O/0330/25

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003716544
IN THE NAME OF OÜ MINDSPA
IN RESPECT OF THE TRADE MARK:

MINDSPA.COM

IN CLASSES 6, 9, 16, 19, 36, 38, 41, 42, 43, 44 AND 45

AND

THE APPLICATION FOR INVALIDATION THEREOF UNDER NO. 506128

BY MIND SOLUTIONS LTD

Background and pleadings

1. OÜ Mindspa ("the proprietor") applied to register trade mark no. 3716544 for the mark MINDSPA.COM in the UK on 01 November 2021. The application claims a priority date of 17 October 2021 from an Estonian trade mark (no. M202101280). The application was accepted and published in the Trade Marks Journal on 21 January 2022, and was registered on 01 April 2022 in respect of goods and services in classes 6, 9, 16, 19, 36, 38, 41, 42, 43, 44 and 45, as set out later in this decision.

2. On 22 May 2023, Mind Solutions Ltd ("the cancellation applicant") applied to invalidate the trade mark registration relying on Section 47(2)(b) and on the basis of Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") as well as relying on Section 47(2)(a) and on the basis of Sections 3(1)(b) and 3(6) of the Act.

3. The application for invalidation based on Section 5(2)(b) is directed against only some of the goods and services, namely those in classes 9, 16, 38, 41, 42, 44 and 45 (in their entirety), and some of those in classes 6, 19, 36 and 43, as set out later in this decision. The application for invalidation based on Section 5(3) is directed against all goods and services, as set out later in this decision. Under both grounds, the cancellation applicant relies on one single earlier mark, being the UK comparable mark no. UK00918172537 for the mark shown below with a filing date of 30 December 2019 and registration date of 22 May 2020:

4. The cancellation applicant relies on all of its good and services under both grounds, those being goods and services in classes 9 and 41, as set out later in this decision.

5. By virtue of its earlier filing date, the cancellation applicant's registration constitutes an earlier mark in accordance with Section 6 of the Act. Since the registration of the cancellation applicant's earlier mark was completed less than 5 years before the application for invalidity, it is not subject to proof of use.

6. In respect of the application for invalidation based on Section 5(2)(b), the cancellation applicant argues that the respective goods and services are identical or similar and that the marks are highly similar, and that as such there is a likelihood of confusion including a likelihood of association between the marks.

7. In respect of the application for invalidation based on Section 5(3), the cancellation applicant claims that the marks are highly similar and that it holds a reputation for its mark in the UK. The cancellation applicant argues there will be a link between the marks, leading (without due cause) to an unfair advantage and to detriment to the distinctive character of its earlier mark.

8. In respect of the application for invalidation based on Section 3(6), the cancellation applicant argues that the proprietor's mark was applied-for in bad faith because it was filed in an attempt to circumvent other opposition proceedings between the parties at the EUIPO and justify various trade mark infringements that started in 2020. The cancellation applicant also states that when the contested mark was filed "*as matter of fact, the registrant of "MINDSPA.COM" was already facing several pre-dating disputes at EUIPO and beyond"* and that the EUIPO has already ruled in the cancellation applicant's favour in two opposition proceedings (opposition n. 003134951 and appeal n. R0374/2022-1 in the case *MINDSPA vs MINDSPA*, and opposition n. 003134952 and appeal n. R0375/2022-1 in the case *MINDSPA vs SYNCTUITION MINDSPA*). The cancellation applicant also states that the proprietor purchased the domain name www.mindspa.com after the registration of its earlier mark and after the launch of the cancellation applicant's "Mindspa" app, and alleges that the proprietor used this website to redirect visitors to their own mobile application (at the time named "Synctuition", now rebranded completely as "Mindspa"). Finally, the cancellation applicant alleges that on 15 May 2023, in an attempt to further justify trade mark infringements, the proprietor purchased a dormant Swedish trade mark "Mindspa" and states that the trade mark in question was acquired from an uninvolved third party, in order to improve the proprietor's position in a trade mark dispute abroad and mislead the public about their products and services. For these reasons, the cancellation applicant states, and for their repeated attempts to deceive the public, the Swedish trade mark is now also facing invalidation.

9. Lastly, the application for invalidation based on Section 3(1)(b) is no longer relevant because it has been withdrawn (see below).

10. The cancellation applicant filed a defence and counterstatement denying the claims.

12. Both parties filed evidence in chief with the cancellation applicant also filing evidence and written submissions in reply. A hearing took place before me on 2 December 2024 by video conference. The proprietor was represented by Becky Knott of counsel instructed by its legal representatives, Boult Wade Tennant LLP. The cancellation applicant has acted without legal representation throughout the proceedings, but Maurizio Savino who has conducted the case for the cancellation applicant, appeared on its behalf.

EU Law

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

The evidence

14. The cancellation applicant's evidence consists of two witness statements of Maurizio Savino, one dated 2 December 2023 and another dated 4 March 2024. Mr Savino is the Director of the cancellation applicant, a position which he has held since 2019. Mr Savino's first witness statement is accompanied by 24 exhibits, being those labelled MS1-MS24, whereas his second witness statement is accompanied by a further eight exhibits, being those labelled MS25-MS32. Mr Savino's evidence was filed in support of the cancellation applicant's claim that it enjoys a reputation in the earlier mark but also in support of the allegations of bad faith. Along with Mr Savino's

first witness statement, the cancellation applicant also filed written submissions dated 02 December 2023.

15. The proprietor's evidence consists of a witness statement of Platon Tinn dated 6 February 2024. Mr Tinn is the sole member of the management board of the proprietor's company, a position which he has held since 2008. His evidence was filed in response to the cancellation applicant's allegations of bad faith.

16. I do not intend to summarise the parties' evidence and submissions in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

WITHDRAWN GROUNDS

17. During the course of his oral submissions, Mr Savino stated that he wished to withdraw the non-distinctiveness ground of invalidation based on Section 3(1)(b). As this ground is no longer pursued, I shall say no more about it.

DECISION

Section 47

18. Sections 5(2)(b), 5(3) and 3(6) have application in invalidation proceedings because of the provisions of Section 47 of the Act. So far as is relevant, Section 47 is as follows:

> "47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).
>
> …
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)…

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

…

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

…

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) […]

(4) […]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

…

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 5(2)(b)

19. Section 5(2)(b) states:

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

(a) …

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

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

20. Section 5A states:

> "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."[1]

21. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

> (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;

[1] This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act.

(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. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union ("CJEU") stated that:

> "23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary."

23. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

(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.

24. The General Court ("GC") confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods (though it equally applies to services) are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

25. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 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."

26. The cancellation applicant's earlier mark is registered for the following goods and services:

> **Class 9:** *Information technology and audio-visual, multimedia and photographic devices.*
>
> **Class 41:** *Teaching.*

27. As it will be recalled, the invalidity action under Section 5(2)(b) is partial, being directed against some of the goods and services in the proprietor's registration.

28. Before I turn to the goods and services, I should make it clear that in an annex accompanying Ms Knott's skeleton argument, she listed the contested goods and services which the proprietor accepts are identical, as well as those which the proprietor accepts are similar, or lowly similar, and those which the proprietor claims are dissimilar. Since Ms Knott drew a distinction between goods and services which the proprietor accepts are "similar", and goods and services which the proprietor accepts are "lowly similar", I will proceed on the basis that the goods and services

which Ms Knott qualifies as being "similar" are accepted by the proprietor to be similar to an average (or medium) degree.

29. Another issue I need to resolve is the question of what, effectively, the cancellation applicant's earlier registration covers. I say this because, as Ms Knott correctly pointed out at the hearing, the cancellation applicant seems to have interpreted the earlier terms *Information technology and audio-visual, multimedia and photographic devices* (in class 9) and *teaching* (in class 41) too broadly, insofar as it claims that the former gives it protection for the field of information technology at large, and the latter covers (or is similar to) anything which has a conceivable educational purpose in that it could be used by a teacher, including for example, entertainment services insofar as they might have a teaching purpose, and meditation booths insofar as it is claimed they might also have a "teaching" purpose in the case of guided meditation. Ms Knott contended that the applicant's approach is wrong because it distorts the meaning of the registered terms, and that the correct approach is to consider the ordinary and literal meaning of these terms.

30. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

> "365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

31. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

32. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

> "[…] the applicable principles of interpretation are as follows:
>
> (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
>
> (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.
>
> (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.
>
> (4) A term which cannot be interpreted is to be disregarded."

33. Although Mr Savino did not file skeleton argument ahead of the hearing, in his oral submissions he stated that (a) *"information technology*" includes science and activity of using computer and software to store and send information and encompasses computer systems, software, programming languages and data and information processing and storage; (b) audiovisual, multimedia and photographic devices covers goods such as cameras and phones and (c) *"teaching*" in class 41 is a broad term for imparting knowledge to someone else.

34. This position mirrors the following points made by the cancellation applicant in the written submissions of 2 December 2023:

> *"17. "Information Technology", according to Wikipedia, is a set of related fields that encompass computer systems, software, programming languages and data and information processing and storage. The Cambridge Business English Dictionary defines Information Technology (abbreviated IT) as follows: "The science and activity of using computers and software to store and send information." Example: He was considering a career in information technology.*
>
> *18. "Audio-visual, multimedia and photographic devices" is consisting of all devices that allow for the storing, processing and reproduction of audio-visual, multimedia and photographic data and resources.*
>
> *19. "Teaching" is the process of imparting knowledge, skills, or information. It involves the transfer of expertise with the aim of promoting learning, understanding, and personal development. According to the Cambridge English Dictionary, teaching defined as: "To give someone knowledge or to train someone; to instruct."*
>
> *20. As such, teaching encompasses a wide range of activities and methods, including instruction, explanation, demonstration, and facilitation, all with the goal of helping individuals acquire new knowledge or skills.*
>
> ….

22. With regards to the goods in class 6: Transportable soundproof booths, meeting rooms, and telephone booths of metal; Transportable soundproof booths for resting and meditation; soundproof transportable metal booths enhanced with video and audio equipment.

23.These goods share a common component which sets them out from other products in the same class, which is the presence of video and audio equipment, which are covered in class 9 of the previous application. Telephone booths, meditation booths with video and audio equipment, are all primary IT equipment. And that is the only factor that distinguishes them from other goods in class 6 (for instance, from metal materials for construction, portable buildings of metal, and containers of metal for storage or 4 transport). Without the technological components, the boots would simply be empty shells, not distinguishable from other booths present in the market.

24.Therefore, these goods are identical and are complementary, in competition, and share the same nature and purpose of the goods in class 9 of earlier mark.
…
25. With regards to the goods in class 9: Recorded content; Information technology and audio-visual, multimedia and photographic devices; Audio recordings; Audio visual recordings; Optic discs carrying audio recordings; Audio tapes; Computer software; Mobile apps; Musical sound recordings; Musical video recordings; Tape recordings of music; Downloadable musical sound recordings; Downloadable video recordings featuring music; Series of musical sound recordings; Downloadable sound recordings; Sound records; Electronic publications, downloadable; Audiovisual teaching apparatus; Data storage media; Audio books; Downloadable electronic books; games software; computer games stored on data carriers; downloadable computer games.

26. All these goods are covered by the earlier trademark protection in class 9. Computer software, recorded content, computer games, games software, mobile apps, optic discs, audio tapes, sound recordings, data storage medias, are all components of the Information Technology category. …"

35. Ms Knott argued that it is trite law that an analysis of goods and services requires considering their ordinary and literal meaning and that *"information technology" per se* is not encompassed by the ordinary and literal meaning of the earlier registered term *Information technology and audio-visual, multimedia and photographic devices* in class 9 which covers specific forms of hardware and devices. She also submitted that a number of assertions from the cancellation applicant as to the comparison of the goods and services in particular in relation to classes 6, 19, 36, and 43 (see below) stem from this misunderstanding and that, as a result, the cancellation applicant's reasoning does not hold up to scrutiny. The same, Ms Knott says, goes for the earlier *teaching* services in class 41 which the cancellation applicant interprets as covering (or being similar to) anything which has a conceivable educational purpose in that it could conceivably be used by a teacher.

36. During the course of the hearing, it became further apparent that Mr Savino had interpreted the registered term *"information technology*" in class 9 as a standalone term, as he stated:

> *"…the Proprietor says that the Applicant has misinterpreted the scope of its own specification. This has been repeated frequently and it says that Information technology and audio-visual multimedia and photographic, they are all devices. The Proprietor says that the classification must be taken literally. If grammar and syntax is correct there are two "and" in the sentence, which is Information technology and audio-visual multimedia and photographic devices, so Information technology must be considered as its own classification. As broad as it is, it includes software, it includes mobile application, so that is my point on that. The same for Teaching. Our product includes psychological education and that as well part of teaching, so I do not see how we might have misinterpreted our classification unless you bend the rules of English grammar and syntax."*

37. The UKIPO classification tool contains the following two accepted terms in class 9 which incorporate the term "information technology" namely:

> "*Information technology and audiovisual equipment"*

“Information technology and audio-visual, multimedia and photographic devices”

38. Whilst Mr Savino is correct in saying that there are two “and” between the words “*information technology”* and “*audio-visual”* and between the words “*multimedia”* and “*photographic devices”*, being the term “*information technology*” registered in class 9, it ought to cover information technology-related goods and cannot cover information technology at large, as a standalone term, because *“information technology*” is not a term which describes a type of goods. Further, the Explanatory Note to class 9 of the Nice Classification explains that *“Class 9 includes mainly apparatus and instruments for scientific or research purposes, **audiovisual and information technology equipment**, as well as safety and life-saving equipment.”* It follows that the words *“information technology”, “audio-visual”, “multimedia”* and *“photographic”* within the whole term *“Information technology and audio-visual, multimedia and photographic devices”* must relate to the function or purpose of the goods (which, in this case, are described as “**devices**”) being the primary criteria according to which goods are classified.[2] In other words, since “information technology” is not a word apt to describe a category or type of goods (as opposed to, for example, the words equipment, apparatus or devices), it must be read as the part of the term *information technology and audio-visual, multimedia and photographic devices* a whole, and as concerned with the word “devices”. Lastly, as there is an “and” which separates “*information technology”* from “*audio-visual, multimedia and photographic devices*”, I consider that the registered term *“Information technology and audio-visual, multimedia and photographic devices”* includes different types of devices, so that the specification should be read as including (i) information technology devices (as a category of devices which relate to computers and information technology, the latter being defined as the branch of technology concerned with the dissemination, processing, and storage of information, esp. by means of computers), (ii) audio-visual, multimedia and photographic devices (as a category of devices which are either audio-visual, or multimedia or photographic or absorb all of those three functions together) and (iii) devices which relate to information technology whilst also being audio-visual, and/or multimedia and/or photographic.

[2] https://euipo.europa.eu/ec2/static/html/nice-general-remarks-en.html

39. Admittedly, many goods which fall within the category of information technology devices are also audio-visual, multimedia and/or photographic, for example, microphones, speakers, cameras, headphones and projectors are items of computer hardware but are also multimedia devices that help in creating, recording, and presenting audio-visual content. Likewise, goods such as computers, laptops, electronic tablets, smartphones are information technology devices which are used to store, process, transmit, and manage data, whilst they are also photographic (because they often have a camera built into them) and multimedia (because they use or combine various forms of digital content such as text, audio, video, and animation).

40. This leads me to the next point. A device is defined as "*an object that has been invented for a particular purpose, for example for recording or measuring something"* and "*a piece of computer hardware that is designed for a specific function"* (Collins online dictionary). Being the earlier goods tangible "devices" or pieces of computer hardware, they cannot be identical to the software goods covered by the proprietor's registration which are intangible sets of instructions according to which a computer or other electronic device operates. At the hearing, I questioned Mr Savino as to which are the goods for which reputation is claimed; his answer was that the cancellation applicant claims reputation in relation to an app and that the app in relation to which the earlier mark has been used falls within the meaning of the registered term "information technology". I will return to this point later, but for now it suffices to say that the cancellation applicant's understanding of the scope of protection given by the registered term *"information technology and audio-visual, multimedia and photographic devices"* goes beyond what it covers, as it cannot cover software.

41. I now turn to the goods and services. The goods and services that are objected to under Section 5(2)(b) are set out below and highlighted in grey, with the terms in strikethrough showing the goods and services which are not pertinent to this ground, albeit they are relevant in the grounds of attack based on Sections 5(3) and 3(6).

Class 6 (this class is opposed only partially)

~~*Metal materials for construction; Portable buildings of metal; Metal hardware; Containers of metal for storage or transport;*~~ *Transportable soundproof booths, meeting rooms, and telephone booths of metal; Transportable soundproof booths for*

resting and meditation; soundproof transportable metal booths enhanced with video and audio equipment.

42. As Ms Knott accepted at the hearing, the question of similarity and dissimilarity are not constrained by the class number, as per Section 60A of the Act.

43. The proprietor's position as regard the contested goods in class 6 is that they are all dissimilar. The cancellation applicant gave the following reasons as to why I should find that the contested goods in class 6 are similar to the earlier goods in class 9:

> *"23. These goods share a common component which sets them out from other products in the same class, which is the presence of video and audio equipment, which are covered in class 9 of the previous application. Telephone booths, meditation booths with video and audio equipment, are all primary IT equipment. And that is the only factor that distinguishes them from other goods in class 6 (for instance, from metal materials for construction, portable buildings of metal, and containers of metal for storage or transport). Without the technological components, the boots would simply be empty shells, not distinguishable from other booths present in the market.*
>
> *24.Therefore, these goods are identical and are complementary, in competition, and share the same nature and purpose of the goods in class 9 of earlier mark."*

44. Whilst *Transportable meeting rooms, and telephone booths of metal* and *soundproof transportable metal booths enhanced with video and audio equipment* might incorporate some of the earlier goods in class 9, for example IT and audio-visual equipment, booths and meeting rooms are not the same as information technology and audio-visual, multimedia and photographic devices which includes, as I have said, goods such as microphones, speakers, cameras, headphones, projectors, computers, laptops, electronic tablets, smartphones etc. The goods have a different nature, purpose, use and method of use. Although some of the contested goods might be equipped with IT and audio-visual equipment for the purpose of carrying out meetings and telephone calls, their primary purpose is to provide a space which is different from the purpose of the earlier goods which is to display, store, record or play photos, music

and videos or to store, process, transmit, and manage data. The goods are unlikely to be distributed through the same trade channels (and there is no evidence to the contrary) and are not interchangeable. Finally, as regard complementarity, in *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

> "61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

45. Accordingly, in this case whilst the earlier IT and audio-visual devices might be incorporated in some of the contested goods, namely *transportable meeting rooms, telephone booths of metal* and *soundproof transportable metal booths enhanced with video and audio equipmen*t, the connection between the goods is not such that customers may think that the responsibility for those goods lies with the same undertaking and there is no meaningful complementary between them. Lastly, for the avoidance of doubt, I do not find any point of similarity with the cancellation applicant's teaching services in class 41. These goods are **dissimilar.**

Class 9 (this class is opposed in its entirety)

Recorded content; Information technology and audio-visual, multimedia and photographic devices; Audio recordings; Audio visual recordings; Optic discs carrying audio recordings; Audio tapes; Computer software; Mobile apps; Musical sound recordings; Musical video recordings; Tape recordings of music; Downloadable musical sound recordings; Downloadable video recordings featuring music; Series of musical sound recordings; Downloadable sound recordings; Sound records; Electronic publications, downloadable; Audiovisual teaching apparatus; Data storage media; Audio books; Downloadable electronic books; games software; computer games stored on data carriers; downloadable computer games.

46. The cancellation applicant argued that all these goods are covered by the earlier specification in class 9 because they are all *"components of the Information Technology category*" and that "*audio books, downloadable electronic books,*

audiovisual teaching apparatus" overlap with the earlier teaching services in class 41, as they can be used for teaching.

47. The proprietor accepts that the following goods in the contested specification are identical to the earlier goods in class 9:

> *Information technology and audio-visual, multimedia and photographic devices.*

48. The proprietor also accepts that the following goods in the contested specification are similar to a medium degree to the earlier goods in class 9:

> *Optic discs carrying audio recordings; Audio tapes; Sound records; Audiovisual teaching apparatus; Data storage media.*

49. While I accept the proprietor's concession of similarity in respect of some of the goods, I am of the view that it is not necessarily applicable to the term *audiovisual teaching apparatus*. The word "*apparatus*" is defined as "*the equipment, such as tools and machines, which is used to do a particular job or activity".* The word *"device*" means *"an object that has been invented for a particular purpose, for example for recording or measuring something"*. The words mean pretty much the same thing and Collins English dictionary confirm my impression that the words are interchangeable by listing "*device"* as a synonym for *"apparatus".*[3] Consequently I consider that *Audiovisual teaching apparatus* falls within the earlier term *Information technology and audio-visual, multimedia and photographic devices* and the goods are **identical** (*Meric)*.

50. This leaves *Recorded content; Audio recordings; Audio visual recordings; Computer software; Mobile apps; Musical sound recordings; Musical video recordings; Tape recordings of music; Downloadable musical sound recordings; Downloadable video recordings featuring music; Series of musical sound recordings; Downloadable sound recordings; Electronic publications, downloadable; Audio books; Downloadable electronic books; games software; computer games stored on data carriers;*

[3] https://www.collinsdictionary.com/dictionary/english-thesaurus/apparatus#apparatus__1

downloadable computer games. Ms Knott submits that these goods *"are dissimilar or at best weakly similar to the [earlier] Class 9 goods. Whilst a degree of complementarity might exist between the goods, this is not sufficient to render them similar in the face of their different natures and uses, and the fact that they are not in competition. Further, again, there is no evidence that different retailers would sell both sets of goods."*

51. I am not sure why *optic discs carrying audio recordings; audio tapes; sound records* would be similar to the earlier *Information technology and audio-visual, multimedia and photographic devices*, whereas other goods such as *Recorded content; Audio recordings; Audio visual recordings; Musical sound recordings; Musical video recordings; Tape recordings of music; Series of musical sound recordings; Audio books* would not. These goods are identical to those which the proprietor accepts are similar as they can all consists of audio and visual recorded content carried on optic discs or tapes. I find that these goods are the same as the other goods which the proprietor accepts are similar to a medium degree to *Information technology and audio-visual, multimedia and photographic devices,* the latter including computers, laptops, electronic tablets, smartphones, computer hardware and equipment for playing optic discs or tapes carrying audio and visual recordings. The same applies to *computer games stored on data carriers* which include computer games that can be played using computers.

52. For the avoidance of doubt, I should say that even in the absence of a concession of similarity by the proprietor, I would have found that the competing goods are similar because, although they have a different nature, purpose, and method of use, and are not in a competitive relationship, neither being substitutable for the other, there is a significant degree of complementarity between them, owing to the fact that the contested goods cannot be used without the electronic hardware, such as that covered by the earlier *information technology and audio-visual, multimedia and photographic devices* and the connection between the goods is sufficiently close for consumers to expect that they are the responsibility of the same undertakings. The goods are also aimed at the same users and are sold through the same distribution channels; for example, computer shops might offer computers and electronic devices and hardware that make it possible to read audio and visual contents, but also digital content,

including content recorded on optic discs, audio tapes, CD-ROMs or other digital data carriers. Similar considerations apply to the contested *Computer software; Mobile apps; Downloadable musical sound recordings; Downloadable video recordings featuring music; Downloadable sound recordings; Electronic publications, downloadable; Downloadable electronic books; games software; downloadable computer games.* The contested *software* and *mobile apps* are unlimited, and cover goods used to enable the earlier *information technology and audio-visual, multimedia and photographic devices* to operate, whereas the latter are used to download the contested downloadable music, sound, videos, books, publications and games from the Internet and play them on computers, laptops and smartphones. Whilst the goods have a different nature, purpose and method of use, and are not interchangeable, they overlap because they are all IT goods that cannot operate without each other and the average consumer may believe that both goods derive from the same undertaking, so the goods are complementary, target the same users and share distribution channels.

53. Overall, the contested goods in class 9 are either **identical or similar to a medium degree** to the earlier goods in class 9.

Class 16 (this class is opposed in its entirety)

Paper and cardboard; printed matter; bookbinding material; photographs; stationery and office requisites, except furniture; adhesives for stationery or household purposes; drawing materials and materials for artists; paintbrushes; instructional and teaching materials; plastic sheets, films and bags for wrapping and packaging; printers' type, printing blocks; Decoration and art materials and media; Stationery and educational supplies; Printed sheet music; Baby books; Baby memory books; Birthday books; Birthday cards; Children's storybooks; Books for children; Children's activity books; Children's books incorporating an audio component; Comics; Books.

54. The proprietor accepts that the following goods in the contested specification are lowly similar to the earlier teaching services in class 41:

instructional and teaching materials
educational supplies

55. The cancellation applicant argues that all the contested goods in class 16 are similar to its earlier teaching services in class 41 because "*paper and cardboards, printed matter, stationery, drawing materials, paintbrushes, instructional materials, educational supplies, are all goods widely used in the field of teaching"* and *"even baby books, birthday books, children's storybooks are used in the practice of teaching young pupils new words and stimulate their curiosity.*" The cancellation applicant further states that these goods are complementary, share the same purpose, users and distribution channels and are often producer by the same undertakings.

56. The proprietor criticises the cancellation applicant's argument stating that it is not a sufficient basis for establishing similarity and points out that printed matter and stationery are used in many different industries without resulting in the goods and services being similar. The proprietor further contends that the goods and services have different uses and nature, do not share trade channels and are not in competition or complementary, pointing out that there is no evidence to substantiate the cancellation applicant's claim that the goods and services are offered by the same undertakings.

57. The contested *printed matter; instructional and teaching materials; educational supplies; Printed sheet music; Baby books; Children's storybooks; Books for children; Children's activity books; Children's books incorporating an audio component; Books; Comics,* can all be used when providing teaching services and although the proprietor is right in saying that there is no evidence that those providing teaching services also provide teaching material, it is not uncommon in my view for undertakings providing teaching services to supply learning material to their students in the form of, for example, printed publications. In any event, even in the absence of evidence about the coincidence of providers and trade channels, I am satisfied that the goods and services share the same relevant public and are highly complementary and that 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. Further, although the goods and services are different in nature, they have the same purpose, i.e. teaching, and are in competition as a student can, for example, choose between accessing the cancellation applicant's teaching services through a tuition centre, or purchasing the

proprietor's books and learning material. These goods are similar to a **medium degree.**

58. However, I find that the contested *Paper and cardboard; bookbinding material; photographs; stationery and office requisites, except furniture; adhesives for stationery or household purposes; drawing materials and materials for artists; paintbrushes; plastic sheets, films and bags for wrapping and packaging; printers' type, printing blocks; Decoration and art materials and media; Stationery; Baby memory books; Birthday books; Birthday cards;* are not similar to the cancellation applicant's teaching services in class 41 because they do not have a teaching purpose and are not complementary to teaching services. In particular, *baby memory books* are journal-style keepsakes where parents can document and preserve their child's memories, milestones, and growth throughout their first year(s), whereas *Birthday books* are books in a diary form for recording people's birthdays. These goods are not used for teaching and therefore, they are not complementary to the opponent's *teaching* services in Class 41. The goods and services also differ in their nature and purpose, and in their distribution channels, providers/manufacturers and method of use. They are neither in competition nor complementary. Lastly, for the avoidance of doubt, I do not find any point of similarity with the cancellation applicant's goods in class 9. These goods are **dissimilar.**

Class 19 (this class is opposed only partially)

~~*Materials, not of metal, for construction; Non-metallic transportable buildings;*~~ *Prefabricated houses, booths, meeting rooms, and telephone booths, not of metal; Telephone booths, not of metal; Transportable non-metallic telephone booths, meeting rooms, booths, for indoor use; Transportable soundproof meeting rooms, booths, telephone booths, not of metal; Modular transportable meeting rooms, booths, telephone booths, not of metal; Transportable soundproof booths for resting and meditation, not of metal; soundproof transportable booths (not of metal) enhanced with video and audio equipment;* ~~*Partitions, not of metal.*~~

59. The reasons provided by the cancellation applicant as regard the similarity of these goods are the same as those provided in relation to the contested goods in class 6. For the same reasons, I reject the submissions. **These goods are dissimilar.**

Class 36 (this class is opposed only partially)

~~Financial, monetary and banking services; insurance services; real estate affairs; Rental and hire of rooms, including short-term; Hire and rental of rooms in public spaces, including short-term; Rental of commercial premises~~; Rental and hire of prefabricated houses, booths, meeting rooms, and telephone booths, including short-term; Rental and hire of modular transportable meeting rooms, booths, telephone booths, including short-term; Rental and hire of transportable soundproof booths for rest and meditation, including short-term; Rental and hire of soundproof transportable booths enhanced with video and audio equipment, including short-term.

60. The reasons provided by the cancellation applicant as regard the similarity of these goods are the same as those provided in relation to the contested goods in class 6. For the same reasons, I reject the submissions. **These goods are dissimilar.**

Class 38 (this class is opposed in its entirety)

Telecommunication services; Transmission of sound or visual recordings over networks; Communications services; Interactive telecommunications services; Streaming of audio material on the internet; Streaming of audio, visual and audiovisual material via a global computer network; providing access to databases; transmission of digital files; streaming of data; computer aided transmission of messages and images; Video-on-demand transmission; Provision of access to content, websites and portals; Providing access to a video sharing portal; Providing access to platforms and portals on the Internet; teleconferencing services; videoconferencing services.

61. The cancellation applicant argues that these services *"are all strictly related and complementary to Information Technology, covered by the earlier trademark in class 9"* and that "*in order to provide these services, it is necessary to make use of the goods covered by the earlier mark and vice versa".* The cancellation applicant further states that *"goods protected by the earlier mark (such as modems, telephones, smartphones, computers, network routers and/or servers) are used in close connection with telecommunication services because they are, or can be, absolutely necessary for performing these services and, from the viewpoint of the consumer, they are indispensable for accessing them*", that the goods are *"regularly marketed together"*

and that they share the same producers. Finally, the cancellation applicant states that *"computers are generally networked, and their autonomous use is actually the exception to the rule; the rule being that communications equipment, computers and software, insofar as they enable access to those services or provide the ability to perform them, renders them."*

62. Ms Knott argues that no evidence for the cancellation applicant's assertions has been provided, and that the contested services are dissimilar to the opponent's goods in Class 9. She states that whilst there may be an overlap in users at a very general level, this is not sufficient to establish similarity and submits that the trade channels are different, as are the natures and uses of the goods and services resulting in the average consumer not perceiving the same undertaking as being responsible for both the goods and the services.

63. I agree with Ms Knott. There is no evidence that the goods and services are distributed through the same trade channels or are offered by the same undertakings. Whilst, from my experience, a telecommunication company such as BT might also install modems, which would fall within the earlier information technology devices, that is only one company providing one example of goods falling within the category of information technology devices, which is very broad and includes a large number of goods that would not be provided by telecommunication companies. The contested communication, transmission and streaming services and teleconferencing and videoconferencing services are technical communication services provided by specialised service providers. The cancellation applicant's Class 9 devices can be used for accessing the proprietor's class 38 services, but those devices do not have the same purpose. Also, the distribution channels for those goods and services are normally different – the cancellation applicant's devices are purchased from computer shops, whereas the proprietor's services are purchased from providers of telecommunication services. Therefore, the nature, purpose, use, method of use and producers/providers of those goods and services are different. Furthermore, these goods and services are not in competition with each other and whilst they might be used together, there is not a sufficiently close connection between them, and customers are unlikely to think that the responsibility for those services lies with the same undertaking who is responsible for the cancellation applicant's goods in class 9.

64. Lastly, for the avoidance of doubt, I do not find any point of similarity with the cancellation applicant’s teaching services in class 41. **These goods are dissimilar.**

Class 41 (this class is opposed in its entirety)

Education; providing of training; entertainment; sporting and cultural activities; Production of sound recordings; Rental of sound recordings; Editing of audio recordings; Production of audio-visual recordings; Rental of audio-visual recordings; Production of audio master recordings; Production of video and/or sound recordings; Entertainment services for sharing audio and video recordings; Entertainment services for matching users with audio and video recordings; Rental of audio tapes bearing recorded music; Production of musical recordings; Production of sound and music recordings; Rental of phonographic and music recordings; Rental of sound and video recordings; Rental of sound and image recordings; Production of educational sound and video recordings; Production of sound and image recordings on sound and image carriers; Rental of motion pictures and of sound recordings; Production of entertainment in the form of sound recordings; Providing digital sound recordings, not downloadable, from the internet; Publication of printed matter; Publication of printed matter and printed publications; Publication of printed matter relating to education; Publication of printed matter in electronic form; Publication of printed matter in electronic form on the Internet; Teaching; Education services relating to health; Education information; Educational research; Educational seminars; Education, entertainment and sport services; Education, entertainment and sports; Education services relating to meditation; Teaching of meditation practices; Educational services relating to spiritual development; Musical education services; Music publishing services; Music publishing and music recording services; Providing online electronic publications in the field of music, not downloadable; Publishing of musical works; Arranging and conducting of music concerts; Pregnancy gymnastics instruction; Organisation of entertainment for birthday parties; Children's entertainment services; Children's adventure playground services; Educational services provided for children; Audio recording and production services; Sound recording and video entertainment services; Arranging, conducting and organisation of concerts; Self-awareness courses [instruction]; Conducting workshops and seminars in self-awareness; Arranging and conducting of workshops and seminars in self-awareness; Health education; Nutrition

education; Dietary education services; Instruction courses relating to health; Instruction in nutrition [not medical]; Publication of books; Providing on-line electronic publications, except downloadable; Providing on-line electronic health, nutrition and dietary publications, except downloadable; Providing on-line videos, not downloadable; Providing on-line educational materials, not downloadable; tutoring; arranging and conducting tutorials; arranging and conducting seminars; Education services relating to meditation; Education services relating to meditation; Teaching of meditation practices; Educational services relating to spiritual development.

65. The proprietor accepts that the following services in the contested specification are **identical** to the earlier teaching services in class 41:

> *Education; providing of training; Teaching; Education services relating to health; Education information; Educational research; Educational seminars; Education; Education; Education services relating to meditation; Teaching of meditation practices; Educational services relating to spiritual development; Musical education services; Pregnancy gymnastics instruction; Educational services provided for children; Self-awareness courses [instruction]; Conducting workshops and seminars in self-awareness; Arranging and conducting of workshops and seminars in self-awareness; Health education; Nutrition education; Dietary education services; Instruction courses relating to health; Instruction in nutrition [not medical]; tutoring; arranging and conducting tutorials; arranging and conducting seminars; Education services relating to meditation; Education services relating to meditation; Teaching of meditation practices; Educational services relating to spiritual development*.

66. The proprietor also accepts that the following services in the contested specification are lowly similar to the earlier *teaching* services in class 41 due to possible complementarity:

> *Publication of printed matter relating to education; Providing on-line educational materials, not downloadable.*

67. This leaves: *Entertainment; sporting and cultural activities; Production of sound recordings; Rental of sound recordings; Editing of audio recordings; Production of audio-visual recordings; Rental of audio-visual recordings; Production of audio master recordings; Production of video and/or sound recordings; Entertainment services for sharing audio and video recordings; Entertainment services for matching users with audio and video recordings; Rental of audio tapes bearing recorded music; Production of musical recordings; Production of sound and music recordings; Rental of phonographic and music recordings; Rental of sound and video recordings; Rental of sound and image recordings; Production of educational sound and video recordings; Production of sound and image recordings on sound and image carriers; Rental of motion pictures and of sound recordings; Production of entertainment in the form of sound recordings; Providing digital sound recordings, not downloadable, from the internet; Publication of printed matter; Publication of printed matter and printed publications; Publication of printed matter in electronic form; Publication of printed matter in electronic form on the Internet; entertainment and sport services; entertainment and sports; Music publishing services; Music publishing and music recording services; Providing online electronic publications in the field of music, not downloadable; Publishing of musical works; Arranging and conducting of music concerts; Organisation of entertainment for birthday parties; Children's entertainment services; Children's adventure playground services; Audio recording and production services; Sound recording and video entertainment services; Arranging, conducting and organisation of concerts; Publication of books; Providing on-line electronic publications, except downloadable; Providing on-line electronic health, nutrition and dietary publications, except downloadable; Providing on-line videos, not downloadable.*

68. In my view, an acceptance that *Publication of printed matter relating to education; Providing on-line educational materials, not downloadable* in class 41 are similar to the cancellation applicant’s *teaching* services in the same class ought to mean that *Publication of printed matter; Publication of printed matter and printed publications; Publication of printed matter in electronic form; Publication of printed matter in electronic form on the Internet; Publication of books; Providing on-line electronic publications, except downloadable* are also similar, because they are sufficiently broad

to include publication of printed matter, books and publications which is educational in nature and can be used in the provision of any teaching services.

69. For the sake of clarity, I should say that even in the absence of a concession, I would have found that that these services are similar to a medium degree to the cancellation applicant's teaching services because although the nature, purpose and method of use of the respective services differs, they target the same users and there is a complementary relationship between them due to the fact that undertakings that provide teaching services are also likely to publish educational material and the respective services are important to one another in such a way that customers may think that the responsibility for those services lies with the same undertaking. This also means that there is coincidence in trade channels. Overall, I find that there is a **medium degree** of similarity between the respective services.

70. The same goes for the contested terms *Providing online electronic publications in the field of music, not downloadable; Providing on-line electronic health, nutrition and dietary publications, except downloadable* because they are sufficiently broad to include music education resources designed to engage and inspire students in various aspects of music learning, and educational publications in the field of health, nutrition and diet, for example, to in order teach children in school about healthy eating and food literacy.

71. Likewise, the following services can all relate to the provision and rental of video and sound recording for educational purposes, sound recording not being limited to music entertainment but also including recordings for teaching purposes, for example for learning languages. Accordingly I find that *Rental of sound recordings; Rental of audio-visual recordings; Rental of sound and video recordings; Rental of sound and image recordings; Rental of motion pictures and of sound recordings; Providing digital sound recordings, not downloadable, from the internet; Providing on-line videos, not downloadable* cover the provision and rental of sound and video recordings for educational purposes and are also similar to a medium degree to the cancellation applicant's teaching services.

72. However, the contested *Production of audio-visual recordings; Production of sound recordings; Production of audio master recordings; Production of video and/or sound recordings; Production of sound and image recordings on sound and image carriers; Audio recording and production services; Editing of audio recordings; Production of musical recordings; Production of sound and music recordings; Production of entertainment in the form of sound recordings; […] music recording services* are production and recording services which consist of the process of creating, capturing, manipulating, editing and preserving audio, music and visual recording so that it can be distributed and enjoyed. Professional audio, music and/or video production assists artists, marketing and entertainment companies with their recording projects and have nothing in common with the earlier information technology and audio-visual photographic devices or teaching services. These services are **dissimilar.** The same applies to *production of educational sound and video recordings*, which are one step removed from the cancellation applicant's teaching services.

73. Lastly, the contested specification covers a range of entertainment services as well as services relating to the rental and publishing of music, namely *Entertainment; sporting and cultural activities; Entertainment services for sharing audio and video recordings; Entertainment services for matching users with audio and video recordings; Rental of audio tapes bearing recorded music; Rental of phonographic and music recordings; entertainment and sport services; entertainment and sports; Music publishing services; Music publishing; Publishing of musical works; Arranging and conducting of music concerts; Organisation of entertainment for birthday parties; Children's entertainment services; Children's adventure playground services; Sound recording and video entertainment services; Arranging, conducting and organisation of concerts*. Whilst I appreciate that entertainment can be educational and vice versa, I do not agree that this renders the respective services identical or similar. The core purposes of entertainment and educational services are different, as are their uses, nature and methods of use. The purpose of entertainment and rental and publishing of music is not to educate, but to entertain. Although both are available to the general public at large, the proprietor's services are used by those seeking enjoyment, whereas the cancellation applicant's teaching services target those seeking opportunities for learning. The trade channels through which the services are

distributed are also different because teaching services are provided through tuition centres, schools, colleges or universities whereas entertainment services are provided through theatres, cinemas, sport/leisure centres, etc and the provision of recorded music are accessed through music shops or the Internet. Lastly, the services are likely to be supplied by different undertakings and are neither complementary nor in competition with each other. These services are **dissimilar.**

Class 42 (this class is opposed in its entirety)

Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; design and development of computer hardware and software; Software development; Creation and development of computer software and hardware; Software creation; Computer programming; Software as a service [SaaS]; Platform as a service [PaaS]; Providing temporary use of non-downloadable computer software; provision of non-downloadable software; Provision of online computer software; Providing temporary use of downloadable online software enabling access to mental health and meditation content; providing temporary use of non-downloadable online software enabling access to soundproof portable rest and meditation booths enhanced with video and audio equipment; providing temporary use of online software for renting, leasing and checking reservation services.

74. The proprietor accepts that the following services in the contested specification in class 42 are similar to a very low degree to the earlier goods in class 9 stating that consumers would not expect the proprietor's specialist services to be sold through the same trade channels as the cancellation applicant's goods:

> *design and development of computer hardware*
> *creation and development of computer hardware*

75. The cancellation applicant states that the proprietor's services in class 42 are similar to its goods and services because:

> *"These services are all related to information technology, and present various similarities also with teaching services protected by the earlier rights.*

Technological services, development of computer hardware and software, the use of software as a service, the provision of online software, all these represent the core of Information Technology, therefore they are identical to the goods protected by the earlier mark in class 9. The provision of software to access mental health and meditation content is also related to teaching, protected by the earlier mark in class 41. Therefore, these services coincide in nature, purpose, producer, distribution channel and relevant public with the earlier trademark"

76. The proprietor denies that the services are similar replying as follows:

"The [proprietor]'s services are highly specialised and would likely be provided by a dedicated entity, with relevant qualifications or training. The consumer would not expect the [cancellation] applicant's goods and services to originate from a single origin with the [proprietor]'s Class 42 services. The [cancellation] applicant's goods and services differ from the [proprietor]'s Class 42 services in use, nature, and trade channels, and are neither in competition nor complementary. They are not similar and certainly not identical.

The [cancellation] applicant also alleges that the [proprietor]'s "Providing temporary use of downloadable online software enabling access to mental health and meditation content" is "related to teaching". This assertion is not understood. The [proprietor]'s Class 42 services protect software as a service. This is wholly unrelated to the [cancellation] applicant's Class 41 services and as such the services are dissimilar."

77. Starting with the comparison between the contested services in class 42 and the earlier goods in class 9, it is self-evident that goods in class 9 cannot be identical to services in class 42. Whilst the goods and services might relate to the same field of information technology, I agree with the proprietor that it is highly unlikely that a consumer, seeking to receive the contested services which relate to *industrial analysis, industrial research and industrial design services, quality control and authentication services, design and development of computer software, computer programming, software as a service [saas], platform as a service [paas], providing*

temporary use of downloadable online software enabling access to mental health and meditation content; providing temporary use of non-downloadable online software enabling access to soundproof portable rest and meditation booths enhanced with video and audio equipment; providing temporary use of online software for renting, leasing and checking reservation services would expect the services to be provided by the manufacturer or distributor of information technology and audio-visual, multimedia and photographic devices. The nature, purpose, use and method of use of the competing goods and services are different. Further, the services are highly specialised and the fact that they belong to the same field of information technology does not necessarily result in a coincidence of trade channels or producers; in this case, as I have said, I think it is unlikely that the goods and services share trade channels and/or producers. Furthermore, these goods and services are not in competition or complementary.

78. However, I find that insofar as the services which are accepted to be similar, i.e. *design and development of computer hardware; creation and development of computer hardware* are encompassed by the term *Scientific and technological services and research and design relating thereto,* the latter are also similar to the contested services. Further, I find that there is a low degree of similarity between the earlier goods in class 9 and the contested *providing temporary use of non-downloadable computer software; provision of non-downloadable software; provision of online computer software* insofar as the services include the provision of software enabling the earlier *information technology and audio-visual, multimedia and photographic devices* to operate.

79. Finally, the claim that there is a degree of similarity with the teaching services protected by the earlier rights is no more than an empty claim as it fails to identify any specific overlap between the goods and services. In particular, I fail to see how the provision of software to access mental health and meditation content is also related to teaching. The nature, purpose, use and method of use of these services are different and they cannot be considered complementary as they are not indispensable for the use of each other. Further, the services do not share the same distribution channels and do not coincide in producers/providers and relevant public.

80. In summary, with the exception of *design and development of computer hardware; creation and development of computer hardware; Scientific and technological services and research and design relating thereto; providing temporary use of non-downloadable computer software; provision of non-downloadable software; provision of online computer software,* I consider all the remaining services to be **dissimilar.**

Class 43 (this class is opposed only partially)

Daycare services; ~~Hotels; Hotel resorts~~; Temporary rental, hire of meeting rooms and provision of temporary meeting rooms; rental, hire and provision of temporary use of soundproof portable rest and meditation booths; rental, hire and temporary use of soundproof portable booths enhanced with video and audio equipment; temporary rental of office premises; booking of premises; ~~room rental services; rental of premises (temporary accommodation); rental of premises for social events; Rental, hire of transportable buildings;~~ temporary provision of meeting and office space ~~and temporary provision of premises for events.~~

81. The reasons provided by cancellation applicant as regard the similarity of *Temporary rental, hire of meeting rooms and provision of temporary meeting rooms; rental, hire and provision of temporary use of soundproof portable rest and meditation booths; rental, hire and temporary use of soundproof portable booths enhanced with video and audio equipment; temporary rental of office premises; booking of premises; temporary provision of meeting and office space,* are the same as those provided in relation to the contested goods in class 6. For the same reasons, I reject the submissions. **These services are dissimilar.**

82. As regard *Daycare services* the cancellation applicant states: "*Daycare services have also a teaching purpose, when they are provided to children; meditation booths serve also a teaching purpose, as in the case of guided meditation, therefore there are clear similarities also with the services protected by the earlier mark in class 41"* and the proprietor accepts that they are similar to a **very low degree**. I will proceed on that basis.

Class 44 (this class is opposed in its entirety)

Medical services; Meditation services; Mental health services; Health spa services for physical and mental health and wellness; Personality testing (mental health services); Personality assessment (mental health services); Spa services (audiomeditation); Meditation services; Advice in the field of childbirth; Consultation relating to bio-rhythms; Consulting services relating to health care; Genetic counselling; Health advice and information services; Health assessment surveys; Health risk assessment surveys; Home health care services; Music therapy for physical, psychological and cognitive purposes; Therapy services; Music therapy services; Health care relating to relaxation therapy; Telemedicine services; providing a web site that features instruction materials about health.

83. The cancellation applicant states:

> *"These services are all related to teaching, education, and information technology protected by the earlier mark. Medical, health, and mental health services serve the same purpose as teaching, which is the passing of information from a knowledgeable individual to a less educated one in the concerned field. The same can be said for advice in the field of childbirth, health consultations, health assessments and therapy services. Meditation services also are strictly related to teaching, as it is often the case with guided meditation classes. These services are all in competition and/or are complementary to the earlier mark. But not only that, they can also be offered via information technology and audio-visual, multimedia and photographic devices, goods that are protected by the earlier mark. Music therapy services cannot be provided without audio devices, telemedicine services cannot be provided without IT equipment, and meditation services are most often provided online via mobile apps.*
>
> *Therefore, these services coincide in nature, purpose, producer, distribution channels and relevant target with those of the earlier mark. Furthermore, they can be complementary."*

84. The proprietor rightly describes the contested services in class 44 as having the purpose of healing the consumer or improve the consumer's health or well-being, as

opposed to the different educational purpose of the cancellation applicant's services in class 41. I also agree with the proprietor that whilst the cancellation applicant's services might result in the user acquiring some further knowledge, it does not override the different natures, purpose, method of use, use and trade channels of the services or render them in competition or complementary (which they are not). In this connection, as the proprietor entirely correctly points out, the applicant's argument stretches the literal meaning of the earlier teaching services beyond their core and natural meaning, which is not the correct approach. Hence, I find these services to be **dissimilar** to the earlier teaching services.

85. I also agree with the proprietor that the fact that some of the contested services, e.g. counselling, therapy, health advice and information services, health assessment surveys; telemedicine services; providing a web site that features instruction materials about health, can be offered through the cancellation applicant's goods in class 9 does not render them similar. The goods and services differ in their nature, purpose, use and method of use. They are neither in competition nor complementary. Further, the contested services are likely be provided by individuals with the relevant medical or health professional qualifications, which means that there is no coincidence of trade channels and providers. Finally, consumers would not expect a manufacturer of IT devices to provide medical, health, therapy and counselling services. These services are **dissimilar.**

Class 45 (this class is opposed in its entirety)

Licensing of printed matter; Licensing services relating to music publishing; Astrological and spiritual services; Mentoring [spiritual]; Spiritual consultancy; Spiritual advice; Counselling relating to spiritual direction.

86. The cancellation applicant states:

> *"These services are all also clearly related to teaching and education, and with information technology, audio-visual and multimedia devices, which are covered by the earlier trademark. Printed matters are complementary with teaching, licensing services relating to music publishing require information technology equipment and audio-devices. Also astrological and spiritual*

services have the same purpose as teaching. Indeed, some religious figures are referred to as 'teachers' and multiple retreats are offered in the form of structured courses and discussions that endeavour to nurture spirituality, spiritual awareness, growth and direction through learning mindfulness techniques, religious teachings, doctrines, philosophies, and practices, 'New Age' esotericism, and other eclectic forms of mysticism. The method of use and the distribution channels can also be the same, since both services can be offered in places of worship (such as monasteries) either online or in-person and they may coincide in providers. They may also target the same relevant public."

87. The proprietor makes the same criticisms against the above claims (as those set out in the context of the contested services in class 44) in that they stem from a misconstruction of the earlier terms that go beyond their core meaning. I agree. I also agree with the proprietor that the contested licensing services are highly specialised and that the contested astrological and spiritual services are personal and social in their nature and that they differ in nature, purpose, use and method of use from the cancellation applicant's teaching services in class 41 and devices in class 9. The goods and services do not coincide in trade channels (and there is no evidence to the contrary) and are neither complementary nor in competition. Finally, given their different nature and the different sector of the market to which they belong, consumers are unlikely to believe that they are offered by the same undertaking. These services are **dissimilar.**

Conclusion on goods and service comparison

88. In *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49........... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to

be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

89. Under the present ground, some similarity of goods and services is therefore essential for a likelihood of confusion to be established. Since I have concluded that there is no meaningful similarity between some of the competing goods and services, the opposition based on Section 5(2)(b) fails in relation to the goods and services which I have found to be dissimilar, namely:

Classes 6, 19, 36, 38, 44 and 45: all of the opposed goods and services in those classes.

Class 16: *Paper and cardboard; bookbinding material; photographs; stationery and office requisites, except furniture; adhesives for stationery or household purposes; drawing materials and materials for artists; paintbrushes; plastic sheets, films and bags for wrapping and packaging; printers' type, printing blocks; Decoration and art materials and media; Stationery; Baby memory books; Birthday books; Birthday cards.*

Class 41: *Entertainment; sporting and cultural activities; Production of sound recordings; Editing of audio recordings; Production of audio-visual recordings; Production of audio master recordings; Production of video and/or sound recordings; Entertainment services for sharing audio and video recordings; Entertainment services for matching users with audio and video recordings; Rental of audio tapes bearing recorded music; Production of musical recordings; Production of sound and music recordings; Rental of phonographic and music recordings; Production of educational sound and video recordings; Production of sound and image recordings on sound and image carriers; Production of entertainment in the form of sound recordings; entertainment and sport services; entertainment and sports; Music publishing services; Music publishing and music recording services; Publishing of musical works; Arranging and conducting of music concerts; Organisation of entertainment for birthday parties; Children's entertainment services; Children's adventure playground services; Audio recording and production services; Sound recording*

and video entertainment services; Arranging, conducting and organisation of concerts.

Class 42: all of the opposed services in this class with the exception of *design and development of computer hardware; creation and development of computer hardware; Scientific and technological services and research and design relating thereto; providing temporary use of non-downloadable computer software; provision of non-downloadable software; provision of online computer software.*

Class 43: all of the opposed services in this class with the exception of *daycare services.*

90. From now, for the purpose of the Section 5(2)(b) only, I will refer solely to the goods and services which I have found to be similar namely:

Class 9: *Recorded content; Information technology and audio-visual, multimedia and photographic devices; Audio recordings; Audio visual recordings; Optic discs carrying audio recordings; Audio tapes; Computer software; Mobile apps; Musical sound recordings; Musical video recordings; Tape recordings of music; Downloadable musical sound recordings; Downloadable video recordings featuring music; Series of musical sound recordings; Downloadable sound recordings; Sound records; Electronic publications, downloadable; Audiovisual teaching apparatus; Data storage media; Audio books; Downloadable electronic books; games software; computer games stored on data carriers; downloadable computer games.*

Class 16: *printed matter; instructional and teaching materials; educational supplies; Printed sheet music; Baby books; Children's storybooks; Books for children; Children's activity books; Children's books incorporating an audio component; Comics; Books.*

Class 41: *Education; providing of training; Rental of sound recordings; Rental of audio-visual recordings; Rental of sound and video recordings; Rental of*

sound and image recordings; Rental of motion pictures and of sound recordings; Providing digital sound recordings, not downloadable, from the internet; Publication of printed matter; Publication of printed matter and printed publications; Publication of printed matter relating to education; Publication of printed matter in electronic form; Publication of printed matter in electronic form on the Internet; Teaching; Education services relating to health; Education information; Educational research; Educational seminars; Education, Education, Education services relating to meditation; Teaching of meditation practices; Educational services relating to spiritual development; Musical education services; Providing online electronic publications in the field of music, not downloadable; Pregnancy gymnastics instruction; Educational services provided for children; Self-awareness courses [instruction]; Conducting workshops and seminars in self-awareness; Arranging and conducting of workshops and seminars in self-awareness; Health education; Nutrition education; Dietary education services; Instruction courses relating to health; Instruction in nutrition [not medical]; Publication of books; Providing on-line electronic publications, except downloadable; Providing on-line electronic health, nutrition and dietary publications, except downloadable; Providing on-line videos, not downloadable; Providing on-line educational materials, not downloadable; tutoring; arranging and conducting tutorials; arranging and conducting seminars; Education services relating to meditation; Education services relating to meditation; Teaching of meditation practices; Educational services relating to spiritual development.

Class 42: *Scientific and technological services and research and design relating thereto; design and development of computer hardware; creation and development of computer hardware; providing temporary use of non-downloadable computer software; provision of non-downloadable software; provision of online computer software.*

Class 43: *daycare services.*

Average consumer

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

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

92. The goods and services found to be identical or similar to varying degrees are directed at the public at large (e.g. goods in class 9 and 16, educational services and provision of publications and recordings in class 41, daycare services in class 43 and design of computer hardware and provision of computer and software services in class 42); whilst they might also be purchased by business users, they do not specifically target businesses.

93. The proprietor states that the majority of the goods and services in question will be selected with a high level of care and attention though it does not explain why. Nevertheless, the proprietor accepts that its class 16 goods will be purchased with a lower degree of care and attention. In my view, whilst the price of the goods and services might vary, their nature is not such that it will attract a high degree of attention. Further, the goods and services do not target businesses or professionals who are more likely to display a high level of attention. I shall therefore focus on the general public, as the lower degree of attention paid means that they are more likely to be confused. With the exception of educational services, which might attract an above average degree of attention, I consider that the general public will by and large pay a medium degree of attention.

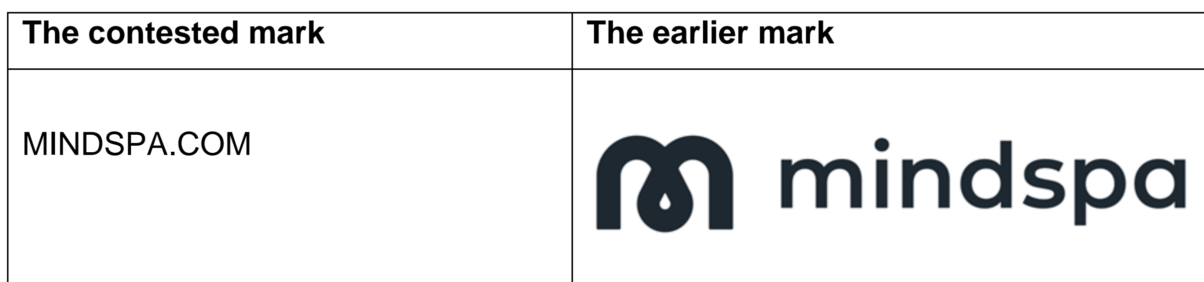
94. The purchasing process is likely to be largely visual as the average consumer will browse websites, see reviews in print and online media, and view promotional material. They may also receive word-of-mouth recommendations. This means that there will also be a role for the aural aspect of the marks.

Comparison of marks

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

96. 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. The respective marks are shown below:



The contested mark	**The earlier mark**
MINDSPA.COM	mindspa

97. The contested mark is a word-only mark consisting of the words ‘MINDSPA’ followed by the top-level domain ‘.COM’. Although ‘MINDSPA’ appears as a single verbal element, the words ‘MIND’ and ‘SPA’ are common words which are clearly recognisable within the mark. Further, it is well-established that although consumers normally perceive a mark as a whole and do not proceed to analyse its various details, when perceiving a verbal sign, they will break it down into elements which, for them, have a real meaning or which resemble words known to them.[4] In the light of this, I find that the relevant public, when perceiving the mark ‘MINDSPA.COM’, will break that mark down into its three elements, ‘MIND’, ‘SPA’ and ‘.COM’. As the element ‘.COM’ will be easily understood as a domain, the overall impression of the mark will be that of website named ‘MINDSPA’, whereby ‘MINDSPA’ will be perceived as a unitary whole being also the most distinctive element of the mark, and the element ‘.COM’ will play a lesser role.

98. The earlier mark consists of a figurative element made up of an overlapping mono line creating two curved interweaving shapes followed by the word ‘MINDSPA’ presented in lower-case letters. The figurative element is likely to be seen as a device of a stylised letter ‘M’. The element ‘MINDSPA’ will be understood as a unitary whole created by the conjoining of the words ‘MIND’ and ‘SPA’ which are clearly identifiable. Whilst the device is not negligible, it is secondary in the overall impression created by the mark. This is because the element ‘MINDSPA’ is averagely distinctive (see below) and the device will be seen as an initial logo incorporating the first letter of the brand ‘MINDSPA’ reinforcing the brand initial ‘M’ which, in turn, would help consumer to remember the brand name ‘MINDSPA’.

Visual similarity

99. The proprietor concedes that the competing marks possess, at best, a medium degree of similarity.

100. The marks coincide in the element ‘MINDSPA’ which is identically present in both marks - notional use of the contested word-only mark covering use in the same lower-

[4] See *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, T-256/04 T-256/04, paragraph 57

case letters and font which is used in the earlier mark. The coinciding element 'MINDSPA' is the dominant and most distinctive element of each mark, and whilst the non-coinciding elements '.COM' (in the contested mark) and 'M' device (in the earlier mark) are points of visual differences, they are less distinctive than the coinciding element 'MINDSPA'. Overall, I consider the marks to be visually similar to a degree between medium and high.

Aural similarity

101. Aurally, the marks coincide in the pronunciation of the element 'MINDSPA' which is identically present in both marks. Whilst the figurative element of the earlier mark will be perceived as a stylised letter 'M', it is unlikely to be pronounced because it would be associated with the initial letter 'M' of 'MINDSPA' and also because consumers tend not to pronounce first letter logos of brand names. The only difference between the marks is the final '.COM'; however, bearing in mind the weakly distinctiveness of this element and the fact that consumer tend to focus on the beginning of marks, I consider the marks to be aurally similar to a high degree.

Conceptual similarity

102. Conceptually, the proprietor accepts that the *"concept of a spa for the mind*" will be perceived in both marks but argues that the conceptual meaning of the contested sign will be differentiated due to the concept of 'online' imported by the element ".COM". Whilst I agree with the proprietor that '.COM' is a differentiating factor between the marks at issue, it will convey a weakly distinctive concept, namely that of a website named 'MINDSPA'. Consequently, insofar as the unitary element 'MINDSPA' is the part that conveys trade mark significance in both marks, the marks are conceptually similar to a very high degree. To that extent as the device will be perceived as a letter 'M' stylised, no concept can be associated with it.

Distinctive character of earlier mark

103. 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 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

104. Registered trade marks possess various 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 by virtue of the use made of it.

105. The proprietor states that both marks are allusive. At the hearing, Ms Knott repeated the claim that the earlier mark is allusive though she did not expand on why it is allusive of *Information technology and audio-visual, multimedia and photographic devices* or *teaching* services within its specification.

106. Whilst the word "mind" in the earlier mark might be remotely allusive of learning in the context of teaching services, because it denotes "*the part of a person that makes*

it possible for him or her to think, feel emotions, and understand things" (Cambridge online dictionary) and also learn, it is not presented (or perceived) on its own but it is conjoined with the word 'SPA' which means *"a place where people go in order to become more healthy, by doing exercises, eating special food, etc.",* with the two words combined to create a unit. Further, as it will be recalled, 'MINDSPA' in the earlier mark conveys the concept of "a spa for the mind" which will be considered to be a place where people go in order to have a healthier and more relaxed mind.

107. Although the concept of a "a spa for the mind" might be allusive of the goods and services in relation to which the cancellation applicant has made actual use the earlier mark, which are concerned with mental health care provided though an mobile application software, such use would be use in relation to mental health services or a mobile app software for mental health, which are not covered by the registered devices in class 9 or teaching services in class 41.

108. In particular, the actual use which is in evidence shows that the cancellation applicant's 'MINDSPA' app falls within several app categories all related to mental health, namely mental wellbeing, self-harm prevention, mood tracker, health diary, mental health support, information and self-help. Whilst use of the app might result in the user gaining advice, information and support about mental health, the average consumer would not describe the app as an information technology device or a teaching app or the services provided through the app as teaching services. Consequently, I find that the earlier mark is nether allusive nor descriptive of the goods and services within the earlier specification and it is distinctive to a medium degree.

Likelihood of confusion

109. 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 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 earlier 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

110. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark,* BL O/375/10, where Iain Purvis Q.C. (as he then was) as the Appointed Person explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: *"The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark"*.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> > (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
> >
> > (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand

or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

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

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

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

112. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17. This is mere association not indirect confusion.

113. Earlier in this decision I found that:

- Some of the contested goods and services are similar to various degree ranging from identical to being similar to a very low degree.

- The goods and services will be selected visually with a degree of attention that is either medium or above medium, although aural considerations cannot be discounted entirely.

- The marks are visually similar to a degree between medium and high, aurally similar to a high degree and conceptually similar to a very high degree.

- The earlier mark is inherently distinctive to a medium degree.

- Although the cancellation applicant has filed evidence of use, the use made is in relation to a software app for mental health which is outside the scope of the goods and services protected by the earlier mark; as such, any use the cancellation might have made of the earlier mark cannot have enhanced its distinctiveness in the context of the registered goods and services.

Evidence of confusion

114. In his evidence, Mr Savino purports to provide evidence of confusion. This consists of a screenshot from Google Play Store showing two 'MINDSPA' apps in the category of health and fitness which, I understand, are provided by the parties. Mr Savino states that this evidence show "*the coexistence of two mobile apps with the same identical name in the app stores; the screenshots taken from Google Play highlight how indistinguishable they look from the consumers standpoint*."[5] In addition, Mr Savino provided a copy of an email[6] from a customer stating as follows:

> *"I received a bill for 102.35 for the MindSpa app I only opened it for the free trial. Not sure if you can verify that on your end. Is there any way to get a refund because I thought I cancelled it a while back. …."*

115. Mr Savino further submitted that this evidence shows that "*users are downloading the later [i.e. the proprietor]'s app instead of the intended earlier app [i.e. the cancellation applicant's app] , and after finding suspicious overcharges, they complain to the [cancellation applicant] believing that both come from the same undertaking".*

116. Ms Knott argued that this evidence is irrelevant because the customer who made the complaint is based in the US and is, as such, wholly irrelevant to the question of a likelihood of confusion in the UK.

[5] MS23
[6] MS24

117. Albeit for different reasons, I agree with Ms Knott that the evidence of confusion filed by the cancellation applicant is irrelevant. This is because, as it will be recalled, the goods and services for which the cancellation applicant has made use of the earlier mark, i.e. a software app for mental health, are not covered by the goods and services for which the earlier mark is protected and in relation to which I must assess the likelihood of confusion.

118. Since the goods and services for which the earlier mark is protected limit my assessment of the likelihood of confusion, the fact that there might be confusion in relation to other goods and services which do not fall within the coverage of the earlier mark is wholly immaterial and does not assist the cancellation applicant.

119. I now turn to the likelihood of confusion.

120. Ms Knott's submission on the likelihood of confusion was that the competing goods and services are mostly dissimilar, or similar to a very low degree, and that where a degree of similarity exists, it is not sufficient to counteract the differences between the marks and the allusive nature of the earlier mark, resulting in no likelihood of confusion on a global assessment. As it will be recalled, I have rejected some of the propositions on which Ms Knott's argument rests, in particular, I found that some of the goods and services are identical, and others are similar to various degree from medium to very low; I have also found a medium to high, or even higher degree of similarity between the marks, and I have rejected the claim that the earlier mark is allusive of the goods and services within the specification.

121. Having carefully considered all of the above factors, I find that there is a likelihood of direct confusion between the marks through imperfect recollection. This is particularly the case given that the dominant and distinctive element of the marks 'MINDSPA' is identically reproduced in both marks, and that the differentiating elements are weakly distinctive and are likely to be overlooked or misremembered by the average consumer. I consider that this applies also when the goods and services are similar to a very low degree as I consider that the similarity between the marks will offset the similarity of the goods and services.

122. Alternatively, I find that there is a likelihood of indirect confusion, and that the proprietor's mark is likely to be perceived as a sub-brand or brand extension of the earlier mark. In reaching this view, I have borne in mind, in particular, the conceptual identity created by the coinciding element 'MINDSPA' which dominates the image of both marks, and which members of the relevant public will keep in their minds. Further, the addition of '.COM' in the later mark is exactly the kind of variation which one would expect to find in a sub-brand or brand extension, insofar as 'MINDSPA.COM' will be interpreted to be the online version of the earlier mark 'MINDSPA', and the figurative element of the earlier mark will be seen as a logo incorporating the initial 'M' of the brand 'MINDSPA', which consumers would not expect to be reproduced in the online version of the brand.

123. There is a likely of both direct and indirect confusion in relation to all of the goods and services which I have found to be identical or similar.

Section 5(3)

124. 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."

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

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

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

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

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

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

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

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

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

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

Reputation

126. To be actionable under this ground, the reputation of the earlier mark must be in goods and/or services covered by the registration. In *Tulliallan Burlington Ltd v EUIPO,* Case T-123/16, the GC considered whether a UK trade mark – BURLINGTON ARCADE – which was registered as a UK trade mark in relation to, inter alia, *the bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from general merchandise retail stores',* was entitled to benefit from the reputation of BURLINGTON ARCADE as the name of a well-know shopping arcade in the UK. The court held (at paragraph 27 of its judgment) that:

"It is apparent also from the file that the applicant's earlier trade marks, which designate services in Classes 35 and 36, are known to a significant part of the public of the relevant market as being the name of a very well-known shopping arcade in the United Kingdom, located in central London, bringing together luxury boutiques within the arcade. Since that reputation of the applicant's earlier trade marks is not disputed by the parties, the question which arises, in the present case, is ultimately whether that reputation corresponds in fact to the services in Class 35 for which the earlier trade marks have been registered, so that the applicant is properly entitled to benefit from the protection of the reputation in question."

127. The court went on to find that the services of bringing goods together via third party outlets in a shopping arcade did fall within the scope of the registration. It is clear from the court's judgment that this was an essential requirement for the trade mark to qualify for protection under article 8(5) of the EU Trade Mark Regulation (which is equivalent to Section 5(3) of the Act).

128. I also note that in Case 252/07, *Intel,* one of the factors the CJEU said should be taken into account in order to decide whether the public will make a link between the earlier mark and the later mark is "*The nature of the goods or services for which the conflicting marks <u>are registered, or proposed to be registered</u>."* (emphasis added)

129. The reputation relied on for the purposes of Section 5(3) of the Act must therefore be in the goods and/or services covered by the trade mark relied on for the purposes of the proceedings.

130. This point was picked up by Ms Knott in her skeleton argument where she stated:

"The [cancellation] applicant has failed to provide any evidence of use of the Mark for the Applicant's Goods and Services, being "Information technology and audio-visual, multimedia and photographic devices" and "Teaching".

What the Applicant has provided evidence showing (albeit, said evidence is ultimately inadequate, as set out below) is use of a mobile app. It is this mobile

app which the Applicant claims is its main product […]. None of the evidence relied upon shows use for anything else, notwithstanding the Applicant's claims that it also offers goods and services such as "B2B…such as workshops, seminars, and tailored digital content for companies", "Web resources", and "Social media" and various other mental health services" […]. In any case, none of these goods and services would appear to be covered by the Applicant's Goods and Services either"

131. At the hearing Mr Savino confirmed that the cancellation applicant's case is that it has a reputation in relation to a mobile app and that the app in relation to which reputation is claimed falls within the registered terms information *technology and audio-visual, multimedia and photographic devices* (in class 9) and *teaching* (in class 41). I have already rejected this claim. Hence, since the claimed reputation does not relate to the goods and services covered by the earlier mark, even if it was established, it could not sustain the cancellation applicant's claim under Section 5(3).

132. The Section 5(3) ground fails at the first hurdle.

Section 3(6)

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

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

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

"(i) […]

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

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

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

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).
(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

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

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

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

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

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

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

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

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

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

135. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

"152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to

distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 […]."

136. As regard the correct approach to assessing bad faith, according to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

137. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards

on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

138. In the course of his oral submissions, Mr Savino attempted to add further reasons to the claim pleaded under Section 3(6) alleging the absence of any commercial logic for the proprietor to apply for some of the contested goods and services, such as, for example, metal material for constructions, insurance and hotel services. However, as I pointed out at the hearing, the cancellation applicant's pleaded case does not rely on the proprietor applying for a deliberately over-broad specification of goods and services, a point which Mr Savino accepted. Accordingly, I will say no more about this allegation.

139. I agree with Ms Knott that the cancellation applicant's case under Section 3(6) is somewhat difficult to tease out from the Form TM26I. Hence, before I turn to it, it is helpful to look at the evidence as it might shed some light on the pleadings.

140. The first relevant point of Mr Savino's witness statement is that "Mindspa" was a recognized mobile app for the relevant public, prior to the filing of the proprietor's trade mark 'MINDSPA.COM' on 01 November 2021 (or priority date of 17 October 2021).

141. The second relevant point is that the proprietor is a direct competitor of the cancellation applicant and a developer of another mobile app in the field of mental health and that, allegedly, when the contested application was filed, the proprietor was aware that the cancellation applicant was using the mark "MINDSPA" for identical or similar goods and services. This, Mr Savino contends, demonstrates that the contested application was filed in bad faith.

142. The third relevant point is that the website www.mindspa.com allegedly changed ownership on 27 July 2020 and that prior to this it was inactive and displayed only a generic "*coming soon*" message. Mr Savino states that after the change of ownership, the website began to redirect users to a mobile app in the field of mindfulness and mental wellbeing called 'Synctuition', which was owned by the proprietor and was an active app in direct competition with the cancellation applicant's 'MINDSPA' app.

143. The fourth relevant point is that on 10 September 2020, Mr Savino sent a request to ‘Synctuition’ to stop using the website www.mindspa.com to redirect users to their mobile app. Mr Savino says that his request was ignored by the proprietor who instead decided to file applications for identical trade marks at EUIPO, and that on 20 October 2020 his lawyer sent a cease-and-desist letter to the proprietor on behalf of the cancellation applicant.

144. The fifth relevant point is that since the start of the dispute between the parties, the proprietor has allegedly wilfully exacerbated the infringement of the cancellation applicant’s earlier mark through the making of *“countless claims such as “The one and only Mindspa” and “The world’s first Mindspa” […] in relation to the “Synctuition” in the months that followed*” with the final rebranding of the proprietor’s mobile app (from “Synctuition” to “Mindspa”) occurring in March 2023 after the proprietor had already lost opposition proceedings at EUIPO and was denied registration of the mark “Mindspa” for, among other classes, mobile applications and meditation services.

145. Lastly, Mr Savino states that bad faith is also evidenced by the proprietor’s deliberate attempts to take the cancellation applicant’s earlier mobile app off the market using the contested trade mark no. UK00003716544 for “MINDSPA.COM (and various other trade mark registrations which Mr Savino alleges the proprietor had filed or acquired speculatively since the start of the dispute) in support of a request to remove the cancellation applicant’s earlier “Mindspa” mobile app from the AppStore.

146. I concord with Ms Knott that the cancellation applicant’s case is, in a nutshell, that at the time when the contested registration was filed, the proprietor knew of the cancellation applicant’s use of the earlier mark and intended to “*gain an advantage or hinder”* the cancellation applicant. The allegation is, in other words, that the proprietor applied for the mark ‘MINDSPA.COM’ in order to prevent the cancellation applicant, who was a competitor, from using the same or a similar mark when it knew or must have known that the competitor had already acquired a valuable right. I also agree with Ms Knott that this would appear to fall within what has recently been termed ‘category (i)’ bad faith by Lord Kitchin in *SkyKick* at [158] as follows:

> “Category (i) cases

> 158. This category of case is generally concerned with conduct by an applicant which was intended to undermine the interests of one or more third parties, although the circumstances which may justify a finding that the application was made in bad faith may vary a great deal from case to case. The applicant may, for example, have appropriated the mark of another trader; or made the application in breach of an agreement or fiduciary duty; or even sought to secure by registration a right to prevent one or more third parties from using a mark in relation to particular goods or services despite those third parties having an earlier right to use the mark in that way. Nor do these circumstances necessarily involve any suggestion that the applicant has not used or does not intend to use the mark itself. Indeed, the impugned conduct may very well involve the use of the mark by the applicant."

147. The first allegation that the cancellation applicant must prove is that the proprietor was aware, or ought to have been aware, that the cancellation applicant was using the mark "MINDSPA" for identical or similar goods and services when it applied to register the contested mark on 01 November 2021 (or the priority date of 17 October 2021). However, the deliberate registration of a mark that conflicts with a third party's mark is not, in itself, sufficient for a finding of bad faith; something more is usually required to rebut the presumption of good faith, in particular evidence establishing that the trade mark applicant must have had some form of dishonest or sinister intention for filing the application. This is a subjective element which must generally be determined by reference to the objective circumstances of the case.[7] Further, in a case such as this, where the allegations of bad faith are ventilated against a competitor who has used and continue to use the mark, the following points are relevant, as for the comment of Lord Kitchin in *SkyKick* at [170] and [172]:

> "170. …the question of bad faith must be assessed having regard to all the circumstances and that these may include matters such as whether a third party competitor has for a long time used a sign for an identical or similar product and that sign enjoys some degree of legal protection; whether the applicant's sole

[7] Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH (C-529/07) at [42]

aim is to compete unfairly with such a competitor; and whether the applicant's aim is in pursuit of a legitimate objective such as to prevent a newcomer competitor from seeking to take advantage of the applicant's mark by copying its presentation"

….

172. The court then reviewed the position at para 53, concluding that in the context of the case, the relevant circumstances may include:

– the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar mark for an identical or similar product capable of being confused with the mark for which registration is sought;

– the applicant's intention to prevent that third party from continuing to use such a mark; and

– the degree of legal protection enjoyed by the third party's mark and by the mark for which registration is sought."

148. I now turn to the evidence.

149. Mr Savino's evidence is that the cancellation applicant's 'MINDSPA' app was released on 30 January 2020 on Google Play Store, and on 1 February 2020 on Apple Store, nearly 2 years before the relevant date when the proprietor's mark was filed on 1 November 2021 (or the priority date of 17 October 2021).[8]

150. Mr Savino says that the mobile app, which is available in multiple languages and operates in the field of mental health care, gained immediate popularity and has exceeded over 1 million downloads globally on Google Play alone. However, this figure is not UK specific and, as Ms Knott entirely correctly pointed out, it is taken from a Google Play app page displaying the details of the cancellation applicant's 'MINDSPA' app updated on 21 March 2023 which means that the 1 million number

[8] MS1-2

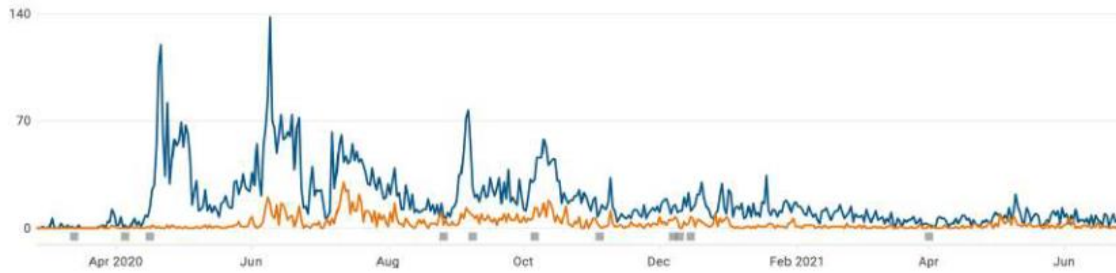
given includes downloads occurred after the relevant date.[9] In the period between 1 January 2020 and 31 October 2021, there were nearly 11,000 UK organic users of the cancellation applicant's website www.mindspa.me corresponding to 8% of the total global 135,000 users.[10] Mr Savino does not explain what organic users are but I understand that the term "organic traffic" is used to refer to the visitors that land on a website as a result of unpaid ("organic") search results. In any event, this figure is of limited assistance as it is not clear what the cancellation applicant's website looked like during that period, whether it was a fully functioning website and whether any goods or services were available to be purchased through it (and were actually purchased). Mr Savino also says that the paid reach of "MINDSPA" promotional campaigns for the UK and Ireland exceeded 50,000 impressions in Google Play for the same period of 1 January 2020 - 31 October 2021. Although Mr Savino does not explain what an "impression" is, Cambridge online dictionary contains the following definition of "impression": *"an occasion when someone visits or sees a particular page on the internet"* which suggests that the adverts for the cancellation applicant's 'MINDSPA' app were seen 50,000 times, though it is not clear what proportion relates to the UK and Northen Ireland (as opposed to Ireland). Although this evidence does not say how many UK users had downloaded the cancellation applicant's app by the relevant date, Mr Savino claims that exhibit MS5 shows that the cancellation applicant's app was a *"recognisable app in the UK since the beginning of 2020";* as Ms Knott entirely correctly pointed out, this is an unsupported assertion as the exhibit consists of one page without any narrative explanation which appears as follows:

[9] MS1
[10] MS3

Store listing visitors, acquisitions, and conversion rate by country

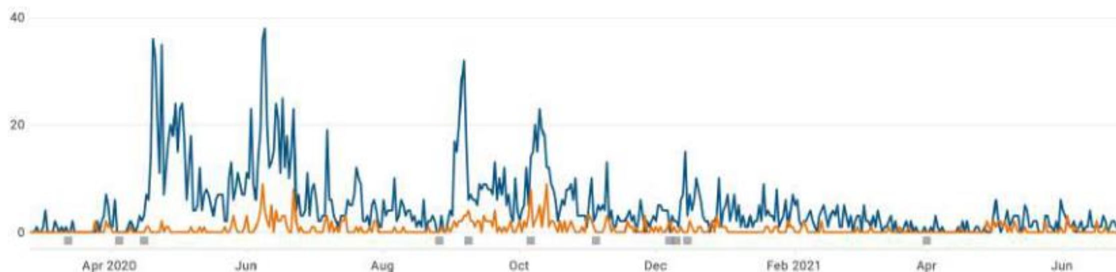
Feb 25, 2020 - Oct 31, 2021

Store listing visitors



Store listing visitors United Kingdom Ireland

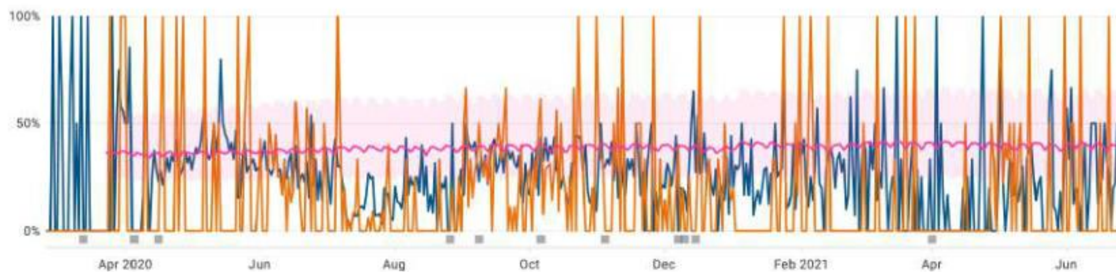
Store listing acquisitions



Store listing acquisitions United Kingdom Ireland

Store listing conversion rate

Peer group: Health & fitness Display: All countries / regions



Store listing conversion rate United Kingdom Ireland Peers' median (All countries / regions) Peers' range (All countries / regions)

Country / region	Store listing visitors	Store listing acquisitions	Store listing conversion rate	Conversion rate vs
Selected countries / regions				
United Kingdom vs. previous period	9,583 -	2,634 -	27.49% -	
Ireland vs. previous period	1,665 -	348 -	20.9% -	

151. First, as Ms Knott observed, it would be surprising if, at the time the app was launched, which was at the beginning of 2020, it immediately became recognisable. Second, without any supportive narrative evidence I am not clear what these graphs show in terms of knowledge within the relevant public in the UK and how they support the claim that the app was instantly recognisable.

152. Likewise, Mr Savino says that on 8 May 2021, the cancellation applicant's 'MINDSPA' app was awarded ORCHA certification of approval (which, he explains, is *"the leading independent digital health evaluation and distribution organisation in the UK, trusted by the NHS*") and that upon receiving the certification, the cancellation applicant's 'MINDSPA' app was included in the National Health System database of health apps and labelled as trusted and safe to use for all UK patients. If one reads carefully through this evidence, it is not possible to say what the National Health System database of health apps is, or when the cancellation applicant's app was included in the data base. It is also clear that whilst ORCHA certification might be trusted by the NHS, this evidence does not say that the NHS adopted or recommended the cancellation applicant's app to its patients.

153. Mr Savino also relies on a number of academic papers to support the claim that 'Mindspa' was a recognized mobile app for the relevant public.[11] The first paper is called *"A review of mobile chatbot apps for anxiety and depression and their self-care features"* from the University of Qatar. The objective of this paper is to assess the quality and characteristics of chatbots for anxiety and depressions available on Google Play store and Apple Store. The second paper is called "*Thematic Analysis Using A Machine Learning Approach on User Reviews for Depression and Anxiety Chatbot Applications"* also from the University of Qatar. The paper aims to explore users' opinions, satisfaction, and attitudes toward anxiety and depression chatbot apps by conducting an analysis of users' reviews of 11 anxiety and depression chatbot apps collected from the Google Play Store and Apple App Store. The third paper is called *"Health-focused conversational agents in person-centered care: a review of apps"*, and appears to be from USA based academics. This paper is also a review of healthbots aims to classify types of healthbots, contexts of use, and their natural language processing capabilities. All these papers refer to the cancellation applicant's 'MINDSPA' app insofar as it is one of the mental health apps subject to review. Aside from showing that the cancellation applicant's app was available on Google Play and Apple Store, these papers convey no information about the level of knowledge of the relevant public in the UK (or anywhere else). Although the third paper list the number

[11] MS7-9

of downloads of in the UK being 658,305 it appears to include 9 other apps and it is dated in 2022 which is after the relevant date.

154. Mr Savino also states that "Mindspa" received *"great visibility in the press, in part thanks to its efforts in fighting gambling addiction together with its parallel endeavour "Gambless".* In support of this claim, Mr Savino exhibits an article[12] titled "GAMBLESS LAUNCHES MENTAL HEALTH APP TO SUPPORT PROBLEM GAMBLERS", published on 1 September 2020 though it is not clear where it was published. The article is about a different application called "Gambless" and although it mentions Mr Savino, it does in his capacity as the CEO of the app Gambless. The article contains only a brief paragraph referring to the cancellation applicant's 'MINDSPA' app stating as follows: "*Mindspa, a mobile app launched by the same team in February 2020 already has more than 90,000 registered users",* however, this appears to relate to global rather than UK users. Another article[13] from 21 July 2021 states that "*Gambless has joined forces with mental health app Mindspa to expand psychiatric support resources for gaming industry employers"* following an 18-month evaluation in which Gambless recognised the mental fatigue of gambling employees working in a 'perpetual state of disruption and uncertainty'. However, it is not clear how the partnership between the two apps worked, whether it was successful, and how many UK users were exposed to the earlier mark 'MINDSPA' as a result of it.

155. In addition to the above, Mr Savino claims that "Mindspa" was mentioned in the press for its effort in providing free support during the pandemic and for its contribution along the app Gambless to the cause of fighting gambling addiction. The first article[14] exhibited in support of these claim is from the USA and is dated 7 April 2020. The second article is dated 29 January 2021; the only reference to 'MINDSPA' is in a brief paragraph which states *"Gambless has been created and developed by the same team of psychologist who designed Mindspa, another mobile app targeting a broader audience on mental health topics".*

[12] MS10
[13] MS11
[14] MS12

156. Although this evidence is not without deficiencies, it establishes that the cancellation applicant had used the sign 'MINDSPA' in relation to a software app for mental health since February 2020 and that the app was available in the UK from two major platforms namely Google Play and Apple Store (a fact which is not disputed by the proprietor).

157. At the filing date of the contested mark the cancellation applicant did not have a registration for the mark 'MINDSPA' covering the goods in relation to which the mark had been used, namely a downloadable software app for mental health. It follows that at the filing date of the contested mark, the cancellation applicant did not have a protection for the relevant goods deriving from a registered trade mark in the UK. As regard the possibility of the cancellation applicant enjoying some degree of legal protection deriving from mere use, the applicant has not pleaded passing off. Further, whilst the evidence is sufficient to establish use in the UK, without further information about turnover, marketing investment and number of users, I am unable to conclude that the cancellation applicant had sufficient goodwill to sustain an action for passing off in the UK, which also means that I am unable to conclude that the cancellation applicant's sign enjoyed some degree of legal protection deriving from the use it had made of it. Nevertheless, the cancellation applicant's 'MINDSPA' app was present on the UK market.

158. Turning to the point as to whether the proprietor knew or must have known that the cancellation applicant was using an identical or similar mark for an identical or similar product capable of being confused with the mark for which registration was sought, Mr Savino relies on the following:

- Records of the website mindspa.com[15] belonging to the proprietor. Whilst it shows an update date of 27 July 2020, I note that it has a creation date of 16 June 1998, which means that the name 'MINDSPA' was coined over 20 years before the cancellation applicant's application was launched in 2020.

[15] MS16

- Copy of a message sent on 10 September 2020 by Mr Savino to Synctuition Support Center through the *"contact us"* page which states:[16] *"Hello, I am the co-founder and CEO of 'MINDSPA' a mobile app dedicated to mental wellbeing. It was recently brought to my attention that the website www.mindspa.com has a redirect to Synctuition, an app that falls under our same category in both App Store and Google Play. I would like to inform you that "mindspa" is a registered trademark, with EUIPO filing number 018172537. I am sure this was a genuine mistake, therefore I kindly request that you:*

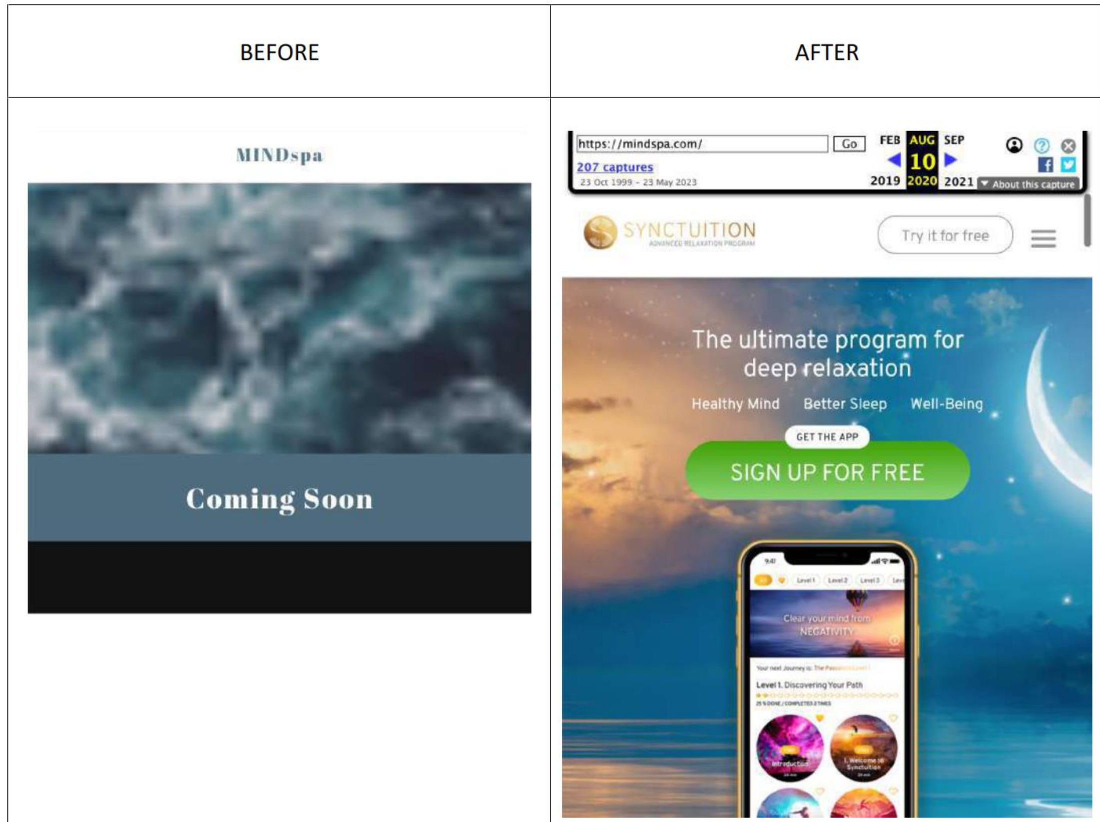
  Cease and Desist
  using the website www.mindspa.com within 10 calendar days from today - September 10th.

  In case of any delay to this request, should the website still be up after September 20th, we will reserve the rights proceed via our lawyers in order to defend our rights, and will demand monetary compensation for the business damage we are incurring."

  The message was acknowledged on 10 September 2020.

- A table showing the comparison between what the proprietor's MINDSPA.COM website looked like on 10 August 2020 and prior to that date. As it can be seen the claim is that prior to 10 August 2020 the website had a coming soon page and after that it was used to redirect users to another app called SYNCTUITION also for mental health:[17]

[16] MS16
[17] MS17



- Copy of a cease-and-desist letter dated 20 October 2020 sent by the cancellation applicant's legal representatives to the proprietor which refers to the cancellation applicant's earlier EUTM no 18172537 (from which the UK comparative mark UK00918172537 derives) and accuses the proprietor of having filed two trade mark applications for the marks 018306780 and 018306782 after they were contacted by Mr Savino. I have checked the EUIPO website which shows that both applications were filed on 14 September 2020, four days after Mr Savino contacted the cancellation applicant raising the issue about the name MINDSPA.

- Copy of an email sent by the proprietor to Apple dated 23 August 2023 (after the relevant date) confirming that on 8 February 2023 the proprietor reported the cancellation applicant's MINDSPA app as infringing on their trade mark right deriving from the contested application Sweden, UK and Russia and requesting removal of the cancellation applicant's MINDSPA app. It states:

"The Developer has presented no legally relevant arguments to justify a continues presence of its app in AppStore as our company owns registered trademark rights in reported jurisdictions that cover "software" and/or services educational, instruction, meditation and/or mental health related services that the Developer app infringes. EU trademark regime is not base don first-to-use, but first to register legal principle. The distinctive part MINDSPA covered by our MINDSPA.COM trademark registration and related also to our website www.mindspa.com is wholly incorporated into the Developer's app title and is used also in description, specification and app screenshots, which are clearly infringing our trademark rights. Therefore, we rely on the following registered trademark rights MINDSPA.COM and ask to restrict the Developer's app in respect of these countries (Sweden, UK and Russia), while other countries remain pending our future reports:

- Sweden, Reg No 550878
- UK, Reg No UK00003716544
- WIPO Reg No 1703427, legal protection granted in Russia, pending in Australia, Brazil, Canada, China, India, Singapore"

Mr Savino replied to the complaint relying on the fact that the cancellation applicant's mobile application was launched on 30 January 2020, had always maintained the name "Mindspa" and preceded any name changes of the proprietor's app and any trade mark that they claim to own. He also pointed out that the only exception was the Swedish trademark, which pre-dates the launch of the cancellation applicant's mobile app - but which the proprietor had acquired from an involved third party on 15 May 2023 - and against which the cancellation applicant had already filed a request for invalidation at the Swedish Patent Office.

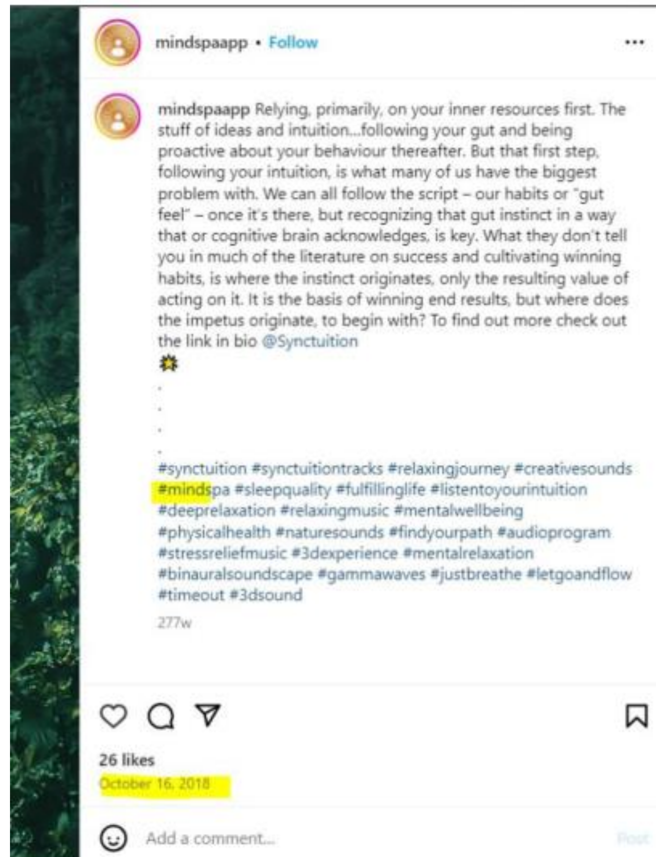
159. In response to Mr Savino's evidence, Mr Tinn filed the following evidence:

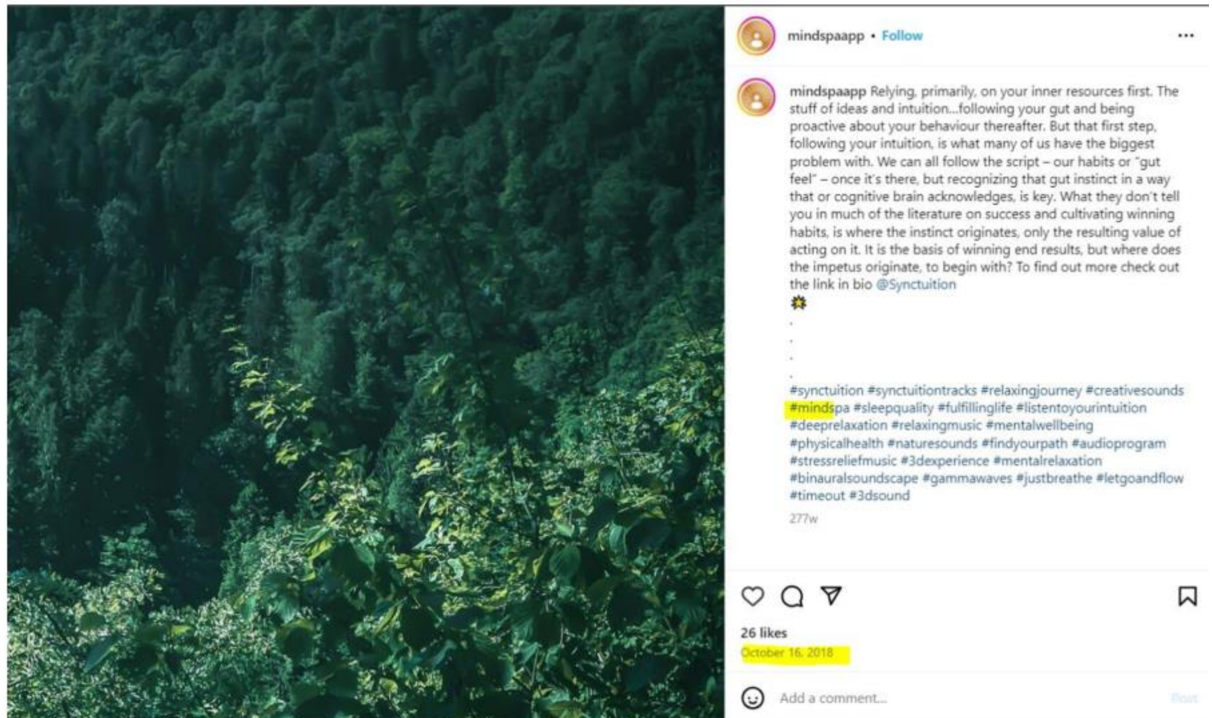
- The proprietor's mark was assigned to the proprietor on 27 March 2023. However, when the mark was initially filed the applicant had the same name as the current proprietor. This is not explained in Mr Tinn's witness statement, but

it is shown from the records kept on file which shows that the assignor changed its company name on 08 November 2022 from OÜ Mindspa to OÜ Kindlife Eesti and the assignee changed its company name on 09 November 2022 from OÜ Synctuition to OÜ Mindspa.

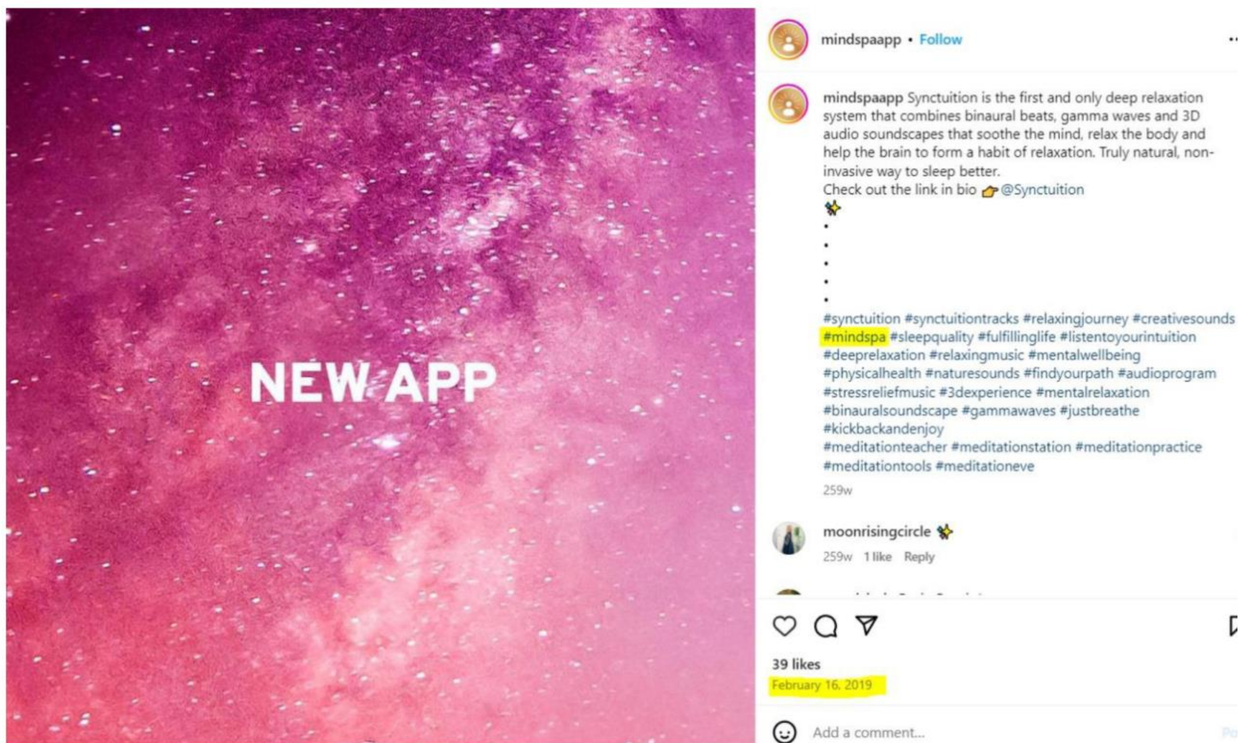
The proprietor launched a meditation and mental health app in early 2019 under the same 'SYNCTUITION'. Mr Tinn says that the app is designed to help users relax, manage stress, improve their sleep, focus, build a positive mindset, and achieve mental clarity and seeks to achieve this by providing informative content and guided meditation, amongst other content. The description of the app experience was referred to as "a spa for the mind", or "mind spa", in the proprietor's pre-launch social media posts and communication as early as October 2018. In support of this claim Mr Tinn exhibits the following two posts which are dated 16 October 2018 and 16 February 2019 from the proprietor's social media from which it can be seen that the proprietor used the expression "mindspa":[18]

[18] PT01





16.10.2018 post on IG account with #mindspa: https://www.instagram.com/p/Bo e2hHjle/

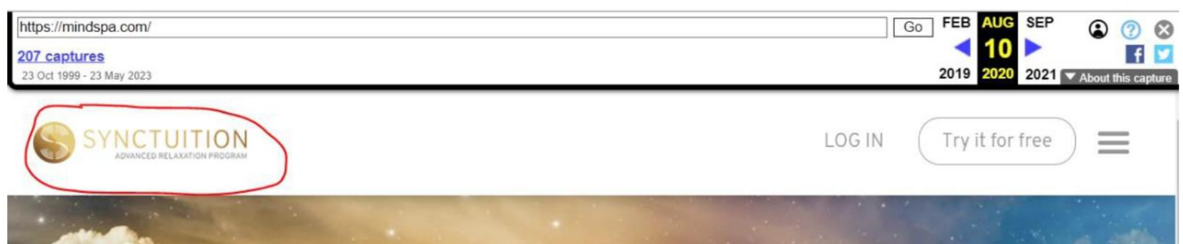


16.02.2019 post on IG account with #mindspa: https://www.instagram.com/p/Bt88kT8nw83/

- Mr Tinn says that subsequently he conceived the name "MINDSPA" as the new name for the entire app and acquired the domain name registration www.mindspa.com on 23 July 2020 (which is before Mr Savino contacted the proprietor on 20 September 2020). Mr Tinn also states that the domain name www.mindspa.com had originally been registered on 19 June 1998 but it was not actively used when he purchased it – this is consistent with the evidence exhibited by Mr Savino himself and noted above. Mr Tinn also says that when he conceived the name, he had not heard of the cancellation applicant, nor was he aware of its activities, until they opposed the proprietor's trade mark application before the EUIPO.

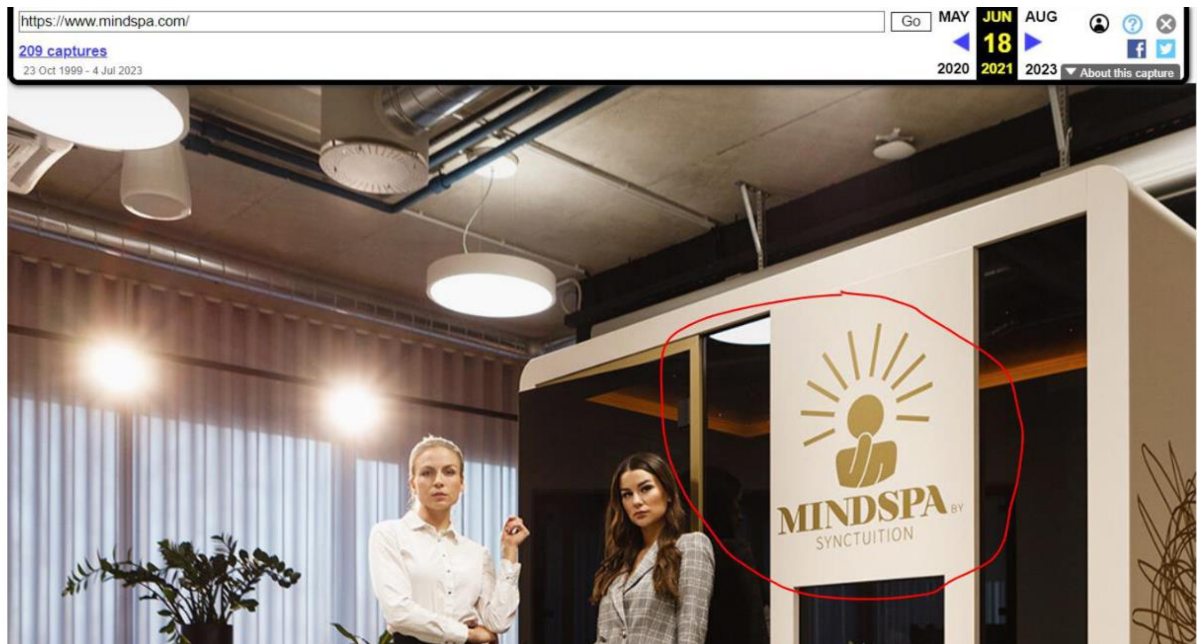
- Mr Tinn says that he subsequently changed the name of the app from 'SYNCTUITION" to "MINDSPA BY SYNCTUITION" and later to "MINDSPA.COM", as he believed the name "SYNCTUITION" alone was too complicated for international users to remember, and the proprietor wanted to add something to their brand name that would deliver the message about their app content to the users. Mr Tinn reiterates that the proprietor has used the term "mindspa" since 2018 gradually increasing the importance of MINDSPA over the initial brand name SYNCTUITION. Mr Tinn also provides screenshots from the website mindspa.com showing the following use:

  10.08.2020: Only the SYNCTUITION mark appears with the words ADVANCED RELAXATION below it:



  28.09.2020: Mindspa appears below the SYNCTUTION logo

18.06.2021: Mindspa appears as the main brand



- Mr Tinn states that the e-mail to their app support team with auto-generated receipt, attached as Exhibit MS 18 to the witness statement of Maurizio Savino, did not reach himself or any member of the management because of reasons not known to him and it is impossible to clarify after such a long time has passed.

- Mr Tinn states that the proprietor's EUTM application filed on 14 September 2020 was opposed by the cancellation applicant on 17 November 2020 and that he subsequently applied to register the Estonian priority application, and then the contested registration in the name of the proprietor, in good faith, to protect the name "MINDSPA.COM" which is identical to the domain name he acquired since July 2020. Further, Mr Tinn states that as a regular activity, the proprietor has strengthened its trade mark protection with several international applications and registrations, including some purchases of available trade marks, including Swedish Registration No. 550878 on 15 May 2023. Mr Tinn

also provides a list of various trade mark applications and registrations owned by the proprietor, with a number including pending proceedings between the parties.

160. In reply to Mr Tinn's evidence, Mr Savino provided a further witness statement in which it challenged the weight to be given to Mr Tinn's evidence. For example, Mr Savino argued that "*the sporadic use of hashtags, among the thousands of posts published by the company on social media, does not equate to commercial usage of a trade mark. Hashtags only serve to broaden post visibility"* and provided evidence[19] showing that the proprietor had used the hashtags #calm and #headspace in recent Instagram posts. Such criticisms are misplaced. First, Mr Tinn's evidence aims to show that the proprietor did not misappropriate the cancellation applicant's earlier mark but independently came up with and used the term 'MINDSPA' for its business and software app product. Second, hashtags are words or phrases preceded by a hash sign (#), used on social media to identify digital content, and businesses might decide to use trade marks in hashtags to strengthen their brand awareness; in this case, I consider that the proprietor adapting the brand in this way was clearly reasonable. Third, I fail to see the relevance of the reference to the proprietor using other hashtags (incorporating different words) after the relevant date.

161. Further, Mr Savino alleges that the proprietor might have edited the evidence showing use of the words 'MINDSPA' in hashtags and contends that *"since there is no way of knowing whether the post caption has been edited, the submitted Exhibit PT01 should be considered partly irrelevant, partly unreliable"* providing an online article[20] with instructions to edit old Instagram posts. Mr Savino essentially alleges that the proprietor has deliberately produced false evidence. This is a serious allegation that should not have been made in the absence of a strong prima facie case that Mr Tinn has given false evidence knowing it to be false. Further, I find that it is a desperate attempt to undermine the proprietor's evidence in circumstances where there is no proper evidential basis for asserting that Mr Tinn's evidence is false. Hence, I reject the allegation.

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[19] MS25
[20] MS27

162. In his witness statement, Mr Savino accepts that the first reliable and verifiable use of the term 'MINDSPA' in a commercial context by the proprietor was made after the acquisition of the domain name www.mindspa.com, which occurred in July 2020, seven months after the cancellation applicant's earlier mark 'MINDSPA' was filed on 30 December 2019 and six months after the cancellation applicant's 'MINDSPA' mobile app was launched. I feel that the cancellation applicant's case on bad faith misses the point. If one looks at the timing of events, the website www.mindspa.com was created on 16 June 1998, over 20 years before the cancellation applicant filed the application for the earlier mark 'MINDSPA' (figurative) and launched its 'MINDSPA' app. This means that that someone before the cancellation applicant came up with the concept of a "spa for the mind" and the brand name 'MINDSPA'. Since I have no reason to believe that the cancellation applicant was aware of the existence of the website www.mindspa.com when it chose the name 'MINDSPA' for its software app product, I conclude that the identity of the name is a mere coincidence. Likewise, I have no information as to who coined the name 'MINDSPA' and purchased the domain name www.mindspa.com in 1998, however, the evidence indicates that Mr Tinn independently came up with the same name as earlier as 2018 and 2019 (before the cancellation applicant filed the application to register the earlier mark 'MINDSPA' in December 2019 and launched the 'MINDSPA' app in January 2020) when it started using it as a descriptor along with the brand SYNCTUITION for the proprietor's app product which was promoted as a "spa for the mind" or "mindspaapp" and described as "*deep relaxation system that […] soothe, relax the body and help the brain to form a habit of relaxation".* Consequently, although the proprietor purchased the name www.mindspa.com in July 2020 (which is after the cancellation applicant had applied for the earlier mark and had launched its 'MINDSPA' application): (a) that domain name was created by a third party 20 years earlier, and (b) its acquisition must be seen as part of the natural process of rebranding from 'SYNCTUITION' to 'MINDSPA', the latter having already been used (prior to any use by the cancellation applicant) by the proprietor along the former to deliver the message about the content of the app to the users.

163. I also think it is also important to note that the combination of the words 'MIND' and 'SPA' to form the expression 'MINDSPA' in order to describe an app which helps users to relax the mind is inherently highly allusive of the product and it is not

implausible that it was chosen by the proprietor independently from the applicant and that the use of the same brand name in relation to similar apps by different traders is a coincidence. This conclusion is corroborated by the evidence establishing that the proprietor used the name MINDSPA over one year before any outward use made by the cancellation applicant. As regards the cancellation applicant's claim that the proprietor must have been aware of the cancellation applicant's use when it purchased the domain name www.mindspa.com in July 2020, it is merely speculation. The first contact the cancellation applicant made with the proprietor was on 10 September 2020, but at that point the proprietor had already purchased the domain name which indicates that it was already working towards the rebranding. As regards the other reasons upon which Mr Savino relies in his second witness statement to claim that the proprietor knew of its 'MINDSPA' app when it purchased the domain name (or even prior to that), they appear to be unsubstantiated and highly speculative and are not supported by any evidence. For example, Mr Savino states that "*given well-known industry practices like App Store Optimization (ASO), it is common to search for names and keywords of other mobile applications in the app stores to obtain better ranking and visibility*" and it is unlikely that the proprietor was unaware of a competitor in the same "Health and Fitness" category, especially given the popularity of the cancellation applicant's app in certain markets. First, this argument relates to the launch of an app on platforms such as Google Play and Apple Store and it does not apply to the decision to purchase a domain name to assist the proprietor with the process of rebranding and, for obvious reasons, it cannot apply retrospectively to the choice of the name in 2018. Second, it is not clear in which countries stores the cancellation applicant's app was available and whether they were the same countries stores where the proprietor's SYNCTUTION app was available. Third, as I have said above, there is no evidence that the cancellation applicant's app was so well known that when the proprietor decided to purchase the domain name in July 2020 it must have been aware of it. Likewise, I reject as merely speculative Mr Savino's claim that in the first two months after the launch of 'Mindspa', the cancellation applicant's mobile app had already gained significant popularity in the Estonian, Ukrainian and Russian app stores, and that the person holding the position of Head of Marketing at the proprietor's company (or its predecessor in tile) at the time was a Ukrainian national who should have been aware of the cancellation applicant's 'MINDSPA' app.

164. In my view, when one puts the cancellation applicant's allegations of bad faith into context and bears in mind (i) the evidence that the proprietor started using the brand 'MINDSPA' prior to, and independently from, the cancellation applicant, (ii) the proprietor's admission that when it applied for the contested mark it was aware of the cancellation applicant's mark (because at that point it had already received the oppositions to the EUIPO applications) and (iii) the reasons given by Mr Tinn that the proprietor applied for the contested mark in response to the cancellation applicant's accusation of trade mark infringement and in order to protect its own brand, the rationale for the application appears to be legitimate and consistent with a good faith explanation for the application. This is because the objectives and commercial logic pursued by the proprietor for registering that mark was to protect the name 'MINDSPA', which it had already started using in 2018 in relation to its products (although in a more descriptive manner) and which it had selected as the new name for its app. In those circumstances, it is reasonable that upon a threat of infringement, a party would quickly apply for a mark in order to try and protect themselves. Consequently, I consider that the proprietor has acted to protect its own brand and its own right, and whilst the identity of the name cannot be denied, it was coincidental, and the proprietor did not appropriate the mark of cancellation applicant. Lastly, whilst it might be argued that the timing of the EUIPO applications (which were filed before the contested application) was too close to the first contact made by Mr Savino and too coincidental to be true, the cancellation applicant did not request to cross-examine Mr Tinn and provided no evidence which undermine his declaration and he was not aware of the cancellation applicant's use of MINDSPA when it filed the trade mark applications at the EUIPO. In any event, even if the proprietor had received Mr Savino email, it would not have changed my conclusion, as I would still see the EUIPO application as made in good faith.

165. The invalidity under Section 3(6) also fails.

CONCLUSION

166. The invalidity action under Section 5(2)(b) has been partially successful in relation to the terms listed at paragraph 90, namely:

Class 9: *Recorded content; Information technology and audio-visual, multimedia and photographic devices; Audio recordings; Audio visual recordings; Optic discs carrying audio recordings; Audio tapes; Computer software; Mobile apps; Musical sound recordings; Musical video recordings; Tape recordings of music; Downloadable musical sound recordings; Downloadable video recordings featuring music; Series of musical sound recordings; Downloadable sound recordings; Sound records; Electronic publications, downloadable; Audiovisual teaching apparatus; Data storage media; Audio books; Downloadable electronic books; games software; computer games stored on data carriers; downloadable computer games.*

Class 16: *printed matter; instructional and teaching materials; educational supplies; Printed sheet music; Baby books; Children's storybooks; Books for children; Children's activity books; Children's books incorporating an audio component; Comics; Books.*

Class 41: *Education; providing of training; Rental of sound recordings; Rental of audio-visual recordings; Rental of sound and video recordings; Rental of sound and image recordings; Rental of motion pictures and of sound recordings; Providing digital sound recordings, not downloadable, from the internet; Publication of printed matter; Publication of printed matter and printed publications; Publication of printed matter relating to education; Publication of printed matter in electronic form; Publication of printed matter in electronic form on the Internet; Teaching; Education services relating to health; Education information; Educational research; Educational seminars; Education, Education, Education services relating to meditation; Teaching of meditation practices; Educational services relating to spiritual development; Musical education services; Providing online electronic publications in the field of music, not downloadable; Pregnancy gymnastics instruction; Educational services provided for children; Self-awareness courses [instruction]; Conducting workshops and seminars in self-awareness; Arranging and conducting of workshops and seminars in self-awareness; Health education; Nutrition education; Dietary education services; Instruction courses relating to health; Instruction in nutrition [not medical]; Publication of books; Providing on-line*

electronic publications, except downloadable; Providing on-line electronic health, nutrition and dietary publications, except downloadable; Providing on-line videos, not downloadable; Providing on-line educational materials, not downloadable; tutoring; arranging and conducting tutorials; arranging and conducting seminars; Education services relating to meditation; Education services relating to meditation; Teaching of meditation practices; Educational services relating to spiritual development.

Class 42: *Scientific and technological services and research and design relating thereto; design and development of computer hardware; creation and development of computer hardware; providing temporary use of non-downloadable computer software; provision of non-downloadable software; provision of online computer software.*

Class 43: *daycare services.*

167. The proprietor's registration no. UK00003716544 will be declared invalid in relation to these goods and services only. However, it will remain registered for the remaining goods and services.

COSTS

168. Since each party has achieved a measure of success, I order that each party bear their own costs.

Dated this 7th day of April 2025

TERESA PERKS
For the Registrar