

O/0581/25

TRADE MARKS ACT 1994

IN THE CONSOLIDATED MATTERS OF

UK TRADE MARK APPLICATION 3429107

IN THE NAME OF IAN GEORGE THOMAS AND OTHERS

FOR THE WORD MARK SERIES

LOVE INJECTION / LUV INJECTION

IN RESPECT OF GOODS AND SERVICES IN CLASSES 9 AND 41

AND

OPPOSITION NO. 419321 THERETO BY WINSTON THOMAS

- AND -

APPLICATION NO. 505806 BY IAN GEORGE THOMAS

TO REVOKE FOR NON-USE UK TRADE MARK NO. 3212085

LUV INJECTION SOUND

REGISTERED IN THE NAME OF WINSTON THOMAS

IN RESPECT OF GOODS IN CLASS 9

INTRODUCTION

The Opposition

1. On 17 September 2019, UK trade mark application No. 3429107 (“**the TM Application**”) was filed in the names of Ian George Thomas, Rochelle Thomas, Shirmala Higgins and Orville Anthony Billy Higgins (“**the TM Applicants**”).
2. The TM Application is for a series of two (word-only) marks – LOVE INJECTION and LUV INJECTION - in respect of the certain goods in Class 9 and services in Class 41. The full list of applied-for goods and services is set out under the goods and services comparison section of this decision.
3. On 5 February 2020, an opposition was filed against the TM Application by Winston Thomas (“**the Opponent/Registered Proprietor**”), based on grounds under **section 5(2)(b)** and **5(4)(a)** of the Trade Marks Act 1994 (“**the Act**”). The Opposition was stayed pending resolution of proceedings between the parties in the High Court and Court of Appeal. In light of findings in those proceedings, the claim under section 5(4)(a) fell away and the present proceedings resumed at the end of 2022, with the opposition now based solely on section 5(2)(b) of the Act.
4. The Opponent relies on trade mark No. 3212085 LUV INJECTION SOUND (“**the Earlier Trade Mark**’), which was applied for on 10 February 2017, and became registered on 5 May 2017 in respect of the following goods: **Class 9: *Hi-fi sound systems; Music recordings***
5. The Opponent’s objection is based on the identical aspects of the applied-for trade mark series with the first two words of the Opponent’s Earlier Trade Mark. The Opponent claims that “*the goods and services are identical and that both parties are using the marks as the name of a Jamaican sound system (musical group), such that the public will assume that Love Injection and Luv Injection is the same as Luv Injection Sound and will confuse the musical offerings of the Applicant and Opponent accordingly. The word “sound” merely describes the musical offering of both the Applicant and Opponent.*”

6. The TM Applicants' defence and counterstatement:
- i. Does not (and could not) put the Opponent to proof of use of the Earlier Trade Mark;
 - ii. Admits that both marks in the applied-for series are similar to the Earlier Trade Mark;
 - iii. Admits that certain goods are identical with or similar to the class 9 goods of the Earlier Trade Mark;
 - iv. Does not admit similarity of the other goods;
 - v. Admits that certain services are similar to the goods of the earlier registration;
 - vi. Does not admit similarity or identity of the other services;
 - vii. Denies that there is a likelihood of confusion. This denial is explained on the following basis: *"Before the UK Intellectual Property Enterprise Court, it was asserted by the Opponent (and the Opponent led evidence to the same effect) that the relevant consumer is accustomed to distinguishing between the operations of the respective parties."*

The Revocation

7. On 7 February 2023, one of the Applicants – Ian George Thomas (**the Applicant**) - applied to revoke the Opponent's Earlier Trade Mark, claiming it has not been put to genuine use in respect of the goods for which it is registered.
8. Revocation under **section 46(1)(a)** of the Act is sought from 6 May 2022 (i.e. 5 years after registration). Revocation under **section 46(1)(b)** is sought in respect of 3 periods of 5 years ("**Relevant Periods**") as shown in the table below —

Start date	End date	Revocation from
1 September 2017	31 August 2022	1 September 2022
1 January 2018	31 December 2022	1 January 2023
7 February 2018	6 February 2023	7 February 2023

9. The Registered Proprietor defended his Earlier Trade Mark registration, filing a Form TM8(N), stating that he has made use of the mark in respect of the registered goods throughout all four Relevant Periods. The counterstatement describes the claimed use as *“in respect of hi-fi sound systems in the course of performances and the rental/loan of such systems to other performers. The owner has also made use of the mark for sound recordings during each of the relevant periods including by making recordings available for download.”*
10. The opposition and revocation proceedings have been consolidated.

Evidence filed

11. Both parties filed evidence, as itemised below. The potential relevance of some of the evidence fell away with the removal of the section 5(4)(a) claim. I refer to points from the evidence to the extent I consider warranted, principally in relation to the Registered Proprietor’s claimed use in defence of the revocation proceedings.

Evidence for the Opponent / Registered Proprietor:

- Witness Statement of Winston George Thomas, dated 20 December 2022, introducing Exhibit WGT1 (December 2022).
- Witness Statement of Winston George Thomas, dated 21 July 2023, introducing Exhibits WGT1 (July 2023) – WGT8
- Reply evidence: Second Witness Statement of Winston George Thomas, dated 14 September 2023, introducing Exhibits WGT9 – WGT14

Evidence for the Applicant(s):

- Witness Statement of Ian George Thomas, dated 12 February 2023, introducing Exhibits IGT1 – IGT4 (February 2023).
 - Witness Statement of Ian George Thomas, dated 10 July 2023,¹ introducing Exhibits IGT1 – IGT4 (July 2023).
12. An oral hearing was held before me by Teams videocall on 14 May 2024. Michael Hicks of counsel, instructed by Higgs LLP attended the hearing on behalf of the

1 The signature date erroneously reads 10 July 2022, but the header of the witness statement makes clear that it dates from 2023.

Opponent / Registered Proprietor. Aaron Wood, of Brandsmiths SL Limited attended for the Applicant(s).

Preliminary matter

13. It was submitted on behalf of the Applicant for revocation that the evidence does not demonstrate genuine use of the earlier trade mark registration relied on as the sole basis of the Opposition, such that it should be revoked for non-use “*and that must bring the Opposition to an end.*” I find that conclusion to be at odds with the statutory provisions. The relevant parts of the section 46 of the Act in the present circumstances are these (my own underlining):

46 Revocation of registration.

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

(a) *that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;*

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

(c) *[...]*

(d) *[...]*

(2). *[...]*

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

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

or resumption began before the proprietor became aware that the application might be made.

(4) [...]

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

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

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

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

14. The application to revoke the Earlier Trade Mark was filed on 7 February 2023. All of the dates from which revocation is sought post-date the filing date the TM Application; the earliest date from which revocation is sought is 6 May 2022. When the Applicants filed their contested Trade Mark Application - on 17 September 2019 – the Opponent's Earlier Trade Mark had been registered for less than five years and it is not claimed that there existed any grounds for revocation at that date. It is therefore clear that even in the event that the Opponent's Earlier Trade Mark is revoked for non-use, the rights stemming from the revoked registration continued to subsist at the filing date of the contested Trade Mark Application. The Opponent is thus able to rely on his Earlier Trade Mark registration irrespective of the outcome of the revocation proceedings.

DECISION

THE OPPOSITION

15. The Opposition is based on section 5(2)(b) of the Act:

“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”.

16. Section 5A of the Act 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.”

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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.

SIMILARITY OF THE PARTIES' GOODS AND SERVICES

- 18. The Opponent's goods under the Earlier Trade Mark are simply **Class 9: *Hi-fi sound systems; Music recordings***, which are to be compared with the Applicants' goods and services set out in the table below.
- 19. The Applicants' counterstatement admitted that many of its goods and services are identical or similar to the goods of the Earlier Trade Mark.

20. The goods and services that the Applicants admitted to be identical or similar are those underlined in the table below.

The applied-for goods and services (conceded similarity underlined)
<p>Class 9: <u>Apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information; reproductions of sound and/or video in electronic and digital form, all supplied by means of multimedia, remote computers or on-line from databases or from facilities provided on the internet(including websites); sound storage media, image storage media and data storage media, all being pre-recorded; downloadable MP3; computer apparatus; computer software; computer programs; multimedia software including CD-Roms, DVD-Roms; digital media; computer software for access to databases relating to music, entertainers, performers, entertainment products, entertainment services and music-related products; computer software for securing digital content; computer programs for managing communications and data exchange relating to music, audio and visual data; multimedia software for downloading music, audio and visual data; computer software for online trading; CD recorders and players; DVD recorder and players; CDs, DVDs; audio tapes (all being sold together with booklets); pre-recorded vinyl records; sound and/or video recording on corresponding recording carriers; gramophone records; sound and/or video cassettes; cassettes for the storage of, or containing, tapes for or bearing sound or video recordings; magnetic tapes, discs, and magnetic wires, all for sound or video recording; membership cards; electronic handheld devices for the wireless receipt and/or transmission of data; digital audio and video devices; head cleaning tapes; audio cassette recorders and players, video cassette recorders and players, compact discs players, digital versatile discs recorders and players, digital audio tape recorders and players; photographic and cinematographic apparatus and instruments; television and radio apparatus; microphones; coin-operated juke boxes; coin or counter-feed sound or video reproduction apparatus; unexposed photographic transparencies; parts and fittings for all the aforesaid goods.</u></p>

Class 41: Entertainment; sporting and cultural activities; production of television and radio programs; providing online entertainment; entertainment services; record production, video production, radio entertainment production and distribution; publication of books and magazines in relation to music and entertainment; entertainment in the nature of live concerts and performances; musical and audiovisual entertainment services; production, distribution and publishing of music and audiovisual material; fan clubs; entertainment in the nature of live concerts and performances by artists and groups; providing digital music and audiovisual material (not downloadable) from the Internet; entertainment services, namely personal appearances by groups, artists and celebrities; entertainment services in the nature of music and audiovisual material rendered by groups and artists through the medium of television, radio, cable, satellite and Internet programmes, shows, films, videos and DVDs; entertainment services rendered by groups and artists including recording performances; entertainment services, namely, providing a web site featuring performances, videos, related film clips, photographs, and other multimedia materials; entertainment services namely live, televised and movie appearances by a professional entertainers; conducting entertainment exhibitions in the nature of live music and entertainment events; sporting and cultural activities; production of television and radio programs; distribution of television and radio programs for others; production and publishing of music; providing online entertainment, namely providing sound and video recordings in the field of music and music based entertainment; entertainment services, namely providing online non-downloadable pre-recorded musical sound and video recordings via a global computer network; fan clubs; development and dissemination of educational materials of others in the field of music and entertainment; radio entertainment production and distribution; audio and sound recording and production; record production; videotape production; production of motion picture films; distribution of motion picture films; television program syndication; entertainment in the nature of ongoing television programs in the field of music and entertainment; entertainment, namely a continuing music and entertainment show distributed over television, satellite, audio, and video media; publication of books and magazines in relation to music and entertainment; entertainment in the nature of ongoing radio programs; entertainment in the nature of live concerts and performances rendered by musical

artists through the medium of television, radio, and audio and video recordings;
entertainment services, namely recorded performances by musical artists;
educational and entertainment services, namely, production and presentation of
television shows and music shows before live audiences which are all broadcast
live or taped for later broadcast; entertainment services, namely, providing a web
site featuring musical performances, musical videos, related film clips,
photographs, and other multimedia materials; entertainment services, namely,
providing on-line reviews of music, musical artists and music videos; entertainment
services, namely, providing pre-recorded music, information in the field of music,
and commentary and articles about music, all online via a global computer network;
entertainment services namely live, televised and movie appearances by a
professional entertainer; conducting entertainment exhibitions in the nature of
music festivals; entertainment services, namely, conducting exhibitions in the field
of music and the arts; organizing exhibitions for entertainment purposes featuring
music and the arts; and publishing of web magazines in relation to music and
entertainment; distribution of music; distribution of musical sound recordings and
video recordings; preparing audio-visual displays in the field of music.

21. In view of the admissions in the Applicants' counterstatement, the similarity of the underlined goods and services is not contested. The counterstatement did not specify the degree of similarity conceded, nor explain the bases for the conceded similarity. However, I do not consider it necessary for this decision to form an assessment on those points since the marks themselves are so similar that a difference of degree in the estimation of the similarity of the goods and services will not change my findings on a likelihood of confusion.
22. It is, however, necessary to undertake a comparison in respect of the goods and services that are *not* admitted to be identical or similar (being those *not* underlined above). If there is no similarity between the goods of the Earlier Trade Mark and the goods and services of the opposed trade mark application a section 5(2)(b) objection cannot succeed. The factors under the relevant case law for assessing similarity of goods and of services are well established. I must consider all relevant factors, including:

- (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) their intended purpose and method of use;
- (f) whether they are in competition with each other;²
- (g) whether they are complementary,³ in the sense 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”.⁴

23. At the hearing, Mr Hicks, for the Opponent, took me through each of the goods and services that the Applicants had *not* admitted to be similar or identical. Where below I am content to find some similarity between the parties' specifications, I explain the factors that lead me to that conclusion. However, noting the extent to which the Applicants counterstatement admit that the applied-for goods and services are identical or similar, and that the remainder are “not admitted” to be similar or identical, and in view of the admitted similarity between the marks themselves, I do not consider it necessary for this decision to estimate a specific degree to which the goods and services are similar. If, having weighed the relevant factors, I find there to be some similarity, that similarity is not so low that it would change my findings on a likelihood of confusion

2 C-39/97 *Canon KKK v Metro Goldwyn Mayer Inc* [1999] RPC 117, the Court of Justice of the European Union (CJEU) at [23].

3 *Ibid*

4 The General Court held in the case of *Boston Scientific Ltd v OHIM* (Case T-325/06, EU:T: 200: 428) at [82].

The applied-for Class 9 Goods:

Apparatus, instruments and media for carrying ... music, sounds

24. Mr Hicks submitted that "*apparatus and media for carrying sounds*" are highly similar, if not identical, to the Opponent's "*music recordings*". I agree that "*media for carrying music*" is at least similar to "*music recordings*", based on physical nature of the goods, complementarity and shared users. I also agree that "*Apparatus, instruments ... for carrying, processing, manipulating... music, sounds*" is at least similar to "*Hi-fi sound systems*", based on physical nature of the goods, purpose, uses and users.

Apparatus, instruments and media for carrying, processing, manipulating, images, text, and information

25. While I acknowledge that "*information*" could potentially include digital data that is music, I do not consider that to be a natural and ordinary understanding of the word. I find **no similarity** between the Opponent's "*music recordings* or "*Hi-fi sound systems*", and the applied-for Apparatus, instruments and media for carrying, processing, manipulating, images, text, and information. (I note that at the hearing Mr Hicks took no issue with such a perspective.)

computer apparatus; computer software; computer programs

26. Mr Hicks argued that that in the modern world, *computer apparatus* is an extremely broad term, and *computer software* and *computer programs*, even wider. He acknowledged judicial observations against an unduly broad construction, where, for instance a computer program could be a specialist program for making, say, top hats. Mr Hicks argued that the present comparison does not require such a stretch of similarity. He argued that it is commonplace these days for "*computer apparatus, computer software, computer programs*" to be for dealing with music, and that at least an aspect of computer apparatus would embrace matter that is similar to "*hi-fi sound systems*" because they are the means by which people play music these days, and that gives rise to similarity. While I am cautious of over-extending the legitimate protection afforded to extremely wide terms such as hardware and software, I

acknowledge that it is difficult to deny the interconnection of “*computer apparatus, computer software, computer programs*” with, say, a SONOS sound system or Apple music and iPod. I find there is some similarity with the ‘older school’ goods of the Earlier Mark “*Hi-fi sound systems*” and “*music recordings*” based at least on the factors of purpose, competition and an overlap in users (those who listen to music). Moreover, my reluctance is lightened in view of the admissions in the counterstatement that there is similarity in respect of other terms. For instance, the Applicants admit that there is similarity in respect of “multimedia software”; if, therefore that term is similar and potentially objectionable, then it follows that computer software/programs are likewise objectionable since they include multimedia software. The Applicants admit that there is similarity in respect of “apparatus and media for recording, reproducing, storing, transmitting, broadcasting, retrieving and reproducing music and sounds”; it is difficult to separate this description from goods that fall legitimately within the term “computer apparatus”.

computer software for access to databases relating to music, entertainers, performers, entertainment products, entertainment services and music-related products

27. Mr Hicks argued that “*music, entertainers, performers, entertainment products, entertainment services and music-related products,*” are words are wide enough to cover musical entertainers, musical performers and so on, so they include within them “music”. He then argued that computer software is similar to “*music recordings*” because these days, the common means of accessing music recordings is via online systems - Spotify and YouTube and other pieces of software like that. Therefore, the whole term is at least similar to “*music recordings*”. While again vigilant not to over-extend the legitimate protection afforded to software, I accept, based at least on the factors of competition and an overlap in users (those who listen to music), that there is some similarity between the Opponent’s *music recordings* and the applied-for *computer software for access to databases relating to music and music-related products*. Moreover, while mindful of ‘similarity creep’ since the following wider terms naturally include music and musicians, I also consider it warranted to find similarity in respect of the wider terms beyond the specified music services - *computer software*

for access to databases relating to entertainers, performers, entertainment products, and entertainment services. There is at least a degree of similarity to the goods of the Earlier Trade Mark (again noting that the Applicants admit that there is similarity in respect of “*multimedia software*”).

computer software for securing digital content

28. On one view, the term “*computer software for securing digital content*” could – possibly - mean software to enable one to “secure” digital content - in the sense of “access” or “get hold of” -and that such digital content could be music, and that “*computer software for securing digital content*” may thereby be considered similar to “*music recordings*”.
29. Mr Hicks submitted that “*computer software for securing digital content*” embraces software for recording (i.e. “securing”) digital content consisting of music and, therefore embraces goods that are similar to “*music recordings*”.
30. In my view, nether interpretation is appropriate, since I find that the natural implication of the term “*computer software for securing digital content*”, viewed from the perspective of the average consumer, is that it means software to enable one to “secure” digital content in the sense of making it secure/safe, as from third party intrusion or malware.
31. I find *computer software for securing digital content* to be **not similar** to the goods of the Earlier Trade Mark.

computer programs for managing communications and data exchange relating to music, audio and visual data

32. Mr Hicks accepted that insofar as the above goods refer to “visual data”, the goods are **not similar**.
33. He argued, however, that since “audio” covers “music”, the applied-for goods “*Computer programs for managing communications and data exchange relating to music and audio*” are similar to “*music recordings*” in the modern world.

34. I find the expression of these specified goods to be more opaque and more “stepped” (through the inclusion of “*for managing communications*”) than the previously considered goods “*computer software for access to databases relating to music*”. However, at base, these two earlier goods appear to be essentially the same as one another, and therefore, for consistency, I find that “*computer programs for managing communications and data exchange relating to music and audio visual data*” may be considered to be similar in some (low) degree to “*music recordings*”, on the basis that the musical content captured in “*music recordings*” may alternatively be accessed by the average consumer by means of software that remotely manages music – i.e. a program that manages an exchange of musical data – data such as album, performer, song titles etc. and the music itself.

multimedia software for downloading music, audio and visual data

35. Again, the “**visual data**” element of these specified goods is **not similar**, but otherwise, “multimedia software for downloading music, and audio data” as a modern means by which one can access and play music has some (low) degree of similarity to the goods of the Earlier Trade Mark.

computer software for online trading

membership cards

36. As Mr Hicks acknowledged at the hearing, neither of these applied-for goods are similar to the goods of the Earlier Trade Mark.

electronic handheld devices for the wireless receipt and/or transmission of data;

37. Mr Hicks submitted that insofar as data covers musical data, these electronic devices are similar to the Opponent’s *hi-fi sound systems*. He acknowledged that what these goods cover is not clear, but argued that the specified term is broad, and that since data could digital data, the goods could therefore include a handheld device for playing music, leading to similarity with *hi-fi sound systems*. In my view, this analysis

overstrains the concept of similarity. A *hi-fi sound system* is different in physical nature from an electronic handheld device, the purposes are different, the methods of use are different, the goods are not naturally competitive, nor are they complementary. I find *electronic handheld devices for the wireless receipt and/or transmission of data* are **not similar** to the goods under the Earlier Trade Mark.

head cleaning tapes

38. The parties made no submissions on these goods. Such goods may be important to the maintenance of a *hi-fi sound system*, and to the health of played *music recordings* insofar as those goods feature cassette tapes. There could therefore be an overlap in users. However, I have no evidence that the average consumer would assume *head cleaning tapes* to come from the same undertakings as the goods of the Earlier Trade Mark, so I do not find them to be complementary. The goods are different in nature, purpose, method of use and not in competition with one another. Even if there is an overlap in channels of trade (a point on which I have no information) I find that overall, *head cleaning tapes* are **not similar** to the goods of the Earlier Trade Mark.

photographic and cinematographic apparatus and instruments

39. Mr Hicks accepted at the hearing, that *photographic apparatus and instruments* are **not similar** to the goods of the Earlier Trade Mark. However, he submitted that *cinematographic apparatus and instruments* embraces apparatus and instruments for playing the audio side of cinematographic films and are therefore similar to *hi-fi sound systems*. I accept that the sound systems underpinning film projections may be an integral part of a cinematic offering. However, in my view, the descriptor “cinematographic” denotes a focus on the visual aspect of capturing motion pictures, - lighting, camera angles, composition and so on. I find the soundtrack aspects, while of course important, are discrete from cinematographic concerns. I find that cinematographic apparatus and instruments are different in nature, purpose, and method of use from *hi-fi sound systems*. While hi-fi sound systems may be important to accompany the use of *cinematographic apparatus and instruments* I have no evidence from which I would conclude the goods to be complementary. They are not

in competition. Overall, I consider *cinematographic apparatus and instruments* to be **not similar** to the goods of the Earlier Trade Mark.

television apparatus

40. Mr Hicks submitted that it is common for a consumer seeking to set up a home cinema to wish for it to feature a high quality sound system, and that *television apparatus* is therefore similar to a *hi-fi sound system*.

41. I find that the ordinary, traditional conception of a *hi-fi sound system* may be of a music machine, historically comprising elements such as turntable, amplifier(s), tape, CD player, tuner and speakers, and now pure digital audio output. However, I find the nature of a *hi-fi sound system* to be essentially an audio system designed to reproduce sound with a high degree of accuracy and fidelity, for a more realistic listening experience. Whereas historically a television set equipped its own, sufficient sound provision, it is increasingly the case that modern, large flat screen televisions have relatively poor sound quality and it is routinely anticipated that the consumer (the general public at large) will likely deploy an auxiliary audio output means – whether a soundbar or other speaker set up. I therefore find that there is a degree of similarity between *television apparatus* and a *hi-fi sound system*, inasmuch as a form of sound system may now be used as standard alongside a large high-definition television screen, such that the “*television apparatus*” are necessarily intermingled. There is an overlap of users, channels of trade (such as TV section of a department store or electronics shop) and purpose (enjoyment of a televisual experience).

microphones

42. Mr Hicks submitted that “*Microphones*” are similar because they are potentially an aspect of a hi-fi sound system, at least on the recording side of such a system. I acknowledge that a hi-fi sound system may typically provide an input for a microphone, but in my view the microphone is a separate, auxiliary item to a hi-fi sound system, different in purpose, method of use, nature. I have no evidence (or specific submissions) on channels of trade or matters of complementarity. The goods do not

compete with each other. Overall, I consider *microphones* to be **not similar** to the goods of the Earlier Trade Mark.

coin-operated juke boxes

coin or counter-feed sound or video reproduction apparatus

43. Mr Hicks submitted that such machines may well play sounds in a hi-fi way and are similar to a hi-fi sound system. I find that these goods are similar in some degree, both being concerned with the delivery of recorded music, overlapping in nature and purpose.

unexposed photographic transparencies

44. As Mr Hicks acknowledged at the hearing, these applied-for goods are **not similar** to the goods of the Earlier Trade Mark.

The Class 41 services

45. The following services are those in respect of which the Applicants' counterstatement admitted no similarity. I bear in mind that for all of the following, there is a consistent difference of nature between services and goods.

sporting activities

46. As Mr Hicks acknowledged at the hearing, these applied-for services are **not similar** to the goods of the Earlier Trade Mark.

cultural activities

47. Mr Hicks submitted that cultural activities includes entertainment, including musical entertainment and are therefore similar to hi-fi sound systems which might give the music entertainment and the musical recordings which may be played. I reject that

submission as obviously strained. In my view, having regard to the case law factors these services are **not similar** to the goods of the Earlier Trade Mark.

production of television and radio programs

48. As Mr Hicks acknowledged at the hearing, these applied-for services are **not similar** to the goods of the Earlier Trade Mark.

providing online entertainment;

49. Mr Hicks submitted that these services are similar to *music recordings*, since *providing online entertainment* could include playing music recordings. I note that, in their counterstatement, the Applicants conceded similarity in respect of “*Entertainment*”, the first of their applied-for first terms specified in Class 41. In my view, it would be inconsistent and artificial to distinguish between “*Entertainment*” in Class 41 and “*providing online entertainment*” in Class 41. A consumer may choose to access music online for entertainment purposes. There is therefore an overlap of purpose and user, and an element of competition.

entertainment services

50. Mr Hicks submitted that “*Entertainment services*” are very broad, including entertainment by playing music, such that these services are similar to *music recordings*. While I have reservations about this line of argument, I again note that, in their counterstatement, the Applicants conceded similarity in respect of “*Entertainment*”. In my view, it would be inconsistent and artificial to distinguish between “*Entertainment*” in Class 41 and “*entertainment services*” in Class 41. In view of the similarity conceded in respect of “*entertainment*” in Class 41, I find “*entertainment services*” in the same class inevitably also similar.

record production

51. The Applicants' counterstatement includes an **admission of similarity** in respect of record production.

video production

radio entertainment production and distribution;

52. The term *radio entertainment production and distribution* appears twice in the applied-for specification, and at its second appearance, Mr Hicks submitted that a typical distribution of a radio entertainment might include distribution of recorded music and that so far as *distribution* is concerned the services are therefore similar to the Opponent's music recordings. I find that having regard to the case law factors these services are **not similar** to the goods of the Earlier Trade Mark. They are different in nature, trade channels and methods of use. (Precisely what is meant by *radio entertainment distribution* is not clear to me, but even if it could simply mean 'providing what is played on the radio', a consumer wishing to listen to a particular music recording could not reliably turn to the radio to fulfil that desire. These services (in contrast to a streaming provision or website) do not therefore compete with the Opponent's music recordings. While music recordings may be an important element of the services, the consumer would not think that the radio entertainment distributor is responsible for the music recordings, so there is no complementarity.

publication of books and magazines in relation to music and entertainment

53. Mr Hicks submitted that these applied-for services are, at best, similar to a low degree to the goods of the Earlier Trade Mark. I find that having regard to the case law factors – different uses, nature, trade channels, methods of use, non-competitiveness and lack of complementarity - these services are **not similar** to the goods of the Earlier Trade Mark.

fan clubs

54. As Mr Hicks acknowledged at the hearing, these applied-for services are **not similar** to the goods of the Earlier Trade Mark.

providing digital music and audiovisual material (not downloadable) from the Internet

55. Mr Hicks submitted that these services involve streaming music (or music within an audiovisual medium) and are similar to “*music recordings*.” I accept that there is similarity based on purpose, user and competition, in that a consumer may choose to purchase a physical music recording (such as vinyl or CD) or may instead choose to access the same content via a streaming service (with or without visuals).

entertainment services, namely, providing a web site featuring [musical]⁵ performances, videos, related film clips, photographs, and other multimedia materials

56. Mr Hicks acknowledged that insofar as these applied-for services do not include music (particularly ***film clips, photographs***) they are **not similar** to the goods of the Earlier Trade Mark. However, insofar as these applied-for services involve providing a website from which a consumer can play standalone music or videos, there is some similarity.
57. In my view, a website is different in nature and method of use from goods that are *music recordings*, and is less directly competitive than a streaming service, but I find there may be considered a degree of similarity in that a consumer may choose to purchase a physical music recording or may instead choose to experience the same content from a website (with or without visuals).

entertainment services namely live, televised and movie appearances by a professional entertainers

58. Mr Hicks submitted that these applied-for services are similar to music recordings, insofar as live appearances are concerned, because it is commonplace for a music recording to be performed also by a professional entertainer. I find that having regard

5 These services appear twice in the Applicants' Class 41 specification, though only in one version is the word “musical” expressly featured.

to the case law factors – different nature, trade channels, methods of use, non-competitiveness and lack of complementarity - these services are **not similar** to the goods of the Earlier Trade Mark.

distribution of television and radio programs for others

59. As Mr Hicks acknowledged at the hearing, these applied-for services are **not similar** to the goods of the Earlier Trade Mark.

development and dissemination of educational materials of others in the field of music and entertainment

videotape production

production of motion picture films

distribution of motion picture films

television program syndication

60. As Mr Hicks acknowledged at the hearing, these applied-for services are **not similar** to the goods of the Earlier Trade Mark.

entertainment in the nature of ongoing television programs in the field of music and entertainment

entertainment, namely a continuing music and entertainment show distributed over television, satellite, audio, and video media

61. Mr Hicks submitted that the above services, insofar as they are concerned with music, are similar to the Opponent's *music recordings*. I find these services differ from the goods in nature, trade channels and methods of use and do not compete with one another. In my view, having regard to the case law factors overall, these services are **not similar** to the goods of the Earlier Trade Mark.

educational and entertainment services, namely, production and presentation of television shows and music shows before live audiences which are all broadcast live or taped for later broadcast

62. Mr Hicks accepted that *educational services* are **not similar**, but submitted that the services of *presenting music shows before live audiences taped for later broadcast* are similar to the goods “*music recordings*”. I accept that there is a degree of similarity in respect of those limited entertainment services on the basis that streaming is a form of broadcasting (transmitting content to an audience). Broadcasting traditionally uses mediums like radio and television, whereas streaming utilises the internet. These days, transmitted content can be accessed on-demand, such that there is degree of similarity based on nature of the consumed content, shared users and an element of competition, since a consumer may choose to view a recorded live music show by streaming it on-demand (on a smartphone, tablet, computer or television) or to buy a physical recording of the same.

entertainment services, namely, providing on-line reviews of music, musical artists and music videos

[...] information in the field of music, and commentary and articles about music [...]

63. As Mr Hicks acknowledged at the hearing, these applied-for services are **not similar** to the goods of the Earlier Trade Mark.

entertainment services, namely, conducting exhibitions in the field of music and the arts

64. Mr Hicks submitted that insofar as those exhibitions may well involve the playing of music they are similar to music recordings. I disagree. I find these services differ from the goods in nature, trade channels and methods of use, are not complementary and

do not compete with one another. In my view, having regard to the case law factors overall, these services are **not similar** to the goods of the Earlier Trade Mark.

Organizing exhibitions for entertainment purposes featuring music and the arts

65. Mr Hicks submitted that organising an exhibition for an entertainment purpose is likely to include the playing of music, and argued that it is a service similar to music recordings. Even if these services may feature the playing of recorded music, I find these services differ from the goods in nature, trade channels and methods of use, are not complementary and do not compete with one another. Overall, these services are **not similar** to the goods of the Earlier Trade Mark.

publishing of web magazines in relation to music and entertainment

66. Mr Hicks acknowledged that these applied-for services are **not similar** to the goods of the Earlier Trade Mark.

ASSESSMENT OF A LIKELIHOOD OF CONFUSION

67. For all of the goods and services in respect of which I have found no similarity, it is inevitable that the Opposition must fail for lack of a required element of a section 5(2)(b) objection. Those applied-for goods and services that survive the Opposition and which may proceed to registration are collated and reiterated at paragraph 73 of this decision.
68. The usual approach to the analysis of a likelihood of confusion is to consider each of the component elements – similarity of goods / services, the average consumer and the nature of the purchasing process, the similarity of the marks themselves, the distinctive character of the earlier trade mark – then to weigh those elements in combination to determine whether they operate to give rise to a likelihood of confusion. In the present case, I do not consider necessary to conduct the analysis in quite that usual separated manner. This is because the Applicants have admitted that the marks are similar, that (some of) the goods and services are similar, and have denied a

likelihood of confusion based only on the specific premise that I set out in the pleadings section of this decision. Before I come on to deal with the Applicants' denial of a likelihood of confusion, the following paragraph addresses the usual component considerations, albeit briefly since these are not issues on which the parties appear to disagree.

69. The Applicants admitted that some of the goods and services are identical or similar, and, as I indicated previously, it is my view that for all of the goods and services in respect of which I have found some similarity based on the factors identified, that similarity, even if low, is sufficient to lead to a likelihood of confusion, taken with all other relevant factors. The marks differ in that the Earlier Trade Mark features a third word – “Sound”. However, in relation to the goods of the Earlier Trade Mark, that word has very little or no distinctive character. The first two words of the Earlier Trade Mark – “Luv Injection” - are aurally and conceptually identical to the applied-for “Love Injection”, and visually, aurally and conceptually identical to the other mark in the applied-for series - “Luv Injection”. The parties' marks are highly similar overall. The Earlier Trade Mark is memorable and distinctive, since the first two words have no descriptive or obvious allusive reference in relation to the earlier registered goods. The average consumer for the goods and services that are similar or identical will be a member of the general public, who will typically pay at least a medium degree of attention when choosing the various, music-based, goods and services.
70. In my view, the high degrees of similarity between the marks, the distinctive conceptual hook and the similarity of the goods and services will lead a member of the public purchasing those goods or services, even paying good attention, to be confused, to mistakenly believe that the goods and services come from the same or economically linked undertakings.
71. I set out the Applicants' reason for denying a likelihood of confusion at paragraph 6(vii) of this decision, based on assertions made by the Opponent in proceedings before the UK Intellectual Property Enterprise Court. The judgment of Mr. Caddick KC in the IPEC is in evidence at Exhibit WGT9. Those proceedings concerned (amongst other things) questions of ownership of goodwill and whether, as a matter of fact, an audience would have been deceived as to give rise to passing off during any particular

performance by the two musical outfits, which involves questions of whether the audience would be deceived in fact during any particular performance. By contrast, this opposition involves the question of notional and fair use of the marks across the range of the relevant goods and services. There is no issue in the present case of acquired distinctiveness, and the matter proceeds on the basis of whether there is objectively a likelihood of confusion, based the Opponent's protection for *hi-fi sound systems* or for *music recordings*.

OUTCOME OF OPPOSITION:

- 72. The Opposition succeeds in relation to the goods and services that are similar and are scored through in the table below.
- 73. Subject to a successful appeal of this decision, the trade mark application may proceed to registration the goods and services that are not similar, and not deleted by way of score-through.

The applied-for goods and services - similarity (conceded or found) marked as deleted
<p>Class 9: Apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information; reproductions of sound and/or video in electronic and digital form, all supplied by means of multimedia, remote computers or on-line from databases or from facilities provided on the internet(including websites); sound storage media, image storage media and data storage media, all being pre-recorded; downloadable MP3; computer apparatus; computer software; computer programs; multimedia software including CD-Roms, DVD-Roms; digital media; computer software for access to databases relating to music, entertainers, performers, entertainment products, entertainment services and music-related products; computer software for securing digital content; computer programs for managing communications and data exchange relating to</p>

~~music, audio and~~ visual data; multimedia software for downloading ~~music, audio and~~ visual data; computer software for online trading; ~~CD recorders and players; DVD recorder and players; CDs, DVDs; audio tapes (all being sold together with booklets); pre-recorded vinyl records; sound and/or video recording on corresponding recording carriers; gramophone records; sound and/or video cassettes; cassettes for the storage of, or containing, tapes for or bearing sound or video recordings; magnetic tapes, discs, and magnetic wires, all for sound or video recording;~~ membership cards; electronic handheld devices for the wireless receipt and/or transmission of data; ~~digital audio and video devices;~~ head cleaning tapes; ~~audio cassette recorders and players, video cassette recorders and players, compact discs players, digital versatile discs recorders and players, digital audio tape recorders and players;~~ photographic and cinematographic apparatus and instruments; ~~television and radio apparatus;~~ microphones; ~~coin-operated juke boxes, coin or counter-feed sound or video reproduction apparatus;~~ unexposed photographic transparencies; parts and fittings for all the aforesaid goods.

Class 41: ~~Entertainment;~~ sporting and cultural activities; production of television and radio programs; ~~providing online entertainment; entertainment services; record production,~~ video production, radio entertainment production and distribution; publication of books and magazines in relation to music and entertainment; ~~entertainment in the nature of live concerts and performances; musical and audiovisual entertainment services; production, distribution and publishing of music and audiovisual material;~~ fan clubs; ~~entertainment in the nature of live concerts and performances by artists and groups; providing digital music and audiovisual material (not downloadable) from the Internet; entertainment services, namely personal appearances by groups, artists and celebrities; entertainment services in the nature of music and audiovisual material rendered by groups and artists through the medium of television, radio, cable, satellite and Internet programmes, shows, films, videos and DVDs; entertainment services rendered by groups and artists including recording performances;~~ entertainment services, namely, providing a web site featuring ~~performances, videos, related~~ film clips, photographs, ~~and other multimedia materials;~~ entertainment services namely live, televised and movie appearances by a professional entertainers; ~~conducting entertainment exhibitions~~

~~in the nature of live music and entertainment events;~~ sporting and cultural activities; production of television and radio programs; distribution of television and radio programs for others; ~~production and publishing of music;~~ ~~providing online entertainment, namely providing sound and video recordings in the field of music and music based entertainment;~~ ~~entertainment services, namely providing online non-downloadable pre-recorded musical sound and video recordings via a global computer network;~~ fan clubs; development and dissemination of educational materials of others in the field of music and entertainment; radio entertainment production and distribution; ~~audio and sound recording and production;~~ ~~record production;~~ videotape production; production of motion picture films; distribution of motion picture films; television program syndication; entertainment in the nature of ongoing television programs in the field of music and entertainment; entertainment, namely a continuing music and entertainment show distributed over television, satellite, audio, and video media; publication of books and magazines in relation to music and entertainment; entertainment in the nature of ongoing radio programs; ~~entertainment in the nature of live concerts and performances rendered by musical artists through the medium of television, radio, and audio and video recordings;~~ ~~entertainment services, namely recorded performances by musical artists;~~ educational and entertainment services, namely, production and presentation of television shows and music shows before live audiences which are all broadcast live or taped for later broadcast; entertainment services, namely, providing a web site featuring ~~musical performances, musical videos,~~ related film clips, photographs, ~~and other multimedia materials;~~ entertainment services, namely, providing on-line reviews of music, musical artists and music videos; entertainment services, namely, providing ~~pre-recorded music,~~ information in the field of music, and commentary and articles about music, all online via a global computer network; ~~entertainment services namely live, televised and movie appearances by a professional entertainer;~~ ~~conducting entertainment exhibitions in the nature of music festivals;~~ entertainment services, namely, conducting exhibitions in the field of music and the arts; organizing exhibitions for entertainment purposes featuring music and the arts; and publishing of web magazines in relation to music and entertainment; distribution of music; ~~distribution of musical sound recordings and video recordings;~~ ~~preparing audio-visual displays in the field of music.~~

THE REVOCATION

74. Section 46 of the Act deals with revocation of a registered trade mark. I set out relevant provisions at paragraph 13 of this decision:

75. The applicable legal principles on what constitutes “genuine use” of a trade mark as required in section 46(1)(a) are very well established. An authoritative summary is given by the Court of Appeal in *Easygroup*.⁶ Points from that summary are set out below (with citations omitted and underlining added for emphasis):

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark.

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark.

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin.

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns. Internal use by the proprietor does not suffice. ...

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark.

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including:

⁶ *Easygroup Ltd v Nuclei Ltd* [2024] FSR 9 (main judgment given by Arnold LJ) at [106]

- (a) *whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question;*
- (b) *the nature of the goods or services;*
- (c) *the characteristics of the market concerned;*
- (d) *the scale and frequency of use of the mark;*
- (e) *whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them;*
- (f) *the evidence that the proprietor is able to provide; and*
- (g) *the territorial extent of the use.*

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule.

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

...

[107] The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act ... In Awareness Ltd v Plymouth CC [2013] R.P.C. 24 Daniel Alexander QC sitting as the Appointed Person said:

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

...

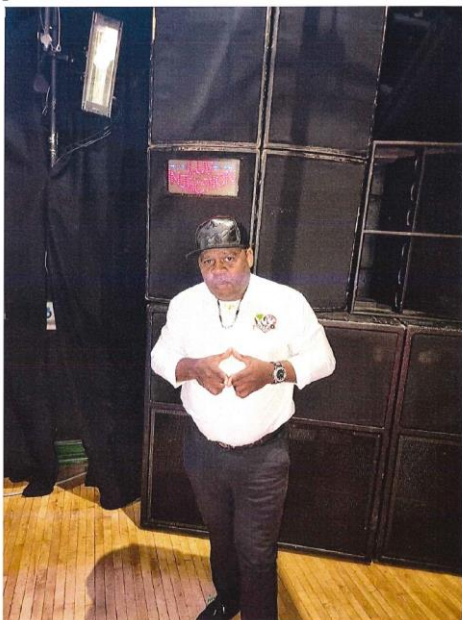
22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a

tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

76. The task before the Registered Proprietor is show that during the Relevant Periods – which span from May 2017 – February 2023 - the registered trade mark “LUV INJECTION SOUND” has been used in the UK as a badge of origin in respect of the **Class 9** goods that are specified in the registration, namely: *Hi-fi sound systems; Music recordings.*
77. In assessing genuine use, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant periods and to compare those findings with the goods or services for which the mark is registered. It is clear even from the claims of the Registered Proprietor/Opponent, that its activities under or by reference to the sign “Luv Injection Sound” do not support a finding of genuine use of that trade mark in respect of the registered goods.
78. As I noted in the pleadings section of this decision, the Opponent’s statement of grounds claims that “... *both parties are using the marks as the name of a Jamaican sound system (musical group) ...*” where “*the word “sound” merely describes the musical offering of both the Applicant and Opponent.*”
79. Although the Registered Proprietor states in its defence of the revocation action that it has made use of the Earlier Trade Mark in respect of the registered goods throughout the Relevant Periods, the use that is described does not satisfy the requirements of genuine use in relation to the goods. As noted previously, the counterstatement describes the claimed use as “*in respect of hi-fi sound systems in the course of*

performances and the rental/loan of such systems to other performers. The owner has also made use of the mark for sound recordings during each of the relevant periods including by making recordings available for download.” At paragraph 8 of his witness statement dated 20 December 2022, the Registered Proprietor confirms that “Luv Injection and Love Injection are both used in respect of Jamaican sound systems, a form of musical group, made up of DJs, engineers and MCs, playing principally reggae music.”

80. The evidence filed at most confirms use of the sign in respect of services in the nature of musical performances, where the Registered Proprietor and others would provide entertainment involving an impressive array of sound equipment and featuring music recordings. The evidence includes images of the equipment used, such as these:⁷



18 December 2022



81. Although not shown with clarity, it is possible to discern that the sign on the speakers, just above the man in the image on the left, does read “Luv Injection”. I also acknowledge that the equipment is an important part of the musical offering provided by groups such as that led by the parties in these proceedings. I acknowledge, too, the cultural description of the musical offerings as “Jamaican sound systems”. However, there is no suggestion that the speakers, amplifiers, mixers and other audio equipment used by the groups are goods for which the parties are economically responsible. The sign on the speaker is simply promotional of the group offering the

7 Exhibit WGT1

musical services. Whilst the parties will likely have purchased and sensitively accumulated the various audio equipment to deliver the desired musical experience, the hi-fi system will be composed of elements under trade marks that are not the Earlier Trade Mark. I note, for example, that there is reference to “a Pioneer controller was hired out for the Simmerdown event.”⁸ There is no evidence, or even suggestion, that Class 9 goods in the form of a hi-fi sound system have been made and branded under the Earlier Trade Mark, or marketed for sale.

82. Likewise, while the Registered Proprietor states that recordings were made of Luv Injection (as the group was previously composed), very little information or evidence is provided around any such music recordings. The Registered Proprietor states that “events were regularly recorded and put online; recordings were used for promotions and as a memento of the event and for people who were unable to attend.” He refers to the potential for social media content “views” to begin to monetise on attaining a certain critical mass. This appears no more than an expression of the witness’s understanding of a general principle. There is nothing in the evidence indicating sales or income from music recordings. I agree with Mr Wood’s submission that any recordings referenced in the evidence are ancillary to, and intended to create or maintain a market for, musical entertainment services. The use shown in the evidence has not established or maintained a market for goods that are *hi-fi sound systems* or *music recordings*.
83. **OUTCOME:** The Registered Proprietor has not established that there has been genuine use of the Earlier Trade Mark in respect of the goods for which it is registered in Class 9. Since there is no evidence satisfying genuine use at any stage of the 5-year periods following registration, **the Earlier Trade Mark (No. 3212085) is revoked in its entirety** as from the revocation date sought under section 46(1)(a), namely **6 May 2022**.

COSTS

84. Winston Thomas, as the Opponent in the Opposition proceedings, succeeded in preventing registration of around 75% of the goods applied-for in Class 9 and around 50% of the services applied-for in Class 41. As the Registered Proprietor in the Revocation proceedings, Winston Thomas has not succeeded in defending the revocation of his Earlier Trade Mark. In these consolidated proceedings, the Applicants have therefore had partial, though lesser, success in the Opposition, but full success in the Revocation.
85. In addition to the parties' respective levels of success and failure in this present substantive decision, I note too that the Applicants will have incurred costs from the attendance (and preparation of a skeleton argument) for the case management conference held on 14 August 2020. That CMC was convened at the instigation of the Opponent. Although at that CMC I forbore from striking-out the section 5(4)(a) claim, pending appeal of the High Court ruling, this had little material impact on the course of these proceedings. It transpired that the section 5(4)(a) claim did indeed fall away (for the reasons that had been indicated in the preliminary view that had been challenged by the Opponent), and CMC anyway also confirmed both a stay of the proceedings and payment of security of costs (based on a failure to make timely payment of costs in previous proceedings between the parties). The letter following that CMC ordered Winston Thomas to pay to his attorneys (Higgs & Sons) the sum of £1500 to be held by them as security towards potential costs in favour of the Applicants in these proceedings. On 2 October 2020, Julia Lowe of that attorney firm (now Higgs LLP) confirmed receipt of that sum by way of security for costs.
86. The majority of the evidence in the present proceedings was filed by the Opponent/Registered Proprietor. Notwithstanding the greater degree of success enjoyed by the Opponent in the Opposition, none of that evidence contributed to such success. Conversely, in the Revocation, despite the defence evidence filed by the Registered Proprietor (which the Applicant(s) will have needed to consider and respond to) the Revocation Applicant succeeded in revoking the Earlier Trade Mark in its entirety. Taken with the costs incurred at the CMC in 2020, it seems to me that the greater entitlement to costs lies with the Applicants. Although only one of the Trade

Mark Applicants applied to revoke the Earlier Trade Mark, they all agreed in these consolidated proceedings to be jointly and severally liable for costs,⁹ so it is appropriate that the benefit of the costs award is likewise equally distributed.

87. I order Winston Thomas to pay to the Applicants the sum of £1400 – namely £350 each to Ian George Thomas, Rochelle Thomas, Shirmala Higgins and Orville Anthony Billy Higgins.¹⁰ The costs are to be paid from the £1500 held in security by Higgs LLP; the small remainder of the security sum held is to return to Winston Thomas. The costs payable to the Applicants should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of June 2025

Matthew Williams

Hearing Officer

For the Registrar

9 Confirmed by email from Mr Wood of Brandsmiths on 5 May 2023, to Julia Lowe and Tribunal Section addresses.
10 It is noted that sadly, Mr Orville Anthony Billy Higgins has passed away since the commencement of these proceedings. His share of the costs award shall be made to his heirs.