

O/0294/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003878848

BY BEYOND ENT. LIMITED TO REGISTER:



(SERIES OF THREE)

AS TRADE MARKS IN CLASSES 9, 16, 18, 21, 28 & 41

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 441191 BY

BOXPARK BRANDS LIMITED

BACKGROUND AND PLEADINGS

1. On 16 February 2023, BEYOND ENT. LIMITED (“the applicant”) applied to register the series of trade marks shown on the cover page of this decision in the UK (“the application”). The application was published for opposition purposes on 3 March 2023 and registration is sought for the following goods and services:

Class 9: Downloadable media; downloadable publications; computer apps; phone cases; boxing helmets; mouth guards for boxing.

Class 16: Printed publications; magazines; books; event programmes; tickets; stationery; posters.

Class 18: Bags; luggage; tote bags; sports bags.

Class 21: Water bottles; mugs; drinkware; tableware; coasters.

Class 25: Clothing; hats; shoes.

Class 28: Sporting and physical exercise equipment; boxing gloves; boxing pads; punch bags and balls; toys, games and playthings.

Class 41: Organisation, arranging and conducting of boxing matches; entertainment services; live entertainment services; organisation of sporting competitions; boxing instruction; sports activities; sports coaching.

2. On 5 June 2023, the application was opposed by Boxpark Brands Limited (“the opponent”). The opposition is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). In respect of the section 5(2)(b) ground, the opponent relies on the following marks:

BOXPARK

UK registration no. 3202772

Filing date 16 December 2016; registration date 10 March 2017

("the opponent's first mark");

BOXPARK

UK registration no. 3427394

Filing date 10 September 2019; registration date 24 January 2020

("the opponent's second mark"); and

BoxHall

UK registration no. 3418244

Filing date 1 August 2019; registration date 25 October 2019

("the opponent's third mark")

3. The specifications of the opponent's marks are set out in the **Annex** of this decision.
4. Under the section 5(2)(b) ground, the opponent relies only upon those services I have underlined in the Annex of this decision. The opponent's position is that the marks at issue are all similar and that the goods and services at issue are identical or closely related. As such, the opponent claims that there is a real and tangible likelihood of confusion between the marks.
5. Under the section 5(3) ground, the opponent relies on only its first and second marks. In respect of the services relied on, it is noted that the opponent claims to enjoy a reputation in all services in its first mark but only in its class 41 and 43 services in its second mark. The opponent's claim is that due the use of its marks

in the UK, it enjoys an extensive reputation in the services relied upon. In light of this and the similarity of the marks, the opponent claims that use of the application would result in consumers calling to mind the opponent's marks. It further claims that this would result in an unfair advantage in favour of the applicant. Additionally, the opponent claims that such use would also cause a detriment to the reputation and/or distinctive character of the earlier marks.

6. The applicant filed a counterstatement wherein it requested that the opponent provide proof of use for its first mark. In addition, the applicant made a series of denials in respect of the claims against it.
7. The applicant is represented by Lee & Thompson LLP and the opponent is represented by Bird & Bird LLP. Both parties filed evidence but I note that during the evidence round, the opponent also filed written observations. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

9. The opponent's evidence came in the form of the witness statement of Mr Simon Champion dated 19 January 2024. Mr Champion is the CEO of the opponent and has been in the role since June 2022. His statement is accompanied by 79 exhibits, being SC1 to SC79, and was adduced to prove use of the opponent's first mark and that both its first and second marks enjoy a reputation.

10. The applicant's evidence came in the form of the witness statement of Razi Hassan dated 5 April 2024. Razi Hassan is the Director of the applicant, a position they have held since 2022. This evidence is accompanied by 11 exhibits, being those labelled RH1 to RH11, and was adduced to demonstrate the applicant's use of its own branding.

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

PRELIMINARY ISSUE

12. As set out above, the applicant's evidence was provided in order to demonstrate the use of its mark. While not expressly stated, it appears to me that this has been filed in order to support a defence that there has been honest concurrent use of the marks at issue. While noted, the narrative evidence confirms that the applicant began using its mark in May 2023. This is after the relevant date for the present proceedings (which is 16 February 2023, being the filing date of the application). As such, even if it could be said to have been evidence filed in order to prove honest concurrent use, it is of no assistance as any claimed use is from after the relevant date and cannot, therefore, be said to point to the position in the marketplace prior to that time.

13. While on the topic of the applicant's evidence, I note that Razi Hassan, at paragraph 5 of their witness statement, sets out they are unaware of any confusion on the part of customers with the opponent's business. On this point, I consider it necessary to refer to the case of *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 wherein Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

14. Further, while Razi Hassan is the director of the applicant, their lack of any awareness of confusion is not a relevant factor. Just because they may not necessary be aware of any actual confusion, it does not mean that it does not exist. Therefore, this comment in the evidence is of no real assessment to the issue of confusion that I have to make in the present case.

DECISION

Proof of use

15. As I have set out above, the applicant has elected to put the opponent to proof of use for its first mark. The opponent's second and third marks were not eligible for the proof of use request as they had not completed their registration processes more than five years prior to the filing date of the application. Therefore, regardless of whether the opponent successfully proves that it used its first mark during the relevant period or not, the opposition will proceed in respect of both grounds relied upon. As a result, I have given consideration as to whether it is necessary for me to consider proof of use in the present proceedings. While the opponent's second mark is a figurative mark, its sole element is the word 'BOXPARK', which is the sole element of the opponent's first mark, albeit the first mark is presented as a word only. As such, it could be argued that these marks are identical but even if not, they are very highly similar. Further, it is noted that the services relied upon in respect of the opponent's second mark cover identical services to those relied upon under its first mark.

16. Taking the above into account, it is reasonable to suggest that even if use was proven for all services, the outcome in respect of any assessment based on the

opponent's first mark would be identical to the outcome of any assessment based on the opponent's second mark. Therefore, I do not consider that the opponent's first mark offers any advantage to the opponent in the present case. As such, I do not consider it necessary to undertake a proof of use assessment in respect of the same. Therefore, I will proceed to consider the section 5(2)(b) ground of opposition in respect of the opponent's second and third marks only.

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

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

“(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 or association with the earlier trade mark.”

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

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

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

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

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

20. The opponent's marks qualify as earlier trade marks under the above provisions. However, as I have confirmed above, the opponent's second and third marks had not completed their registration processes more than five years before the filing date of the application. As such, they are not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on all of the services highlighted in its notice of opposition for these marks.

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

22. The applicant's goods and services can be found at paragraph 1 above. The opponent's services that are relied upon here are those underlined in the Annex of this decision (insofar as they cover the second and third marks only).

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

"Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für 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.”

26. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46 to 57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

27. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

28. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*, Case C-398/07P, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in Oakley did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

29. I note that the opponent has made detailed submissions in respect of the goods and services comparison. While I do not intend to repeat them here, I can confirm that I have taken the submissions into account.

Class 9

Downloadable media; computer apps.

30. As set out in the case law cited above, goods are capable of being similar to the retail services for said goods. In considering the above terms, I am of the view that downloadable media can cover computer games and that computer apps are a type of software. As such, I find that the above goods are similar to "retail services in relation to the sale of [...] computer software [and] computer games" in the opponent's second mark's specification. I say this because there is clearly a degree of complementarity between these goods and services in the way described by the case law cited above. Further, the goods and services overlap in trade channels and user. Overall, I find that these goods and services are similar to a medium degree.

Downloadable publications.

31. The above term can reasonably be said to cover e-books. In considering the opponent's services, I note that the second specification does include the term

“retail services in relation to the sale of [...] books”. It is not specified what type of books this service covers and by virtue of being in class 35, it cannot be said that the books referred to are limited to those that would ordinarily sit in class 16. As a result, I consider it reasonable to suggest that it covers any type of book, including electronic ones. Therefore, I am of the view that there exists a complementary relationship between the goods and services and that they overlap in trade channels and user. As such, I find that these goods and services are similar to a medium degree.

32. In the event that I am wrong in approaching this comparison on the basis that the opponent’s term can cover any type of book, then I find that they are still similar. While the degree of complementarity would no longer exist, I consider that there still exists an overlap in trade channels and user on the basis that a retailer that sells physical books may also sell e-books and said goods and services will be aimed at the same user. Therefore, if I am wrong to find as I have above, then I make an alternative finding that they are similar to a low degree.

Phone cases.

33. In respect of the above term, I note that the opponent’s second mark’s specification includes the term “retail services in relation to the sale of [...] wallets and cases”. The term ‘cases’ is not limited in any way and can, therefore, cover any type of case including a phone case. As such, and following the same logic applied at paragraph 30 above, I find that these goods and services are similar to a medium degree.

Boxing helmets; mouth guards for boxing.

34. The above goods are articles for participating in sport with the boxing helmet possibly also being an article of protective clothing. On this point, I note that the opponent’s second mark’s specification includes “retail services in relation to the

sale of [...] articles for playing sports [and] protective clothing”. I appreciate that someone participating in boxing would not necessarily be considered as someone who ‘plays’ boxing, however, I am of the view that playing and participating in sports are interchangeable terms depending on the sport. So while the opponent’s term is expressed as ‘articles for playing sports’, I am of the view that it can cover goods used for boxing. As such, and again following case law cited above and the same reasoning set out throughout this comparison, I find that these goods and services are similar to a medium degree.

Class 16

Printed publications; magazines; books; event programmes; tickets; stationery; posters.

35. I note that the opponent’s second mark’s specification includes retail services for a range of printed matter goods and stationery, being “retail services in relation to the sale of [...] books, magazines, greeting cards, gift boxes, wrapping paper, [...] stationery, [...] paintings, [...] photographs [and] art prints”. Following the same logic applied throughout this comparison, I find that these goods and services are similar to a medium degree on the basis that they share a complementary relationship and overlap in trade channels and user.

Class 18

Bags; luggage; tote bags; sports bags.

36. The opponent’s second mark’s specification covers “retail services in relation to the sale of [...] handbags, sports bags, travelling bags, trunks [and] luggage”. While some of the goods may not necessarily be identical to those covered by the services, I am of the view that the close association between the different type of bags covered is such that it leads to a medium degree of similarity between these

goods and services. Again, I say this because the goods and services share a complementary relationship and overlap in trade channels and user.

Class 21

Water bottles; mugs; drinkware; tableware; coasters.

37. As was the case with several of the comparisons I have made above, the opponent's second mark's specification include retail services that cover a range of goods that describe the same (or broader) goods as the applicant's above terms. In the present case, that term is "retail services in relation to the sale of [...] glassware, porcelain and earthenware, plates, platters, cups, mugs, bowls, dishes, jugs, jars [and] bottles". While some of the goods are broad and may cover those that are not necessarily identical to those covered by the services, I am of the view that the close association between the different type of goods is such that it results in the existence of a complementary relationship and overlap in trade channels and user. As such, these goods and services are similar to a medium degree.

Coasters.

38. The above goods are not identical to those covered by the opponent's term of "retail services in relation to the sale of [...] glassware, porcelain and earthenware, plates, platters, cups, mugs, bowls, dishes, jugs, jars [and] bottles". However, I am of the view that the close association between coasters and mugs (and other types of tableware covered by the opponent's service, for that matter) is such that the same overlaps discussed in the preceding paragraph apply. As such, I find that these goods are also similar to a medium degree with the opponent's service.

Class 25

Clothing; shoes.

39. The opponent's second mark's specification includes the term "retail services in relation to the sale of [...] clothing [and] footwear". To repeat what I have several times above, I find that these goods and services share a complementary relationship to one another and overlap in trade channels and user. As such, I find that they are similar to a medium degree.

Hats.

40. As per the preceding paragraph, the opponent's second mark is registered for "retail services in relation to the sale of [...] clothing [and] footwear". Plainly, hats are not a type of clothing or footwear and, as such, there cannot be a complementary relationship between these goods and services. That being said, I consider that the relationship between hats and clothing and footwear is such that there still exists a degree of overlap in trade channels and user in respect of these goods and services. As such, I find that these goods and services are similar to a low degree.

Class 28

Sporting [...] exercise equipment; boxing gloves; boxing pads; punch bags and balls.

41. The above goods are all those that can be said to either be sports apparatus or those goods that relate to playing (or participating in) sports. In light of the fact that the opponent's second mark's specification includes "retail services in relation to the sale of [...] articles for playing sports [and] sports apparatus", I find that there is a complementary relationship between the goods and services and that they

overlap in trade channels and user. As such, I find that these goods and services are similar to a medium degree.

Physical exercise equipment.

42. The above term covers goods such as treadmills or weights benches. While these are not the same as articles for playing sports and sports apparatus (being those covered by the opponent's term of "retail services in relation to the sale of [...] articles for playing sports [and] sports apparatus"), I do consider that there is some similarity between them. I say this because while they will not be complementary, their trade channels will overlap on the basis that they are likely to be produced and sold by the same undertakings. Further, the goods and services will be sought by the same user, meaning that there is an overlap here too. As a result, I find that these goods and services are similar to a low degree.

Toys, games and playthings.

43. While the opponent's second mark is registered for a wide range of retail services, none of the services relate to goods that cover the above term of the applicant. On this point, I do not consider that "retail services in relation to the sale of [...] articles for playing sports [and] sports apparatus" can be said to cover the sale of toys, games or playthings. I am of the view that this term represents the opponent's best case in respect of the above terms. However, I do not consider that the relationship between articles for playing sports and sports apparatus and the applicant's goods is sufficiently pronounced. I accept that large retail stores (be that supermarkets or online retailers) may sell both goods, however, the goods will not be found in similar locations of said stores or within the same section of websites (where sold online). As such, I do not consider that the simple fact that both goods may be sold via the same retailer means that there is an overlap in trade channels.¹ As for user, both

¹ For analogy, I will say here that a supermarket may sell frozen fish but also sell televisions. However, "frozen fish" would plainly not share an overlap in trade channels with "retail services for televisions".

the goods and services will likely be aimed at the same average consumer. However, given the broad nature of the userbases for such goods and retail services means that any overlap is at a very general level. Taking all of this into account, I find that these goods and services are dissimilar.

Class 41

Organisation, arranging and conducting of boxing matches; organisation of sporting competitions.

44. I note that the opponent's specifications have a series of 'arranging, conducting and hosting' services for different types of events, including sporting events. While not expressly stated as such, I consider them to be the same as organisational services. As such, I find that the opponent's term of "arranging, conducting and hosting of [...] sporting events and competitions" (which is present in both marks) encompasses the first term listed above. These services are, therefore, identical under the principle outlined in *Meric*. As for the second term of the applicant, I consider that this describes the same service as the opponent's term and, therefore, I find that they are self-evidently identical.

Entertainment services; live entertainment services.

45. The above terms are for the provision of services which can include any type of event put on for the purpose of entertaining the viewer. In considering these terms, I note that both of the opponent's specifications include the term "provision [...] of entertainment events". Plainly, the provision of an entertainment event is an entertainment service and can even cover live events. As such, I find that the opponent's services can be said to fall within the applicant's terms meaning that they are identical under the principle outlined in *Meric*.

Sports activities.

46. The above term can, in my view, cover the provision of a wide range of sporting events. In considering this term, I note that both of the opponent's specifications include the term "provision [...] of [...] sporting events and competitions". Because a 'sport activity' is a sporting event, I find that the above service of the applicant falls within the term of the opponent. As such, I find that these services are identical under the principle outlined in *Meric*.

Boxing instruction; sports coaching.

47. It is my view that instructional and coaching services are forms of educational services. I say this on the basis that the instruction and coaching provided will aim to educate the participant on how to box or how to play certain sports. While these are not educational or sporting events, I do consider that there is some degree of similarity between the above services and "provision [...] of [...] educational events, sporting events and competitions" in both of the opponent's specifications. I say this because the opponent's service can cover an event such as a boxing demonstration in order to educate the viewers on the sport, for example. During said event, there could be instruction/coaching information. As a result, I am of the view that while the natures and methods of use differ, there is a degree of overlap in purpose because both aim to provide educational benefits to the user. Further, I am of the view that an undertaking that provides smaller boxing instruction or sports coaching classes, may also put on the larger scale events of the opponent. Lastly, the services will be targeted at the same users. Taking all of this into account, I find that these services are similar to a medium degree.

Conclusion of goods and services comparison

48. Where there is no similarity between goods and services, there can be no likelihood of confusion under section 5(2)(b) grounds.² In light of my findings above, it follows that the present ground of opposition fails against the applicant's term of "toys, games and playthings", being the one term that I found to be dissimilar. The opposition will, however, proceed against all remaining goods or services on the basis that I have found them to be identical or similar.

The average consumer and the nature of the purchasing act

49. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

50. The goods at issue will be selected by members of the general public at large. The goods are likely to be selected from a range of retail providers (be that general or

² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

more specialist, such as sporting good providers) where they will be self-selected by the consumer who will view them on shelves or racks. Further, the goods will also be available online where they will be selected after the consumer views an image of them on a webpage. As a result, the selection process for the goods at issue will be primarily visual, though I do not discount an aural component playing a part by way of word-of-mouth recommendations or advice from sales assistants.

51. In respect of the frequency of selection and cost of these goods, I am of the view that this will vary. For example, clothing and stationery goods are likely to be selected on a fairly frequent basis and at a low to moderate cost. However, some sporting equipment can be rather expensive and will be selected on a less frequent basis. When selecting the goods, consumers are likely to consider a range of factors, which will vary. For example, stationery goods are likely to cover more casual selections that will attract a lower degree of attention. However, when selecting clothing, consumers will consider the materials used, suitability, style and fit, all of which pointing to a medium degree of attention being paid. Even for the more expensive goods (such as physical exercise equipment), I consider that this will also attract relatively ordinary factors such as suitability, weight capacity and speed (the latter points being relevant to treadmills, for example). As such, I consider that the majority of the goods at issue will attract a medium degree of attention but appreciate that this may be low for some goods.

52. Turning to the services, I am of the view that these will be selected by business users looking to organise different types of events. The services are likely to be available from the provider directly and sought from either their physical premises or their websites. In respect of the former, the services will either be listed on placards or pamphlets whereas, for the latter, they will be listed on webpages. The services will, therefore, be viewed before being selected. Having said that, the nature of the services is such that they are also likely to be made after detailed conversations with sales assistants. As a result, I consider that the visual and aural component will play an equal role in the selection process.

53. For the most part, the services will be selected infrequently, however, I do appreciate that some business users will look to put on events with a certain degree of frequency (for example, quarterly or annually). As for the cost, I suspect that they will be rather expensive as there are a lot of moving parts when it comes to organising various types of events. In respect of the degree of attention paid, I consider that this will be at a relatively high (though not the highest) degree. I say this because the selection will be important for the business user because they will wish to ensure that the event takes place without any issues and the selection is, generally, likely to impact upon the success of their business.

Comparison of the marks

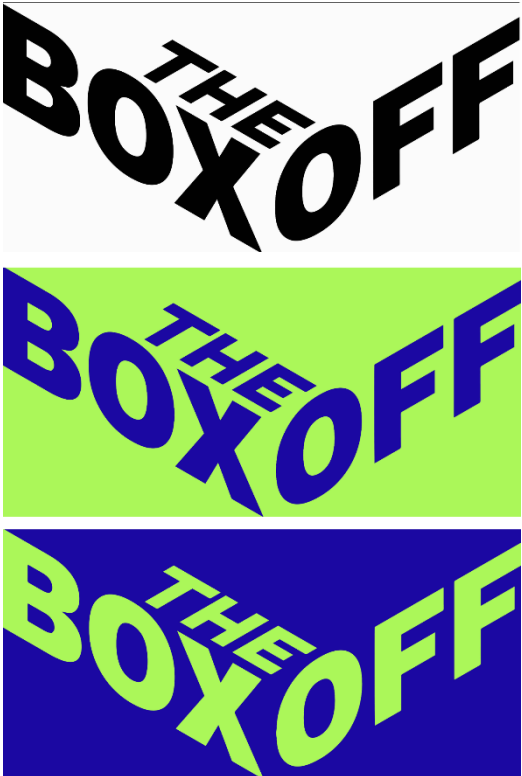
54. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

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

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

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

57. The respective trade marks are shown below:

The opponent's marks	The application
<p data-bbox="309 920 791 1014">BOXPARK</p> <p data-bbox="320 1048 767 1081">("the opponent's second mark")</p> <p data-bbox="488 1160 600 1189">BoxHall</p> <p data-bbox="341 1216 746 1249">("the opponent's third mark")</p>	 <p data-bbox="1007 1541 1233 1574">(series of three)</p>

58. Save for their differing uses of colour, the marks in the application are identical. I do not consider that the differences in colour between these marks are of any real impact on the comparison of the marks so I will, therefore, base my comparison on the first mark in the application only. I do so because fair and notional use of the opponent's second mark, being a figurative black word presented on a white

background, is such that it can extend to use of the word in any colour on a background, also of any colour. As for the opponent's third mark, this is a word only mark and is also capable of being used in any colour and presented on a coloured background. As a result, the use of colour is not a point of visual distinction between the parties' marks, hence the comparison being based on the first mark of the application. For the purposes of this comparison and for ease of reference, I will refer to the first mark in the application simply as 'the applicant's mark'.

Overall impression

59. The applicant's mark is a figurative mark featuring the words 'THE BOX OFF' in a black standard typeface on a white background. The words are presented at different angles and directions so as to appear almost as if it was a 3D box shape. In this arrangement, the word 'THE' is presented in a smaller typeface at the top of the mark with 'BOX OFF' presented in a larger font. Despite the placement of 'THE' at the top of the mark, it will still be viewed as 'THE BOX OFF'. In terms of overall impression, I note that the opponent's position is that the word 'BOX' plays the greater role in the overall impression of this mark. While noted, I do not consider that it does and I see no reason why the word 'OFF' should be said to have a lower impact on the mark as a whole. Instead, I consider that it is the words 'BOX OFF' that will play the strongest role in the overall impression of the mark. I consider that 'THE' and the presentation of the words in the marks will play lesser roles.

60. The opponent's second mark is a figurative mark featuring the word 'BOXPARK' in a standard black typeface on a white background. This will be understood as the conjoining of two words, being 'BOX' and 'PARK'. As was the case with the applicant's mark, the opponent argues that 'BOX' plays the greater role in the overall impression of this mark. The opponent argues that this is the case because it is the first element of the mark. Clearly, it is the mark's first element but I see no reason why consumers would solely focus on this to the point that they would

attribute a lesser role to the word 'PARK'. Instead, I find that this mark will be dominated by the word element as a whole. Given the standard nature of the stylisation of said word, I consider that this will play a negligible role. As for the opponent's third mark, this is a word only mark that consists solely of the word 'BoxHall'. Like the opponent's second mark, despite being presented as one word, the mark will be viewed as two conjoined words, being 'Box' and 'Hall'. Again, the opponent argues that the word 'Box' plays the greater role but, for the same reasons as set out above, I disagree. Instead, I find that the overall impression of the mark lies in the word itself.

Visual comparison

The opponent's second mark and the applicant's mark.

61. Visually, these marks share the word 'BOX'. This is the sole point of similarity as the marks differ in the presence of the words 'THE' and 'OFF' in the applicant's mark and the word 'PARK' in the opponent's mark. The marks differ further in the way they are presented. While the word 'THE' and the presentation of the applicant's mark play lesser roles in that mark, they are still points of visual difference. Overall, I find that the marks are visually similar to a medium degree.

The opponent's third mark and the applicant's mark.

62. Visually, these marks share the same points of similarity of the marks discussed above. As for the differences, this will be in the words 'THE' and 'OFF' in the applicant's mark and the word 'Hall' in the opponent's mark. On this point, I will say that I do not consider that the opponent's mark, despite being a word only mark, is capable of being fairly presented in the same way as the applicant's mark. Therefore, the presentational element of the applicant's mark is a point of visual difference. Taking all of this into account, I am of the view that these marks are visually similar to a medium degree.

Aural comparison

The opponent's second mark and the applicant's mark.

63. Despite the lesser role that 'THE' plays in the mark, I consider that it will be pronounced. As such, the aural element of the applicant's mark will be 'THE BOX OFF' which will consist of three syllables and will be pronounced in the ordinary way. As for the opponent's mark, this will be pronounced as 'BOX PARK' which consists of two syllables that will be pronounced in the ordinary way. The pronunciation of the word 'BOX' will clearly be a point of aural identity; however, all other elements differ. Aurally, both marks can be said to be short marks and while there is no special test for short marks,³ I am of the view that in the present case, the shortness of the marks at issue means that the average consumer is more likely to notice the differences. Overall, I consider that these marks are aurally similar to a medium degree.

The opponent's third mark and the applicant's mark.

64. The opponent's third mark is two syllables in length that will be pronounced in the ordinary way. Given that this mark is structured very similarly to the opponent's second mark, I consider that the same finding reached in the preceding paragraph can be said to apply here. As such, I find that these marks are also aurally similar to a medium degree.

Conceptual comparison

65. In respect of the conceptual comparison, I note that the opponent submits that the additional words, being 'OFF' in the applicant's mark, 'PARK' in its second mark

³ See paragraph 44 of *BOSCO*, BL O/301/20

and 'HALL' in its third mark will be attributed little or no weight. As such, the opponent seeks to pin its submissions on the conceptual similarity between these marks on the basis that they share the word 'BOX'. I disagree with this argument raised by the opponent on the basis that, as I have set out above, the words 'OFF', 'PARK' and 'HALL' all play equally dominant roles with the word 'BOX' in each mark. Further reasons for this finding will be provided below.

The opponent's second mark and the applicant's mark.

66. In considering the concept of 'THE BOX OFF', I am of the view that it forms a unitary meaning that carries two potential meanings. First, it may be seen as a play on the concept of 'a box office', being a location where tickets to various events can be purchased. Second, it may be viewed as a play on the concept of 'a face off', being a confrontation between two people. In this context though, this reference will be understood as 'a box off' as in a reference to a boxing confrontation between two people. As for the opponent's second mark, the word 'BOXPARK' will, as above, be seen as two words, 'BOX' and 'PARK'. I consider that these words will form a unitary meaning and be viewed as a park that is shaped like a box⁴ or refers to a park named 'BOX'. While on the topic of the concept of the opponent's second mark, I have given consideration as to whether 'BOXPARK' would be understood as a park where boxing takes place. In short, I appreciate that some consumers may see the mark in this way, however, I do not consider that those consumers would form a significant proportion of average consumers. As such, I do not consider that this concept is of any assistance to the present proceedings.

67. In comparing these marks, I am of the view that while they share the word 'BOX', the meaning associated with this word is not the same within both marks. I say this because, as above, the word 'BOX' in applicant's mark will either be viewed as a

⁴ I appreciate that the concept of a box shaped park is unusual (because a box is a 3D shape), this concept is more likely to be understood as a square or rectangular park.

reference to a box office or the sport of boxing whereas this word in the opponent's second mark will be understood as a reference to the shape/structure of a box. As a result, I find that these marks are conceptually dissimilar.

The opponent's third mark and the applicant's mark.

68. The concept associated with the opponent's third mark will not be too dissimilar from that associated with its second mark. I say this because the concept of 'BoxHall' will be that of a hall shaped like a box⁵ or a hall named 'Box'. Comparing this to the applicant's mark, which I have assessed above, I find that for the same reasons as set out in the preceding paragraph, these marks are conceptually dissimilar.

Distinctive character of the opponent's marks

69. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

⁵ As was the case with the opponent's second mark, I have given consideration as to whether consumers would understand this as a reference to a hall where boxing takes place. As above, I appreciate that some consumers may see it this way, however, this will not form a significant proportion of consumers.

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).”

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

71. The distinctiveness of the opponent’s second mark lies in the word element, being ‘BOXPARK’. As above, this will either be understood as a box shaped park or a park called ‘BOX’. This message is not descriptive or allusive to the services relied upon. While that may be the case, I do not consider that it will be considered particularly remarkable from a trade mark perspective and, as such, I find that it enjoys a medium degree of inherent distinctive character. Turning to the opponent’s third mark, I consider that an identical finding to that reached in respect of the opponent’s second mark can be made. I say this because the mark is neither descriptive nor allusive but neither is it particularly remarkable. As a result, I find that this mark also enjoys a medium degree of inherent distinctive character.

72. Before getting into the evidence, I wish to state at the outset that the opponent has provided a total of 79 exhibits. While noted, I do not consider it necessary to discuss each and every exhibit filed. To do so would result in a very long evidence summary which I do not consider to be necessary in the present case. Instead, I will simply endeavour to summarise the most salient points of the evidence below.

73. An organisational chart of the group of companies that the opponent is a part of is provided.⁶ The group of companies all appear to sit under a holding company, being Generate Topco Ltd. The opponent itself is labelled as the 'brand owner and licensing company' and this appears to sit underneath the company 'Boxpark Limited'. There are a number of other companies that fall underneath the 'Boxpark Ltd' company such as 'Boxpark Trading Ltd' and 'Boxpark Croydon Ltd'. I do not consider that much turns on this evidence as regardless of which entity is the one using the mark, it is all clearly use as part of one corporate structure and I find it reasonable to infer that any and all use is with the requisite consent of the opponent.

74. Provided in evidence are a number of excerpts from the annual reports of 'Boxpark Limited'.⁷ These show turnover figures in the sums of £12,482,720 for 2019, £5,202,366 in 2020, £6,793,286 in 2021 and £18,857,657 in 2022. 2023 figures are provided but given that the relevant date for the present proceedings is in February of that year, it follows that the majority of the 2023 figures will have been accrued after that.

75. The opponent's evidence begins by setting out that it presently operates three locations in London, being in Shoreditch, Croydon and Wembley. The first of these was the Shoreditch location that opened in 2011. Third-party coverage regarding

⁶ SC1

⁷ SC2

the opening of this venue and copies of brochures for the venue are provided.⁸ The Croydon location opened on 29 October 2016 and the Wembley location opened on 8 December 2018. Third-party coverage regarding the launches of these locations is provided.⁹

76. A printout showing TripAdvisor reviews is provided that shows a number of reviews stemming from visits to the various BOXPARK locations.¹⁰ The reviews all show images of the locations and are dated prior to the relevant date.

77. Attendance figures are provided for the BOXPARK venues for the years 2020 to 2022.¹¹ Again, 2023 is provided but for the same reasons above, I will not discuss those here. These figures are broken down on a per location and per year basis and I reproduce them below:

	2020	2021	2022
Croydon	650,744	606,760	696,179
Shoreditch	1,137,103	1,001,308	1,101,925
Wembley	504,064	814,729	1,274,614
Total	2,291,911	2,422,797	3,072,718

78. A number of sponsorships are then discussed wherein BOXPARK has collaborated with a number of well-known and high-profile brands on various product and service launches. Some of the examples provided are from after the relevant date so I will not discuss them here. Of the ones relevant to the present proceedings, I note that the collaborations are with well-known brands such as Google Pixel, SportBible, Crystal Palace Football Club, Jameson Whiskey and Chivas Regal. Press coverage regarding these collaborations is provided in evidence.¹²

⁸ SC3

⁹ See SC4 and SC5, respectively.

¹⁰ SC6

¹¹ SC7

¹² See SC10, SC11, SC13, SC15 and SC16.

79. Within the BOXPARK locations are a range of retail establishments that offer retail services. This is confirmed in evidence and reference is made to a number of different retail brands such as Astrid & Miyu (being a jewellery shop and piercing studio), Awe London (being a nail salon), Get A Drip (being a retailer than offers vitamin drips and booster shots) and The Journal Shop (being a retailer of Japanese inspired stationery), for example. Printouts of the opponent's website are provided that show images of the various shops within the BOXPARK locations.¹³ I note that these printouts are all obtained from the internet archive facility, the Wayback Machine. These printouts show a wider range of retailers than that covered in the narrative evidence. For reasons that will become obvious below, I note that the retailers listed show those that retail in the following goods:

Food and drink, fragrances, cosmetics, artificial nails, jewellery, clocks, watches, umbrellas, clothing, sunglasses, underwear, spectacles, footwear, porcelain and earthenware, furniture, picture frames, stationery, paintings, sculptures, art prints, and skateboards (being a type of sports apparatus).¹⁴

80. It is clear from this evidence that the opponent does not provide the retail services itself, however, it does provide space for a wide variety of retailers to operate within their locations.

81. The evidence then goes on to discuss events that the opponent organises at its locations. These include live music shows, screenings of sports events and films, quizzes, children's entertainment and karaoke. A spreadsheet is provided that lists all of the events provided between 2019 and 2024 at the opponent's three locations. The events listed are extensive and I have no intention to list them all but note, for illustration, that they include events such as 'BIG FAT QUIZBOX'

¹³SC20

¹⁴ It may very well be the case that there are additional goods/services provided by these retailers but the goods listed here are all that appear evidence to me upon review of the printouts. If it was the case that more goods were subject to these retail offerings then it was for the opponent to clarify as such.

(which appears numerous times throughout), screenings of a number of sporting events such as Euro 2020 football games, Premier League football games, Superbowl events and Six Nations rugby matches and film screenings for a range of films including 'A Star is Born' and 'BlacKKKlansman'. I also note that various events appear to take place with a high level of consistency between 2019 and the relevant date. In addition to the spreadsheet of events, the opponent has provided printouts from its own website showing the various events scheduled for the different locations.¹⁵ These printouts are from the Wayback Machine and show dates prior to the relevant date and refer to various events such as 'LIVE AT BOXPARK', 'SOULFUL SUNDAYS' and 'FRIDAY FEELINGS'.

82. There is additional evidence regarding events run at the various locations. Given I have already discussed the wide breadth of events put on, I do not intend to discuss them any further. That being said, I do note that there is evidence of live music shows from artists such as Stormzy¹⁶ and Fatboy Slim.¹⁷ In addition, some of the sporting events relate to weigh-ins for boxing events, provided in conjunction with the boxing event provider itself.¹⁸

83. The evidence then moves to discuss the different offerings of the opponent. This includes the provision of ticket reservation and booking services,¹⁹ venue hire services for private third-party events (which include the private hire of the opponent's premises for various events such as the IKEA Christmas Party, the Pret A Manger Summer Party and the Dishoom Christmas party, for example)²⁰ and food and beverage services.²¹ In respect of the provision of food, I note that the evidence lists a range of third-party providers such as 'Smoky Boys', 'Hola Guacamole' and 'Nanny Bills', amongst others. This, to me, indicates that the

¹⁵ SC22

¹⁶ SC23

¹⁷ SC30

¹⁸ See SC26 and SC27 which show promotional weigh-in events for two different boxing events.

¹⁹ SC36

²⁰ See SC37 as well as SC38 to SC47 for the different 'private hire' events that have taken place at the opponent's locations.

²¹ SC49

provision of such services is by these third-parties as opposed to the opponent itself. As for the drinks, however, I note that there are images of bars which are actually branded as 'BOXPARK' so I accept that these services may be those of the opponent itself.²²

84. In respect of advertising, the opponent has provided figures in relation to its total spend for the years 2019 to 2024. As was the case with other evidence discussed above, the figures from 2023 and 2024 will be dismissed for the purposes of this assessment. I note that the spend was £90,000 in 2019, £91,500 in 2020, £76,000 in 2021 and £152,600 in 2022. The opponent also offers a newsletter to its subscribed members which, on 12 January 2024, was received by 947,000 recipients. The total number of subscribers that also opt-in to general marketing updates was, at that same date, approximately 1,600,000. While these figures are from approximately one year after the relevant date, I consider it reasonable to suggest that even at the relevant date, the numbers for the recipients would have been at a respectable level. Examples of some of the newsletters are shown in evidence.²³

85. The opponent operates a customer loyalty scheme that it calls the 'Black Card'. Information regarding this is provided in evidence²⁴ and I note that as of 25 December 2023, there were 1,561,290 UK customers who had signed up to the 'Black Card' scheme. While noted, there is nothing to suggest when the 'Black Card' scheme launched and, even so, the figures provided cover 1 December 2023 to 31 December 2023 with the graphs provided showing the earliest point of use for these cards as 20 November 2023. To me, this suggests that the card was not launched until on or around 20 November 2023. Even if that was not the case, I have nothing before me to suggest whether the card was launched prior to the relevant date and, if so, how many had signed up to the scheme by that date.

²² See the first photograph provided at SC49

²³ SC55

²⁴ See SC56 to SC59

86. Awards are then discussed and I note that a printout from the opponent's website is provided that shows a number of the awards achieved.²⁵ I do not intend to discuss them all but note that they show a variety of different awards and cover awards from organisations such as 'RMI' (being the Restaurant Marketer and Innovator'), the 'Sunday Times Fast Track 100' and the 'Deliveroo Restaurant Awards'. The majority of these awards are from 2022 and earlier.

87. Website information is provided and I note that a Google Analytics printout shows that between 1 January 2018 and 31 December 2022, the webpage attracted 27,363,593 page views from 7,349,202 users. 81.12% of these users are from the UK.²⁶

88. The evidence goes on to discuss the opponent's social media presence. Multiple screenshots of the opponent's accounts on X/Twitter, Instagram, Facebook and TikTok are provided.²⁷ I do not intend to discuss these in any detail save to say that they all show the 'BOXPARK' branding. In respect of the follower figures, a report has been provided from 'sproutsocial' which shows the various audiences for the accounts between 1 January 2018 and 31 December 2023 (although the report for the lattermost year is of no real assistance here). For the relevant years, (which includes 2017 as the 2018 report refers to figures from 2017 also) the audience of the opponent's total social media platforms grew from 38,223 in 2017 to 386,137 by 31 December 2022.

89. The evidence discusses reviews that it receives on independent review websites. A printout from 'Feed it Back Limited' (being a company that collates consumer feedback) is provided and I note that it shows 779 reviews of the various BOXPARK

²⁵ SC60

²⁶ SC62

²⁷ SC64 to SC75

locations.²⁸ While the reviews do not appear in date order, it appears to me that they range from between 25 November 2021 and 15 February 2023.

90. Lastly, the evidence includes reference to press coverage. Examples of the press coverage the opponent has achieved are shown in evidence.²⁹ These include the appearance of the BOXPARK brand in the following publications:

- a. 'Fashion Network' in 2011;
- b. 'Your Croydon' in 2015;
- c. Crystal Palace FC's website, The Telegraph, the Independent in 2018;
- d. Julius Bar, The Grocer, the Industry Fashion and BBC News in 2019;
- e. Verge, The Athletic, The Drum and The Standard in 2021 the Standard, SW Londoner, London Post, in 2022; and
- f. Food Service News in 2023 (before the relevant date).

91. All of the articles provided discuss the BOXPARK operation generally, with the latter article discussing the increase in revenue for the year ending April 2022 increasing from £6.8m for the year before to £18.9m.

92. Taking all of the evidence into account and even bearing in mind that the opponent only operated out of three locations prior to the relevant date, the opponent operated a sizeable and successful business in the UK prior to the relevant date. In reaching this conclusion I remind myself that the evidence demonstrates a sizeable turnover for the business at large and this is reflected further in the attendance figures provided at each location. In respect of the turnover provided, I appreciate that this was the turnover of the 'Boxpark Limited' business as a whole, however, there is nothing to suggest that this company had any other business activity beyond the 'BOXPARK' operations shown in evidence. In addition, the third-party press coverage, while not overly extensive, is clearly reflective of a large

²⁸ SC76

²⁹ SC77 to SC79

enough operation to warrant coverage from some nationwide publications such as the BBC, the Telegraph and the Standard. As such, despite the fact that use of the mark stems from just three locations in London, I am willing to find that the 'BOXPARK' brand has become known by a significant part of the relevant public in the UK. Saying that, this finding extends to the 'BOXPARK' brand only, meaning that the 'BoxHall' mark (being the opponent's third mark) does not benefit from this finding. Overall, I consider that while the use is at an acceptable level to enhance the distinctiveness of the opponent's second mark, this will not be to an outright high degree. I say this because the use is not overly significant and nor is it particularly widespread. Instead, I consider that the distinctiveness of the opponent's second mark has been enhanced to between a medium and high degree. That being said, this does not extend to all services relied upon and I will discuss this further below.

93. In considering the type of business the opponent operates, it is clear to me that while it does not necessarily offer its own retail services, it does bring together a range of retail outlets for a variety of purposes. Following my comments at paragraph 79 above, I find that this extends to the following services in class 35:

"The bringing together for the benefit of others of a variety of retail outlets connected with the sale of food and drink, fragrances, cosmetics, artificial nails, jewellery, clocks, watches, umbrellas, clothing, sunglasses, underwear, spectacles, footwear, porcelain and earthenware, furniture, picture frames, stationery, paintings, sculptures, art prints, and sports apparatus; the bringing together for the benefit of others of a variety of restaurants, enabling customers to conveniently make use of such facilities in a shopping mall or other managed retail environment"

94. While the above is noted, none of the above services in class 35 of the opponent's specification actually formed the basis of the goods and services comparison I undertook at paragraphs 30 to 43 above. Instead, I focused on the actual retail

services for which the opponent's second mark is registered. While there may be degrees of similarity between the above services and some of the goods in the applicant's specification, I consider that it would be at a lower degree than I have found above. As such, even taking into account any enhanced distinctiveness of the opponent's mark, I consider that the stronger degree of similarity offers the opponent its best case. If necessary, I will discuss this further below.

95. I turn now to the class 41 services. It is clear to me that the opponent has a clear focus on sport, entertainment (including quiz competitions) and culture events. In providing these events itself, the evidence also satisfactorily demonstrates that it also provides facilities for such events (by way of boxing weigh-ins and private hire events, for example). In addition, the opponent operates its own booking system for these events. As a result, my finding of enhanced distinctiveness applies onto the following class 41 services:

“Arranging, conducting and hosting of entertainment events, musical events, cultural events, sporting events and competitions; provision and management of entertainment events, musical events, cultural events, sporting events and competitions; providing facilities for sporting events and competitions; ticket reservation and booking services for entertainment events, musical events, cultural events, sporting events and competitions; provision of information about entertainment events, musical events, cultural events, sporting events and competitions, including information provided via online networks and the Internet.”

Likelihood of confusion

96. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible

undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global 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 mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their minds.

97. I have found the goods and services to either be identical or similar to varying degrees, including low. The average consumer base is formed of both members of the general public and business users. The former group of consumers will, for the most part, select the goods via primarily visual means (with the aural component contributing to some degree) whereas the latter will do so after having paid attention to both visual and aural components equally. When selecting the goods at issue, I have found that the level of attention will, generally, be medium but, for some goods, will extend to a lower degree. As for the business user, in selecting the services, I found that this will be done after having paid a relatively high (though not outright high) degree of attention. In respect of the similarity of the marks at issue, I have found the marks in the application to be visually and aurally similar to a medium degree and conceptually dissimilar to both the opponent's second and third marks. Lastly, I have found that all of the opponent's marks are inherently distinctive to a medium degree with the second mark's distinctiveness being enhanced to between a medium and high degree, but only for some of the services relied upon (being those listed at paragraphs 93 and 95 above).

98. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I consider that the average consumer, upon being

confronted by the parties' marks, even on identical services, would be able to accurately recall or remember which mark was which. I say this because whilst the parties' marks all share the word 'BOX', the additional element in the parties' marks, being the words 'PARK' and 'HALL' in the opponent's marks and the word 'OFF' in the marks in the application will not be overlooked despite their placement at the end of the mark.³⁰ On this point, I remind myself that the words 'BOX' and 'OFF' form the dominant element of the marks in the application and combine to form a unitary meaning. Such points are factors against a finding of direct confusion and will, in my view, enable consumers to accurately recall and remember the parties' marks for one another. Lastly, I appreciate that, for some services, the opponent's second mark enjoys a higher degree of distinctive character thanks to the use made of it. However, even considering this factor, the visual, aural and conceptual differences between the marks 'BOXPARK' and 'BOX OFF' are such that the consumer will not be directly confused.³¹ Consequently, I do not consider that there exists a likelihood of direct confusion between the marks, even on identical services.

99. I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

³⁰ In considering direct confusion, I am of the view that the word 'THE' at the beginning of the marks in the application will be overlooked.

³¹ On this point, I am of the view that even if the class 35 services listed at paragraph 93 above could be said to be similar to the applicant's goods, the enhanced distinctiveness of the opponent's mark in respect of those services would not be sufficient enough to overcome the conclusions reached here, especially given the further distance between said goods and services.

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)".

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

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

102. I appreciate that, for some services, the opponent’s second mark enjoys a higher degree of distinctive character. However, that finding relates to the mark as a whole meaning that the elevated level of distinctiveness of the opponent’s second mark lies in the word ‘BOXPARK’, not ‘BOX’ solus. As for the third mark, this does not enjoy an enhanced degree of distinctive character but the same finding remains, namely that its distinctiveness lies in the word ‘BoxHall’, not ‘Box’ solus.

103. In considering the issue of indirect confusion, I do not consider that the distinctiveness of the common element is such that consumers would think that only one undertaking would use it, especially considering that it carries a specific meaning in the marks of the application which is different from that of the same word in the opponent’s marks. In addition, I see no reason why an average consumer would, upon viewing the marks, believe the differences between them as logical and consistent indicators of a brand extension or a sub-brand. As I have found above, the opponent’s marks will either be viewed as a reference to a park or a hall shaped like a box. When confronted by the parties’ marks, I consider that consumers would view the changes as illogical and inconsistent. In short, I do not consider that consumers would believe that the user of the marks ‘BOXPARK’ or ‘BoxHall’ would change them by removing the words ‘PARK’ and ‘Hall’ and replacing them with the word ‘OFF’ which, as above, creates a unitary meaning distinct from that of the opponent’s marks. Lastly, I do not consider that there are any additional scenarios wherein a likelihood of indirect confusion would occur.

Therefore, based on my findings above and bearing in mind the comments set out in the case law discussed at paragraph 101 above, I find that there exists no likelihood of indirect confusion between the marks at issue, even when viewed on identical services.

Final remarks under section 5(2)(b)

104. In respect of the opponent's first mark, I am of the view that any finding of genuine use would have only extended to those same services for which its second mark enjoys an enhanced degree of distinctive character. While there may have remained a level of similarity between the goods and services of the parties, it would not have altered the outcome of there being no confusion between the marks at issue. I say this whilst relying on the same reasons set out above.

105. In addition, I will say that even if it could be said that the word 'BOX' played the greater role in the opponent's marks (as argued by the opponent), this would have no effect on the above outcome either. I say this because regardless of the role of 'BOX' in the opponent's marks, the unitary meaning of the marks in the application is such that the above findings in respect of confusion would remain applicable. Further, for the sake of completeness, I wish to discuss the fact that I found the marks conceptually dissimilar. On this point, I was wrong and it *is* the case that those consumers who derive the concept of boxing from the opponent's marks *do* form a significant proportion of consumers, I find that there would still be no likelihood of confusion between the marks. I make this finding on the basis that even if the concept of 'boxing' was taken from the opponent's marks (as a 'park for boxing' or a 'hall for boxing'), this would still form a unitary meaning which is still somewhat distinct from the meaning of the marks in the application (even if the shared reference to boxing is noted). Further, the distinctive character of the opponent's marks would still lie in the marks as wholes, being 'BOXPARK' and 'BoxHall'. As such, despite the connection to boxing, consumers would not see the application as a logical brand extension or sub-brand of the opponent's marks.

106. The present ground fails in its entirety. I will now proceed to consider the section 5(3) ground of the opposition.

Section 5(3)

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

“5(3) A trade mark which –

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

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

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

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *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 Salomon, paragraph 29* and *Intel, paragraph 63*.

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

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

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

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs

particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

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

109. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar.³² Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the applicant's mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

³² As per my comparison of the marks under the section 5(2)(b) ground above, this condition has been satisfied.

Reputation

110. I remind myself that under the present ground, the opponent relies on its first and second marks only. The opponent's first mark is subject to a proof of use request and while I have not conducted such an assessment, my position remains that it is not necessary to do so. I say this because the marks are essentially identical and, further, the services in the opponent's second mark offer the opponent its best case. On this point, I note that unlike the section 5(2)(b) ground above, the opponent also relies on the class 43 services in its second mark's specification.

111. Before proceeding, I consider it necessary to briefly discuss a point raised in the opponent's written observations, namely the comments found at paragraph 103 of the same. I note that the opponent claims that it has a reputation due to its high degree of the use of the word 'BOX' which forms the core of its brand. On this point, it refers to additional brands it uses such as 'BEATBOX', 'PLAYBOX' and 'BOXYARD'. Further, the opponent refers to evidence which shows press coverage regarding plans to open a 'BoxHall' venue in Summer 2023.³³ While noted, I fail to see how this assists the opponent's claim that it has a reputation in the word 'BOX' as the core of its brand. I say this because the opponent has not sought to rely on a 'family of marks' argument to the point that it can be said that consumers will associate any use of 'BOX' with the opponent.³⁴ Additionally, the marks referred to here are not relied upon under the present ground (the first three are of no issue to the proceedings as a whole whereas the evidence in respect of the 'BoxHall' mark relates to future activity so would be of no assistance in any event). Therefore, the reference to these additional marks has no impact on my evidential assessment as to the existence of a reputation in 'BOXPARK'.

³³ SC18 and SC19

³⁴ Even if it had, the structure of the marks referred to are different from one another in that some include the word 'BOX' as a prefix and some include it as a suffix. In such a scenario, consumers would not be able to detect a common element or pattern amongst said marks.

112. In considering the issue of a reputation, I remind myself that I have summarised the evidence filed by the opponent at paragraphs 73 to 92 above. I do not intend to reproduce the evidence summary here but remind myself that the evidence confirms that prior to the relevant date, the opponent operated out of three locations in London and that it generated a turnover of approximately £41 million between 2019 and 2022. In addition, for those same years, the opponent incurred an advertising spend of approximately £409,000. I also note that between 2020 and 2022, the three 'BOXPARK' locations combined to attract a total of 7.6 million visitors. Lastly, I remind myself that the opponent achieved press coverage prior to the relevant date stemming from a series of nationwide publications. Taking all of this into account, I accept that the opponent's evidence is sufficient to give rise to a finding that its second mark enjoyed a reputation in the UK as at the relevant date.³⁵ As for the strength of said reputation, I am of the view that the use before me is not at such a high level or at such a widespread/large scale that it can be said to be sufficient enough to warrant a strong reputation. Instead, I consider the strength of said reputation to be moderate.

113. Having said the above, the finding of a reputation does not extend to all of the services relied upon. Under this ground, I remind myself that the opponent relies only on services in class 41 and 43. I assessed the class 41 services under my assessment of an enhanced degree of distinctiveness above. Therefore, for the same reasons given at paragraph 95 above, I find that the opponent's reputation vests only in the following class 41 services:

Class 41: Arranging, conducting and hosting of entertainment events, musical events, cultural events, sporting events and competitions; provision and management of entertainment events, musical events, cultural events, sporting events and competitions;

³⁵ For the avoidance of doubt, this reputation lies in the word 'BOXPARK' as whole and not in the word 'BOX', solus. Further, the finding of a reputation does not mean that consumers will view 'BOX' as forming the core identity of the opponent's brand.

providing facilities for sporting events and competitions; ticket reservation and booking services for entertainment events, musical events, cultural events, sporting events and competitions; provision of information about entertainment events, musical events, cultural events, sporting events and competitions, including information provided via online networks and the Internet.

114. As for the class 43 services, I remind myself that these are as follows:

Class 43: Provision of event facilities, including for entertainment events, musical events, cultural events, marketing events, promotional events and educational events; services for the provision of food, drink and beverages; restaurant, cafe and catering services; public house services; bar services; temporary accommodation; temporary room hire.

115. Based on the evidence I have summarised at paragraphs 73 to 92 above, I am of the view that it is clear in that the opponent offers the provision of event facilities for various purposes, such as entertainment, musical or promotion. As for the provision of food and drink, I accept that the 'BOXPARK' venues operate their own bar services to sell alcohol and other beverages to consumers. However, there is nothing before me to suggest that this applies to food. I say this because the evidence before me is clear in that the food is provided by third party providers. Therefore, I consider that the finding of a reputation extends to the following services in class 43:

Class 43: Provision of event facilities, including for entertainment events, musical events, cultural events and promotional events; services for the provision of drink and beverages; bar services.

Link

116. As noted above, 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.

117. I conducted comparisons of the marks under the section 5(2)(b) ground above. These same findings apply here, namely that the marks at issue are visually and aurally similar to a medium degree and conceptually dissimilar.

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

118. While I conducted a comparison of the goods and services under the section 5(2)(b) ground of this decision, this is not necessarily applicable under the present ground. I say this because the opponent's class 35 services that formed the comparison against the applicant's goods in classes 9, 16, 18, 21, 28 and 28 are not relied upon under the present ground. In considering these goods against the opponent's reputed services, I see no obvious degree of similarity. I do not intend to conduct another full goods and services comparison but, for example, I note that the applicant's goods include terms such as "downloadable media", "posters", "luggage", "water bottles", "clothing" and "toys, games and playthings". Clearly these all differ in nature, method of use and purpose with the opponent's reputed services. As for trade channels, I appreciate that undertakings that offer the same services as the opponent may also sell merchandising goods, however, I have nothing to suggest that this is common in the trade to the point that it suggests a meaningful overlap in trade channels. Lastly, I accept that the user may overlap but without anything further, I do not consider that this is sufficient to give rise to a

finding of similarity. For the avoidance of doubt, this applies to all of the applicant's goods and not just those mentioned as examples above.

119. As for the class 41 services of the parties, it is my view that "organisation, arranging and conducting of boxing matches", "entertainment services", "live entertainment services", "organisation of sporting competitions" and "sports activities" are identical to the opponent's reputed services, namely "arranging, conducting and hosting of entertainment events, musical events, cultural events, sporting events and competitions" and "provision and management of entertainment events, musical events, cultural events, sporting events and competitions". As for "boxing instruction" and "sports coaching", I am of the view that while they differ in nature, method of use and purpose to the opponent's reputed services, there is a degree of overlap in trade channels and user on the basis that the providers of sporting events may also provide instruction and coaching in relation to various sports and those will be targeted at the same consumer. As such, I find that there is a low degree of similarity between such services.

The strength of the earlier mark's reputation.

120. I have found that the opponent's mark enjoys a moderate reputation.

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

121. Under the section 5(2)(b) ground, I found the opponent's second mark to be inherently distinctive to a medium degree and that, due to the use made of it, this was enhanced to between a medium and high degree for some services. The inherent position is equally applicable here, however, the position in respect of enhanced distinctiveness is not. I say this because that finding related to class 35 services that are not at issue here. Further, the class 43 services relied upon here

were not at issue under the section 5(2)(b) ground. Saying that, I am of the view that the same finding of an enhanced degree of distinctiveness can be applied to the present ground and I hereby find that the opponent's second mark enjoys the same finding of an enhanced degree of distinctive character in its reputed services.

Whether there is a likelihood of confusion

122. Under the section 5(2)(b) ground, I found that there is no likelihood of direct or indirect confusion between the marks at issue.³⁶ That being said, the provisions of section 5(3) offer additional protection which takes into account the repute and distinctiveness of the earlier marks. For example, some marks are so distinctive and well-known that there is likely to be some confusion almost irrespective of the goods or services on which the marks are used. While that may be the case for some marks, I do not consider that the opponent's mark's reputation or distinctiveness are at such a high level that they qualify to be offered the additional protection of the present ground. As such, even taking into account the opponent's reputation or enhanced degree of distinctive character, there remains no confusion between the marks at issue.

Conclusion on link

123. While I have found there to be no confusion, this is not the end of the matter as the opponent has claimed that consumers will bring to mind the opponent's mark when confronted by the marks in the application. This claim is noted, however, I see no reason why the consumer would bring to mind the opponent's 'BOXPARK' mark when confronted by the applicant's series of 'THE BOX OFF' marks, even on identical services. Further, I do not consider that the consumer would be caused to wonder if the marks at issue were linked. I make this finding because while the marks share the word 'BOX', this is an ordinary dictionary word so its shared use

³⁶ This even applies if there is some degree of conceptual similarity between the marks in the shared reference to the sport of boxing.

is not entirely surprising to the point that the consumer would automatically think of 'BOXPARK'.³⁷ Further, the concept associated with this word across the parties' marks is not the same. Following the same reasons I have already discussed above, the opponent's use of this word will be viewed as a reference to the shape or structure of a 'BOX' (forming the shape or name of the 'PARK' referred to) whereas the applicant's use of the same word will be viewed as forming a unitary phrase with 'OFF', thereby carrying the concept associated either with *a box office* or a *boxing confrontation*.³⁸ As a result, I am of the view that the conceptual impact of 'THE BOX OFF' is such that it will not lead consumers to think of the 'BOXPARK' mark, even if said consumer was aware of the opponent's reputation.

124. Taking all of the above into account, I find that there exists no link between the marks at issue. Without a link between the marks, there cannot be any damage and, as such, I find that the section 5(3) ground fails at this stage.

CONCLUSION

125. The opposition fails in its entirety and, subject to any successful appeal of my decision, the application is permitted to registration for all of the goods and services applied for.

COSTS

126. The applicant has succeeded in full and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. While I do not consider that the applicant's evidence was of any real assistance in the present proceedings, I note that the applicant was required to

³⁷ Especially given that the reputation lies in 'BOXPARK' as a whole and not 'BOX', solus.

³⁸ On this point, this difference will still be present even if the shared used of 'BOX' in the parties' marks was associated with the sport of boxing.

consider the evidence of the opponent so should still be awarded costs in respect of this task.

127. In the circumstances, I award the applicant the sum of £1,000 as a contribution towards its costs. The sum is calculated as follows:

Considering a notice of opposition and preparing a counterstatement:	£300
Considering evidence of the opponent and filing its own evidence:	£700
Total:	£1,000

128. I hereby order Boypark Brands Limited to pay BEYOND ENT. LIMITED the sum of £1,000. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 28th day of March 2025

A COOPER
For the Registrar

ANNEX

The opponent's first mark

Class 41

Arranging and conducting of entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; provision and management of entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; providing facilities for sporting events and competitions; ticket reservation and booking services for entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; provision of information about entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions, including information provided via online networks and the Internet.

Class 43

Provision of event facilities, including for entertainment events, musical events, cultural events, marketing events, promotional events and educational events; services for the provision of food, drink and beverages; restaurant, cafe and catering services; public house services; bar services; temporary accommodation; temporary room hire.

The opponent's second mark

Class 35

Retail services in relation to the sale of domestic electrical items, cooking and refrigerating apparatus, lighting apparatus, candles, computer software, computer games, apparatus for the recording, transmission or reproduction of sound and images, CDs, DVDs, videos, digital recordings, food and drink, toiletries, fragrances, cosmetics, essential oils, lotions for cosmetic purposes, hair lotions, shampoos, soap,

anti-perspirants, artificial nails, jewellery, clocks, watches, handbags, sports bags, travelling bags, trunks, luggage, umbrellas, clothing, walking sticks, wallets and cases, sunglasses, underwear, spectacles, belts, ties, scarves, footwear, cooking pans, cooking utensils, cutlery, glassware, porcelain and earthenware, plates, platters, cups, mugs, bowls, dishes, jugs, jars, bottles, vases, coffee pots, tea-pots, dustbins, mops, brooms, mirrors, furniture, picture frames, books, magazines, greeting cards, gift boxes, wrapping paper, bows, ribbons, stationery, vinyl records, paintings, sculptures, photographs, art prints, articles for playing sports, sports apparatus, bicycles, protective clothing, curtains, bedding, soft furnishings, hair accessories; the bringing together for the benefit of others of a variety of retail outlets connected with the sale of domestic electrical items cooking and refrigerating apparatus, lighting apparatus, candles, computer software, computer games, apparatus for the recording, transmission or reproduction of sound and images, CDs, DVDs, videos, digital recordings, food and drink, toiletries, fragrances, cosmetics, essential oils, lotions for cosmetic purposes, hair lotions, shampoos, soap, anti-perspirants, artificial nails, jewellery, clocks, watches, handbags, sports bags, travelling bags, trunks, luggage, umbrellas, clothing, walking sticks, wallets and cases, sunglasses, underwear, spectacles, belts, ties, scarves, footwear, cooking pans, cooking utensils, cutlery, glassware, porcelain and earthenware, plates, platters, cups, mugs, bowls, dishes, jugs, jars, bottles, vases, coffee pots, tea-pots, dustbins, mops, brooms, mirrors, furniture, picture frames, books, magazines, greeting cards, gift boxes, wrapping paper, bows, ribbons, stationery, vinyl records, paintings, sculptures, photographs, art prints, articles for playing sports, sports apparatus, bicycles, protective clothing, curtains, bedding, soft furnishings, hair accessories enabling customers to conveniently make use of such facilities in a shopping mall; the bringing together for the benefit of others of a variety of restaurants, enabling customers to conveniently make use of such facilities in a shopping mall or other managed retail environment; management of shopping malls and other retail operations, including food and drink outlets.

Class 36

Leasing of retail outlet units and retail space; leasing of restaurants and units for the provision of food and drink; real estate management, letting and sale; management of commercial property.

Class 41

Arranging, conducting and hosting of entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; provision and management of entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; providing facilities for sporting events and competitions; ticket reservation and booking services for entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; provision of information about entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions, including information provided via online networks and the Internet.

Class 43

Provision of event facilities, including for entertainment events, musical events, cultural events, marketing events, promotional events and educational events; services for the provision of food, drink and beverages; restaurant, cafe and catering services; public house services; bar services; temporary accommodation; temporary room hire.

The opponent's third mark

Class 35

Retail services in relation to the sale of domestic electrical items, cooking and refrigerating apparatus, lighting apparatus, candles, computer software, computer games, apparatus for the recording, transmission or reproduction of sound and images, CDs, DVDs, videos, digital recordings, food and drink, toiletries, fragrances, cosmetics, essential oils, lotions for cosmetic purposes, hair lotions, shampoos, soap,

anti-perspirants, artificial nails, jewellery, clocks, watches, handbags, sports bags, travelling bags, trunks, luggage, umbrellas, clothing, walking sticks, wallets and cases, sunglasses, underwear, spectacles, belts, ties, scarves, footwear, cooking pans, cooking utensils, cutlery, glassware, porcelain and earthenware, plates, platters, cups, mugs, bowls, dishes, jugs, jars, bottles, vases, coffee pots, tea-pots, dustbins, mops, brooms, mirrors, furniture, picture frames, books, magazines, greeting cards, gift boxes, wrapping paper, bows, ribbons, stationery, paper articles, cardboard articles, vinyl records, paintings, sculptures, photographs, art prints, articles for playing sports, sports apparatus, bicycles, protective clothing, curtains, bedding, soft furnishings, hair accessories; the bringing together for the benefit of others of a variety of retail outlets connected with the sale of all of the aforesaid enabling customers to conveniently view and purchase these goods; the bringing together for the benefit of others of a variety of restaurants, enabling customers to conveniently make use of such facilities in a shopping mall or other managed retail environment; management of shopping malls and other retail operations, including food and drink outlets; Arranging, conducting and hosting of marketing events and promotional events; provision and management of marketing events and promotional events.

Class 36

Leasing of retail outlet units and retail space; leasing of restaurants and units for the provision of food and drink; real estate management, letting and sale; management of commercial property.

Class 41

Arranging, conducting and hosting of entertainment events, musical events, cultural events, educational events, sporting events and competitions; provision and management of entertainment events, musical events, cultural events, educational events, sporting events and competitions; providing facilities for sporting events and competitions; ticket reservation and booking services for entertainment events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions; provision of information about entertainment

events, musical events, cultural events, marketing events, promotional events, educational events, sporting events and competitions, including information provided via online networks and the Internet.

Class 43

Provision of event facilities, including for entertainment events, musical events, cultural events, marketing events, promotional events and educational events; services for the provision of food, drink and beverages; restaurant, cafe and catering services; public house services; bar services; temporary accommodation; temporary room hire.