O-0593-25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO 3874470

IN THE NAME OF MATTHEW JAMES MCMILLAN

FOR THE FOLLOWING MARK:

IYKYK

IN CLASSES 18, 25, 35 & 42

AND

OPPOSITION THERETO (UNDER NO. 440308)

BY

MICHAEL FISHER

BACKGROUND

1) On 03 February 2023, Matthew James McMillan ('the applicant') applied to register the trade mark, IYKYK, in the UK, in respect of the following goods and services:

Class 18: Pet clothing; Clothing for animals; Clothing for pets; Pets (Clothing for -); Bags for sports clothing.

Class 25: Clothing; Knitwear [clothing];Jackets [clothing];Ready-to-wear clothing; Woolen clothing; Furs [clothing];Clothing layettes; Layettes [clothing];Garments for protecting clothing; Linen clothing; Headbands for clothing; Headbands [clothing]; Clothes; Gloves as clothing; Gloves [clothing];Aprons [clothing];Maternity clothing; Kerchiefs [clothing];Jerseys [clothing];Shorts [clothing];Denims [clothing];Cashmere clothing; Capes (clothing);Oilskins [clothing];Gabardines [clothing];Silk clothing; Clothing of leather; Leather clothing; Leather (Clothing of -);Parts of clothing, footwear and headgear; Collars [clothing];Veils [clothing];Knitted clothing; Corsets [clothing, foundation garments];Embroidered clothing; Hoods [clothing];Windproof clothing; Wristbands [clothing];Belts for clothing; Belts [clothing];Casual clothing; Rainproof clothing; Bandeaux [clothing];Waterproof clothing; Jackets being sports clothing; Visors [clothing];Jackets (Stuff -) [clothing];Stuff jackets [clothing];Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Latex clothing; Trunks being clothing; Playsuits [clothing];Woven clothing; Infant clothing; Drawers [clothing];Drawers as clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Ties [clothing];Clothing for children; Muffs [clothing];Bodies [clothing];Clothing for infants; Clothing for babies; Tops [clothing];Weatherproof clothing; Clothing for cycling; Water-resistant clothing; Fabric belts [clothing];Pockets for clothing; Handwarmers [clothing];Clothing for skiing; Beach clothing; Triathlon clothing; Chaps (clothing);Thermal clothing; Cowls [clothing];Fishing clothing; Men's clothing; Dance clothing; Mitts [clothing];Braces for clothing; Plush clothing.

Class 35: Retail services connected with the sale of clothing and clothing accessories.

Class 42: Design of clothing, footwear and headgear; Designing of clothing; Design of clothing; Design of clothing accessories.

2) The application was published in the Trade Marks Journal for opposition purposes on 17 March 2023 and opposition was later filed by Michael Fisher ('the opponent'). The opponent claims that the application offends under Section 5(3) of the Trade Marks Act 1994 ('the Act'). In support of that ground, the opponent relies upon the following trade mark registration:

- **UKTM 3694487**

Class 25: Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Hoods [clothing]; Leisure clothing; Infant clothing; Childrens' clothing; Sports clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Jerseys [clothing]; Bodies [clothing].

Class 34: Smoking pipes; Smoking tobacco; Electronic smoking pipes; Vaporizers for smoking purposes; Smoking sets for electronic cigarettes; Smoking urns; Herbs for smoking; Smoking pipe cleaners; Pipes for smoking mentholated tobacco substitutes; Tea for smoking as a tobacco substitute.

Filing date: 14 September 2021
Date of entry in register: 14 January 2022

3) It is claimed that the earlier mark has a reputation in the UK. It is further claimed that it is well-known that 'IYKYK' is an abbreviation of 'If You Know You Know' and that use of the contested mark would lead to unfair advantage and damage to the earlier mark's reputation and distinctive character.

4)The trade mark relied upon by the opponent is an 'earlier mark' in accordance with section 6 of the Act. As it had not completed its registration procedure more than five years prior to the date on which the contested application was filed, it is not subject to the proof of use conditions, as per section 6A of the Act.

5) The applicant filed a brief counterstatement stating that there is no likeness whatsoever between the relevant marks and disagreeing with the opponent's statements.

6) Neither party is legally represented. The opponent filed evidence in the form of a witness statement from Michael Fisher with seven exhibits[1]. Neither party requested a hearing nor filed written submissions in lieu. I now make this decision based on the papers before me.

DECISION

7) 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. Hence, this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

[1] IYKYK01 – IYKYK07

8) Section 5(3) of the Act provides, as follows:

> "(3) A trade mark which-
>
> (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
>
> (3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

9) The relevant case law can be found in the following judgments of the Court of Justice of the European Union (CJEU): *General Motors Corporation v Yplon SA*, C-375/97, EU:C:1999:408, [1999] ETMR 950; *Intel Corporation, Inc. v CPM United Kingdom Limited,* 252/07, EU:C:2008:655, [2009] ETMR 13; *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.,* C-408/01, EU:C:2003:582, [2004] ETMR 10; and *L'Oréal & Ors v Bellure & Anor*, C-487/07, EU:C:2009:378, [2009] ETMR 55; *Interflora & Anor v Marks & Spencer & Anor*, C-323/09, EU:C:2011:604; and *Environmental Manufacturing LLP v OHIM*, C-383/12P, EU:C:2013:741. 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 Saloman*, paragraph 29 and *Intel*, paragraph 63.

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

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

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

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

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

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

earlier mark, the easier it will be to prove that detriment has been caused to it: *L'Oréal v Bellure NV*, paragraph 44.

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

Reputation

10) The first hurdle that the opponent must overcome under section 5(3) of the Act is to show that the earlier mark had a reputation in the UK on the date that the applicant's mark was filed. The relevant date in these proceedings is, therefore, **03 February 2023.** If the evidence does not establish the existence of a reputation on the relevant date, the opponent's case must fail. This is because, without a qualifying reputation, there can be no link made in the consumer's mind between the relevant marks nor can there be any unfair advantage taken of, or damage to, the earlier mark.

11) In *General Motors,* the CJEU gave guidance on what is required to establish the necessary reputation:

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

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

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

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

12) The opponent's evidence is very thin. Insofar as demonstrating the use that has been made of the earlier mark for the goods relied upon, there are four relevant exhibits[2]. These consist of the following:

- Exhibit IYKYK1: A print from what is said to be the opponent's distributor's website listing products for sale including grinders and rolling trays. The opponent does not say that this page is representative of how that website looked before the relevant date and the copyright date on the website is 2024. On the face of it, this page, therefore appears to emanate from after the relevant date.
- Exhibit IYKYK2: An image of a flyer that is said to be distributed with the opponent's products. The flyer is entitled "#IYKYK 2023 Product Highlights". Products such as grinders, ashtrays and rolling trays are shown on the flyer. As this appears to be the same flyer as shown in exhibit IYKYK3, it appears that the said flyer was created after the relevant date (on 28 May 2023).
- Exhibit IYKYK3: A print from the opponent's account on vistaprint.com. stating that the design of the flyer was created on their website on 28 May 2023. This is clearly from after the relevant date.

[2] IYKYK1 – IYKYK4

- Exhibit IYKYK4: A print from the website ‘Exhale Harm Reduction Centre’ showing the same flyer as in IYKYK2. This is undated.

This evidence comes nowhere near establishing the requisite reputation. It is not clear that any of the evidence comes from before the relevant date. There is no evidence of turnover, no evidence of any marketing or advertising spend and no evidence of market share. As the opponent has failed to overcome the first hurdle of demonstrating a reputation, the opposition must fail.

OUTCOME

13) The opposition fails.

COSTS

14) As Matthew James McMillan has been successful, he is, in principle, entitled to an award of costs. The official letter, dated 20 September 2024, advised Mr McMillan that, if he intended to make a request for an award for costs he should complete and return the relevant costs proforma by 18 October 2024. The same letter stated, inter alia, that:

> “If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

No costs proforma was filed by Mr McMillan and he has paid no official fees in these proceedings. Bearing this in mind, I make no award of costs.

Dated this 30th day of June 2025

Beverley Hedley
For the Registrar