

O/0187/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003721761
BY JOINT APPLICANTS CHIKAMSO CHINONYE EFOBI
AND DOXA CONSULTING LTD
TO REGISTER THE FOLLOWING TRADE MARKS:

BOSS BIBLE

AND

Boss Bible

(SERIES OF 2)

IN CLASSES 9, 16 AND 41

AND

AN OPPOSITION THERETO UNDER NUMBER 433152
BY THE LADBIBLE GROUP LIMITED

BACKGROUND AND PLEADINGS

1. On 16 November 2021, Chikamso Chinonye Efobi and Doxa Consulting Ltd (jointly, “the applicant”) applied to register “BOSS BIBLE” and “Boss Bible” as a series of two trade marks in the UK (collectively, “the contested mark”). The application was accepted and published for opposition purposes on 4 February 2022 and registration is sought for goods and services in Classes 9, 16 and 41.¹

2. On 3 May 2022, The Ladbible Group Limited (“the opponent”) opposed the application in full, based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).² The opponent relies upon the following six registered trade marks (collectively, “the earlier marks”):³

i. Trade mark number UK00916685315 (“the BIBLE mark”)⁴

Representation: BIBLE

Filing date: 8 May 2017

Registration date: 8 March 2018

Priority date: 9 November 2016

Specification relied upon: Goods and services in Classes 9 and 41.

ii. Trade mark number UK00003296777 (“the LAD mark”)

Representation: LAD BIBLE

Filing date: 14 March 2018

Registration date: 8 June 2018

Specification relied upon: Goods and services in Classes 9 and 41.

¹ These will be listed in the goods and services comparison.

² 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.

³ The opponent originally relied upon eight registered trade marks but amended its pleadings during the course of the proceedings, reducing this to six.

⁴ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EU trade mark (“EUTM”). As a result of the opponent having an EUTM protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

- iii. Trade mark number UK00913065024 (“the SPORT mark”)⁵
Representation: The SPORT Bible
Filing date: 8 July 2014
Registration date: 25 November 2014
Specification relied upon: Goods and services in Classes 9, 16 and 41.

- iv. Trade mark number UK00915216047 (“the FOOD mark”)⁶
Representation: The FOOD Bible
Filing date: 15 March 2016
Registration date: 3 February 2017
Specification relied upon: Goods and services in Classes 9, 16 and 41.

- v. Trade mark number UK00916749087 (“the CONTENT mark”)⁷
Representation: CONTENT BIBLE
Filing date: 18 May 2017
Registration date: 7 December 2017
Specification relied upon: Goods and services in Classes 9, 16 and 41.

- vi. Trade mark number UK00914266531 (“the GAMING mark”)⁸
Representation: The Gaming Bible
Filing date: 16 June 2015
Registration date: 15 December 2015
Specification relied upon: Goods and services in Classes 9, 16 and 41.

3. The marks relied upon by the opponent are considered earlier marks in accordance with section 6(1)(a) of the Act given they were filed for registration earlier than the date of application for the contested mark.

4. The BIBLE mark, the LAD mark, the FOOD mark and the CONTENT mark had not been registered for five years at the date of application for the contested mark and so, in accordance with section 6A of the Act, the marks are not subject to proof of use; the

⁵ See 4.

⁶ See 4.

⁷ See 4.

⁸ See 4.

opponent may rely upon all the goods and services identified for this opposition. The SPORT mark and the GAMING mark, however, are subject to proof of use; the opponent made a statement of use in relation to all the goods and services relied upon.

5. The opponent claims that the earlier marks relied upon constitute a ‘family’ of marks on the basis that they possess common characteristics: each mark features the suffix BIBLE. It is claimed that the family of marks is present on the UK market.

6. Under section 5(2)(b), the opponent relies upon all six of the earlier marks and claims that there is a likelihood of confusion between each of them and the contested mark, on the basis that the marks are similar and the respective goods and services are similar. The goods and services relevant to this ground will be listed in the appropriate section of this decision.

7. Under section 5(3), the opponent relies upon the BIBLE mark and the LAD mark and claims to have a substantial reputation in the UK for the goods and services relied upon in each mark’s specification. The opponent claims that use of the contested mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or reputation of the BIBLE and LAD marks. The goods and services relevant to this ground will be listed in the appropriate section of this decision.

8. Under section 5(4)(a), the opponent relies upon the unregistered signs “BIBLE” and “LAD BIBLE”, both of which the opponent claims to have used throughout the UK since 2012 in relation to the following services:

Provision of publishing services, social media services, content creation, collation and publication; marketing services; promotional services; entertainment publisher both online and via App software; provision of a wide range of publications, news, sports content, gaming content, educational content, images, entertainment, music content, trending content, marketing, advertising, promotional and viral videos, images and other content.

9. Under section 5(4)(a), the opponent claims to have generated a substantial goodwill in “BIBLE” and “LAD BIBLE” in the UK and that use of the contested mark would

constitute a misrepresentation to the public that would damage the opponent's goodwill. Therefore, use of the mark would be contrary to the law of passing off.

10. The applicant filed a defence and counterstatement essentially denying each ground of opposition. The applicant requested proof of use of the SPORT mark and the GAMING mark.⁹ I will deal with the applicant's request as a preliminary issue, below.

11. Both parties filed evidence in chief in these proceedings. The opponent chose not to file evidence in reply. Neither party requested a hearing but both parties filed written submissions in lieu. The opponent is represented by Bristows LLP; the applicant is unrepresented.

PRELIMINARY ISSUES

12. In its defence and counterstatement, the applicant's request for proof of use contained the following comment:

“Please provide evidence of use of the following marks particularly in the form of electronic diaries (Class 9) books, diaries and journals in physical form, (Class 16) and publication of books, journals and handbooks (Class 41). They should cover the list of goods and services in my trademark application.”

13. The applicant has listed goods and services that do not appear in the SPORT and GAMING marks' respective specifications. The opponent is expected neither to demonstrate use for goods and services on the basis that they appear in the applicant's specification, nor to demonstrate use for any goods and services that do not feature in its own marks' specifications. I understand the applicant's wording – especially its use of the word “particularly” – as a request for proof of use of the marks in their entirety, with an emphasis on the listed goods and services. That is seemingly how the opponent understood the request and filed its evidence accordingly and that

⁹ The applicant also requested proof of use of the two marks that were removed from the opposition by the opponent: this request is redundant.

is how I will proceed in my decision. In any event, as will become apparent, this point is unlikely to make a material difference to the outcome of this opposition.

14. Also in its defence and counterstatement, the applicant claims that its use of the contested mark predates the registration dates of the BIBLE mark and the LAD mark; the applicant has filed evidence accordingly. I refer to Tribunal Practice Notice (“TPN”) 4/2009, which is titled “Trade mark opposition and invalidation proceedings – defences”. Under the heading “The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark”, the following is stated:

“4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”

15. That is the case here. In these proceedings, the opponent’s earlier marks have priority as the earlier registered marks and, as the applicant has not sought to invalidate the earlier marks, any claim that the applicant was trading prior to the opponent’s registrations does not preclude the opponent bringing an opposition under sections 5(2)(b) or 5(3).

EVIDENCE

16. The opponent filed evidence in chief in the form of the witness statement of Ben Elshaw dated 10 March 2023 and its corresponding 29 exhibits (BE1-BE29). Mr Elshaw is Director of Group Operations at the opponent's company.

17. The applicant filed evidence in chief in the form of the witness statement of Chikamso Chinonye Efobi (the applicant) dated 5 July 2023 and its corresponding 33 exhibits (BCD01-BCD033).

18. I have taken the entirety of the evidence into account in reaching this decision and will refer to it below where necessary. As there was no hearing, this decision is taken following a careful consideration of all the papers before me.

MY APPROACH

19. In my view, it is not necessary to consider the likelihood of confusion under section 5(2)(b) in regard to all of the six earlier marks relied upon. The SPORT and GAMING marks are subject to proof of use; whilst they are registered for Class 16 goods, unlike the BIBLE and LAD marks, it is immediately obvious from the evidence that use of those marks has not been shown for Class 16 goods and so the advantage in that respect over some of the other marks is redundant. The remaining four of the six earlier marks are not subject to proof of use and can be relied upon for all their registered goods and services, which, collectively, have a broader scope of protection than the SPORT and GAMING marks. As such, I do not intend to carry out a separate proof of use assessment for the SPORT and GAMING marks. I will return to those marks only if it becomes necessary to do so.

DECISION

Section 5(2)(b)

20. Sections 5(2)(b) and 5A of the Act are as follows:

“5. [...]

(2) A trade mark shall not be registered if because –

(a) [...]

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

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

[...]

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

Relevant law

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

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of marks

22. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

23. 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 trade 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.

24. The trade marks to be compared are as follows:

The earlier marks	The contested mark
(i) BIBLE (ii) LAD BIBLE (iii) The FOOD Bible (iv) CONTENT BIBLE	(i) BOSS BIBLE (ii) Boss Bible (series of two)

25. I will consider first the overall impression of all the marks contained in the table above. I will then, in turn, compare each of the earlier marks with the contested mark.

26. The “BIBLE” mark comprises a single component, in which the overall impression solely resides. “LAD BIBLE” comprises two word elements, which hang together to form one meaning (with ‘LAD’ qualifying the word ‘BIBLE’, as per my later conceptual assessment) and contribute equally to the overall impression of the mark. The same applies to the contested mark and to the “CONTENT BIBLE” mark (though the meaning of this mark is more ambiguous). “The FOOD Bible” comprises three word elements, which hang together to form a unitary meaning; however, the definite article is neither dominant nor distinctive in the mark whereas ‘FOOD’ and ‘Bible’ contribute equally to the overall impression. The difference in case between the marks in the contested series does not affect the mark comparison since fair and notional use of a word mark, such as BOSS BIBLE, extends to the use of upper case, lower case, or sentence case.

(i) BIBLE

27. Visually, the marks coincide in the word ‘bible’; the entirety of the earlier mark is contained, as the second word, in the contested mark. The additional word ‘boss’ in the contested mark creates the visual difference. Overall, the marks are visually similar to a medium degree.

28. The earlier mark will be pronounced as the ordinary dictionary word ‘bible’, as two syllables. The contested mark will be pronounced as two words comprising three syllables. The aural similarity is the result of the shared word ‘bible’, whereas the word

'boss' in the contested mark creates a difference. Overall, I consider the marks to be aurally similar to a medium degree.

29. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court ("GC") and the CJEU including *Ruiz Picasso v OHIM*.¹⁰ The assessment must be made from the point of view of the average consumer.

30. The earlier mark, "BIBLE", will immediately conjure, in the mind of consumers, either the holy book of certain religions, or, informally, a book/work regarded as authoritative in a particular sphere. The contested mark, given the inclusion of the word 'boss' preceding the word 'bible', is unlikely to portray the concept of the holy book. "BOSS BIBLE" hangs together and the concept associated with the mark as a whole will be that of an authoritative book for a 'boss', being a reference to a particular person: someone who is in charge or makes decisions. In circumstances where the earlier mark is seen as a reference to the holy book, there is no meaningful conceptual similarity between the marks. Where the earlier mark is seen more generally as an authoritative book, there is at least a low degree of conceptual similarity between the marks.

(ii) LAD BIBLE

31. Visually, the marks coincide in their second word, 'bible', which is identical. The marks contain different first words: "LAD" versus "BOSS". Overall, the marks are visually similar to a medium degree.

32. The earlier mark will be pronounced as the two ordinary words it comprises, as three syllables. The contested mark will be pronounced as I have described in paragraph 28, above. On the basis that each mark comprises three syllables, the first being quite different and the final two being identical, there is a medium degree of aural similarity between the marks.

¹⁰ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

33. The concept associated with the contested mark is that which I have explained in paragraph 30, above. The concept associated with the earlier mark is also an authoritative book for a particular person, in this instance a 'lad', a word commonly used in relation to a boy or young man. Whilst 'boss' and 'lad' have different meanings, the fact that both marks indicate an authoritative book for a person, results in a similar concept. "LAD BIBLE" and "BOSS BIBLE" are conceptually similar to a medium to high degree.

(iii) The FOOD Bible

34. Visually, the marks coincide in their final word, 'bible', which is identical. The additional two words in the earlier mark, 'the' and 'food', as well as the first word, 'boss', in the contested mark, act as points of visual difference. Overall, the marks are visually similar to a low to medium degree.

35. The contested mark will be pronounced as I have described in paragraph 28, above. Despite the definite article in the earlier mark being neither dominant nor distinctive within the mark, that does not deem it aurally invisible.¹¹ "The FOOD Bible" will be articulated in its entirety, as three words comprising four syllables. The marks share the final two syllables and differ, aurally, in their remaining components. I find the marks to be aurally similar to between a low and medium degree.

36. The concept associated with the contested mark is that which I have explained in paragraph 30, above. The concept associated with the earlier mark will be that of an authoritative book in regard to food, i.e., a recipe book, for example. The marks both refer to books, though in different spheres. I therefore find only a low degree of conceptual similarity between the marks.

¹¹ Mr Philip Harris sitting as the Appointed Person in *Purity Wellness Group Ltd v The Stockroom (Kent) Ltd*, BL O/115/22, at [31].

(iv) CONTENT BIBLE

37. Visually, the marks coincide in their second word, 'bible', which is identical. The marks contain different first words: "CONTENT" versus "BOSS". Overall, the marks are visually similar to a medium degree.

38. The contested mark will be pronounced as I have described in paragraph 28, above. The earlier mark will be pronounced as the two ordinary words it comprises, as four syllables. The marks share the final two syllables and differ, aurally, in their remaining components. I find the marks to be aurally similar to between a low and medium degree.

39. The concept associated with the contested mark is that which I have explained in paragraph 30, above. I am not satisfied that the earlier mark will portray an immediately recognisable concept.¹² Whilst the word 'bible', as explained earlier in this decision, might cause consumers to think of the holy book or an authoritative book on a particular topic, it being preceded by the word 'content' renders the meaning of the mark slightly odd. The idea of 'a book containing content', the most obvious meaning of the two words, is unusual. If such a meaning is immediately grasped by consumers, the marks are conceptually similar to only a low degree, at best. In the alternative, the marks are conceptually neutral on the basis that consumers would grasp no clear meaning in relation to the earlier mark.

40. That concludes my comparison of the contested mark with each of the earlier marks. It is my view that based on my findings above, the "LAD BIBLE" mark is the opponent's best case for a finding of a likelihood of confusion. This is on the basis that it shares a similar concept with the contested mark and is, at least, as equally visually and aurally similar to the contested mark as the remaining earlier marks. I will proceed with my decision under section 5(2)(b) on the basis of the LAD BIBLE mark. If there is no likelihood of confusion with this mark, the remaining earlier marks do not improve the opponent's case, at least when considered individually.

¹² *Ruiz Picasso* (cited above).

Distinctive character of the earlier mark

41. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

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

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

42. 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/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

43. I will consider first the inherent distinctiveness of the LAD BIBLE mark, before I move onto the assessment of an enhanced distinctive character. The mark comprises two ordinary words which will be seen as a reference to an authoritative book/work aimed at ‘lads’, i.e., boys or young men. Where the opponent’s goods and services

broadly relate to publications, online publishing and the provision of online content, I find the LAD BIBLE mark to allude to the content or target audience of those goods and services, and to be distinctive to a lower than average degree. For the remainder of the specification, the mark has an average degree of inherent distinctive character.

44. Turning now to consider whether the distinctiveness of the earlier mark has been enhanced through use, I refer to the opponent's evidence of use. The opponent was founded in 2012, the principal activity of which is described as an online media publisher.¹³ For the years 2017 to 2021, inclusive, the opponent's UK revenue totalled over £140 million,¹⁴ though this figure is not broken down by each of their brands. In May 2021, the opponent's global audience totalled 264 million, with 29 million unique users (defined as those who view or interact with the opponent's content and who 'follow' the opponent's online accounts) in the UK.¹⁵ The opponent's content is said to reach an estimated two thirds of 18-34 year olds and over half of all adults in the UK.¹⁶ According to YouGov research conducted in 2022, of 1221 "nationally representative interviews of the GB population", 67% had heard of LAD BIBLE. The opponent's five websites (one of which is ladbible.com) attract almost 5 million unique visitors every month¹⁷ and the LAD BIBLE website in particular attracted between 71.2 million and 99 million UK visitors every year from 2015 to 2021.¹⁸

45. As of March 2019, LAD BIBLE was the most watched Facebook video publisher worldwide:¹⁹ the LAD BIBLE Facebook account attracted 132.4 billion views of its videos between 2016 and 2021.²⁰ On the same social media platform, the opponent's LAD BIBLE account has had between 30.4 million and 46.6 million followers every year from 2017 to 2022; the LAD BIBLE Instagram account had between 5.4 million and 12.8 million followers for the same years. LAD BIBLE Twitter (now 'X'), TikTok and YouTube accounts had 3.6 million, 10.2 million and 2.22 million followers/subscribers, respectively, in 2022.²¹ Mr Elshaw estimates (based on Google

¹³ Companies House Annual Reports for the years 2017-2021 at Exhibit BE2.

¹⁴ Mr Elshaw's witness statement at [35] and supported by Exhibit BE2.

¹⁵ Mr Elshaw's witness statement at [6].

¹⁶ Mr Elshaw's witness statement at [6].

¹⁷ Mr Elshaw's witness statement at [7].

¹⁸ Exhibit BE12.

¹⁹ Exhibit BE5.

²⁰ Mr Elshaw's witness statement at [54] and Exhibit BE12. The figure includes repeat views and is not limited to UK users.

²¹ Exhibit BE12.

Analytics data and UK website traffic data) that around 30% of the aforementioned global social media figures can be attributed to UK users.²²

46. The opponent has won or been shortlisted, or nominated, for several awards between 2015 and 2022,²³ including the Cannes Lions Awards, the Digital Entrepreneur Awards in 2015 and the Prolific North Awards in 2016 for ‘Video of the Year’ in relation to the LAD BIBLE app launch. There are also numerous examples of LAD BIBLE featuring in press coverage between 2015 and 2022, including BBC News, Business Wire and Press Gazette.²⁴ With regard to advertising and promotion, Mr Elshaw explains that the opponent rarely advertises itself beyond its own social platforms and websites,²⁵ however, he has provided the following UK advertising expenditure figures:²⁶

YEAR	UK EXPENDITURE (£)
2022 HY	1,037,000
2021	1,027,000
2020	506,000
2019	834,000
2018	615,000
2017	503,000
Aug 2016-Dec 2016	285,672
Aug 2015-July 2016	658,614
Aug 2014-July 2015	181,343
Aug 2013-July 2014	41,109

47. Taking the evidence as a whole, it is abundantly clear to me that the mark has a great capacity to identify some of the goods and services for which it is registered as coming from the opponent and, therefore, to distinguish those goods and services from those of other undertakings. There has been fairly long-standing but very intensive

²² Mr Elshaw’s witness statement at [53].

²³ Mr Elshaw’s witness statement at [11] and [23]-[31].

²⁴ Exhibit BE7.

²⁵ Mr Elshaw’s witness statement at [39].

²⁶ Mr Elshaw’s witness statement at [40]. These are not broken down by brand and so include promotion of the LAD BIBLE mark as well as all other marks/brands forming part of the opponent.

use of the mark which has had an enormous reach across the UK. As a result of its use, the mark is highly distinctive. However, that finding does not extend to the full breadth of the goods and services relied upon. I have considered the entirety of the evidence before me, with particular attention on Exhibit BE11, comprising representative content from across the opponent's platforms. The content is hugely varied and includes campaigns covering a broad range of issues – such as mental health, abortion, sexual abuse and environmental issues – as well as entertainment and news content. The content, all in electronic format, includes text, images and video. I consider the following to be sufficiently broad to cover the goods and services for which the opponent has shown an enhanced distinctive character in its LAD BIBLE mark:

Class 9: *Publications in electronic format consisting of social media content.*

Class 41: *Provision of entertainment information via social media; providing non-downloadable electronic publications consisting of social media content; entertainment publishing services via social media; online publication of news and current affairs via social media; providing on-line videos (non-downloadable).*

Comparison of goods and services

48. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

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

49. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281 for assessing similarity between goods/services also

include an assessment of the users and channels of trade of the respective goods/services.

50. Further, in *Kurt Hesse v OHIM*,²⁷ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,²⁸ the GC stated that “complementary” means:

“...there is 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.”

51. In *Gérard Meric v OHIM*, the GC confirmed that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):²⁹

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

52. I bear in mind that it is permissible to group goods/services together for the purposes of assessment: *Separode Trade Mark*.³⁰

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same

²⁷ Case C-50/15 P.

²⁸ Case T-325/06.

²⁹ Case T-133/05.

³⁰ BL O/399/10.

reasons, the decision taker may address them collectively in his or her decision.”

53. Finally, the judgment of Jacob J (as he then was) in *Avnet Incorporated v Isoact Limited* is also relevant:³¹

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

The applicant’s goods and services

Class 9: *Diaries (Electronic -); Electronic diaries; Cases for electronic diaries.*

Class 16: *Books; Song books; Book covers; Cookery books; Story books; Book bindings; Flip books; Gift books; Wedding books; Educational books; Index books; Memorandum books; Fiction books; Dictation books; Book wrappings; Log books; Appointment books; Recipe books; Cook books; Check books; Account books; Ledger books; Manuscript books; Score books; Birthday books; Autograph books; Copy books; Comic books; Sketch books; Commemorative books; Book jackets; Signature books; Book markers; Cheque books; Activity books; Diaries; Pocket diaries; Desk diaries; Leather covered diaries; Diaries [printed matter]; Children's books; Sticker books; Agenda books; Coupon books; Book ends; Printed books; Painting books; Scrap books; Writing books; Guide books; Travel books; Bill books; Religious books; Data books; Information books; Fantasy books; Rule books; Poster books; Blank journal books; Journals; Blank journals; Trade journals; Legal journals; Medical journals; Blank writing journals; Printed horoscopes; Cartoon prints; Leather book covers; Covers for books; Book-cover paper; Check book*

³¹ [1998] F.S.R. 16.

*covers; Protective covers for books; Leather appointment book covers; Covers for cheque books; Covering materials for books.*³²

Class 41: *Publication of books, magazines, almanacs and journals; Publication of electronic books and journals online; Online publication of electronic books and journals; Publishing of electronic books and journals online; Freelance journalism; Journalism services; Publishing of electronic books and journals on-line; Publication of electronic books and journals on-line; On-line publication of electronic books and journals; Publication of journals; Publishing of journals; On-line publication of electronic books and journals [not downloadable]; On-line publication of electronic books and journals (non-downloadable); Multimedia publishing of journals; Publishing of journals, books and handbooks in the field of medicine; Publication of scientific information journals; Concert booking; Rental of books; Loan of books; Publishing of books; Booking of entertainment; Publication of books; Publication of books, reviews; Booking of entertainment halls; Publication of year books; Concert booking.*

The opponent's goods and services (covered by the LAD BIBLE mark)

Class 9: *Publications in electronic format; downloadable publications; downloadable electronic publications; online electronic publications downloadable from the Internet; publications in electronic form supplied online from databases or from facilities provided on the Internet (including web sites); electronic magazines; multi-media recordings and publications; printed publications in electronically readable form; computer software and programs; computer games; downloadable software; downloadable software applications; computer software downloadable from the Internet; application software; application software for mobile communication devices; Video games software; Interactive video game programs; Instruction manuals in electronic format; Encoded identity cards; Downloadable interactive entertainment*

³² Some of the terms in the applicant's Class 16 are duplicated up to four times. I have removed the duplicates from the list for the purposes of this decision.

software; Computer software for use in providing multiple user access to a global computer information network; data recorded in electronic, optical or magnetic form; data carriers; data storage media; memory cards; audio and/or video recordings; downloadable and streamable audio and/or video recordings; pre-recorded videos, CDs, CDIs, CD-ROMs, discs, cassettes and other data carriers containing information recorded in magazine form; Computer peripheral devices; keyboards, mice (data processing), trackballs for moving the cursor and wireless electronic controls, all for use with electronic apparatus for consumers; Data processing equipment; Remote controls; Computer keyboards; audio headphones and headsets for use with computers and video gaming; Downloadable video recordings; computer game programs; game programs for arcade video game machines; video game controllers, namely remote controls, joysticks, interactively controlled floor pads, steering wheels for video games, headphones, keyboards and mice (data processing), all for use with computers and consoles for video game platforms; wireless mice (data processing) and remote controls for use with televisions, computers and set-top boxes (decoders); mouse pads; touch keys (touch pads); computer keyboard controllers; computer programs and software for use in conjunction with the provision of an interface (interface devices or interface programs for computers) between a computer and a peripheral apparatus; interactive user manuals sold as a units with the aforesaid goods; eyewear; glasses; spectacles; sunglasses; lenses; frames for spectacles and sunglasses; cases and boxes for spectacles and sunglasses; cords, straps and chains for spectacles and sunglasses; sports eyewear; eye protection wear for sports; glasses for sports; magnets; digital photograph frames; covers and cases for mobile phones, computers and personal electronic devices; parts and fittings for all the aforesaid goods.

Class 41: *Entertainment services; education services; sporting and cultural activities; online education entertainment services; entertainment services provided via the Internet and other computer and communications networks; entertainment services featuring electronic*

media, multimedia content, audio and video content, movies, music, games, photos, images, pictures, graphics, text, messages, information, data, news and user-generated content provided via the Internet and other computer and communication networks; presentation of data, messages and documents for entertainment purposes; interactive information provided online via the Internet and other computer and communication networks relating to education, entertainment, music, films and sports; interactive information provided online via the Internet and other computer and communication networks relating to news and entertainment in the fields of fashion, food, careers, travel, women's health and adventure sports; provision of entertainment information for accessing via communication and computer networks; providing non-downloadable electronic publications; providing online publications (not downloadable); providing online non-downloadable magazines; production of video recordings and sound recordings; production of webcasts; production of podcasts; publishing services; publication of magazines, books, texts and printed matter; publishing by electronic means; digital video, audio and multimedia entertainment publishing services; multimedia publishing of magazines, journals and news; provision of audio and/or visual material and games online (not downloadable); online publication of news and current affairs; electronic publications (not downloadable); providing on-line videos (non-downloadable); provision of entertainment services through the media of video-films; arranging, organising and conducting of games, contests, competitions, quizzes, awards, conferences, exhibitions, courses, seminars and events; organising, conducting and production of shows, displays and parties; arranging, organising, presentation and provision of concerts, live entertainment, musical performances; arranging and conducting award ceremonies; presentation of awards for achievement; arranging, organising and conducting of events for cultural and sporting purposes; organisation of sporting competitions and sports events; gaming services; hospitality services (entertainment); hospitality services, namely customer reception services (entertainment services), including provision of admission tickets for sporting or entertainment

events; fan club services; information, advisory and consultancy services relating to all of the aforesaid services.

54. I will now proceed to the comparison.

Class 9

Diaries (Electronic -); Electronic diaries

55. These terms are interchangeable. Electronic diaries are physical electronic devices used for notetaking and recording events and experiences. Notes or records might be made using either a digital pen or a built-in electronic keyboard. The opponent's LAD BIBLE specification in Class 9 includes *data processing equipment*, which refers to devices or systems which process digital data. Electronic diaries are a type of data processing equipment and so these goods are identical in line with *Meric*. In the event that I am interpreting *data processing equipment* too widely³³ I consider such a term to at least cover computers, which I find similar to a medium to high degree to electronic diaries on the basis of an overlap in nature, user, method of use and channels of trade.

Cases for electronic diaries

56. The opponent's LAD BIBLE specification in Class 9 includes *covers and cases for mobile phones, computers and personal electronic devices*. An electronic diary is a personal electronic device and so the applicant's *cases for electronic diaries* fall within the scope of the opponent's *covers and cases for...personal electronic devices*. These goods are identical in line with *Meric*.

Class 16

Books; Song books; Cookery books; Story books; Flip books; Gift books; Educational books; Fiction books; Recipe books; Cook books; Birthday books; Copy books; Comic

³³ *Avnet*, cited above.

books; Activity books; Children's books; Sticker books; Printed books; Painting books; Guide books; Travel books; Religious books; Data books; Information books; Fantasy books; Rule books; Poster books; Journals; Trade journals; Legal journals; Medical journals; Printed horoscopes; Cartoon prints.

57. The above goods are types of books, texts or other printed matter that have, or are likely to have, content; they contain information, literature or other content. All of these goods will be published, i.e., they go through the various stages of publishing: editing, design, proofreading, printing and marketing; the content of the goods is made available to the public via this process. They are, therefore, collectively, publications. I consider there to be an overlap between these goods and the opponent's term *publications in electronic format*. The nature differs since the applicant's goods, by virtue of being in Class 16, are printed publications whereas the opponent's are electronic publications, but all other relevant factors overlap. I consider these goods similar to a high degree.

Wedding books; Index books; Memorandum books; Dictation books; Log books; Appointment books; Check books; Account books; Ledger books; Manuscript books; Score books; Autograph books; Sketch books; Commemorative books; Signature books; Cheque books; Diaries; Pocket diaries; Desk diaries; Leather covered diaries; Diaries [printed matter]; Agenda books; Coupon books; Scrap books; Writing books; Bill books; Blank journal books; Blank journals; Blank writing journals.

58. The above goods are books, diaries and journals that are unlikely to have content. They are usually wholly, or mainly, blank for the user to complete themselves. The activity for preparing these goods for sale is unlikely to fall within the ordinary meaning of publishing. The minimal content of these goods means that they go through a far simpler production process, which can more accurately be described as manufacturing as opposed to publishing. On this basis, whilst the opponent's *publication of magazines, books, texts and printed matter* is the most obvious term in the LAD BIBLE's specification for comparison, when considering the core meaning of these services, in line with *Avnet*, it would be too wide an interpretation to find that publication services cover blank books, diaries and journals, which are not 'published'. There is no meaningful similarity between these goods and services, nor between the

applicant's goods and any other of the opponent's goods and services in its LAD BIBLE specification, including *publications in electronic format*.

Book covers; Book bindings; Book wrappings; Book jackets; Book markers; Book ends; Leather book covers; Covers for books; Book-cover paper; Check book covers; Protective covers for books; Leather appointment book covers; Covers for cheque books; Covering materials for books.

59. Whilst publication services are similar to books, being publications, on the basis of an overlap in purpose and end user, the same reasoning does not extend to the above goods, which can all be described as either accessories for books or materials for making or covering books. Whilst there may be a broad overlap in the end user of these goods and the opponent's *publication of magazines, books, texts and printed matter*, this similarity is at such a general level that I do not consider it could be relevant to the likelihood of confusion.

60. I have also considered any potential similarity between these goods and the opponent's *covers and cases for mobile phones, computers and personal electronic devices*. Besides a slight overlap in the physical nature of covers for books and covers for personal electronic devices, for example, there is no meaningful similarity. Users will only overlap to the extent that they are members of the general public; the goods are not complementary or in competition and they are not sold in close proximity, neither do they share a purpose – they cover/protect different items.

61. I find no similarity between the applicant's goods listed above and any of the opponent's goods or services in its LAD BIBLE specification.

Class 41

Publication of books, magazines, almanacs and journals; Publication of journals; Publishing of journals; Publishing of journals, books and handbooks in the field of medicine; Publication of scientific information journals; Publishing of books; Publication of books; Publication of books, reviews; Publication of year books.

62. Either because of their identical wording, or due to the *Meric* principle, the above terms in the applicant's specification are identical to the opponent's *publication of magazines, books, texts and printed matter*.

Publication of electronic books and journals online; Online publication of electronic books and journals; Publishing of electronic books and journals online; Publishing of electronic books and journals on-line; Publication of electronic books and journals on-line; On-line publication of electronic books and journals; On-line publication of electronic books and journals [not downloadable]; On-line publication of electronic books and journals (non-downloadable).

63. The above services are identical to the opponent's *publishing by electronic means and/or digital video, audio and multimedia entertainment publishing services*.

Multimedia publishing of journals

64. The applicant's *multimedia publishing of journals* is identical to the opponent's *multimedia publishing of magazines, journals and news*.

Freelance journalism; Journalism services

65. Journalism involves collecting, preparing and distributing news, through print and electronic media. The opponent's LAD BIBLE specification, in Class 41, includes *interactive information provided online via the Internet and other computer and communication networks relating to news [...], multimedia publishing of magazines, journals and news and online publication of news and current affairs*. These services are not on all fours with journalism: they involve the making available of news but not necessarily the collecting or preparing of it. I do consider there to be a degree of similarity, though. I bear in mind the core meaning of the services and find an overlap in the users and the end purpose, which is to provide news to consumers. The trade channels will overlap and there is a degree of complementarity in that journalism and publishing are important for one another to the extent that consumers may believe that the provider for both is the same. Overall, I find a medium degree of similarity between these services.

Rental of books; Loan of books.

66. These are services usually offered by a library and involve consumers borrowing books for a period of time. The opponent has not suggested any particular terms for which it considers there to be similarity and so I will consider the opponent's *publications in electronic format* on the basis that these include e-books. These goods and services differ in nature and method of use, and do not overlap in trade channels; the services offer the rental or loan of physical books intended for traditional reading, whereas the goods are electronic publications meant for accessing online or downloading and reading electronically: therefore, the purpose also somewhat differs. However, I acknowledge there is a general overlap in purpose to the extent that there is a shared intention of providing the user with reading material. On the same basis, the users are those looking to access reading material, albeit different types of reading material accessed in different ways: there is a distinction between the two groups and so this is not a hugely persuasive factor. I recognise there may be a fleeting element of competition when readers decide whether to visit a library to borrow a physical book or to download/access an electronic publication. Again, this is not compelling given the degree of generality. Overall, I am not satisfied that the similarities between these goods and services are sufficient to make an overall finding of similarity which could be relevant to the likelihood of confusion.³⁴ I have considered the remainder of the opponent's specification and have not identified a term which puts the opponent in a better position. I find no similarity between *rental of books; loan of books* and any of the opponent's goods and services.

Concert booking; Booking of entertainment; Booking of entertainment halls.

67. These services all involve the booking of entertainment. The opponent's specification includes *entertainment services*. Whilst entertainment services do not include the booking of entertainment but rather the provision of the entertainment itself, meaning the core purpose and method of use differs, there is a complementary nature between these services. Providers of entertainment often offer their own booking

³⁴ See the comments of Mr Iain Purvis KC in *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)* [2024] EWHC 1098 (Ch).

services rather than having to book via a third party and so users will be open to the idea that there is a link between the undertakings responsible for the entertainment services and the booking thereof. Overall, I find a medium degree of similarity between these services.

68. In accordance with *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, if there is no similarity between goods and services, there is no likelihood of confusion to be considered. Consequently, the opposition under section 5(2)(b) has failed in relation to the following goods and services:

Class 16: *Wedding books; Index books; Memorandum books; Dictation books; Log books; Appointment books; Check books; Account books; Ledger books; Manuscript books; Score books; Autograph books; Sketch books; Commemorative books; Signature books; Cheque books; Diaries; Pocket diaries; Desk diaries; Leather covered diaries; Diaries [printed matter]; Agenda books; Coupon books; Scrap books; Writing books; Bill books; Blank journal books; Blank journals; Blank writing journals; Book covers; Book bindings; Book wrappings; Book jackets; Book markers; Book ends; Leather book covers; Covers for books; Book-cover paper; Check book covers; Protective covers for books; Leather appointment book covers; Covers for cheque books; Covering materials for books.*

Class 41: *Rental of books; Loan of books.*

69. For reasons that will become apparent, I will also compare the applicant's goods and services to the goods and services for which the opponent has demonstrated an enhanced distinctive character ("the enhanced goods and services"):

Class 9: *Publications in electronic format consisting of social media content.*

Class 41: *Provision of entertainment information via social media; providing non-downloadable electronic publications consisting of social media content; entertainment publishing services via social media; online publication of*

news and current affairs via social media; providing on-line videos (non-downloadable).

Class 9

Diaries (Electronic -); Electronic diaries

70. These goods are not similar to any of the enhanced goods or services; they are devices for recording data; they are not publications, nor do they go through, or involve, the publishing process, or the provision of entertainment. There is no meaningful overlap between any of the relevant factors and so I find no similarity.

Cases for electronic diaries

71. As per my previous paragraph, there is no obvious similarity between these goods and any of the enhanced goods and services. There is no meaningful overlap between any of the relevant factors and so I find no similarity.

Class 16

Books; Song books; Cookery books; Story books; Flip books; Gift books; Educational books; Fiction books; Recipe books; Cook books; Birthday books; Copy books; Comic books; Activity books; Children's books; Sticker books; Printed books; Painting books; Guide books; Travel books; Religious books; Data books; Information books; Fantasy books; Rule books; Poster books; Journals; Trade journals; Legal journals; Medical journals; Printed horoscopes; Cartoon prints.

72. There is a degree of similarity between these goods and some of the enhanced goods and services (electronic publications in Class 9 and non-downloadable publications in Class 41). There is some overlap in nature and purpose to the extent that there is a shared intention of providing the user with reading material, and there is a degree of competition with users choosing between printed reading material and online reading material. However, the enhanced goods and services relate to social media and online content. For this reason, the nature, purpose and user are further

removed than the broader 'publication' terms; the degree of competition is also lessened. Overall, I find these goods similar to a low degree to the enhanced goods and services.

Wedding books; Index books; Memorandum books; Dictation books; Log books; Appointment books; Check books; Account books; Ledger books; Manuscript books; Score books; Autograph books; Sketch books; Commemorative books; Signature books; Cheque books; Diaries; Pocket diaries; Desk diaries; Leather covered diaries; Diaries [printed matter]; Agenda books; Coupon books; Scrap books; Writing books; Bill books; Blank journal books; Blank journals; Blank writing journals.

73. My comparison at paragraph 58 applies equally here. I have found no meaningful similarity between these goods and any of the opponent's goods and services and so these goods have survived the opposition under section 5(2)(b).

Book covers; Book bindings; Book wrappings; Book jackets; Book markers; Book ends; Leather book covers; Covers for books; Book-cover paper; Check book covers; Protective covers for books; Leather appointment book covers; Covers for cheque books; Covering materials for books.

74. My comparison at paragraph 59 applies equally here. I have found no meaningful similarity between these goods and any of the opponent's goods and services and so these goods have survived the opposition under section 5(2)(b).

Class 41

Publication of books, magazines, almanacs and journals; Publication of journals; Publishing of journals; Publishing of journals, books and handbooks in the field of medicine; Publication of scientific information journals; Publishing of books; Publication of books; Publication of books, reviews; Publication of year books.

75. There is some overlap between these services and some of the enhanced services (providing non-downloadable electronic publications consisting of social media content; entertainment publishing services via social media; online publication of news

and current affairs via social media): they are all publications services. The content of the publications differs and so there is minimal overlap in the services' nature and purpose, though there is an overlap in user and trade channels. Overall, I find a medium degree of similarity between these services.

Publication of electronic books and journals online; Online publication of electronic books and journals; Publishing of electronic books and journals online; Publishing of electronic books and journals on-line; Publication of electronic books and journals on-line; On-line publication of electronic books and journals; On-line publication of electronic books and journals [not downloadable]; On-line publication of electronic books and journals (non-downloadable).

76. On the principle outlined in *Merit* I find the above services to encompass some of the opponent's enhanced services: *providing non-downloadable electronic publications consisting of social media content; entertainment publishing services via social media; online publication of news and current affairs via social media*. These are identical.

Multimedia publishing of journals

77. The comparison with these services can be made on much the same basis as in my previous paragraph. I find these services identical.

Freelance journalism; Journalism services

78. My comparison at paragraph 65 applies equally here. The applicant's *freelance journalism* and *journalism services* are similar to a medium degree to the opponent's enhanced services.

Rental of books; Loan of books.

79. My comparison at paragraph 66 applies equally here. I have found no meaningful similarity between these services and any of the opponent's goods and services and so these goods have survived the opposition under section 5(2)(b).

Concert booking; Booking of entertainment; Booking of entertainment halls.

80. These services all involve the booking of entertainment. There is no meaningful similarity between these and any of the opponent's enhanced goods and services.

81. That concludes my comparison of the parties' goods and services.

The average consumer and the purchasing act

82. It is necessary for me to determine who the average consumer is for the respective parties' goods/services. I must then determine the manner in which the goods/services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

83. The relevant goods and services are those for which I have found similarity or identity. For the majority of the goods (books and electronic diaries) and some of the services (entertainment and concert bookings), the average consumer will be a member of the general public who will purchase the goods and services reasonably frequently with a fairly average degree of attention: considerations as to the price and content (of books and of concerts) will be relevant. For some of the goods (types of journals in particular) there will be a second group of consumers: businesses or organizations, such as educational institutions, purchasing journals for use in their individual settings. In such circumstances, a slightly higher than average degree of

attention will be paid to the purchase given the impact of the accompanying texts on the quality and reputation of the services offered.

84. For the publishing and journalism services and, to some extent, the entertainment booking services, the average consumer is likely to be a business or professional, who will have consideration as to a wide variety of factors. For the entertainment services, an average degree of attention will be paid. On the other hand, publishing and journalism services are ones which are likely to attract a higher than average degree of attention: business or professional users will deliberate associated costs and terms of potential contracts, for example.

85. Generally speaking, for all the goods and services at issue, a combination of visual and aural considerations will be relevant to the selection. For the goods, which are likely to be self-selected from the shelves of physical outlets, from the pages of catalogues or from online retailers, the visual impact of the marks is of more importance, though I do not discount an aural consideration based on verbal recommendations or conversations with retail assistants. Again, for the services, there might be a verbal element in preliminary dialogue and word of mouth recommendations, however, visual scrutiny of the marks on websites and marketing literature will predominate, particularly as contracts for services such as publishing and journalism, are drawn up.

Likelihood of confusion

86. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, with no process of reasoning, whilst indirect confusion is where the average consumers realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to

keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

87. Earlier in this decision I found that:

- Where the goods/services are not dissimilar, the degree of similarity between the relevant goods and services varies from medium to identical.
- BOSS BIBLE and LAD BIBLE (being the opponent's best case, as explained in paragraph 40, above) are visually and aurally similar to a medium degree and conceptually similar to between a medium and high degree.
- LAD BIBLE has a lower than average degree of inherent distinctive character for its goods and services which broadly relate to publications, online publishing and the provision of online content, and an average degree for the remainder of its goods/services.
- Based on the extensive evidence of LAD BIBLE, the mark is highly distinctive for the following goods and services:

Class 9: *Publications in electronic format consisting of social media content.*

Class 41: *Provision of entertainment information via social media; providing non-downloadable electronic publications consisting of social media content; entertainment publishing services via social media; online publication of news and current affairs via social media; providing on-line videos (non-downloadable).*

- The average consumer will either be a member of the general public, a business or organisation, or a professional, depending on the goods and services.
- For members of the general public, the degree of attention paid to the selection of the goods and services is fairly average. For the goods and services purchased by businesses, organisations or professionals, a higher than average degree of attention will be paid.
- For all the goods and services, the purchasing process is predominantly visual, though there will be an aural element.

88. Notwithstanding the principle of imperfect recollection, I consider that there are sufficient visual and aural differences between the marks to avoid them being mistakenly recalled as one another. Any group of consumers, regardless of the degree of attention paid to the selection, will notice that the first word in each mark – BOSS and LAD – is entirely different and will, therefore, not be misremembered. Direct confusion is not likely between these marks for any goods or services.

89. I go on to consider whether the average consumer, having recognised that the marks are different, considers the common element of both marks (the word BIBLE) and determines, through a mental process, that the marks are related and originate from the same, or an economically linked undertaking.

90. Indirect confusion was described in the following terms by Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*³⁵

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the

³⁵ BL O/375/10.

later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

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

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

91. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis' formulation but added:

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporated

the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licencing).

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

92. In *Duebros Limited v Heirler Cenovis GmbH*, James Mellor QC, sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element.³⁶ This is mere association not indirect confusion.

93. In the case before me, the common element is BIBLE. The presence of the word BIBLE preceded by a word that may be seen as a reference to a person, when bearing in mind the enhanced distinctive character of LAD BIBLE, has the potential to confuse consumers in relation to certain goods and services. LAD BIBLE has a great capacity to identify some of the goods and services for which it is registered as coming from a particular undertaking. Therefore, when consumers see BOSS BIBLE in relation to online content, for example, consumers already having seen LAD BIBLE in relation to the same goods and services, and seeing it as highly distinctive in that field, may believe the undertakings to be the same or related. It seems entirely logical to me that consumers may believe BOSS BIBLE to be a sub-brand of LAD BIBLE, being used in relation to online publications with a different content, i.e., content aimed at a ‘boss’ as opposed to a ‘lad’.

³⁶ BL O/547/17.

94. To my mind, there is only a likelihood of indirect confusion for the applicant's goods/services which are the same as the goods and services for which the opponent has shown an enhanced distinctive character. Although the earlier mark is highly distinctive in its sector (broadly speaking, online publishing via social media and electronic publications consisting of social media content), the enhanced distinctiveness resides in LAD BIBLE as a whole and not in the word BIBLE, solus. Therefore, where the goods/services are only similar, or relate to goods/services for which the distinctive character of LAD BIBLE has not been enhanced through use, and therefore remains only average, it is far more likely that it will be seen as a coincidence that two entities incorporate the common word BIBLE, rather than it being a variant used by the opponent. Accordingly, in respect of the applicant's goods and services which are not the same as those goods and services for which the opponent has shown an enhanced distinctive character, I see no proper basis for a finding of indirect confusion.

Family of marks

95. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility

that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64. As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65. Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66. It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

96. For marks to constitute a 'family' there must be several marks which possess common characteristics, all of which must be present on the market. The opponent claims that its six earlier marks (BIBLE, LAD BIBLE, The SPORT Bible, The FOOD Bible, CONTENT BIBLE and The Gaming Bible) constitute a 'family' of marks on the basis that each features the suffix 'BIBLE'. The opponent's case is that the contested mark has an identical construction to its family of marks, i.e., "word + BIBLE",³⁷ and that, as a result, there exists a likelihood of confusion.

³⁷ Paragraph 10 of the opponent's statement of grounds.

97. There is little to no evidence of the BIBLE mark being used on its own without a word preceding it. As such, I do not consider it forms part of the opponent's family of marks. As for the remaining five earlier marks, on the basis of the social media accounts and website evidence,³⁸ I am satisfied that each mark was present on the UK market at the relevant date (being the application date of the contested mark).³⁹

98. Looking at those five marks as a 'family', the common element is plainly "BIBLE": a word which will be immediately seen as a reference to either the holy book, or to an authoritative book/work. Further, the word or words preceding BIBLE do not appear to follow any particular pattern, other than being nouns. The submission that the opponent's family extends to any mark including 'word + BIBLE' amounts to a claim to a very powerful monopoly in the use of a word extremely well-known by the general public. I cannot accept that no one but the opponent should be able to market a publication about a topic using the name of the topic followed by -BIBLE. Even considering the opponent's (five) earlier marks as a 'family', the evidence before me does not support the broad conclusion that any mark containing 'word + BIBLE' would be regarded as a member of the opponent's family. Bearing in mind my findings in relation to the opponent's most similar mark – LAD BIBLE – the broader family of marks argument takes the opponent's 5(2) case no further.

Conclusion

99. I find there to be a likelihood of confusion for the applicant's services which are identical to those of the opponent for which I have found an enhanced distinctive character. The opposition under section 5(2)(b) succeeds for the following services, which are refused registration:

Class 41: *Publication of electronic books and journals online; Online publication of electronic books and journals; Publishing of electronic books and journals online; Publishing of electronic books and journals on-line; Publication of electronic books and journals on-line; On-line publication*

³⁸ See Exhibits BE25, 26 and 29 and the witness statement of Mr Elshaw at [108] and [126].

³⁹ Whilst the SPORT and GAMING marks are subject to proof of use, for reasons that will become apparent, I will proceed to consider the family of marks argument as though genuine use has been demonstrated for those marks.

of electronic books and journals; On-line publication of electronic books and journals [not downloadable]; On-line publication of electronic books and journals (non-downloadable); Multimedia publishing of journals.

Section 5(3)

100. Section 5(3) states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

101. Section 5(3A) of the Act states:

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

102. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oréal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

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

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

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal v Bellure NV*, paragraph 44.

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oréal v Bellure NV*, paragraph 44.

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

Reputation

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

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

104. Under section 5(3), the opponent relies upon “BIBLE” and “LAD BIBLE” for goods in Class 9 and services in Class 41.⁴⁰ As discussed at paragraph 40, above, I found the LAD BIBLE mark to represent the opponent’s best case under section 5(2)(b). For the same reasons, I consider this also to apply to the section 5(3) ground of opposition and so I will proceed on the same basis.

105. I recall my summary and assessment of the evidence, at paragraphs 44 to 47, in regard to the enhanced distinctive character of LAD BIBLE. The factors that were relevant in that assessment are also the ones that I must consider when deciding whether the mark has a reputation and so the assessment of the opponent’s evidence applies equally here. I am satisfied that the LAD BIBLE mark was known by a significant part of the public and that it had, at the date of application, a substantial reputation for the following goods and services in its specification:

Class 9: *Publications in electronic format consisting of social media content.*

Class 41: *Provision of entertainment information via social media; providing non-downloadable electronic publications consisting of social media content; entertainment publishing services via social media; online publication of news and current affairs via social media; providing on-line videos (non-downloadable).*

⁴⁰ These are listed in full in the Annex to this decision.

Link

106. My assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

107. In *Adidas-Salomon*, the CJEU held that the similarity of signs must be assessed in the same way for sections 5(2) and 5(3) of the Act. As such, my findings at paragraphs 26 and 31 to 33 are equally applicable here and I adopt them accordingly.

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

108. The relevant goods and services are those in the application and those for which I have found the opponent to have a reputation. I have compared those goods and services at paragraphs 69 to 80, above. I will briefly recap my findings.

109. I found no similarity between the opponent's reputed goods and services and the following terms from the applicant's specification:

Class 9: *Diaries (Electronic -); Electronic diaries; Cases for electronic diaries.*

Class 16: *Wedding books; Index books; Memorandum books; Dictation books; Log books; Appointment books; Check books; Account books; Ledger books; Manuscript books; Score books; Autograph books; Sketch books; Commemorative books; Signature books; Cheque books; Diaries; Pocket diaries; Desk diaries; Leather covered diaries; Diaries [printed matter]; Agenda books; Coupon books; Scrap books; Writing books; Bill books; Blank journal books; Blank journals; Blank writing journals; Book covers; Book bindings; Book wrappings; Book jackets; Book markers; Book ends; Leather book covers; Covers for books; Book-cover paper;*

Check book covers; Protective covers for books; Leather appointment book covers; Covers for cheque books; Covering materials for books.

Class 41: *Rental of books; Loan of books; Concert booking; Booking of entertainment; Booking of entertainment halls.*

110. I found a medium degree of similarity between the opponent's reputed goods and services and the following terms from the applicant's specification:

Class 16: *Books; Song books; Cookery books; Story books; Flip books; Gift books; Educational books; Fiction books; Recipe books; Cook books; Birthday books; Copy books; Comic books; Activity books; Children's books; Sticker books; Printed books; Painting books; Guide books; Travel books; Religious books; Data books; Information books; Fantasy books; Rule books; Poster books; Journals; Trade journals; Legal journals; Medical journals; Printed horoscopes; Cartoon prints.*

Class 41: *Publication of books, magazines, almanacs and journals; Publication of journals; Publishing of journals; Publishing of journals, books and handbooks in the field of medicine; Publication of scientific information journals; Publishing of books; Publication of books; Publication of books, reviews; Publication of year books; Freelance journalism; Journalism services.*

111. I found identity between the opponent's reputed goods and services and the following terms from the applicant's specification:

Class 41: *Publication of electronic books and journals online; Online publication of electronic books and journals; Publishing of electronic books and journals online; Publishing of electronic books and journals on-line; Publication of electronic books and journals on-line; On-line publication of electronic books and journals; On-line publication of electronic books and journals [not downloadable]; On-line publication of electronic books and journals (non-downloadable); Multimedia publishing of journals.*

The strength of the earlier mark's reputation

112. LAD BIBLE has a substantial reputation for the goods and services listed in paragraph 105.

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

113. LAD BIBLE has either a lower than average or an average degree of inherent distinctiveness (depending on the goods/services), which has been enhanced to a high degree through use in relation to the reputed goods and services.

Whether there is a likelihood of confusion

114. I have found a likelihood of indirect confusion between the opponent's reputed goods and services and some of the applicant's services in Class 41 (see paragraph 111, above). I found no likelihood of confusion for the remainder of the applicant's specification.

Conclusions on link

115. Consumers will make a link between the marks if the contested mark is used in relation to:

Class 41: *Publication of electronic books and journals online; Online publication of electronic books and journals; Publishing of electronic books and journals online; Publishing of electronic books and journals on-line; Publication of electronic books and journals on-line; On-line publication of electronic books and journals; On-line publication of electronic books and journals [not downloadable]; On-line publication of electronic books and journals (non-downloadable); Multimedia publishing of journals.*

116. For the remaining goods and services, the burden is on the opponent to show that the earlier mark will be brought to mind by the later mark. What is common between the marks is the ordinary word BIBLE. The reputed mark is LAD BIBLE. When a different mark, BOSS BIBLE is used for different goods/services, I see no reason why a mental link would be made between the parties' marks. It does not seem logical to me that consumers would see BOSS BIBLE on printed books or in relation to journalism services, for example, and make a link between that mark and LAD BIBLE, which has a reputation for online publishing and online content relating to social media. Therefore, the differences between the marks and the remaining goods and services are sufficient to rule out any mental link. If I am wrong on this point, and a link is made, it will, in my view, be no more than a momentary bringing to mind of the opponent's mark. I bear in mind that, in accordance with *L'Oréal v Bellure NV*, paragraph 44, "the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark". The converse also applies: the less strongly the earlier mark is brought to mind, the less the likelihood of damage. This applies in the case before; even if a link is made for these goods/services, I consider there to be no damage to the opponent.

Damage

117. I have already found for the opponent under section 5(2)(b) on the same set of services and so, at this point, section 5(3) takes the opponent's case no further. I will address damage briefly; the opponent has pleaded all three heads of damage. If I am right as to reputation and link, my finding that there is a likelihood of confusion indicates that the BOSS BIBLE mark would take unfair advantage of that reputation in relation to the relevant services in Class 41.

Conclusion

118. The section 5(3) ground succeeds in relation to the following services:

Class 41: *Publication of electronic books and journals online; Online publication of electronic books and journals; Publishing of electronic books and*

journals online; Publishing of electronic books and journals on-line; Publication of electronic books and journals on-line; On-line publication of electronic books and journals; On-line publication of electronic books and journals [not downloadable]; On-line publication of electronic books and journals (non-downloadable); Multimedia publishing of journals.

Section 5(4)(a)

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

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

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

(aa) [...]

(b) [...]

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

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

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

Relevant law

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

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

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

122. In *Advanced Perimeter System Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (as he then was), as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TMO-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of

the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

123. The relevant date for this opposition is the date of the application, i.e., 16 November 2021.

Goodwill

124. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

125. The opponent relies upon the signs BIBLE and LAD BIBLE. I repeat here my previous reasoning for proposing that LAD BIBLE is the opponent's best case under each of the grounds of opposition. The opponent, under section 5(4)(a) relies on a slightly different list of services to sections 5(2)(b) and 5(3). However, I do not propose to repeat here the analysis I have already made of what is shown by the evidence. I am satisfied that at the relevant date the opponent had goodwill in the sign LAD BIBLE for:

Provision of publishing services, social media services, content creation, collation and publication; entertainment publisher both online and via App software; provision of a wide range of publications, news, sports content, gaming content, educational content, images, entertainment, music content, trending content, marketing, advertising, promotional and viral videos, images and other content.

Misrepresentation

126. The relevant test was set out by Morritt LJ in *In Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC at [473]:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is:

‘Is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product].’

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

127. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely, in the light of the Court of Appeal’s decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here. Whilst the list of services differs under this ground, there are no terms that would alter the goods/services comparison as to offer the opponent a better position here. Under section 5(2)(b), I found that only where the goods/services were identical would there be a likelihood of confusion. For all other goods/services, where the LAD BIBLE mark had only an lower than average or average degree of distinctiveness as opposed to a high degree through use, the marks were too far apart for the consumer to be confused. I consider that those same factors are sufficient to avoid a substantial number of the relevant public being misled into believing that the applicant’s goods

and services are those of the opponent. I find that misrepresentation is only made out for:

Class 41: *Publication of electronic books and journals online; Online publication of electronic books and journals; Publishing of electronic books and journals online; Publishing of electronic books and journals on-line; Publication of electronic books and journals on-line; On-line publication of electronic books and journals; On-line publication of electronic books and journals [not downloadable]; On-line publication of electronic books and journals (non-downloadable); Multimedia publishing of journals.*

Damage

128. I consider that, as a result of the misrepresentation, there is likely to be a diversion of sales from the opponent to the applicant.

Conclusion

129. The section 5(4)(a) ground succeeds in relation to the following services:

Class 41: *Publication of electronic books and journals online; Online publication of electronic books and journals; Publishing of electronic books and journals online; Publishing of electronic books and journals on-line; Publication of electronic books and journals on-line; On-line publication of electronic books and journals; On-line publication of electronic books and journals [not downloadable]; On-line publication of electronic books and journals (non-downloadable); Multimedia publishing of journals.*

OVERALL CONCLUSION

130. The opposition has succeeded in relation to the following services, which will be refused registration:

Class 41: *Publication of electronic books and journals online; Online publication of electronic books and journals; Publishing of electronic books and journals online; Publishing of electronic books and journals on-line; Publication of electronic books and journals on-line; On-line publication of electronic books and journals; On-line publication of electronic books and journals [not downloadable]; On-line publication of electronic books and journals (non-downloadable); Multimedia publishing of journals.*

131. The application may proceed to registration for the following goods and services:

Class 9: *Diaries (Electronic -); Electronic diaries; Cases for electronic diaries.*

Class 16: *Books; Song books; Book covers; Cookery books; Story books; Book bindings; Flip books; Gift books; Wedding books; Educational books; Index books; Memorandum books; Fiction books; Dictation books; Book wrappings; Log books; Appointment books; Recipe books; Cook books; Check books; Account books; Ledger books; Manuscript books; Score books; Birthday books; Autograph books; Copy books; Comic books; Sketch books; Commemorative books; Book jackets; Signature books; Book markers; Cheque books; Activity books; Diaries; Pocket diaries; Desk diaries; Leather covered diaries; Diaries [printed matter]; Children's books; Sticker books; Agenda books; Coupon books; Book ends; Printed books; Painting books; Scrap books; Writing books; Guide books; Travel books; Bill books; Religious books; Data books; Information books; Fantasy books; Rule books; Poster books; Blank journal books; Journals; Blank journals; Trade journals; Legal journals; Medical journals; Blank writing journals; Printed horoscopes; Cartoon prints; Leather book covers; Covers for books; Book-cover paper; Check book covers; Protective covers for books; Leather appointment book covers; Covers for cheque books; Covering materials for books.⁴¹*

⁴¹ Some of the terms in the applicant's Class 16 are duplicated up to four times. I have removed the duplicates from the list for the purposes of this decision.

Class 41: *Publication of books, magazines, almanacs and journals; Publication of journals; Publishing of journals; Publishing of journals, books and handbooks in the field of medicine; Publication of scientific information journals; Publishing of books; Publication of books; Publication of books, reviews; Publication of year books; Freelance journalism; Journalism services; Concert booking; Rental of books; Loan of books; Booking of entertainment; Booking of entertainment halls; Concert booking.*

COSTS

132. Whilst the opponent has been partly successful, the opposition has failed for more goods/services than it succeeded. I therefore consider it appropriate for each party to bear its own costs in these proceedings.

Dated this 28th day of February 2025

MRS E FISHER

For the Registrar

Annex - Opponent's goods and services relied upon under section 5(3)

Trade mark number UK00916685315 "BIBLE"

Class 9: *Publications in electronic format; downloadable publications; downloadable electronic publications; online electronic publications downloadable from the Internet; publications in electronic form supplied online from databases or from facilities provided on the Internet (including web sites); electronic magazines; multi-media recordings and publications; printed publications in electronically readable form; computer software and programs; computer games; downloadable software; downloadable software applications; computer software downloadable from the Internet; application software; application software for mobile communication devices; Video games software; Interactive video game programs; Instruction manuals in electronic format; Downloadable interactive entertainment software; Computer software for use in providing multiple user access to a global computer information network; data recorded in electronic, optical or magnetic form; data carriers; data storage media; memory cards; audio and/or video recordings; downloadable and streamable audio and/or video recordings; pre-recorded videos, CDs, CDIs, CD-ROMs, discs, cassettes and other data carriers containing information recorded in magazine form; Downloadable video recordings; computer game programs; game programs for arcade video game machines; computer programs and software for use in conjunction with the provision of an interface (interface devices or interface programs for computers) between a computer and a peripheral apparatus; interactive user manuals sold as a units with the aforesaid goods; all of the aforementioned providing original and user generated content featuring topical news and current affairs, entertainment, frivolous or comedic information; all the aforesaid relating to media culture, politics, celebrities, fashion, food, health and mental health, environmental issues, fitness, careers, travel, sports, hobbies, crafts Encoded identity cards; Computer peripheral devices; keyboards, mice (data processing),*

trackballs for moving the cursor and wireless electronic controls, all for use with electronic apparatus for consumers; Data processing equipment; Remote controls; Computer keyboards; audio headphones and headsets for use with computers and video gaming; computer controllers, namely remote controls, computer joysticks, interactively controlled floor pads, steering wheels for video games, headphones, keyboards and mice (data processing), all for use with computers and video gaming software platforms; wireless mice (data processing) and remote controls for use with televisions, computers and set-top boxes (decoders); mouse pads; touch keys (touch pads); computer keyboard controllers; eyewear; glasses; spectacles; sunglasses; lenses; frames for spectacles and sunglasses; cases and boxes for spectacles and sunglasses; cords, straps and chains for spectacles and sunglasses; sports eyewear; eye protection wear for sports; glasses for sports; magnets; digital photograph frames; covers and cases for mobile phones, computers and personal electronic devices; parts and fittings for all the aforesaid goods.

Class 41: *Entertainment services; education services; cultural activities; online education entertainment services; entertainment services provided via the Internet and other computer and communications networks; entertainment services featuring electronic media, multimedia content, audio and video content, movies, music, games, photos, images, pictures, graphics, text, messages, information, data, news and user-generated content provided via the Internet and other computer and communication networks; presentation of data, messages and documents for entertainment purposes; interactive information provided online via the Internet and other computer and communication networks relating to news and entertainment in the fields of fashion, food, careers, travel, women's health and adventure sports; provision of entertainment information for accessing via communication and computer networks; providing non-downloadable electronic publications; providing online publications (not downloadable); providing online non-downloadable magazines; production of video recordings and sound recordings;*

production of webcasts; production of podcasts; publishing services; publication of magazines, books, texts and printed matter; publishing by electronic means; digital video, audio and multimedia entertainment publishing services; multimedia publishing of magazines, journals and news; provision of audio and/or visual material and games online (not downloadable); online publication of news and current affairs; electronic publications (not downloadable); providing on-line videos (non-downloadable); provision of entertainment services through the media of video-films; arranging, organising and conducting of games, contests, competitions, quizzes, awards, conferences, exhibitions, courses, seminars and events; organising, conducting and production of shows, displays and parties; arranging, organising, presentation and provision of concerts, live entertainment, musical performances; arranging and conducting award ceremonies; presentation of awards for achievement; arranging, organising and conducting of events for cultural purposes; hospitality services (entertainment); hospitality services, namely customer reception services (entertainment services), including provision of admission tickets for sporting or entertainment events; information, advisory and consultancy services relating to all of the aforesaid services; providing non-downloadable publications and interactive information providing original and user generated content featuring topical news and current affairs, entertainment, frivolous or comedic information; providing non-downloadable publications and interactive information relating to media culture, politics, celebrities, fashion, food, health and mental health, environmental issues, fitness, careers, travel, sports, hobbies, crafts; information, advisory and consultancy services relating to all of the aforesaid services Sporting activities; interactive entertainment information provided online via the Internet and other computer and communication networks, relating to music, fashion, films, food, careers, travel, sports, adventure and lifestyle; arranging, organising and conducting of events for sporting purposes; organisation of sporting competitions and sports events; gaming services; fan club services.

Trade mark number UK00003296777 “LAD BIBLE”

Class 9: *Publications in electronic format; downloadable publications; downloadable electronic publications; online electronic publications downloadable from the Internet; publications in electronic form supplied online from databases or from facilities provided on the Internet (including web sites); electronic magazines; multi-media recordings and publications; printed publications in electronically readable form; computer software and programs; computer games; downloadable software; downloadable software applications; computer software downloadable from the Internet; application software; application software for mobile communication devices; Video games software; Interactive video game programs; Instruction manuals in electronic format; Encoded identity cards; Downloadable interactive entertainment software; Computer software for use in providing multiple user access to a global computer information network; data recorded in electronic, optical or magnetic form; data carriers; data storage media; memory cards; audio and/or video recordings; downloadable and streamable audio and/or video recordings; pre-recorded videos, CDs, CDIs, CD-ROMs, discs, cassettes and other data carriers containing information recorded in magazine form; Computer peripheral devices; keyboards, mice (data processing), trackballs for moving the cursor and wireless electronic controls, all for use with electronic apparatus for consumers; Data processing equipment; Remote controls; Computer keyboards; audio headphones and headsets for use with computers and video gaming; Downloadable video recordings; computer game programs; game programs for arcade video game machines; video game controllers, namely remote controls, joysticks, interactively controlled floor pads, steering wheels for video games, headphones, keyboards and mice (data processing), all for use with computers and consoles for video game platforms; wireless mice (data processing) and remote controls for use with televisions, computers and set-top boxes (decoders); mouse pads; touch keys (touch pads); computer keyboard controllers; computer programs and software for use in conjunction with*

the provision of an interface (interface devices or interface programs for computers) between a computer and a peripheral apparatus; interactive user manuals sold as a units with the aforesaid goods; eyewear; glasses; spectacles; sunglasses; lenses; frames for spectacles and sunglasses; cases and boxes for spectacles and sunglasses; cords, straps and chains for spectacles and sunglasses; sports eyewear; eye protection wear for sports; glasses for sports; magnets; digital photograph frames; covers and cases for mobile phones, computers and personal electronic devices; parts and fittings for all the aforesaid goods.

Class 41: *Entertainment services; education services; sporting and cultural activities; online education entertainment services; entertainment services provided via the Internet and other computer and communications networks; entertainment services featuring electronic media, multimedia content, audio and video content, movies, music, games, photos, images, pictures, graphics, text, messages, information, data, news and user-generated content provided via the Internet and other computer and communication networks; presentation of data, messages and documents for entertainment purposes; interactive information provided online via the Internet and other computer and communication networks relating to education, entertainment, music, films and sports; interactive information provided online via the Internet and other computer and communication networks relating to news and entertainment in the fields of fashion, food, careers, travel, women's health and adventure sports; provision of entertainment information for accessing via communication and computer networks; providing non-downloadable electronic publications; providing online publications (not downloadable); providing online non-downloadable magazines; production of video recordings and sound recordings; production of webcasts; production of podcasts; publishing services; publication of magazines, books, texts and printed matter; publishing by electronic means; digital video, audio and multimedia entertainment publishing services; multimedia publishing of magazines, journals and news; provision of audio and/or visual material and games online (not*

downloadable); online publication of news and current affairs; electronic publications (not downloadable); providing on-line videos (non-downloadable); provision of entertainment services through the media of video-films; arranging, organising and conducting of games, contests, competitions, quizzes, awards, conferences, exhibitions, courses, seminars and events; organising, conducting and production of shows, displays and parties; arranging, organising, presentation and provision of concerts, live entertainment, musical performances; arranging and conducting award ceremonies; presentation of awards for achievement; arranging, organising and conducting of events for cultural and sporting purposes; organisation of sporting competitions and sports events; gaming services; hospitality services (entertainment); hospitality services, namely customer reception services (entertainment services), including provision of admission tickets for sporting or entertainment events; fan club services; information, advisory and consultancy services relating to all of the aforesaid services.