ‘Kinfolk Hotel’ evidence is dated October 2022 and consists of mood boards for design concepts for hotel spaces; also included are design concepts, schematics and floor-plans for public spaces of *‘Kinfolk Dosan’* in Seoul, Korea.²³

45. Mr Park states that KIP’s website is ‘www.kinfolk.com’ and was first registered on 22 May 2003, and that KIP also maintain a website ‘www.kinfolk.kr’, registered since 25 June 2020.²⁴ To this end he exhibits ‘WHOIS’ record data for these two domains.²⁵ The data for the ‘.com’ address is redacted for privacy therefore the name, address, contact details etc. for the registrant are not included and in any event do not demonstrate that KIP own the ‘.com’ domain; the data for the ‘.kr’ address shows that KIP is the registrant with an address in Seoul, Korea.

46. Mr Park states that the ‘KINFOLK’ brand has collaborated *“with a variety of artists, brands and companies including the athleisure brand Fila in June 2018, as well as previous events and collaborations found on the KINFOLK website”*. To this end he produces Exhibit CPJ10.

47. Exhibit CPJ10 consists of three pieces of evidence, namely: (1) an undated interview with an artist posted on the ‘KINFOLK.com’ website (no evidence of any collaboration with this artist is provided); (2) an interview with an architect for issue 41 of the KINFOLK magazine (no evidence of any collaboration with this architect is given); and (3) print outs of pages from the ‘news’ section of a website other than the ‘kinfolk.com’ and ‘kinfolk.kr’ domains, namely, ‘www.kinfolk**life**.com’ (my emphasis for clarity). A reference to ‘Fila’ is included in this third part of the evidence and it is in relation to a collaboration between a Brooklyn-based menswear designer (‘Kinfolk’) and ‘Fila’ for a footwear collection.

48. The ‘kinfolk**life**.com’ printouts have a date stamp of ‘11/9/2018’, and only show the first few lines of each news post – the posts are dated from 25 February 2016 to 5 September 2018 (these are dates that fall before the date of the Vanity Fair article with

²² Exhibit CJP8, pages 1 to 9.

²³ Exhibit CJP8, pages 10 to 38.

²⁴ Paragraph 16 of Mr Park’s witness statement.

²⁵ Exhibit CJP11.

Nathan Williams, and all after the 2015 head office move from Portland in the US to Copenhagen in Denmark).²⁶

49. The banner for the 'kinfolk**life**.com' website displays 'Kinfolk' with a backwards 'K' as follows:



50. The exhibited posts from 'kinfolk**life**.com' make reference to 'Kinfolk' having its origins in Tokyo, Japan, "*home to the original Kinfolk bar*"; they state that the Kinfolk Managing Director is Keith Abrams and the Creative Director Jey Perie; they reference various clothing collections and the launch of a "*limited edition sweater featuring the classic backwards "K" Kinfolk logo*" and a jacket bearing the Kinfolk "*classic embroidered bunny rabbit logo*"; they reference 'Kinfolk' as being 'menswear' designers; they reference their 'Brooklyn boutique' and 'Kinfolk' as being the "*go-to*" spot in Brooklyn for "*some of Japan's most coveted brands*"; and they reference the name of two event/ bar venues in Brooklyn, being 'Kinfolk 90' and 'Kinfolk 94'.²⁷ In addition to the 'Fila' brand collaboration, they mention collaborations with 'GAP', 'Converse' and 'Levi's', with a 'Levi's' collaboration being crafted in the 'Kinfolk' Brooklyn boutique leading to the creation of the "*Double Bunny Trucker Jacket*".²⁸ Excerpts from some of the posts taken from the 'kinfolk**life**.com' evidence are annexed to this decision for ease of reference.

51. Mr Park states "*I now produce and mark as Exhibit CJP7 examples of KINFOLK branded apparel including KINFOLK apparel promoted through various social media platforms and examples of KINFOLK branded wine dated from 2021 as well as events related to the promotion of KINFOLK wine.*"

52. Exhibit CJP7 contains two images from an Instagram account named 'kinfolkdosan' dated 6 March 2021, showing images of models wearing loungewear, the wording 'Kinfolk x Casestudy' and 'available online at Kinfolk.kr and Kinfolk.com'. The remainder of Exhibit CJP7 consists of a collection of undated images, namely t-shirts with what appears to be 'Kinfolk' magazine covers printed on them, and images

²⁶ The 'Kinfolk**life**.com' printouts are found on pages 12 to 38 of Exhibit CJP10.

²⁷ I am aware that Brooklyn is a borough of New York City, USA.

²⁸ See the Annex to this decision for information on the brand collaborations.

of t-shirts with a backwards 'K' Kinfolk logo with, and without, a 'double bunny' motif; as well as images of shirts with 'Kinfolk' and 'Pottery' printed on the inside label and 'Pottery' on the swing tag. A solitary undated image of a bottle of wine on a non-descript shelf with 'Kinfolk' printed on the label is also provided (see examples below):



53. Mr Park asserts the following in relation to social media presence:

“17. My Company is active in social media and uses various social media platforms to promote the KINFOLK trade mark. My Company has a strong fandom community and in October 222 enjoyed a following of 1. 7 million on Instagram page. My Company's Face book page has over 350,000 followers and has received over 300,000 likes. Our X (formerly known as Twitter) page

has over 60,000 followers. I now produce and mark as Exhibit CJP12 extracts of these social media pages.”

Conclusions on the evidence

54. Firstly I note FHHB’s submissions on the evidence.²⁹ FHHB addresses each of Mr Park’s exhibits in turn and challenges the evidence to the extent that it submits that each exhibit does not show evidence of genuine use of the earlier mark, concluding its assessment with the following submissions:

“11. In summary, the evidence submitted by [KIP] is clearly insufficient to prove use of the Contested Registration for all the contested goods and services. It is lacking essential evidence which would exist if [KIP] had genuinely used their registration in the UK (or EU where relevant). It is all merely token and does not show actual commercial exploitation of the Contested Registration. The Contested Registration must therefore be removed from the register.

12. We reserve our ability to cross-examine Chul-Joon Park should this matter proceed on appeal, specifically on the deficiencies in the evidence, the lack of use provided, and the assignment of the trade mark mentioned in the Statement from Kinfolk Inc.”

55. I now turn to my conclusions of the evidence. Firstly, there appears to be nothing in the evidence which goes beyond information publicly available on the ‘kinfolk.com’ and ‘kinfolk.kr’ websites and the social media pages, nor anything that goes beyond the article published by Vanity Fair, and the ‘wiki’³⁰ information contained in the Wikipedia entry. Indeed, parts of Mr Park’s narrative evidence are taken verbatim from the Vanity Fair article (including the statistics on print circulation of the magazine); and they are taken verbatim from the Wikipedia evidence, including the list of books published.

56. The evidence paints the picture of a business of two halves, namely a lifestyle magazine having its origins in Portland (USA) and later Copenhagen (Denmark), and

²⁹ See FHHB’s submissions in lieu, paragraphs 10, 11 and 12.

³⁰ I note that a ‘wiki’ web page, as defined by the Oxford English Dictionary, is “a type of web page designed so that its contents can be edited by anyone who accesses it, using a simplified markup language”.

the other a menswear clothing brand, appearing seemingly planted in Brooklyn, New York (USA) with origins stemming from Japan. Both sides seem to be individually recognised in their respective fields, with the magazine being recognized as having a 'cult' following and influencing paired-back minimalism interior style trends and lifestyle trends; and the menswear side being urban streetwear, having garnered recognition from the likes of 'GQ' and having collaborated with recognised names in the fashion industry such as 'Fila', 'Levi's', 'GAP' and 'Converse'.

57. KIP submits that:³¹ *“the successful nature of [KIP’s] magazines, both printed and online, naturally leads to a finding of genuine use in relation to Class 16 and 41”*; that *“such use is in the United Kingdom as per the last sentence in paragraph 4 of the Witness Statement. The magazine is circulated globally including online, demonstrating use in the United Kingdom”*; and that *“brand collaborations with the likes of Samsung at page 1 of Exhibit CJP8 and GAP at page 17 of Exhibit CJP10 are examples of use that are highly significant whilst being relatively infrequent.”*

58. Notwithstanding any industry recognition and scant details of brand collaborations, there is nothing in the evidence deriving from KIP itself (which is not in the public domain) providing details about the commercialisation of the 'Kinfolk' brand, whether independently or as part of a collaboration. For example, no financial information whatsoever has been provided, therefore the turnover of the business during the relevant periods is unknown – this is essential information and information which should be known to KIP. No invoices have been provided, no details of orders etc. that would be able to shed any light on revenue generated by KIP (again, this is information that would be exclusively privy to KIP). Furthermore, the evidence is largely undated and therefore it is impossible to ascertain whether it relates to the relevant periods.

59. Mr Park asserts that *“KINFOLK is advertised on a number of websites, publications and journals”*, yet no evidence of any advertising campaigns is provided and no details as to advertising spend have been provided either, nor any details of market share held by the brand. Articles written by third parties about the brand are not advertising campaigns initiated by the owner of the mark.

³¹ KIP's submissions in lieu dated 5 April 2024.

60. Whilst Mr Park has asserted that the brand is present in the UK, there is no information derived from his company (as opposed to being derived from third parties, such as the Vanity Fair article) that would give an indication as to the actual geographic spread of the brand. Indeed, the evidence predominantly appears to be focused on the USA, and the Vanity Fair article in any event makes no reference to the spread of the magazine in the EU and the UK.

61. Sweeping statements that the magazine is available worldwide do not suffice and evidence dated within the relevant periods has not been provided which would enable me to determine where the magazine is sold. Although it is apparent that the 'Kinfolk magazine' and some of the 'Kinfolk books' were listed for sale on the websites of UK retailers, this evidence is undated therefore it is impossible to know whether those items were ever available in the UK during the relevant periods.

62. Although the head office of the magazine is based in Denmark, there are no other details provided about the business' activities in the rest of the EU. Mr Park refers to the 'Kinfolk Gallery' event space, but that appears to be a part of the business that is geographically limited to one location in Copenhagen and would not in any event show widespread geographical use of the mark for gallery / event space in the relevant territories. Furthermore, the information contained in the 'kinfolklife.com' evidence all points to the 'Kinfolk 90' and 'Kinfolk 94' venues being located specifically in Brooklyn (New York City), which is obviously not within the relevant territories.

63. Mr Park has provided undated screenshots from the magazine website which state that orders are shipped from a UK warehouse. However, that is not sufficient to prove genuine use of the mark in the relevant territories during the relevant periods, not least because no specific, dated information is provided as to what products were shipped, where they were shipped and when they were shipped.

64. Furthermore, having a warehouse located in the UK and having an office located in Denmark is not evidence of genuine use of the mark in those two territories for the goods and services for which it is registered.

65. Whilst I acknowledge that images of clothing have been provided in Exhibit CJP7, these images are (with the exception of the 'kinfolkdosan' Instagram pages) undated, and there is no evidence that any of the products shown in Exhibit CJP7 were sold in

the relevant territories during the relevant periods. Although an undated image of a 'Kinfolk' labelled bottle of wine is provided, a solitary undated image is not evidence of genuine use of the mark and there is no financial evidence of sales of wine under the Kinfolk brand either.

66. Whilst it appears from Mr Park's narrative evidence and accompanying Exhibit CJP12 that 'Kinfolk' has a sizeable following across various social media platforms, this evidence is not in a trading context, and is not sufficient (alone) to clearly establish the extent to which the mark has been used commercially in the EU and the UK.

67. In conclusion, in the context of an overall assessment of the evidence and of the relevant factors, I consider that the evidence does not lend support to a finding that KIP has proved that the mark has been put to genuine use in the relevant territories in either of the relevant periods. In reaching this conclusion I take note of Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*.³² He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”.”

68. The evidence contains many deficiencies and I bear in mind that I am entitled to be sceptical of a case of use where the material actually provided is inconclusive. The onus is on KIP to have filed evidence of genuine use that is sufficiently solid and conclusive – in my view KIP has fallen short in this task. I conclude therefore that KIP has not shown genuine use of the mark in the relevant territories during either of the relevant periods (nor during any period which would engage the operation of section 46(3) of the Act).

³² Case BL O/424/14.

OUTCOME OF THE REVOCATION

69. The revocation is successful in its entirety under section 46(1)(a) of the Act.

70. As there is no evidence of genuine use in either period, in accordance with section 46(6) of the Act, UK comparable trade mark (EU) registration number 912052197 shall be revoked in the UK from the earlier revocation date sought, namely from 7 February 2019. The outcome of the revocation action affects only the rights conferred in the UK.

THE OPPOSITION

71. As I have found that KIP's right in Mark 1 ceased to exist in the UK from 7 February 2019, Mark 1 cannot be relied on as a basis for the opposition, since it was not in force in the UK on the relevant date i.e. the date of application of FHFB's trade mark. The opposition shall therefore proceed on the basis of KIP's reliance solely on Mark 2 which is not subject to any use provisions.

Legislation and Case Law

72. Section 5(2)(b) and 5A of the Act are as follows:

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

[...]

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

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

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

73. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-*

Goldwyn-Mayer Inc, Case C-39/97, Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

74. In *Gérard Meric v Office for Harmonisation in the Internal Market*,³³ (“**Meric**”), the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa (this principle equally applies to services).

75. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia:³⁴

- (1) the physical nature of the goods or acts of service;
- (2) their intended purpose;
- (3) their method of use / uses;
- (4) who the users of the goods and services are;
- (5) the trade channels through which the goods and services reach the market;
- (6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

³³ Case T- 133/05

³⁴ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

- (7) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);
- or
- (8) whether they are complementary to each other.

76. 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*”.³⁵ Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.³⁶

77. I also note that section 60A(1)(a) of the Act provides that goods and services are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, nor dissimilar to each other on the ground that they appear in different classes under the Nice Classification.

78. The goods and services to be compared are shown in the table below.

KIP’s specification	FHFB’s specification
<p><u>Class 30</u></p> <p>Coffee, tea, cocoa and artificial coffee; Rice, pasta and noodles; Tapioca and sago; Flour and preparations made from cereals; Bread, pastries and confectionery; Chocolate; Ice cream, sorbets and other edible ices; Sugar, honey, treacle; Yeast, baking-powder; Salt, seasonings, spices, preserved herbs; Vinegar, sauces and other condiments; Ice [frozen water].</p> <p><u>Class 31</u></p> <p>Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; Raw and unprocessed grains and seeds; Fresh fruits and vegetables, fresh herbs; Natural plants and flowers;</p>	<p><u>Class 35</u></p> <p>Business management and administration; provision of commercial and business information; advertising services (relating to hotels); marketing services (relating to hotels); promotional services (relating to hotels); administrative hotel management; hotel management for others; business operation of commercial real estate, offices and office space, business operation of commercial real estate, offices and office space, namely, shared office venues with conference facilities; providing co-working facilities within a hotel, equipped with private offices, office equipment including stationary, mailroom, printing centre, receptionist, kitchen, meeting rooms, computer and</p>

³⁵ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

³⁶ *Kurt Hesse v OHIM*, Case C-50/15 P

Bulbs, seedlings and seeds for planting; Live animals; Foodstuffs and beverages for animals; Malt.

Class 43

Services for providing food and drink; Temporary accommodation.

internet facilities, telecommunications equipment; promotional services in relation to hotels; marketing services in relation to hotels; advertising services in relation to hotels; information, advisory and consultancy services in relation to the aforesaid.

Class 36

Real estate services; real estate acquisition services; arranging for ownership of real estate, including condominiums, apartments, vacation homes, and villas; leasing of real estate and real property, including condominiums, apartments, vacation homes, and villas; real estate time-sharing, including condominiums, apartments, vacation homes, and villas; incubation services, namely, rental of office space within a hotel to freelancers, start-ups, existing businesses and non-profit organisations; information, advisory and consultancy services in relation to the aforesaid; none of the aforesaid services shall relate to investment services or lending services.

Class 43

Hotel services; resort services; providing food and beverage services; hotel reservation services; restaurant services; bar services; lounge services; provision of conference and meeting facilities; providing meeting room space; providing food and drink; providing food and beverage services; providing facilities for business meetings and business events; banqueting, cocktail lounge; providing facilities for exhibitions and conferences; cafes; snack bars; information, advisory and consultancy services in relation to the aforesaid.

79. With regard to KIP's Class 43 specification, I interpret the services of providing food and drink as those services provided by food and drink establishments such as restaurants, cafés, bars, pubs etc. as well as catering companies (i.e. they encompass services for providing prepared food and for serving drinks in dedicated public premises, which can be distinguished from food and drink retailers such as supermarkets). I interpret temporary accommodation as short stay accommodation consisting primarily of a bedroom with bathroom facilities which is paid for by the day/week and typically used for overnight stays, by holidaymakers, travellers, tourists etc.

80. With this in mind I proceed firstly with comparing the applied-for Class 43 with KIP's specification since both specifications contain Class 43 services.

Class 43

Providing food and beverage services; restaurant services; bar services; lounge services; providing food and drink; providing food and beverage services; banqueting, cocktail lounge; cafes; snack bars; information, advisory and consultancy services in relation to the aforesaid.

81. The above are services for the provision of food and drink. They are therefore **identical** to KIP's Class 43 "*Services for providing food and drink*" on the principle outlined in *Meric*.

82. To the extent that the information, advisory and consultancy services relate to the aforesaid applied-for services, these too are identical to KIP's "*Services for providing food and drink*" on the principle outlined in *Meric*. This is because the broad category of "*services for providing food and drink*" is likely to encompass the provision of information, advice and consultancy in relation to those services. For example, a caterer who provides catering for events is offering "*services for providing food and drink*" – as part of the catering service they will likely consult with their client and provide information, advice and consultancy about things such as menu choices, timing of food and drink service, layout, cost etc.

Hotel services; resort services; information, advisory and consultancy services in relation to the aforesaid.

83. The above are services for the provision of temporary accommodation when factoring in that resort services encompass 'hotel' resorts. These services are therefore **identical** to KIP's Class 43 "*temporary accommodation*" on the principle outlined in *Meric*.

84. To the extent that the information, advisory and consultancy services relate to the aforesaid applied-for services, these too are identical to KIP's "*temporary accommodation*" on the principle outlined in *Meric*. This is because the broad category of services for providing "*temporary accommodation*" are likely to encompass the provision of information, advice and consultancy in relation to those services.

Hotel reservation services; information, advisory and consultancy services in relation to the aforesaid.

85. Albeit a consumer can reserve a hotel room directly with a hotel itself, this is not what I consider to be "*hotel reservation services*". The reservation services would likely be provided by third parties such as travel agencies, booking websites and travel websites, who specialise in, and offer reservation services to hotels operated by multiple providers. The purpose, nature and method of use of the reservation services are different to KIP's Class 43 "*temporary accommodation*". The services are not in competition with each other either.

86. However, I consider the respective services to be complementary on the basis that a consumer requiring temporary accommodation such as a hotel room, is likely to require hotel reservation services, therefore the services are important to each other in such a way that the consumer may believe that they are offered by the same undertaking (such as a travel agency or tour operator – especially when taking into consideration that these entities may own their own hotels as well as provide reservation services for third party hotels). It therefore follows that the respective services would share the same user and also share the same trade channels. These services are similar to a **medium degree**.

Provision of conference and meeting facilities; providing meeting room space; providing facilities for business meetings and business events; providing facilities for exhibitions and conferences; information, advisory and consultancy services in relation to the aforesaid.

87. These services are for the provision of spaces to host events for multiple people to attend. Therefore, the purpose, nature, method of use and user of these services differs with KIP's Class 43 "*temporary accommodation*" (when bearing in mind my interpretation of the term 'temporary accommodation' as set out in my paragraph 79 above) and the respective services would not be in competition either.

88. However, I recognise that these facilities/ event spaces could be located in a hotel for instance, and therefore the users and trade channels are likely to overlap. For example, the provision of temporary accommodation could be provided by a hotel as part of their hospitality package for conference events i.e. the hotel would provide the event space as well as bedrooms for the attendees to stay in. As such the above services are similar to KIP's to a **low degree**.

89. To the extent that the information, advisory and consultancy services relate to the aforesaid applied-for services, these too are similar to KIP's "*temporary accommodation*" applying the same foregoing reasons.

Class 35

90. FHHB submits the following:

"17. The Class 35 services in the Mark Applied For are a range of business management, business administration and business operational services, advertising and promotional services, and related information, advisory and consultancy services, many of which relate to hotels. These are dissimilar to the services which [KIP's] relevant registration covers. Whilst the services may benefit a hotel (which is a Class 43 service) they are not for the same customer or end user. The public are therefore very different. Thus, they have completely different purposes and methods and are not in competition nor complementary to one another."

91. FHFB's submissions focus on a comparison between the applied-for Class 35 services with KIP's Class 43 services and it expands on its reasoning in paragraphs 18 to 29 of its submissions in lieu. It concludes that the Class 35 services are dissimilar to KIP's services

92. I have taken its submissions into account and I agree with FHFB to the extent that I consider the applied-for Class 35 services to be **dissimilar** to the Class 43 services contained in KIP's specification.

93. I also add that I consider the respective services would not share the same trade channels; and with regard to complementarity I note that, as I consider the users to be different, there can be no complementarity. This is because a finding of similarity on the basis of complementarity presupposes that the services are intended for the same public. It follows therefore that the services cannot be complementary if they are intended for different publics.³⁷

94. For completeness, FHFB submits that *"the Class 35 services in the Mark Applied For are clearly dissimilar to the registered goods in classes 30 and 31."* I also agree with this submission. KIP's Class 30 includes goods that are *"mainly foodstuffs of plant origin, except fruits and vegetables, prepared or preserved for consumption, as well as auxiliaries intended for the improvement of the flavour of food."*³⁸ Its Class 31 includes goods that are *"mainly land and sea products not having been subjected to any form of preparation for consumption, live animals and plants, as well as foodstuffs for animals."*³⁹ These goods share no overlap with FHFB's Class 35 services, this is because they do not share the same purpose nature nor method of use. The users would not overlap in any meaningful way and the respective goods and services would not share the same trade channels nor be in competition with each other. They would also not be complementary either. The respective goods and services are therefore **dissimilar**.

³⁷ See *Commercy AG v OHIM – (easyHotel)*, Case T-316/07, paragraphs 57 – 58 (which was cited by the General Court in *Pucci International v OHIM — El Corte Inglés (Emidio Tucci)*, T-357/09, paragraph 50; and that paragraph of *'Emidio Tucci'* was cited by the General Court in *Compagnie des montres Longines, Francillon SA v OHIM*, Case T-505/12, paragraph 58).

³⁸ See the 'Explanatory Note' for Class 30 of the Nice Classification.

³⁹ See the 'Explanatory Note' for Class 31 of the Nice Classification.

Class 36

95. FHFB submits the following:

“30. The Class 36 services in the Mark Applied For cover a wide range of real estate services and related information, advisory and consultancy services (excluding investments).

31. Temporary accommodation services in Class 43, such as that covered in [KIP’s] relevant registration include the services rendered to satisfy consumers’ needs for short accommodation, for example an accommodation bureau offering holiday homes for a week or a couple of days. It does not cover permanent property purchases or ownership which is covered by the Mark Applied For. These services target very different consumers and have different purposes/intentions. They are therefore completely dissimilar.

32. For completeness, the Class 36 services in the Mark Applied For are clearly dissimilar to the registered goods in classes 30 and 31.”

96. KIP on the other hand submits that the applied-for Class 36 services, *“being real estate services, [...] are similar to [KIP’s] Class 43 services of ‘temporary accommodation’ owing to the intended purpose of securing shelter and the nature of the service both relating to real estate”*.⁴⁰

97. Bearing in mind my interpretation of the term ‘temporary accommodation’,⁴¹ I disagree with KIP’s submissions. A consumer seeking temporary accommodation to stay in for their holidays would seek the services of a travel agent for example and not the services of a real estate agent – the consumer is not looking to enter into a contract to rent or lease property where deposits and background checks are needed, they are merely looking for a hotel room to stay in for a few nights for example. I therefore agree with FHFB’s overall assessment that the respective services are **dissimilar**, I also add that I do not consider there would be any overlap in trade channels, the respective services would not be in competition with each other and they are not complementary either.

⁴⁰ KIP’s submissions in lieu, paragraph 35.

⁴¹ See my paragraph 79.

98. As a matter of completeness I also note that I agree with FHHB on dissimilarity between its Class 36 services and KIP's Class 30 and 31 goods. Such a comparison does not put KIP in a more favourable position than a comparison with its class 43 services. Applying the same reasoning as set out in my paragraph 94, my overall assessment is that the respective goods and services are **dissimilar**.

Conclusions on the goods and services comparison

99. I have found that some of the applied-for services are identical and similar to KIP's, whilst the remainder are dissimilar. Since some similarity between the goods and services is required for the purposes of a section 5(2)(b) claim,⁴² the opposition must fail in respect of the dissimilar services identified above, namely:

Class 35

All of the applied-for services.

Class 36

All of the applied-for services.

100. I therefore proceed to consider a likelihood of confusion only in relation to the services that are identical and similar.

The average consumer and the nature of the purchasing act

101. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the services in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word "average" merely denotes that the person is typical,⁴³ which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of

⁴² See *Waterford Wedgwood plc v OHIM* – C-398/07 P (case of the CJEU); and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

⁴³ *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), paragraph 60

those characteristics.⁴⁴ It is therefore necessary to determine who the average consumer of the services is, and how the consumer is likely to select those services.

102. The average consumer for the services still in play will either be a member of the general public or they will be professional users. The average consumer therefore encompasses individuals as well as organisations requiring catering for events for example or temporary accommodation for their staff for business trips as another example.

103. The services will be selected following the viewing of signage on the frontage of premises, or they will be selected online, from brochures, over the phone, or even through word-of-mouth recommendations, therefore visual and aural considerations will both apply, although I consider the services would be predominantly selected visually where the consumer will see an image of the mark before making their selection.

104. The services are on average likely to be used relatively frequently. In selecting the services, the average consumer will take various factors into consideration such as the cost, the type of cuisine, drinks / accommodation offered and the standards of customer service and cleanliness.

105. Irrespective of whether they are members of the public or professional users, the average consumer will want to make sure that the services suit their needs and requirements. I therefore consider the average consumer will pay no more than a medium degree of attention when selecting the services at hand.

Comparison of marks

106. I have already set out the principles gleaned from established case law with regard to comparing competing marks. I also note that the Court of Justice of the European Union stated in *Bimbo SA v OHIM*,⁴⁵ 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

⁴⁴ *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

⁴⁵ Case C-591/12P, at paragraph 34.

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.”

107. It would be wrong, therefore, to dissect the trade marks artificially, 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.

108. The marks being compared are shown below:

KIP's Mark 2	FHHB's mark
KINFOLK	KINSFOLK

109. Both are word-only marks therefore the overall impression of the marks rests solely in those words.

110. KIP's mark is a seven letter word and FHHB's mark is an eight letter word. Visually the marks only differ with regard to the letter 'S' in the middle of the applied-for mark (being the fourth letter in FHHB's mark). The marks otherwise share the same three letter beginnings, 'KIN' and the same four letter endings, 'FOLK'. As a general rule of thumb, the first parts of a mark normally carry a greater significance.⁴⁶ In *El Corte Inglés, SA v OHIM*, the General Court found that the identity of the first few letters can give rise to a strong visual similarity which, moreover, can be reinforced by the presence of identical endings.⁴⁷ I consider the respective marks to be **visually similar to a high degree**.

111. KIP's mark would be pronounced as 'KIN-FOLK' (as though it consists of two words). FHHB's mark would be pronounced as 'KINS-FOLK'. Aurally the marks only differ with regard to the letter 'S' which doesn't create too much of an aural divergence

⁴⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81

⁴⁷ *Ibid*, paragraphs 81 to 83. In this case the marks being compared were the ten letter word 'MUNDICOLOR' and the eight letter word 'MUNDICOR', which not only had identity owing to the same seven letters at the beginning, they also shared identity with regard to the last letter (and the only visual difference between the signs was the letters 'LO'). Indeed, the General Court recognised that the identity of the first seven letters gave rise to a strong visual similarity which was, moreover, reinforced by the presence of the letter 'R' at the end of the two signs.

between 'KINSFOLK' and 'KINFOLK' as the 'S' is a soft sounding letter, sitting at the middle of the word. I consider the marks to be **aurally similar to a high degree**.

112. As a final point I note that with regard to the visual and aural comparison, FHFB's position is that the difference between the marks owing to the letter 'S' is significant, submitting that "*due to the [high degree of] attentiveness of the relevant public, the inclusion of the central letter "S" in the Mark Applied For is a striking difference which the public would notice [...] accordingly, any level of similarity from a visual and aural point of view is very low.*"⁴⁸ I point out that FHFB's assessment of the average consumer also encompasses the average consumer for the services no longer in play.

113. In any event I disagree with this submission which doesn't take into account that the average consumer rarely has the opportunity to compare marks side by side and instead must rely on the imperfect picture of them which they have kept in mind. Even if I were with FHFB on the high level of attentiveness of the average consumer (which for clarity, I am not), the difference in one letter which sits at the middle of the contested mark does not pose the significant difference which FHFB purports it to be, especially when factoring in the reasons I have set out above when comparing the competing mark visually and aurally (which are reasons given with the principle of imperfect recollection in mind, as prescribed by the relevant case law).

114. I now move on to a conceptual comparison. KIP's position is that the respective marks are conceptually highly similar if not identical, because it submits that "*as provided in case law,*" the semantic content of the word 'KINSFOLK' will be associate with the word 'KINFOLK', because it submits that the applied-for mark is misspelt. KIP provides the following case citation from *Cabel Hall Citrus Ltd v OHIM*, Case T-488/07 in support of this submission: "*...as the Board of Appeal noted, in so far as the word 'ugli' in the earlier mark is likely to be associated with the English word 'ugly' by the relevant public...*"⁴⁹ FHFB makes no submissions as to the conceptual comparison.

115. I note that the entry for 'KINFOLK' in the Oxford English dictionary defers its definition to the definition contained in the entry for 'KINSFOLK', meaning 'persons of the same kin; relations by blood; relatives'. The respective marks therefore have an equivalent meaning such that they are **conceptually identical**. Even if the average

⁴⁸ FHFB's submissions in lieu, paragraphs 36 and 37.

⁴⁹ KIP's submissions in lieu, paragraph 27.

consumer is not aware of the meaning of the word 'KINFOLK' / 'KINSFOLK' they are likely to derive meaning from its component parts, as they would be familiar with the word 'kin' when used in reference to the term 'next of kin'; and they would also be familiar with the ordinary word 'folk' to mean people. Thus combining the two they are likely to perceive it as a way of referring to one's relatives, thereby making the marks **conceptually identical** even in those circumstances.⁵⁰

116. In the **alternative**, if the average consumer does not derive any meaning from the marks, then they are **conceptually neutral**.

Distinctive character of the earlier mark

117. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be.⁵¹

118. 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.

119. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,⁵² the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-

⁵⁰ As regards the conceptual comparison, see *Usinor SA v OHIM*, Case T-189/05, paragraph 62, in which the General Court found that the average consumer, when perceiving a verbal sign, will break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him.

⁵¹ Although it is always important to bear in mind what it is about the earlier mark which gives it distinctive character. See *Kurt Geiger v A-List Corporate Limited*, Case O-075-13, paragraph 39

⁵² Case C-342/97.

109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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).”

120. The word ‘KINFOLK’ is a dictionary defined word, however, I take into account that the average consumer may not know this and therefore may perceive it as an invented word being coined from the words ‘kin’ and ‘folk’.

121. Where the average consumer perceives ‘KINFOLK’ as an invented word, then the inherent degree of distinctive character would be high. Even if it is perceived as the ordinary dictionary-defined word, I still consider the degree of distinctiveness would be medium to high because it does not allude in any way to the goods and services for which it is registered.

122. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it, however, it is only use in the UK which is relevant to the question of whether that use has been enhanced and thus may increase the likelihood of confusion.⁵³ This is because the assessment is made from the perspective of the UK average consumer, therefore the relevant market for assessing this is the UK market.

123. KIP has produced evidence in support of its claim that it has made genuine use of ‘KINFOLK’. Mr Park’s witness statement does not state that it is specific to use of Mark 1. I therefore have taken the evidence into account in relation to Mark 2 and conclude that there is no evidence provided that would enable me to determine KIP’s market share in relation to the goods and services for which Mark 2 is registered, nor

⁵³ Tribunal Practice Notice 2/2020.

any details of advertising expenditure, and nothing to enable me to determine the geographic extent of the use of the earlier mark in the UK market. In summary, I do not find the evidence sufficient to establish any enhancement of the distinctiveness of the earlier mark in the UK market beyond the inherent degree of distinctiveness I have already attributed to it.

Likelihood of confusion

124. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.⁵⁴ I must also consider the average consumer of the services, the nature of the purchasing process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.⁵⁵

125. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.⁵⁶ The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.⁵⁷

126. Confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect, which is where the consumer notices that the marks are different, but the later mark and the earlier mark share common elements that lead the consumer to conclude that it is another brand of the owner of the earlier mark.⁵⁸

⁵⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

⁵⁵ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

⁵⁶ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

⁵⁷ See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

⁵⁸ See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion

127. I have found that the applied-for services still in play are predominantly identical to terms contained in KIP's specification (with one term being similar to a medium degree and the remainder similar to a low degree - in any event there is no minimum threshold level of similarity that has to be shown as it is sufficient that some similarity exists in order to consider the likelihood of confusion⁵⁹). I have also found that the marks are similar visually and aurally to a high degree and (depending on perception) are conceptually identical, or in the alternative are conceptually neutral. Even in circumstances where the two marks are conceptually neutral, I note that this would not neutralise the visual and aural similarities between the marks, especially when taking into account that I have found that the selection process of the services is primarily visual and has an aural element.

128. I have found that, depending on perception, the earlier mark is inherently distinctive to either a high degree or to between a medium and high degree, there being no enhancement of the distinctiveness of the mark through use.

129. Taking all the above factors into consideration, and allowing for imperfect recollection, whilst bearing in mind the principle of interdependency, I find that the average consumer, or at least a significant proportion thereof, will mistake one mark for the other and be directly confused as to the origin of the relevant services.

OUTCOME OF THE OPPOSITION

130. The opposition under section 5(2)(b) of the Act is partially successful. Subject to any appeal, contested trade mark application number 3808200 shall be refused registration in respect of the services detailed below, and shall proceed to registration in respect of all remaining services applied for. Registration is therefore refused in respect of the following services only:

Class 43

Hotel services; resort services; providing food and beverage services; hotel reservation services; restaurant services; bar services; lounge services; provision of conference and meeting facilities; providing meeting room space; providing food and drink; providing food and beverage services; providing facilities for business

⁵⁹ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

meetings and business events; banqueting, cocktail lounge; providing facilities for exhibitions and conferences; cafes; snack bars; information, advisory and consultancy services in relation to the aforesaid.

COSTS

131. As FHFB has enjoyed a significantly greater degree of success in both the revocation and the opposition it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. However, in light of KIP succeeding in opposing some of the applied-for terms, I consider it appropriate to reduce the costs award to a degree.

132. In the circumstances, I award costs to FHFB as follows, taking into account the economies of consolidation and an appropriate reduction in order to reflect KIP's partial success:

Official fee for the revocation action	£200
Preparing the revocation application and considering KIP's counterstatement	£150
Considering the notice of opposition and preparing the defence and counterstatement	£150
Considering KIP's evidence and preparing submissions in lieu of a hearing	£500
TOTAL	£1,000

133. I therefore order Kinfolk IP Co., Ltd. to pay FHFB (Hospitality) Ltd the sum of **£1,000**. This sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of February 2025

Daniela Ferrari

For the Registrar

ANNEX

Excerpts from pages 12 to 38 of Exhibit CJP10

Date	Excerpt (my emphasis for clarity)
10 March 2016	“ The [Planet K] collection continues to break new ground for Kinfolk, including first time productions of anoraks [and] a tailored collaborative summer suit [...]”
16 March 2016	“Kinfolk SS 2016 Release – Kinfolk released their highly anticipated SS 2016 collection Thursday. Inspired by the limelight of the 70’s and 80’s and Tokyo nightlife, Planet K features a new, vibrant colour palette and some speciality pieces you won’t want to miss. The Fam Kinfolk men , Maceo, Salah, Keith & Brandon.”
19 April 2016	“Besides being the go-to spot for some of Japan’s most coveted brands in Brooklyn , Kinfolk has deeper connections to the vibrant country than many think. Tokyo is where it all began and Nakameguro, a neighbourhood in Tokyo, is home to the original Kinfolk bar . [...]”
5 May 2016	“Kinfolk is excited to announce the arrival of our first ever denim collection! The roots of Kinfolk are firmly planted in Japan , so it’s only natural that we would go back to produce our first denim pieces. Specifically, we went to Okayama, which is world renowned for producing the highest quality of denim. [...]”
6 June 2016	“The June issue of the Culture Crush asks ‘Where have all the Bohemians gone?’. The answer, of course, is Kinfolk. The Culture Crush creative director Debra Scherer sat down [to talk] with Ryan Carney, Jay Perie, Keith Abrams, Salah Mason, and Maceo Eagle [...]”
2 November 2016	“Kinfolk is excited to collaborate with Converse Essentials for a limited edition sweater featuring the classic backwards “K” Kinfolk logo . For the launch of its new apparel collection , Converse selected 13 stores around the globe to be included in this project based on their personal connection to the unique style of their community [...]”
6 December 2016	“In collaboration with the Levi’s Tailorshop , Kinfolk presents the Double Bunny Trucker Jacket. This limited edition collaboration marks the beginning of a larger partnership between the two brands and the arrival of Levi’s Made & Crafted in our Brooklyn boutique . Kinfolk Creative Director Jey Perie , on the design inspiration [...]”
12 December 2016	“On December 08, we celebrated the release of our exclusive collaboration with the Levi’s Tailorshop by throwing a party at Kinfolk 90 , inviting all our friends, and getting them drunk! [...]”
27 December 2016	“A collaboration between Japanese-based brand Ink x Kinfolk, the Rabbit Military Jacket takes our classic embroidered bunny rabbit logo and stitches it on the back of military jackets. [...]”

12 January 2017	“ Kinfolk Creative Director Jey Perie recently sat down with one of our favourite publications, Playboy, to discuss his take on what’s at the forefront of menswear right now. [...]”
15 February 2017	“In anticipation of our first ever pop up in Hong Kong with Lane Crawford, Kinfolk Managing Director Keith Abrams and Creative Director Jey Perie spent a day with the luxury retailer to chat about the concept behind Kinfolk. The SS '17 collection , entitled High Life Low Life, debuts exclusively at Lane Crawford on February 16 [...]”
1 May 2017	“This Sunday night, 5/7, Club Paradise is back at Kinfolk 90 to bring some Miami flavour to Brooklyn . They’ve also created a mix exclusively for Kinfolk [...] Listen below [...]”
1 September 2017	“Every year, GQ scours the menswear landscape to find new designers to create a capsule collection for iconic American clothing brand Gap . And we are beyond stoked to have been included as part of their first ever global edition. GQ chronicled the whole things, and you can watch Episode One below [...]”
26 September 2017	“The Kinfolk x GAP collaboration has officially launched. A few weeks ago we were stoked to share that Kinfolk was selected as one of GQ’s Coolest Designers On the Planet . Kinfolk held the torch for Brooklyn , while the other winners repped for Tokyo and Paris. The selected few created an exclusive mini-collection [...]”
25 October 2017	“Halloween is creeping right around the corner so let’s have some skele-fun at Kinfolk . [...] We’re going to be live at 90 and 94 , so come through with your ghouls in your freshest costumes. [...]”
12 December 2017	“Ain’t no party like a Kinfolk New Year’s Eve party [...] Kinfolk 90 and Kinfolk 94 are the places to be [...]”
20 December 2017	“The Kinfolk Store is your go-to retailer for rare and vintage reads . Through the years we have curated a specialized collection in magazines and books. [...] Our art books span from decades [...]”
4 April 2018	“ Kinfolk is known as ‘Good Times International’ – quintessential lifestyle. We carried that energy from Paris Fashion Week, New York Fashion Week, and finally ended it with Tokyo Fashion Week . During our trip to Japan we collaborated with Suntoury’s Makers Mark to bring Kinfolk’s energy and New York experience to Tokyo.”
20 June 2018	“ KINFOLK X FILA CAPSULE COLLECTION . After the success of Kinfolk teaming up with Fila on their Mindblower footwear collection , the two come together once again for a special capsule paying homage to both companies. With the huge amount of popularity in the recent years with vintage tennis shoes , the Fila Original Fitness silhouette offers a wearable nostalgia for all. [...]”