

O/0315/26

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION TO PROTECT
INTERNATIONAL TRADE MARK REGISTRATION NO.
WO0000001744812**

Digital Chopin

IN THE NAME OF N-EM LABORATORIES INC.

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 446080 BY
NARODOWY INSTYTUT FRYDERYKA CHOPINA**

BACKGROUND AND PLEADINGS

1. On 3 February 2023, N-EM LABORATORIES INC (“the holder”) designated the International Registration (“IR”) shown on the cover of this decision for protection in the UK. The IR has priority dates of 19 August 2022 and 27 October 2022.¹

2. Protection is sought in respect of the following goods and services:

Class 9

Telecommunication devices and apparatus; personal digital assistants [PDAs].

Class 41

Concert booking; booking of seats for shows.

Class 42

Hosting on-line web facilities for others for sharing on-line content; creating and maintaining web sites for others.

3. On 23 February 2024, the designation was opposed by Narodowy Instytut Fryderyka Chopina (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods and services listed above. Under both grounds, the opponent relies on UKTM No. 913485867, **CHOPIN**, which has a filing date of 25 June 2013 and a registration date of 21 November 2014. It is registered for goods and services in a large number of classes, only some of which are being relied on in these proceedings.

4. Under section 5(2)(b), the opponent relies on the following goods and services:

Class 9

Computer software, recording discs, DVDs and other digital recording media.

Class 41

Education, providing of training, entertainment, sporting and cultural activities.

The opponent claims that the marks are similar, sharing the same distinctive element “CHOPIN”, with the “Digital” of the IR being descriptive. It also claims that all the goods

¹ Priority is claimed from Japanese Trademarks 2022-100836 and 2022-128356.

and services are similar and so there is a likelihood of confusion on the part of the public.

5. Under section 5(3), the opponent claims that the earlier mark has a reputation for piano competition services and organising piano competitions, which are included in the following services in Class 41: *Education, providing of training, entertainment ... and cultural activities*. It argues that the mark is associated with “*high quality, prestige, excellence, elitism, reputation and recognition*.” The opponent claims that the similarity between the earlier mark and the contested IR is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the parties. It also claims that the holder will take unfair advantage of the reputation of the earlier mark.

6. The holder filed a defence and counterstatement denying the claims made and putting the opponent to proof of use for all the goods and services relied upon.

7. Only the opponent filed evidence. This comes from Artur Szklener, director of the Narodowy Instytut Fryderyka Chopina, a position he has held since 1 May 2012. His witness statement is dated 9 August 2024 and is accompanied by 23 exhibits. It goes to the use made of the earlier mark and the claims of reputation. Some of these exhibits have been translated from the Polish. There is also a witness statement from the translator Magdalena Ślifarczyk dated 11 September 2024. She confirms that she is fluent in English and Polish. The opponent also filed written submissions dated 9 August 2024. These come from Mr Szklener and contain screenshots taken from the holder’s YouTube channel. However, these have not been filed in evidential format so I shall disregard them for the purposes of making my decision.

8. Neither party requested a hearing or filed written submissions in lieu of the same. In these proceedings, the opponent is represented by Cleveland Scott York and the holder by Briffa. I have taken this decision following a careful consideration of the papers.

RELEVANCE OF EU LAW

9. 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.

DECISION

Proof of Use

10. Section 6A of the Act is as follows:

“(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in sections 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if-

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

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

(4) For these purposes-

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

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

[(5) Repealed]

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

...”

11. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

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

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

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

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

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

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

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

12. The relevant period for the purposes of assessing genuine use is the five years that ends with the date of application for the registration, that is, 4 February 2018 to 3 February 2023.

13. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W. F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [72]; *Leno* at [55].

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

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the

commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

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

...

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

The opponent's evidence

14. The opponent, Narodowy Instytut Fryderyka Chopina (in English, “The Fryderyk Chopin Institute”), is a Polish public body established in 2001 for the purpose of promoting and protecting the legacy of the nineteenth-century Polish composer, Fryderyk Chopin. One of the ways it does this is through the organisation of The International Fryderyk Chopin Piano Competition, which takes place every five years

in Warsaw. According to Mr Szklener, it is commonly known as “The Chopin Competition” and is one of the oldest, most famous and most prestigious piano competitions in the world. It was first held in 1927 and has been won by some of the world’s leading pianists, such as Maurizio Pollini (1960) and Martha Argerich (1965).²

15. Within the relevant period for proof of use, the competition has been held once, in 2021. This was the 18th competition and it took place a year later than originally planned because of the Covid pandemic. However, the process from application to final stage was a long one, with the closing date for entries being 1 December 2019, preliminary rounds held in July 2021, and the competition taking place over the month of October 2021.³ There were 500 candidates from 55 different countries, with 87 making it through to the final stages.⁴

16. Tickets for the various stages of the competition went on sale on 1 October 2019. A print-out from the opponent’s website chopincompetition2020.com gives the prices in Polish currency and I note that it refers to the competition both as “*the XVIII International Fryderyk Chopin Piano Competition*” and “*the XVIII Chopin Competition*”.⁵ Mr Szklener states that the tickets sold out immediately⁶ and that income from ticket sales amounted to PLN 1,091,005.⁷

17. People who had not been able to purchase the tickets were able to watch coverage on television, the opponent’s channel on YouTube or via a downloadable mobile app. A Facebook post by the opponent dated 3 October 2022 states that Polish television broadcast 147 hours of coverage and the prize winners’ concert was watched by approximately 1.8 million people.⁸

18. Mr Szklener states that the opponent’s YouTube channel had more than 67 million views in 2021. It “*currently*” has almost 215 million views and 479,000 subscribers. The table below shows the amount of content that was published on the channel:⁹

² Exhibit AS9.

³ Exhibit AS8.

⁴ Exhibits AS3 and AS7, reproduced on pages 11 and 12 of the witness statement.

⁵ Exhibit AS12.

⁶ Witness statement, paragraph 9, page 13.

⁷ Witness statement, paragraph 9, page 14; Exhibit AS14.

⁸ Exhibit AS7.

⁹ Witness statement, paragraph 10, page 16.

	Published content on the Chopin Institute YouTube channel		
	Videos	Livestream	Others
2018	257	20	1
2019	20	4	0
2020	119	79	2
2021	623	197	4
2022	136	54	0
Total	1,155	354	7

19. Mr Szklener states that the channel is used to provide cultural and entertainment services, including broadcasting events organised by the opponent, such as the piano competition and concerts.

20. Exhibit AS25 contains statistics on the geographical location of viewers of content on the opponent’s YouTube channel. Mr Szklener states that between 2018 and 2022, the channel was viewed 2,232,990 times in the UK with a total viewing time of almost 250,000 hours. He gives the following figures: 235,682 (2018), 242,489 (2019), 399,366 (2020), 890,788 (2021) and 464,665 (2022).¹⁰ These figures are significantly higher for the year in which the competition was held. A screenshot of the YouTube channel is shown in Exhibit AS15 and is headed “Chopin Institute”. There is also a figurative mark, reproduced later in this decision in paragraph 30.

21. The mobile app called Chopin Competition 2020 was released on 9 March 2020 and made available to users on Google Play and the Apple App Store. Mr Szklener says that on 7 October 2021 it was the fifth most popular app in the music section on the Apple App Store. Exhibit AS4 contains a screenshot showing the opponent’s Facebook post on this subject. The mobile phone screen shows text in Polish, so it is not clear whether this reflects national or global popularity. However, it does show the title of the app in English.

22. Mr Szklener states that there were 883 downloads of the app in the UK: 791 through the Apple App Store and 92 through Google Play. He goes on to say that there were “*many downloads*” in EU Member States between 9 March 2020 and 31 December 2020.¹¹ No figures – either precise or approximate – are given.

¹⁰ Witness statement, paragraph 10, page 17.

¹¹ Witness statement, paragraph 6, pages 3-4.

23. Content was also posted on the opponent's website. The domain www.chopin2020.pl was, Mr Szklener says, used for organising the Chopin Competition and providing related entertainment and cultural activities. An undated screenshot from the website shows that recordings from the competition were available at the time the screenshot was captured.¹²

24. The opponent also organised another competition in September 2018: the 1st International Chopin Competition on Period Instruments, in which entrants played on historical pianos. Sixty pianists from around the world applied and thirty of these qualified for the Main Competition.¹³ An Instagram post dated 25 March 2022 invites entrants for the 2nd competition, to be held in Warsaw from 5-15 October 2023.¹⁴

25. Since 2005, the Institute has organised an annual music festival called "Chopin and His Europe". During the relevant period, it took place on 9-31 August 2018 and 14 August-1 September 2019 in Warsaw. The 2019 poster is reproduced below. I note here that the evidence also includes a poster from 2020, but this is so blurred that I cannot make out any details.¹⁵

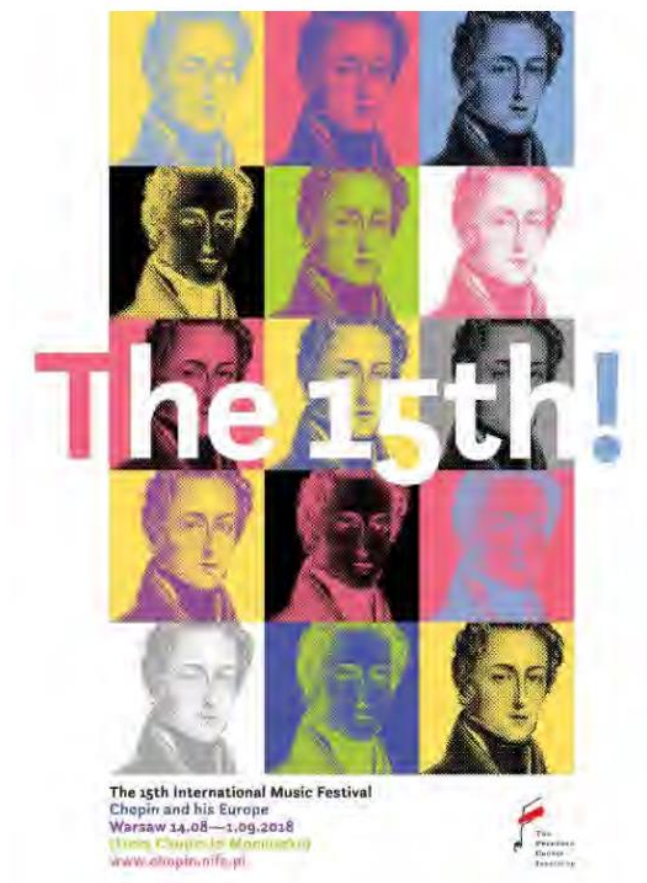
[THE REST OF THIS PAGE IS INTENTIONALLY BLANK]

¹² Exhibit AS20.

¹³ Exhibit AS24.

¹⁴ Exhibit AS23, page 2.

¹⁵ Exhibit AS21.

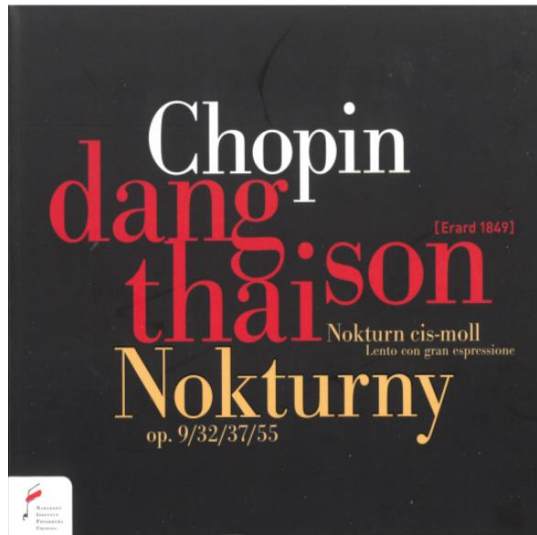


26. I note that the opponent sold CDs and DVDs. Mr Szklener states that sales of CDs and DVDs to UK customers amounted to PLN 59,677 in 2019, PLN 39,158 in 2020, PLN 103,893 in 2021 and PLN 96,935 in 2022.¹⁶ Exhibit AS11 contains sample invoices showing sales of CDs and DVDs within the EU. These are dated 6 September 2019 (for PLN 21,028.02), 3 March 2020 (for PLN 8,386.08) and 28 September 2020 (for PLN 4,828.18). The addresses have been redacted but Mr Szklener's statement that they represent sales to EU customers has not been challenged. I accept his evidence on this point.

27. Exhibit AS5 contains detailed information for 16 CDs and 2 DVDs, along with thumbnails from screenshots dating from 2021 which indicate that a larger selection was available. An example can be seen below:¹⁷

¹⁶ Paragraph 7, page 6; Exhibits AS10.1-AS10.4.

¹⁷ Exhibit AS5.1 part 2.



28. The above CD is shown on the opponent's website. This screenshot was captured after the relevant date on 31 March 2023 but it states that the CD was published in 2009.¹⁸ It also appears as a thumbnail on the 2021 screenshots to which I have already referred.

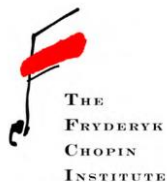


¹⁸ Exhibit AS5.1 part 1.

29. In his witness statement, Mr Szklener provides a larger, clearer version of the sign that can be seen in the bottom left corner of the CD cover.¹⁹ It is shown below. I note that it also appears on the opponent's YouTube channel and can be seen on the website referred to in paragraph 23, although, as I have already said, this screenshot is undated.



30. The sign also sometimes appears in the following form:



An example can be seen in the bottom right corner of the music festival poster in paragraph 25.

31. Finally, I note that Exhibit AS23 contains a series of Instagram posts that appear to show a wide range of activity undertaken by the opponent. The formatting of this exhibit does not make the posts entirely easy to read. Eight website screenshots are compressed into each page, with the result that some of the text is missing and what text there is can only be read when enlarged on a screen. The first 12 posts date from 2019, i.e. before IP completion day, and refer to the main competition, the Chopin and His Europe festival and the streaming of concerts. The remaining posts date from 2022 and do not shed light on the use of the mark in the UK. Throughout these posts, the opponent is referred to as "Chopin Institute" or "Fryderyk Chopin Institute", and the main competition as "the Chopin Competition".

¹⁹ Paragraph 7, page 7.

Genuine Use

Form of the mark

32. I shall begin my assessment of the use made of the earlier mark by considering whether the forms shown in the evidence constitute acceptable variants of the registered mark per section 6(4)(a) of the Act. The correct approach to the test under the equivalent provision in revocation proceedings (section 46(2)) was considered by Professor Phillip Johnson, sitting as the Appointed Person, in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22. He said:

“13. ... While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:20, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-164/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI.Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the

distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word 'MEDIA' would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

33. The question of variant use also applies where a mark has been used with other matter. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the Court of Justice of the European Union (“CJEU”) confirmed that the use of a mark encompasses both its independent use and its use as part of another mark. However, the use of a mark as part of a composite mark or alongside another mark will only be genuine use where the mark continues to be perceived as indicative of the origin of the product or service at issue: see paragraphs 31-35 of the court’s judgment.

34. The earlier mark consists of the single word “CHOPIN”. There is nothing else in the mark to give it distinctive character. It can be seen in white letters towards the top of the cover of the CD reproduced in paragraph 27 above. However, I do not consider that this is trade mark use, which was described by the General Court (“GC”) in *Danjaq LLC v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Dr No)*, Case T-435/05, thus:

“23. ... it is settled case-law that the essential function of a trade mark is to identify the commercial origin of goods or services, thus enabling the consumer who purchases them to repeat the experience if it proves to be positive, or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition (Case T-360/00 *Dart Industries v OHIM (UltraPlus)*)

[2002] ECR II-3867, paragraph 42, and Case T-242/02 *Sunrider v OHIM* (TOP) [2005] ECR II-2793, paragraph 88).”

Rather, the use of the word “Chopin” on the cover informs the consumer that the music featured on the disc was composed by Chopin. The commercial origin of the compact discs is indicated by the figurative sign in the bottom left corner of the cover and enlarged in paragraph 27 above. A similar reasoning applies in the case of the music festival “Chopin and His Europe”. The commercial origin is shown by the figurative sign. I shall come back to the question as to whether this is an acceptable variant shortly.

35. The phrase “Chopin Competition” has been used in connection with piano competitions and goods and services related to it. These consist of the mobile app, video content published on the opponent’s website and YouTube channels, live performances, and ticket sales. When used for the competition, the word “Competition” is plainly descriptive. The other words that were sometimes used – “XVIII”, “2020”, “international”, “period instruments” – are also descriptive of characteristics of that particular competition. Consequently, I find that the only distinctive element of the marks “Chopin Competition”, “Chopin Competition 2020”, “the XVIII Chopin Competition” and “The 1st International Chopin Competition on Period Instruments” is the word “Chopin”. In my view, the distinctive character of the mark is not changed when these variants are used for the piano competitions. I find that they are acceptable variants in respect of these services. However, I do not consider that they are acceptable when used for the Class 9 goods such as the smartphone app or for broader cultural services in Class 41. This is because “competition” is no longer descriptive of a characteristic of the goods or services or, particularly in the case of recorded discs, the phrase conveys a message about the content of the goods or services, rather than the commercial origin. The phrase “Chopin Competition” forms a whole that is more distinctive than the word “Chopin” and the origin function is no longer served by the word “Chopin” independently of the complete phrase.

36. I come to the same conclusion in respect of the name of the opponent, Narodowy Instytut Fryderyka Chopina or The Fryderyk Chopin Institute, its shortened form “The Chopin Institute” and the figurative marks. The origin function is not served by the word

“Chopin” independently of the complete phrase or of the phrase with the device, and so these are not acceptable variants of the earlier mark as registered.

Sufficiency of use

37. Both the main piano competition and the period instrument competition were held once during the relevant period (in 2021) and the evidence indicates that the period instrument competition was also held once (in 2018). The opponent is not required to show use through the entirety of this period and an article from PIANOTEA provides evidence that some other prestigious piano competitions are held on a similar schedule. For example, the Tchaikovsky International Competition in Moscow is held every four years.²⁰ In the sector concerned, the scale of use does not appear to be uncommon. The location of the use is also relevant. The two competitions took place in Poland, but were open to entrants from around the world. The relevant territory for the period up to IP completion day (31 December 2020) is the EU; thereafter, it is the UK. Even though the main competition was held after IP completion day, I note that preparations for the main competition had been made before that day, that tickets had been advertised and offered for sale in October 2019, and that, had it not been for the Covid pandemic, the final stages of that competition would have taken place in 2020. In my view, the scale of use shown in the evidence is such as to be warranted to create or maintain a share of the market for piano competitions. Therefore, I consider that the evidence shows that the earlier mark has been used for piano competitions.

A fair specification

38. The Class 41 services for which the earlier mark is registered consist of *Education, providing of training, entertainment, sporting and cultural activities*. I do not consider that the evidence shows any use of the mark with respect to services falling within the terms *Education, providing of training or sporting activities*. At this point, it is appropriate to note that, although Mr Szklener states that “*At the centre of the Institute’s activities is the provision of cultural, education, training and entertainment services*”, he also says that he has limited the evidence to a few examples in this class.²¹

²⁰ Exhibit AS9, page 3.

²¹ Paragraph 8.

39. This leaves *Providing of entertainment ... and cultural activities* and I must now address whether this represents a fair specification on which the opponent may rely in these proceedings. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification in opposition and invalidation proceedings. He said:

“244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. ... It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

40. This approach was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36:

“261. ... First, there can be no doubt that an application to register a mark in respect of a broad category of goods or services may be made *partly* in bad faith in so far as the broad description includes distinct sub-categories of goods or services in relation to which the applicant never had any intention to use the mark, whether conditionally or otherwise. In my view, that emerges clearly from the decision of the CJEU in this case. The approach to be adopted in such a case was explored and explained by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp* [2017] EWCA Civ 1834; [2018] ETMR 10, at paras 241-2491 and, so far as I am aware, that approach has proved workable and appropriate and has stood the test of time, save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use.”

41. The purpose of a piano competition is to identify, and give wider exposure to, talented young pianists. It serves a further purpose in providing entertainment to music

lovers. In *ACTC GmbH v European Union Intellectual Property Office (EUIPO)*, Case C-714/18 P, the CJEU said:

“51. ... if, as in the present case, the goods concerned have several purposes and intended uses – as is often the case – determining whether there exists a separate subcategory of goods by considering in isolation each of the purposes that those goods may have will not be possible, contrary to what the applicant claims. Indeed, such an approach would not enable independent subcategories to be identified coherently and would have the effect ... of limiting excessively the rights of the proprietor of the earlier mark, inter alia in that his legitimate interest in expanding his range of goods or services for which his trade mark is registered would not sufficiently be taken into consideration.”

42. In *Ferrari SpA v DU*, Joined cases C-720/18 and C-721/18, the CJEU said:

“43. As is apparent from paragraph 37 of this judgment, the only relevant question in that regard is whether a consumer who wishes to purchase a product or service falling within the category of goods or services covered by the trade mark in question will associate the goods or services belonging to that category with that mark.”

43. In my view, a fair specification for the earlier mark would be *Providing of entertainment and cultural activities*. However, even if I am wrong in this and a narrower specification is the fair one, it will become clear that nothing turns on the question of whether a fair specification is this broader term or a narrower one, limiting coverage to music or to piano competitions. I shall proceed on the basis of the broader term, as in my view, this is more in line with the guidance of the legal authorities that I have cited.

Section 5(2)(b)

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

“A trade mark shall not be registered if because—

...

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

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

45. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2025] UKSC 25:

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, 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 greater 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; and
- 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

46. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the GC said in *Boston Scientific Ltd v OHIM*, Case T-325/06, goods and services are complementary when

“82. ... there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

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

Contested goods and services	Earlier services
<u>Class 9</u> <i>Telecommunication devices and apparatus; personal digital assistants [PDAs].</i>	
<u>Class 41</u> <i>Concert booking; booking of seats for shows.</i>	<u>Class 41</u> <i>Providing of entertainment and cultural activities.</i>
<u>Class 42</u> <i>Hosting on-line web facilities for others for sharing on-line content; creating and maintaining web sites for others.</i>	

48. The holder's Class 9 goods are types of telecommunications and digital equipment. Their purpose is to allow the user to send, receive, view and store data. This differs from the purpose of the opponent's services. The nature and method of use of the parties' respective goods and services also differ. The goods and services are likely to be distributed through different trade channels. I cannot see that they are complementary or in competition. The only similarity I find is that both parties' goods and services are used by the general public. This similarity is at such a general level that I do not consider that it is relevant to the question of confusion: see *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)* [2024] EWHC 1098 (Ch), paragraph 23. I find that the Class 9 goods are dissimilar to the earlier services.

49. The holder's Class 41 services relate to the booking of seats for concerts and shows more generally. In my view, shows would include music shows. From my own experience as a consumer, I am aware that this is a service that is sometimes offered by a specialist undertaking, booking seats for third parties' concerts and shows. The organisers of such events may also offer consumers a service for booking tickets for them. The purpose of the services differs, as does the nature and method of use. They are targeted towards the same users and there is likely to be some overlap in trade channels, but I would expect this to be fairly small. The services are not in competition.

In my view, there is a degree of complementarity between the services. The opponent's services are essential for the provision of the holder's services and it is my view that the average consumer is likely to believe that there is some connection between the parties. Taking all these factors into account, I find that there is a low degree of similarity between the holder's *Concert booking* and *Booking of seats for shows* and the opponent's *Providing of entertainment and cultural activities*.

50. I cannot see any similarity between the holder's Class 42 services and the opponent's services. They have different purposes, nature and method of use. I consider that they are likely to be distributed through different trade channels and they are not complementary or in competition. Again, the only similarity I find is that they are both likely to be used by the general public. Following the reasoning in paragraph 48, I find that they are dissimilar.

51. A likelihood of confusion may only be found under section 5(2)(b) where the goods and services are at least similar: see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA, paragraph 49. My consideration of this ground continues in respect of the opposed Class 41 services only.

Average consumer and the purchasing process

52. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of services in question: see *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 26.

53. I have received no submissions on the identity of the average consumer. However, it seems to me that the average consumer of both parties' services is likely to be a member of the general public. In my view, they will pay a medium degree of attention during the purchasing process. The average consumer is likely to make their choice of provider by browsing through websites or seeing advertisements and so will see the mark in use. While the visual aspects of the mark would make a greater impression, I do not discount the possibility that the average consumer would receive word-of-mouth recommendations or hear the mark used in aural advertising.

Comparison of marks

54. It is clear from the judgment of the CJEU in *SABEL BV v Puma AG*, Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: see, in particular, paragraph 23. In the same case, the court explained that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impression created by the marks: see *Bimbo SA v OHIM*, Case C-519/12 P, paragraph 34.

55. The respective marks are shown below:

Contested IR	Earlier mark
Digital Chopin	CHOPIN

56. I have already found that the overall impression of the earlier mark lies in the single word “CHOPIN”. This is a word mark and in *LA Superquímica v EUIPO*, Case T-24/17, the GC held that such marks protected the word or words contained in them, which may be used in any form, colour or typeface: see paragraph 39 of that judgment.

57. The contested IR is also a word mark, consisting of two words. The opponent submits that the second of these, “Chopin”, is the distinctive element of the mark, as “Digital” is descriptive. I agree with the opponent on the basis that the holder’s services are likely in this day and age to be delivered online. I find that the distinctive element of the mark is “Chopin”, with the word “Digital” making only a small contribution to the overall impression of the mark.

Visual comparison

58. The marks differ in that the earlier mark consists of a single word, while the contested IR has two. However, the earlier mark is the distinctive element of the

contested IR. While the English-speaking consumer reads from left to right, and so the first word tends to attract more attention, this is not a hard and fast rule. I am required to take into account the distinctive and dominant elements of the marks and, in the case of the contested IR, it is the second word that is the distinctive element. Consequently, I find that the marks are visually similar to a medium to high degree.

Aural comparison

59. For some consumers, “Chopin” will be a recognisable word that they know how to pronounce. I do not consider that this will be the case for all consumers. Nevertheless, however the consumer says the word, it is likely to be the same in both marks. Because the word “Digital” is the first word of the earlier mark, I consider it more likely than not that it will be spoken, and it will be pronounced in the usual way. There may be some consumers who do not articulate it, where it is used for online services, given its descriptive nature, and the tendency of people in everyday life to say things in a simplified form: see *Enrich Learning*, BL O/1141/25, paragraph 16. Where consumers do not say “Digital”, the marks are aurally identical. Where they do say the contested IR in its entirety, I find that, taking into account the distinctive element, the marks are aurally similar to a medium to high degree.

Conceptual comparison

60. The evidence shows that Chopin was a noted nineteenth-century composer, particularly famous for his piano music. Some consumers of the services at issue will be aware of him and his work, and so the earlier mark will bring these concepts to mind. However, I consider that there is a significant group of consumers who do not know about him and will instead perceive the word to be an invented, or at least unknown, one. The earlier mark will, for this group, have no semantic content. For the first group of consumers (who know about Chopin), the contested IR carries an additional concept of digital services. For them, the marks are conceptually similar to a medium to high degree. For the second group of consumers (who think it is an invented or unknown word), the only conceptual message conveyed by the contested IR relates to the digital services. As this concept is absent from the earlier mark, which I have found to have no meaning for these consumers, I find that the marks are conceptually dissimilar for this group.

Distinctive character of the earlier mark

61. Distinctive character is a measure of how strongly a mark distinguishes the services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

“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).”

62. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, 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 the mark can be enhanced by the use that has been made of it.

63. The inherent distinctive character of the earlier mark will be high for those consumers who believe the word “Chopin” to be invented. For those consumers who are aware of the composer, the inherent distinctive character of the earlier mark will be at a low to medium level for services that relate to music, and at a medium to high level for other entertainment and cultural services.

64. For the purposes of assessing whether the distinctive character of the earlier mark has been enhanced, it is the UK average consumer that is relevant. There is little evidence that goes directly to use in the UK. I have already referred to 883 downloads of the Chopin Competition 2020 smartphone application and the numbers of views of the Chopin Institute YouTube channel, which are set out in paragraph 20 above. It is not clear what was watched but Mr Szklener states that the main subject of the videos

is the piano competitions. The UK is not listed as one of the countries where the 2020/2021 competition was most watched. These were Japan, Poland, South Korea, USA, China, Taiwan and France.²² Over 50% of the competition's viewers were from Japan.²³ While I have no information on the size of the market for entertainment and cultural activities, a total of 2,232,990 views over a five-year period and 883 downloads of an app seem to be very small. There is no information on how many social media followers were in the UK. Consequently, I find that the level of distinctive character has not been enhanced for *Providing entertainment and cultural activities*. It seems likely that the market for piano competitions is significantly smaller than the total market for entertainment and culture. However, even here the evidence is patchy, particularly when the volume that has been filed is taken into account. In my view, it falls short of what would be required to show that the distinctive character of the earlier mark had been enhanced through use.

Conclusions on likelihood of confusion

65. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the services at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services or vice versa.

²² Exhibit AS3.

²³ Exhibit AS7.

66. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting 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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.’

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

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

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

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

67. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

“12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] ‘a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

68. Earlier in my decision, I found that:

- i) The holder’s *Concert booking* and *Booking of seats for shows* are similar to a low degree to the opponent’s services;
- ii) The average consumer is a member of the general public paying a medium degree of attention during a largely visual purchasing process;
- iii) “Chopin” is the distinctive element of the contested mark;
- iv) The parties’ marks are visually similar to a medium to high degree; aurally similar to a medium to high degree or aurally identical (depending on whether the word “Digital” is articulated); and conceptually similar to a medium to high degree or conceptually dissimilar (depending on whether the consumer understands the meaning of “Chopin”);
- v) For those consumers who do understand the meaning of the word “Chopin”, the earlier mark has a low to medium degree of inherent distinctive character for services related to music, and a medium to high degree for other services;

vi) For those consumers who do not understand the meaning of the word “Chopin”, the earlier mark has a high degree of inherent distinctive character; and

vii) The inherent distinctive character of the earlier mark has not been enhanced through use.

69. On encountering the contested mark, the average consumer is likely to notice the word “Digital” at the front. Given its descriptive nature, I consider that the average consumer would be unlikely to remember whether it appeared in the opponent’s mark where that mark was used for entertainment and cultural activities delivered online. Such activities would be included in the terms which I found to be a fair specification, and this would apply equally had I narrowed that fair specification to cover activities relating to music or even simply piano competitions. Given the complementarity of the services, which means that the average consumer is likely to assume they come from the same undertaking or connected undertakings, the identity of the distinctive elements, and the imperfect recollection of the average consumer, I find that there is a likelihood of direct confusion. If I am wrong in this finding, and the average consumer recalls the differences of the marks, they are likely to be indirectly confused, given the descriptiveness of “digital” in relation to services that would be covered by fair and notional use of the contested IR.

70. The opposition is successful under section 5(2)(b) in respect of the following services:

Class 41

Concert booking; booking of seats for shows.

Section 5(3)

71. Section 5(3) of the Act is as follows:

“A trade mark which–

(a) is identical with or similar to an earlier trade mark,

[...]

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

72. As the earlier mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

“(1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to-

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom includes the European Union.”

73. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L’Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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 and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68. Whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

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

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

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

i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal*, paragraph 40.

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

Reputation

74. In *General Motors*, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the

absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

75. The opponent claims that the earlier mark has a reputation for *Piano competition services* and *Organising piano competitions*. Any reputation under this section must be in goods and/or services covered by the earlier mark: see *Tulliallan Burlington Ltd v EUIPO*, Case T-123/16, paragraph 27. I agree with the opponent that the services in respect of which the opponent claims a reputation are encompassed by broader terms in Class 41 of the earlier specification.

76. The factors that are to be considered in an assessment of reputation are the same as those that are relevant to the question of enhanced distinctiveness. In *CXO2 Trade Mark*, BL O/393/19, Professor Phillip Johnson said that the threshold for reputation is higher than that for acquired distinctiveness: see paragraph 39 of that decision. It will be recalled that I found that the distinctive character of the earlier mark had not been enhanced, even for the narrower term of *Piano competition services*. However, it must also be borne in mind that the relevant territory for the purposes of enhanced distinctiveness was the UK, while for the purposes of section 5(3) it is the EU up to IP completion day (31 December 2020) and the UK between 1 January 2021 and 3 February 2023.

77. The relevant public for the *Piano competition services* and *Organising piano competitions* consists of professional or would-be professional pianists on the one hand and classical music lovers on the other. This is likely to be a relatively small section of the general public in the EU/UK. While the postponement of the 18th competition to the year after IP completion day means the television broadcasts in Poland cannot be taken into account, the fact that tickets went on sale in 2019 and quickly sold out is testament to the reputation among the relevant public. A summary of ticket sales is provided in Exhibit AS14. This is in Polish and has not been translated. Even so, it does not appear to contain any information on where the purchasers of these tickets were located. The promotional brochure in Exhibit AS3 states that “*the audience of the Competition comprises people from all over the world*”.²⁴

²⁴ Page 2.

78. In his witness statement, Mr Szklener says the following about the 17th competition, that was held in 2015:

“Furthermore, materials relating to the auditions and concerts that took place as part of the 17th Chopin Competition have also been available on the Chopin Institute YouTube channel since their publication in 2015. It is worth adding that, on the day when the results were announced of the 17th Chopin Competition organised by the Institute in 2015, Google noted that ‘Chopin’ as a search term was more popular than ‘shopping’.”²⁵

79. I have read through all the evidence carefully and can find no documentary evidence supporting this last statement. Again, there is nothing to tell me about the location of the people searching for this term on Google. It is worth noting that the competition that year was won by a South Korean pianist, with second place going to a Canadian, and third to a pianist from the US. There is likely to have been a good deal of interest in the outcome of the competition from outside the EU.

80. Exhibits AS25 and AS26 contain statistics relating to the opponent’s YouTube channel from 2018 to 2022. Neither of these exhibits has been translated. While the opponent has highlighted in Exhibit AS25 the figures relating to the UK and Mr Szklener has reproduced them in English in his witness statement, none of the country names have been translated. I can hazard a guess that “Polska” is Poland and “Francja” France, but am not clear, for example, whether “Niemcy” or “Wlochy” are in the EU or not, and it would not be appropriate for me to carry out my own research on the matter. In *ARMANDO POLLINI Trade Mark*, BL O/146/02, Professor Ruth Annand said that exhibits should be translated if they are to be relied upon: see paragraph 32 of that decision. I therefore find these exhibits give me little assistance in determining whether the earlier mark has a reputation.

81. Taken as a whole, I find the evidence lacks specificity on the reputation of the earlier mark in the relevant territory. It shows that the competition is prestigious, but does not give me sufficient detailed evidence to draw any conclusions about whether a significant part of the public in the relevant territory concerned with the services knows about the mark to denote the commercial origin of those services, rather than

²⁵ Paragraph 9, page 14.

as the name of a very famous composer. I find that the opponent has not shown that the earlier mark has a reputation for the services. The opposition under section 5(3) therefore fails.

82. However, in case I am wrong in this finding, I will proceed to consider whether there is a link on the basis that the reputation is as high as the opponent claims it to be for *Piano competition services* and *Organising piano competitions*.

Link

83. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU at paragraph 42 of its judgment in *Intel*. I shall consider each of them in turn.

The degree of similarity between the conflicting marks

84. Earlier in my decision, I found that the marks were visually and aurally similar to a medium to high degree if, as I considered would be likely, the contested IR would be articulated in full. The relevant public for the earlier services would identify “Chopin” as the name of a composer and so I find that the marks are conceptually similar to a medium to high degree.

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

85. I found that the Class 9 goods and the Class 42 services were dissimilar to the opponent’s *Providing of entertainment ... and cultural activities*. This term includes *Piano competition services* and *Organising piano competitions*. My finding of dissimilarity under section 5(2)(b) therefore carries over to section 5(3).

86. Turning now to the Class 41 services, I found them to be similar to the opponent’s broader services to a low degree. I consider that the same applies where the opponent’s services are narrower, as here. *Concert booking* and *Booking of seats for shows* are services that are complementary to *Piano competition services* and *Organising piano competitions*. There will also be an overlap in user and trade channels.

The strength of the earlier mark's reputation

87. To give the opponent its best case, I am proceeding on the basis that the earlier mark has a strong reputation for *Piano competition services* and *Organising piano competitions*.

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

88. As I am proceeding on the basis that the earlier mark has a strong reputation, I will also consider that the mark has a high degree of distinctive character.

Whether there is a likelihood of confusion

89. I found a likelihood of confusion under section 5(2)(b) for the Class 41 services.

90. Section 5(3) provides additional protection for those marks with a reputation. It acknowledges that some marks are so highly distinctive and well known that there is likely to be some confusion almost irrespective of the goods or services in relation to which they are used. I am required to take account of the distinctiveness and repute of the opponent's mark and to decide whether in this particular case the public may be caused to believe that the user of the contested mark for goods or services in Classes 9 and 42 is connected to the user of the earlier mark. In my view, the services of the opponent are specialised services that are very different from the Class 9 telecommunications and digital devices and Class 42 website creation, maintenance and hosting services. I cannot see that the public would believe that there is a connection between the parties where the contested mark is used for these goods and services.

Conclusions on link

91. Where there is a likelihood of confusion, there will automatically be a link. This is the case for the Class 41 services.

92. The level of similarity between the marks required for the public to make a link between the marks for the purposes of section 5(3) may be less than the level of similarity required to create a likelihood of confusion: see *Intra-Press SAS v OHIM*,

Joined cases C-581/13 P and C-582/13 P, paragraph 72. In addition, there is no requirement that the goods and services be similar or identical. However, in my view, the distance between the holder's Class 9 goods and Class 42 services on the one hand and the opponent's *Piano competition services* and *Organising piano competitions* on the other is so great that the public will not make a link between the marks, despite their medium to high degree of similarity and the high reputation and distinctiveness that I am assuming that the earlier mark enjoys. Even if a link were made, it would, to my mind, be so fleeting as not to cause damage. The opposition under section 5(3) would fail at this point for these services, even had I found a reputation.

Damage

93. I will briefly make some comments on damage. The likelihood of confusion I have found for the Class 41 services means that the holder would gain an unfair advantage from the reputation of the opponent. However, I have already made a finding of a likelihood of confusion under section 5(2)(b), so this ground puts the opponent in no better a position, even had I found that the earlier mark had a reputation.

OUTCOME

94. The opposition is partially successful. Protection for the contested IR is refused for the following services:

Class 41

Concert booking; booking of seats for shows.

95. Subject to a successful appeal, the IR No. WO0000001744812 is designated for protection in the UK for the following goods and services:

Class 9

Telecommunication devices and apparatus; personal digital assistants [PDAs].

Class 42

Hosting on-line web facilities for others for sharing on-line content; creating and maintaining web sites for others.

COSTS

96. Both parties have enjoyed some success in these proceedings with the greater part going to the holder, who is entitled to a contribution towards its costs. I have taken into account the relative share of success of both parties and the fact that the holder did not file any evidence or written submissions. Consequently, I award the holder the sum of £150 as a contribution towards the preparation of its statement of defence and consideration of the opponent's statement of grounds.

97. I therefore order Narodowy Instytut Fryderyka Chopina to pay N-EM Laboratories Inc. the sum of £150. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of April 2026

**Clare Boucher
For the Registrar,
Comptroller-General**