O/0673/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003649300
BY GHOST BRAND LIMITED TO REGISTER:

GHOST

GHOST

(SERIES OF TWO)

AS TRADE MARKS IN CLASSES 2, 5, 6, 8, 9, 11, 12, 15, 23, 26, 28, 29, 30, 31, 34 & 44

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 435197 BY
GHOST FOUNDATION LIMITED

BACKGROUND AND PLEADINGS

1. On 31 May 2021, Ghost Brand Limited ("the applicant") applied to register the series of trade marks shown on the cover of this decision ("the application") in the UK. Currently, registration is sought for the goods and services listed in **Annex 1** of this decision.[1]

2. The application was published for opposition purposes on 22 April 2022 and, on 22 July 2022, it was opposed by Ghost Foundation Limited ("the opponent"). The opposition is aimed at only the following goods:[2]

   Class 9: Mobile apps; laptop cases; mobile phone cases; parts, fittings and accessories for all the aforementioned goods.

3. The opposition is reliant upon sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). In respect of the 5(1), 5(2) and 5(3) grounds, the opponent relies on the following mark:

   GHOST
   UK registration no. 912308946[3]
   Filing date 13 November 2013; registration date 14 April 2014
   Relying on all goods and services namely:

   Class 9: Computer software which provides the facility to share text, data, sound and images, excluding computer imaging software; computer software operated online, which provides the facility to share text, data, sound and images, excluding computer imaging

[1] The applicant's mark, since publication, has been subject to an opposition and as I will come to discuss below, a number of specification amendments.
[2] It is noted that the scope of the opposition originally extended to a broader set of class 9 goods. However, the applicant subsequently amended its specification on a number of occasions. As such, the goods initially targeted in the notice of opposition are significantly different than those that remain on the register. However, the opponent's written submissions in lieu refer to a similarity between the goods listed here and those relied upon. I will, therefore, take this to be the opponent's case.
[3] The opponent's mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

software; computer software for creating dynamic websites and blogs.

Class 38: Provision of on-line communication services, blogs and forums.

Class 42: Hosting of websites on the internet, specifically websites used to host online blogs, forums and journals; creating and maintaining of blogs for others; hosting of digital content, namely on-line journals and blogs; providing temporary use of non-downloadable computer software for use in the creation and publication of on-line journals and blogs; maintenance of websites and hosting on-line web facilities for others in relation to online blogs, forums and journals; design and creation of websites for others, primarily for the purpose of hosting online blogs, forums and journals; development, programming and implementation of computer software operated online, which provides the facility to share text, data, sound and images, excluding computer imaging software; advice and consultancy in respect of all aforesaid services; hosting services and software as a service and rental of software operated online, which provides the facility to share text, data, sound and images, excluding computer imaging software.

4. Under the section 5(1) ground, the opposition is targeted only against those goods I have underlined above, being those that the opponent claims to be identical. In addition, the opponent argues that due to the marks being identical, the application should be refused. As for the section 5(2)(a) ground, the opponent maintains its position that the marks are identical, however, it argues that because the goods at issue are identical or similar to its own goods and services, there exists a likelihood of confusion between the marks. The opponent's reliance upon the section 5(2)(b) ground is such that if the marks are not considered identical, then they are highly similar and, relying on the same argument as to identity/similarity of the goods and services at issue, the opponent's position is that there is a likelihood of confusion under this ground also.

5. Under the section 5(3) ground, the opponent claims that its mark has been used continuously throughout the UK since 2013 and, therefore, enjoys an established and well-developed goodwill and reputation. In using the identical/highly similar marks of the application, the opponent claims that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between them. As a result, the opponent claims that the application takes unfair advantage of the opponent's marks and is detrimental to the distinctive character of the same.

6. Lastly, under the section 5(4)(a) ground the opponent relies upon the unregistered sign 'GHOST' that it claims to have used throughout the UK since as early as 2013 in respect of the same goods and services for which its earlier mark is registered, being those reproduced as paragraph three above. The opponent claims to enjoy a protectable level of goodwill in its sign and use of the applicant's identical/similar mark would constitute a misrepresentation as to the commercial origin of the goods which would cause damage to the opponent.

7. The applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use of its mark.

8. The opponent is represented by Mathys & Squire LLP and the applicant is represented by Murgitroyd & Company. During the evidence rounds, the opponent filed evidence in chief and also filed written submissions. The applicant did not file evidence in chief but did file written submissions. In reply, the opponent filed further evidence and submissions. Neither party requested a hearing and both parties filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying

assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

10. The opponent's evidence in chief came in the form of the witness statement of Mr John O'Nolan dated 30 January 2023. Mr O'Nolan is the CEO of the opponent, a position he has held since 2013. Mr O'Nolan's evidence is accompanied by nine exhibits, being those labelled JO1 to JO9 and speaks to the opponent's use of its mark. As for the opponent's evidence in reply, this came in the form of the witness statement of Mr Gary William Anthony Johnston dated 26 October 2023. Mr Johnston is a Chartered Trade Mark Attorney at the opponent's representative firm and is, therefore, duly authorised to file evidence on its behalf. Mr Johnston's evidence is accompanied by four exhibits, being those labelled GWAJ1 to GWAJ4, and was filed in response to the written submissions of the applicant.

11. I do not intend to summarise the opponent's evidence or either parties' written 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.

PRELIMINARY ISSUE

Claimed expiry of the opponent's mark

12. In the applicant's submissions, I note that it raised an issue regarding the fact that the opponent's mark was due for renewal on 13 November 2023. The applicant claims that the mark was not renewed and is now deemed to have expired. Having considered the register, it is noted that the opponent's mark was renewed on 28 December 2023. While this was after the expiry date, the correspondence from the Registry set out that the mark could be renewed up to six months after the date of expiry. The opponent's mark is now due for renewal on 13 November 2033 and has not, as the applicant suggests, expired.

Ghost Foundation

13. Also in the applicant's submissions, it sought to make an issue of the fact that the opponent's evidence was filed by John O'Nolan who is confirmed in the evidence as being the CEO of Ghost Foundation and not Ghost Foundation Limited. Therefore, it argues that the opponent's evidence and submissions, for that matter, were not filed on behalf of the opponent. Having considered the applicant's arguments, I note that this point was not taken up in its own submissions filed during the evidence rounds. Instead, the applicant's primary position at that time was that the requirements for genuine use, reputation or goodwill were not met in the opponent's evidence. If this were a genuine point of dispute, I consider it reasonable to suggest that the applicant should have raised it at that time and the opponent could have elected to respond to the issue in reply.

14. By taking the approach that it has, it appears to me that the applicant reserved this issue until the filing of written submissions in lieu as to do so would mean that the opponent would have no means by which to respond. In my view, this is procedurally unfair and if it were a serious point for the opponent to have to contend with, I would re-open the evidence rounds to allow for the opponent to address the issue. However, I see no merit in the argument raised by the applicant so do not consider it necessary to take this step at this time. I say this because I consider it reasonable to suggest that the reference to Ghost Foundation can be read as a reference to Ghost Foundation Limited on the basis that the address given for the opponent in its notice of opposition is the same address given by John O'Nolan in his evidence. It was, therefore, plainly intended that the evidence covers use by that same undertaking. Further, I note that the opponent's evidence does contain reference to Ghost Foundation Ltd (by way of confidential invoices at Exhibit JO3). Clearly, this implies that Mr O'Nolan had access to the appropriate records of the opponent. For the avoidance of doubt, I will say nothing further on this point.

DECISION

Proof of use

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

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> (aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;
>
> (ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.
>
> […]
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

16. Section 6A is also relevant. It reads:

"(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the

mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5)-(5A) [Repealed]

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

17. Section 100 of the Act is also relevant. It reads:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

18. As the opponent's first mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

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

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

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

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

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

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

19. Given its filing date, the opponent's mark qualifies as an earlier trade mark under the above provisions. The opponent's mark had completed its registration processes over five years prior to the filing date of the applicant's mark. As set out above, the applicant requested that the opponent provide proof of use in respect of the same. Therefore, the opponent's mark is subject to the proof of use assessment.

20. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v*

Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the

sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

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

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

21. As per section 6A of the Act (cited above), the relevant period for the present assessment is the five-year period prior to the filing date of the applicant's mark, being 31 May 2021. The relevant period is, therefore, 1 June 2016 to 31 May 2021 ("the relevant period").

22. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[4] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

23. In respect of the issue of genuine use, I have submissions from both parties. I have considered these submissions and while I do not intend to reproduce them here, I will state briefly that the opponent's position is that it has genuinely used its mark during the relevant period but it is the applicant's position that it has not. Even though I have submissions from the parties, the assessment I must make here is based upon my own assessment of the evidence before me. Any determination of the evidence will be made on the basis of the case law above and not on the submissions filed.

Evidence of use

24. The opponent's evidence confirms that its 'GHOST' brand was founded in the UK in 2013 following a Kickstarter campaign. The focus of the company was to create a new platform for professional publishing with an aim to create and offer open-source tools for journalists and content creators around the world. In 2017, the company moved to Singapore.

[4] *Jumpman* BL O/222/16

25. The opponent's business is built around what it refers to as a 'free core application' that runs on a premium platform as a service. In addition, the evidence discusses a piece of software that is used for the online publishing of news, journalism, blogs, magazines, newsletters and journals. This software has a desktop functionality for writing and sharing media, collaborating with other users, creating membership signups, taking payments and running an online community or business. The evidence confirms that both its software and platform can be downloaded.

26. In respect of the users of the 'Ghost' platform, the evidence sets out that it powers a range of websites and that its clients include individual bloggers as well as writers and editors of some of the largest organisations in the world. I also note that, as at the date of the witness statement, the 'Ghost' platform has been installed over 3.1 million times. While noted, this figure is to be taken as being true as at the date of the statement, being 30 January 2023, which is around 18 months after the end of the relevant period. Therefore, the full figures cannot be reflective of the position during the relevant period. Further, the fact that the opponent claims that its products are aimed at journalists and creators from around the world means that it is likely that some of these users are from outside of the relevant territory (being the EU until 31 December 2020 and the UK thereafter). As a result, I must take the user figures with a degree of caution.

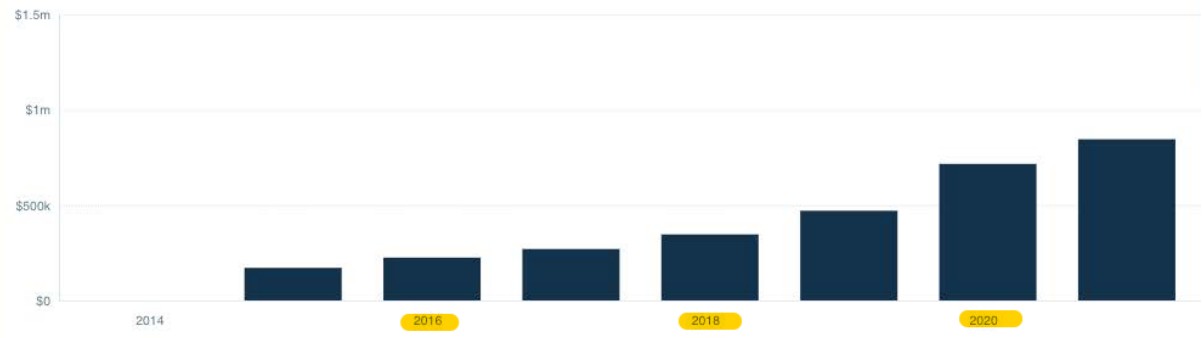
27. Evidence in relation to what is referred to as the 'annual run rate' is provided.[5] The narrative evidence confirms that the annual run rate is the aggregate sum of the value of all active premium monthly and yearly subscriptions that will occur over the next 12 calendar months. This information is shown in graph form. The first graph provided covers information taken from January 2015 to January 2022[6] and shows a total annual run rate of $5,615,235 with 4 billion requests a month[7] and 17,771 active customers during this time. I note that the second graph provided

[5] JO1
[6] The last date covered by this graph is September 2021. However, I note that the graph continues after this date and based on the intermissions on the graph provided (being January, May and September of each year), it is logical to infer that the set of information following September 2021 ran up until January 2022.
[7] I have nothing to suggest what a 'request' is.

covers the same time period as the first, however, the annual run rate figure as at May 2021 is shown. I note that this shows an annual run rate was $3,499,716.

28. Further information is provided via a graph that appears to show that, by February 2021, the opponent had 6,271 active customers, a monthly run rate of $254,465 and 2.5 million installs.

29. My criticism of the above evidence would naturally focus on the fact that the figures appear to be global. However, the opponent has helpfully provided evidence regarding its annual run rate in Europe and the UK between 28 December 2014 and 16 January 2023.[8] This information is provided via a bar graph and, for ease, I will simply reproduce the graph below (though I will omit the figures from 2022 as they fall after the relevant date):



30. The above graph clearly represents a steadily increasing level of use that reached almost $1 million worth of annual run rates per year for Europe (including the UK). In support of UK and EU use, a range of sample invoices has been provided.[9] I note that this exhibit is subject to a confidentiality order so I will refrain from discussing it in full detail. However, I will say that there are 30 invoices of different subscription levels (Basic, Business and Personal Pro, for example) to customers that the narrative evidence confirms as being from the UK and the EU. I note that, of the 30 invoices provided, 28 are from within the relevant period, however, two

[8] JO2
[9] JO3

are from after its conclusion. I do not consider that the inclusion of two invoices outside of the relevant period does anything to alter the opponent's case.

31. When the opponent launches a new product or feature, it is announced on its website. Printouts of the website showing such posts are provided in evidence.[10] While a number of posts shown are from after the relevant period, a range of them are from between 1 March 2017 and 5 April 2021. Of the relevant posts, I note that there is reference to new features offered within the 'Ghost' software. The narrative evidence confirms that these have been seen by 320,000 users worldwide and 86,000 users in Europe and the UK. Information regarding the opponent's website, generally, is provided and I note that the evidence confirms that this has been visited almost 2.5 million times by visitors in Europe between 1 January 2016 and 31 December 2021. A printout taken from Google Analytics is provided to confirm this.[11]

32. A printout is shown of the opponent's Twitter account which is taken from the internet archive facility, the Wayback Machine.[12] This is dated 7 May 2021, being just at the end of the relevant period and shows that, at that time, the opponent had 35,000 followers. While noted, the exhibit immediately preceding this one shows that the biggest user base for the opponent's goods/services are based in the Americas. Further, I note that while Europe is the second largest user base, Asia comes a close third. As a result, it is likely that the majority of the followers of the opponent's Twitter account will be users from outside the relevant territory.

33. The evidence moves to discuss press coverage of the 'Ghost' brand. Examples of this press coverage is provided in evidence.[13] I note that this evidence spans 139 pages of articles. My issue with the evidence is not in its length but the fact that a wide range of the articles are from outside the relevant period. Those articles provided after the relevant period have no relevance to these proceedings and there is no indication from the opponent as to whether they can be said to cast light

[10] JO4
[11] JO5
[12] JO6
[13] JO7

backwards on the position during that time. However, the articles from prior to the relevant period, while not strictly relevant to the present assessment, will become relevant below when considering this issue of distinctiveness, reputation and goodwill. In addition, the evidence covers a wide range of publications and while some of these (such as WIRED and the Guardian)[14] are widely known publications, the majority of them are not. On this point, I note that there is nothing before me to suggest the level of readership or reach of these publications across Europe or the UK. As such, I do not consider that the evidence is of any real assistance to this issue of genuine use.[15]

34. Lastly, the evidence discusses the opponent's product usage data which shows that the UK is the opponent's third largest user base.[16] While the printout showing this is undated, it appears to me to be based on statistics taken from 2013 to 2022, therefore it can be said to cover the relevant period. I note that this same data set seemingly shows an additional range of data. However, this data covers a range of information but provides no explanation as to what it actually shows. For example, the printout includes a number of graphs but provides nothing to suggest what these graphs are meant to represent. I also note that a list of UK based websites is provided that seemingly lists websites that use the 'Ghost' platform in order of their traffic. While noted, I fail to see what use of the 'Ghost' platform by high traffic websites offers beyond the evidence I have already discussed above regarding the opponent's user figures and run rate data.[17]

35. As for the opponent's evidence in reply, this is aimed mostly at the goods and services comparison. However, I do wish to briefly touch upon the fact that the opponent has provided a printout from its website from the Wayback Machine dated 25 January 2020 which confirms that its goods are available as both desktop

[14] All articles from these publications (of which there are three) are from 2013 and, therefore, are from prior to the relevant period.
[15] On this point, I note that follower figures are provided at JO8 for a Charlotte Crosby, being an author of one of the undated articles from JO7. However, the article is undated and, therefore, it is not possible to determine whether the actual post shown to me in evidence is from the relevant period. In any event, I am not convinced that a follower figure on social media is reflective of a significant readership of one's personal blog.
[16] JO9
[17] In addition to this evidence, I note that the opponent sought to introduce printouts of these websites in reply at GWAJ4. While noted, I see no reason to consider them further based on the same point made here.

and mobile apps.[18] While there are no download figures for the mobile app, I consider it reasonable to infer that a fair proportion of the users of the opponent's products/services would also use its mobile app.

Assessment of use

36. In considering the evidence as a whole, it is clear to me that during the relevant period the opponent made a genuine attempt to create and preserve a market share in respect of the goods and services that it offers. I appreciate that the user base figures are somewhat imprecise in that they cover global use, however, the UK and Europe annual run rates are such that they clearly reflect a sufficient user base in the relevant territories. On this point, I wish to point out that while the figures provided are in dollars and no conversion is provided, I see no reason not to infer that the figures still equate to a sizeable amount in British sterling or Euros.[19] As a result, I am satisfied that the opponent has genuinely used its mark during the relevant period.

37. Despite my finding of there being genuine use, I do not consider that this finding extends to all goods and services relied upon. On this point, I do not intend to go into a full fair specification assessment as I consider that it is quite clear from the evidence what it is that the opponent's offers, namely downloadable software (be that desktop software or mobile apps) and a platform as a service for users to create and share their blogs or websites. I note that the opponent's class 9 terms can all be said to cover software for this purpose so I am content to grant use for the same.[20] As for its class 38 services, I appreciate that the software/platform is for blogs, however, I do not consider that the opponent is actually providing a communication service in class 38. Lastly, I move to the class 42 services. I do not consider that the evidence is sufficient to show that the opponent actually hosts its

[18] GWAJ1
[19] I make this finding regardless of whether the $ symbol is meant to reflect US dollars or Singapore dollars (being where the opponent is now based).
[20] Even if it were not the case that 'mobile apps' were covered in the evidence, I consider the terms as registered are reflective of a fair specification on the basis that this is how average consumers would seek to describe the opponent's use of its mark. (see *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch))

users websites which are more likely to be hosted by the website itself or through third party hosting service providers. Further, I do not consider that the opponent actually designs the blogs/websites itself but, instead, offers a platform to the user so that they can do it themselves and I consider that any service in respect of the same is suitably covered by the evidence before me.

38. As a result of the above, I consider that the opponent may proceed in reliance upon the following:

Class 9:	Computer software which provides the facility to share text, data, sound and images, excluding computer imaging software; computer software operated online, which provides the facility to share text, data, sound and images, excluding computer imaging software; computer software for creating dynamic websites and blogs.
Class 42:	Providing temporary use of non-downloadable computer software for use in the creation and publication of on-line journals and blogs; software as a service and rental of software operated online, which provides the facility to share text, data, sound and images, excluding computer imaging software.

Sections 5(1) and 5(2)(a)

39. Section 5(1) of the Act reads as follows:

> "(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

40. Section 5(2)(a) of the Act reads as follows:

> "(2) A trade mark shall not be registered if because –

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

[…]

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

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

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

Identity of the marks

42. It is a pre-requisite of both section 5(1) and 5(2)(a) of the Act that the trade marks are identical. I note that in its counterstatement, the applicant denied that the marks are identical or similar. Plainly, this is not the case for any comparison between the opponent's mark and the first mark in the application, both being for the word only mark, 'GHOST'. Despite the fact that the second mark in the application is figurative, it remains a standard representation of that same word element and I am of the view that it is still identical to the opponent's word only mark. I make this finding because the opponent's mark, being a word only mark in black and white, is capable of being presented in any standard typeface and in any colour. Therefore, it is capable of being used in the exact same way as the second mark in the application. Even if this were not the case, I remind myself of the case of *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA,* Case C-291/00, wherein the Court of Justice of the European Union ("CJEU") held that:

"54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

43. In my view, the use of stylisation in the applicant's second mark is so banal that any differences created by this would be viewed as so insignificant that they would go unnoticed by an average consumer. Given the identity of all marks, the opposition in reliance upon section 5(1) and 5(2)(a) may proceed.

Comparison of goods and services

44. The competing goods and services are as follows:

The opponent's goods and services	The applicant's goods
Class 9 Computer software which provides the facility to share text, data, sound and images, excluding computer imaging software; computer software operated online, which provides the facility to share text, data, sound and images, excluding computer imaging software; computer software for creating dynamic websites and blogs. Class 42 Providing temporary use of non-downloadable computer software for use in the creation and publication of on-line journals and blogs; software as a service and rental of software operated online, which provides the	Class 9 Mobile apps; laptop cases; mobile phone cases; parts, fittings and accessories for all the aforementioned goods.

facility to share text, data, sound and images, excluding computer imaging software.	

45. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

47. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

48. I appreciate that the opposition reliant on the section 5(1) ground is aimed only at "mobiles apps" and "parts, fittings and accessories for all the aforementioned goods". Rather than conduct a separate comparison in respect of only those goods, I will simply conduct a full comparison of all goods and services at issue. I will say, however, that if I find the above goods to be identical to the opponent's goods then the opposition against those goods will succeed. Alternatively, if these goods are similar to any degree (or not similar), the section 5(1) ground will fail. However, these goods are targeted under both the section 5(2)(a) and 5(2)(b) grounds (which only requires a level of similarity to proceed) so the opposition may still proceed on that basis. If necessary, I will discuss this point further at the conclusion of my comparison.

49. Both parties have filed submissions in respect of the identity and similarity (or lack thereof) of the goods and services at issue. I do not intend to reproduce these here but confirm that I have taken them into account in making the following comparison.

50. The applicant's specification includes the term "mobile apps". A mobile app is a type of computer software for use on a mobile device. Further, the term is sufficiently broad that it can be said to cover mobile apps for any purpose, including for creating websites and blogs. As such, this term can be said to cover "computer software for creating dynamic websites and blogs" which, itself, can include mobile computer software. These goods are, therefore, identical under the principle

outlined in *Meric*. If I am wrong to find identity between these goods then I consider them to be similar to at least a medium degree on the basis that they overlap in purpose, trade channels and user and share a competitive relationship.

51. I turn now to consider both "laptop cases" and "mobile phone cases" in the applicant's specification. In considering these goods, it is clear that their natures, methods of use and purposes differ from the goods and services covered by the opponent's specification. Additionally, the goods are not competitive and neither are they complementary to the opponent's goods and services. This leaves user and trade channels. I appreciate that the user may overlap, however, any overlap is on a very broad basis given the size of the user base for the applicant's goods. Lastly, in respect of trade channels, I note that the opponent has filed evidence in reply that it claims to prove that producers of software goods also produce and sell mobile phone and laptop cases.[21] This evidence is in the form of a number of printouts from RedBubble which show phone and laptop cases for sale bearing the brands WIX, Shopify and Joomla.org. While noted, I do not consider that it is of any assistance to the opponent. I say this because the goods shown in this evidence are not those produced or sold by the undertakings that actually produce the software under the brands WIX, Shopify or Joomla. Instead, the goods in evidence appear to be those that are designed and sold by unconnected third parties.[22] On this point, I appreciate that large undertakings such as Apple or Samsung produce their own software and also their own laptop and phone cases,[23] however, this does not equate to such a practice being common in the trade. As such, I am not willing to find that there exists any overlap in trade channels between the goods and services at issue here. Taking all of this into account, I am of the view that an overlap in user is not sufficient to warrant a finding that these goods are similar to the opponent's goods and services. They are, therefore, dissimilar.

[21] GWAJ3
[22] For example, the Joomla products are set out as being designed and sold by Artinkshop.
[23] I do not consider much turns on this point but, for the avoidance of doubt, I do not consider this is something that would be subject to any serious dispute. Therefore, in accordance with *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08, this is something I am entitled to take judicial notice of.

52. I move now to consider the term of "parts, fittings and accessories for all the aforementioned goods". I will first consider this term in conjunction with the applicant's 'mobile apps'. I will begin by setting out that it is my view that accessories for mobile apps may cover devices that are plugged in to the device that is running the software and then the device is used to offer some sort of control over the software or the provision of additional features. As for parts and fittings, I am not entirely sure what parts and fittings for mobile apps could cover. Having said that, whatever goods the applicant's term can be said to cover, I consider that it will share a degree of similarity with the opponent's computer software goods. This is on the basis that, as set out above, the opponent's terms cover mobile software and, therefore, I consider it reasonable to conclude that the applicant's parts, fittings and accessories for the same would be produced by the same undertaking as the software goods themselves. Further, the goods would be selected by the same user as they would be used in conjunction with one another. Lastly, while the goods are not competitive in nature, I do consider that they are complementary to one another. I say this because software products are important and/or indispensable to the parts, fittings and accessories for the same. Further, the consumer would consider that one undertaking is responsible for both goods.[24] Overall, I consider that there exists a medium degree of similarity between the goods.

53. Lastly, I turn to the term "parts, fittings and accessories for all the aforementioned goods" in the context of the terms "laptop cases" and "mobile phone cases". As I have found the goods themselves to be dissimilar to the opponent's goods and services, I see no reason why a different finding would apply to the parts, fittings and accessories for the same. As such, I find that these goods are dissimilar.

Conclusion on the goods and services comparison

54. In respect of the section 5(1) ground, the fact that I have found "mobile apps" to be identical means that the opposition in reliance upon that ground succeeds against

[24] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

those goods. It fails, however, for all remaining goods on the basis that I have found them either similar to a medium degree or dissimilar. For the avoidance of doubt, the opposition reliant upon sections 5(2)(a) (and 5(2)(b), for that matter) also fails in respect of those dissimilar goods. This is on the basis that for there to exist a likelihood of confusion, there must be a degree of similarity between the goods.[25]

55. As a result of the above, the section 5(2)(a) ground only proceeds in relation to the similar goods. While the section 5(1) ground has succeeded against "mobile apps", I will, for the sake of completeness, proceed on the basis of my back up finding in respect of that term, namely that they are similar to at least a medium degree. As a result, the opposition under the section 5(2) grounds proceeds only against the following:

Class 9:	Mobile apps; parts, fittings and accessories for all the aforementioned goods

The average consumer and the nature of the purchasing act

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

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

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

"average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

57. The applicant's submissions appear to me to argue that the user of the opponent's goods are professional publishers. The opponent sets out that the user base for the applicant's goods will be members of the general public and that its own goods will be selected by a range of customers such as businesses, publishers and content creators. Clearly, there is some common ground between the parties as both suggest that the average consumer base for the opponent's goods will be made up of business users. This is something I agree with. However, I consider that it also applies to the applicant's goods as they are unlimited and can, therefore, cover mobile apps used by business users. In addition, I am of the view that both parties' goods will also be sought by members of the general public at large. I say this because (1) the applicant's goods are so broadly worded and (2) the opponent's goods may also be sought be individuals seeking to design their own personal blogs or websites.

58. The goods at issue will be selected via a range of retailers, be that general or specialist. This includes both physical retailers and online stores such as app stores or websites. Further, the goods will be available from the producers directly. Regardless of the selection scenario, the consumer will select the goods after seeing them on a shelf or an image of the same on a website/app store. As such, I find that the goods will be selected primarily via visual means, though I do not discount an aural component playing a role by way of advice from sales assistants or word of mouth recommendations.

59. The cost and frequency of selection of the goods at issue will vary. I say this because mobile apps is such a broad term that it will cover very cheap, or even free, apps that can be downloaded on a user's phone. Alternatively, computer software goods can be relatively expensive in comparison and may be selected on a much less frequent basis. In terms of the level of attention paid, I note that the opponent submits that the applicant's goods will be selected with a low to medium degree of attention and that its own goods will be selected with a medium to high

degree of attention. While I accept that some of the goods at issue (being those that cover cheap, or free, mobile apps)[26] will be selected with a lower degree of attention, I am of the view that, for the most part, the selection process will be approached with a medium degree of attention. This is on the basis that the consumer will consider factors such as ease of use, compatibility and reliability of the software. I appreciate that business users will consider the selection of software for creating their websites to be important to their business, however, the factors those users consider will be the same as listed above, none of which being particularly involved considerations. Therefore, I disagree with the submission that the selection process will attract a high degree of attention.

Distinctive character of the opponent's mark

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

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

[26] Which can also be the case for the opponent's goods.

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)."

61. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up 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. In the present case, the opponent has filed evidence of use and, therefore, I consider it necessary to assess the position with respect of enhanced distinctiveness. Before doing so, however, I will consider the inherent position.

62. The opponent's mark is a word only mark that consists solely of the word 'GHOST'. While it is not descriptive or allusive of the goods at issue, it is an ordinary dictionary word with a well-known meaning. As such, I do not consider its use as the basis for a trade mark is particularly remarkable. As a result, I find that the opponent's mark is inherently distinctive to a medium degree.

63. Turning to the evidence of use, I am of the view that I can deal with this briefly. In doing so, I rely on the same evidence that I have summarised above. That evidence focused on both the UK and the EU use together. The present assessment I must make is based on the UK consumer. That being said, I note that information was provided in evidence that confirms that the UK is the opponent's third largest market base, behind the USA and users of '.io' domains (which I understand to be a domain assigned to the British Indian Ocean Territory). I remind myself that the UK and EU evidence sets out that the opponent achieved an annual run rate of almost $1 million by 2020 and that, by February 2021, it had to 6,271 active customers, a monthly run rate of $254,465 and 2.5 million installs. Based on the confirmation that the UK is the opponent's third largest customer base, it is reasonable to conclude that a significant proportion of these figures can be said to cover UK use. While I appreciate that I have no way to determine precisely how

much use stems from the UK alone, I am satisfied that the evidence before me demonstrates a level of awareness of the opponent's mark in the UK. On this point, I also wish to point out that the articles from WIRED Magazine and The Guardian (that I have discussed above) are relevant here.[27] These are popular publications that have significant reach across the entirety of the UK and while they are from 2013, they indicate that from the outset, the opponent's brand was reported on in large publications.

64. Taking all of the above into account, I am satisfied that the evidence is sufficient to give rise to a finding that the distinctiveness of the opponent's mark has been enhanced due to the use made of it. Saying that, the evidence before me is not reflective of such large scale use that its distinctiveness can be said to have been enhanced to high. Instead, I consider that it has only been enhanced to slightly above a medium degree.

Likelihood of confusion

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and 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

[27] On the basis that the present assessment focuses on the relevant date of 31 May 2021 only and is not constrained to the start of the relevant period. As such, evidence from earlier than 1 June 2016 is relevant here.

trade marks and must instead rely upon the imperfect picture of them that he has retained in his or her mind.

66. My primary finding is that some goods are identical and that others are similar to a medium degree. However, I have proceeded in considering the present ground on the basis that those identical goods are only similar to at least a medium degree. I have found the average consumer for the goods to be members of the general public at large and business users. The consumers will select the goods via primarily visual considerations (though I do not discount the aural component) after having paid, generally, a medium degree of attention. I have, however, found that some goods will be selected after the consumer pays a lower degree of attention. In respect of the marks at issue, I have found them to be identical. I have found that the opponent's mark is inherently distinctive to a medium degree but this has been enhanced, but only to a slightly above medium degree, due to the use made of it.

67. Taking all of the above factors into account, particularly given the identity of the marks at issue, I am satisfied that the average consumer would likely mistake the parties' marks for each other. I am, therefore, satisfied that there will be a likelihood of direct confusion between the parties' marks for the goods at issue. As a result, the opposition in reliance upon the section 5(2) grounds succeeds against only the following goods:

Class 9:	Mobile apps; parts, fittings and accessories for all the aforementioned goods

68. I will now proceed to consider the remaining grounds.

Section 5(2)(b)

69. Given the success of the section 5(2)(a) ground, I see no merit in considering the section 5(2)(b) ground further. This is because the outcome in respect of the section 5(2)(b) ground would be identical to that of the section 5(2)(a) ground.

Section 5(3)

70. 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."

71. 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).*

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

Reputation

73. The opponent relies upon the same earlier mark and the same goods and services under the present ground as it did under its section 5(1) and 5(2) grounds. That mark is a comparable mark meaning that EU use prior to IP Completion Day (being 31 December 2020) is relevant to the issue of reputation.

74. I have summarised the opponent's evidence at paragraphs 24 to 35 above. That same summary is relevant here on the basis that it covers the same territory that is relevant here. As for the relevant period that was applicable to the genuine use assessment, this is not in play here. However, the relevant date for this assessment

is the same date as the last date of the relevant period, being 31 May 2021. Further, the assessment I must make here is not constrained to an earlier date. On this point, I remind myself that my summary of the evidence did include evidence from prior to the relevant period. That evidence is now relevant to the assessment I must make.

75. I do not intend to reproduce my evidence summary again here, though I will briefly remind myself that, as at the relevant date, the opponent had 6,271 active customers, a monthly run rate of $254,465 and 2.5 million installs in the UK and the EU. Further, I note that the annual run rate of UK and EU customers steadily increased between 2014 and 2020, at which point, it was achieving an annual run rate of almost $1 million. In addition to this, the evidence as to press coverage from The Guardian and WIRED Magazine are relevant here. These are publications that have a significant reach across the UK and, therefore, are of some assistance to the opponent. While I note that they were published in 2013, they indicate that from the outset, the opponent was reported on in large publications.

76. Taking all of the evidence into account, I am of the view that it is sufficient to demonstrate that the opponent's mark enjoyed a reputation in the relevant territories. Following the same reasons given when considering a fair specification of the opponent's mark, I consider that this finding only applies to those same goods and services for which I found genuine use, namely the following:

Class 9:	Computer software which provides the facility to share text, data, sound and images, excluding computer imaging software; computer software operated online, which provides the facility to share text, data, sound and images, excluding computer imaging software; computer software for creating dynamic websites and blogs.
Class 42:	Providing temporary use of non-downloadable computer software for use in the creation and publication of on-line journals and blogs; software as a service and rental of software operated

online, which provides the facility to share text, data, sound and images, excluding computer imaging software.

77. While the above finding of a reputation is noted, the use shown before me is not on such a large scale that the reputation would be considered strong. Instead, I am of the view that the strength of the opponent's mark's reputation is moderate (i.e. between a medium and high degree).

Link

78. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

79. The marks are identical.

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

80. I have found that applicant's "mobile apps" are identical to the opponent's reputed goods but note that I have also made a back-up finding that they are similar to at least a medium degree. As for the parts, fittings and accessories to mobile apps, these are similar to a medium degree with the opponent's reputed goods. As for "mobile phones cases", "laptop cases" and the parts, fittings and accessories to the same, I have found these to be dissimilar.

81. Regardless of any identity or similarity between the goods, they are all such that will be selected by the same relevant section of the public. Therefore, all goods can be said to share a degree of closeness.

The strength of the earlier mark's reputation.

82. I have found that the strength of the reputation enjoyed by opponent's mark is at a moderate level.

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

83. I have found the opponent's mark to be inherently distinctive to a medium degree and that this has been enhanced through use but only to a slightly above medium degree.

Whether there is a likelihood of confusion

84. I have found that there exists a likelihood of direct confusion between the marks but only in respect of the identical/similar goods.

Conclusions on link

85. While the present assessment as to the existence of a link is not the same as the one undertaken when considering the issue of confusion, I consider that as there exists confusion between the marks in respect of some goods, it plainly follows that, for those goods, consumers would, upon being confronted by the applicant's mark, be caused to wonder if it was linked to the opponent's mark. As for those goods that are not similar, I am of the view that when consumers are confronted with the applicant's identical marks on "mobile phone cases", "laptop cases" and the parts, fittings and accessories for the same, they would still consider the marks to be linked. I say this because the relevant section of the public that selects the parties' goods would be the same so a consumer who is aware of the reputation of the opponent's mark on software goods would, upon seeing the dissimilar goods under the identical branding 'GHOST', be caused to wonder if the opponent had expanded its brand to sell mobile phone and laptop cases. In my view, such an expansion is one that is not too far removed from what the opponent's reputation

vests in. As such, I am of the view that a link is made out in respect of all goods so the opposition in reliance upon the section 5(3) ground may proceed in full.

Damage

86. The opponent has pleaded that use of the applicant's mark would, without due cause, lead to an unfair advantage in favour of the applicant and cause a detriment to both the reputation of the opponent and to the distinctive character of the opponent's mark.

Unfair Advantage

87. I bear in mind that unfair advantage has no effect on the consumers of the opponent's goods. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to select the goods of the later mark than they would otherwise have been if they had not been reminded of the earlier mark.

88. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts

to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

89. Where I have found there to be a likelihood of confusion between the marks at issue, I consider that unfair advantage is automatically made out on the basis that consumers (who are aware of the opponent's mark and its reputation) will erroneously purchase the applicant's goods on the mistaken belief that they are connected to the goods of the opponent. Such a scenario clearly demonstrates a transfer of image from the opponent's mark to the applicant's marks, therefore giving the proprietor a commercial advantage without paying financial compensation. The applicant's claim as to unfair advantage, therefore, succeeds for those goods I have found to be identical or similar.

90. As for those goods that there exists no likelihood of confusion (on the basis that they are dissimilar), I consider that unfair advantage is made out in any event. While I acknowledge that the reputation and enhanced distinctiveness of the opponent's mark are not particularly strong, they are sufficient enough to result in a finding that there is potential for the applicant to gain an unfair advantage by using either of its series marks. This is particularly the case given that the marks at issue are identical. Further, the dissimilar goods will be sought by the same section of the relevant public so I consider it likely that the image associated with the opponent's brand would transfer onto the application as a result of the use of its marks. As a result, I find that the applicant's use of its marks would achieve instant familiarity in the eyes of the average consumers, thereby securing a commercial advantage and benefitting from the opponent's reputation without paying financial compensation. Such commercial advantage would not exist were it not for the reputation of the opponent's mark. Therefore, I find that, in respect of all of the goods at issue, it is likely that the application will take unfair advantage of the opponent's mark.

91. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage. The section 5(3) ground of the present opposition, therefore, succeeds.

Section 5(4)(a)

92. Section 5(4)(a) of the Act reads as follows:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) …..
> >
> > (b) …..
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

93. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

94. I accept that, based on the evidence before me (and as already assessed above), there exists a level of protectable goodwill in the opponent's business in respect of the goods for which there exists genuine use and that the opponent's sign is distinctive of and/or associated with that goodwill. However, I do not consider that this ground would garner the opponent any success beyond that offered by the section 5(2)(a) ground and neither would it achieve the same level of success as the section 5(3) ground. In respect of the point in relation to the section 5(2)

grounds, I remind myself that while the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it is unlikely that the difference between the legal tests will produce different outcomes.[28] In the present case, there was confusion under the section 5(2)(a) ground in respect of identical/similar goods. While I am of the view that this same finding would be ultimately reached here, it would not extend to cover the dissimilar goods. I say this because while it is possible for section 5(4)(a) grounds to succeeds in instances where the parties operate in different fields of activity, I remind myself that the burden in proving misrepresentation in such circumstances is a heavy one.[29] On balance, I do not consider that the evidence before me discharges this burden.

95. So while it is likely that the section 5(4)(a) ground would achieve the same level of success as the section 5(2)(a) ground, it would not extend beyond that level so I see no merit in considering the same in full.

CONCLUSION

96. The opposition has succeeded in full meaning that the application is, subject to any successful appeal against this decision, hereby refused for the following goods:

Class 9:	Mobile apps; laptop cases; mobile phone cases; parts, fittings and accessories for all the aforementioned goods.

97. As this was a partial opposition aimed only against those goods listed above, the application may proceed to registration for all of the remaining goods and services in the applicant's specification.

[28] See *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501
[29] See *Stringfellow and Anr. v McCain Foods (G.B.) Limited and Another* [1984] RPC 501 (COA)

COSTS

98. As the opponent has succeeded, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £1,600 as a contribution towards its costs. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement of the applicant:	£300
Preparing evidence:	£800
Filing written submissions in lieu	£300
Official fees:	£200
Total:	**£1,600**

90. I hereby order Ghost Brand Limited to Ghost Foundation Limited the sum of £1,600. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of July 2024

A COOPER
For the Registrar

ANNEX

Class 2

Paints; varnishes; lacquers; preservatives against rust and against deterioration of wood; colorants; dyes; inks for printing, marking and engraving; raw natural resins; metals in foil and powder form for use in painting, decorating, printing and art .

Class 5

Preparations for destroying vermin; fungicides; herbicides; baby diapers; babies' nappies; babies' swim nappies; babies' nappy pants; nappy changing mats, disposable, for babies; none of the aforementioned in the field of dietary and nutritional supplements.

Class 6

Common metals and their alloys; ores; metal materials for building and construction; transportable buildings of metal; non-electric cables and wires of common metal; small items of metal hardware; metal containers for storage or transport; safes; parts, fittings and accessories for all of the aforementioned goods.

Class 8

Hand tools and implements, hand-operated; cutlery; side arms; razors; knives; irons; steam irons; travel irons; curling tongs; hair straighteners; hair irons; parts, fittings and accessories for all of the aforementioned goods.

Class 9

Mobile apps; mechanisms for coin-operated apparatus; cash registers; diving suits; divers' masks; ear plugs for divers; nose clips for divers and swimmers; gloves for divers; breathing apparatus for underwater swimming; fire-extinguishing apparatus; radios; tape measures, spirit levels; radios incorporating alarm clocks; electric plug adapters; adapters; laptop cases; mobile phone cases; optical goods; articles of eyewear and fashion eyewear; spectacles; spectacle frames; spectacle cases; spectacle holders; spectacle straps; spectacle cords; sunglasses; parts, fittings and accessories for all the aforementioned goods.

Class 11

Apparatus and installations for lighting, heating, cooling, steam generating, cooking, drying, ventilating, water supply and sanitary purposes; lamps; lamp shades; lamp fittings; lighting installations; chandeliers; lanterns; ceiling fans; electrical fans for ventilation; desk fans; electric kettles; coffee machines; toasters; bathroom sinks; kitchen sinks; taps; mixer taps; bath taps; shower taps; kitchen taps; hair dryers; travel kettles; parts, fittings and accessories for all of the aforementioned goods.

Class 12

Apparatus for locomotion by air or water; parts, fittings and accessories for all of the aforementioned goods.

Class 15

Musical instruments; music stands and stands for musical instruments; conductors' batons; parts, fittings and accessories for all of the aforementioned goods.

Class 23

Yarns and threads, for textile use.

Class 26

Lace; braid; embroidery; haberdashery ribbons; haberdashery bows; buttons; hooks; eyes; pins; needles; artificial flowers; hair decorations; false hair; wigs; hair extensions; parts, fittings and accessories for all of the aforementioned goods.

Class 28

Games; toys; playthings; playing cards; video game apparatus; gymnastic articles; sporting articles; decorations for Christmas trees; parts, fittings and accessories for all of the aforementioned goods; none of the aforementioned goods relating to golf, or to motor vehicle miniatures and parts thereof included in this class.

Class 29

Meat; fish; poultry; game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies; jams; compotes; eggs; milk; cheese; butter; yogurt; other milk products; oils and fats for food; soup; preparations for making soup; sandwiches; sandwich fillings; prepared meals; prepared dishes; ready meals; none of the aforementioned in the field of dietary and nutritional supplements.

Class 30

Coffee; tea; cocoa; artificial coffee; rice; pasta; noodles; tapioca; sago; flour; preparations made from cereals; bread; pastries; confectionery; chocolate; ice cream; sorbets; edible ices; sugar; honey; treacle; yeast, baking-powder; salt; seasonings; spices; preserved herbs; vinegar; sauces; condiments; ice; sandwiches; sandwich fillings; prepared meals; prepared dishes; ready meals; puddings; desserts; salad dressing; none of the aforementioned in the field of dietary and nutritional supplements.

Class 31

Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables; fresh herbs; natural plants; flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals; malt; none of the aforementioned in the field of dietary and nutritional supplements.

Class 34

Tobacco substitutes; cigarettes containing tobacco substitutes; smokers' articles; personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; oral vaporisers for smokers; electronic smoking devices; electronic cigarettes; electric cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; electronic cigarette cartridges; electronic inhalation devices; electronic cigarette liquid [e-liquid]; liquid solutions for use in electronic cigarettes; liquid nicotine solutions for use in electronic cigarettes; electronic cigarette atomisers; electronic cigarette cartomisers; electronic cigarette clearomisers; electronic cigarette cartridges; electronic cigarette refill cartridges; electronic cigarette filters; refill cartridges for electronic cigarettes; flavourings for electronic cigarettes; holders for electronic

cigarettes; electronic cigarette cases; electronic cigarette boxes; electronic cigarette cleaners; electronic cigars; electronic smoking pipes; electronic shisha pipes; electronic hookahs; electronic cigarette kits comprising electronic cigarette cartridges, a battery, a battery charger and an atomiser; battery powered, rechargeable portable vaporising units; battery-powered, disposable portable vaporising units; disposable and reusable cartridges filled with vaporisable liquid for use with battery-powered, rechargeable portable vaporising units; imitation cigarette vaporising units; flavourings for use in electronic cigarettes; smokeless cigarette vaporiser pipes; smokers' articles; matches; parts, fittings and accessories for all of the aforementioned goods.

Class 44

Medical services; veterinary services; hygienic and beauty care for human beings or animals; beauty treatment; beauty consultancy; beauty therapy; agriculture, aquaculture, horticulture and forestry services; information, advisory and consultancy services in relation to all of the aforementioned services.