

O/0706/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003885229

BY ALICE LIVEING LIMITED

TO REGISTER

ALICE LIVEING

AS A TRADE MARK

IN CLASSES

3, 9, 14, 16, 18, 25, 35, 38, 41 AND 44

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. OP000441029

BY

ALICE LTD

BACKGROUND AND PLEADINGS

1. On 5 March 2023, ALICE LIVEING LIMITED (“the applicant”) applied to register the trade mark shown on the cover of this decision in the UK for the goods and services listed in Annex 1 of this decision. The applicant’s mark was published for opposition purposes on 24 March 2023.
2. The applicant’s mark is opposed by Alice Ltd (“the opponent”) who filed a Form TM7 dated 24 May 2023 based on sections 5(2)(b) and 3(6) of the Trade Marks Act 1994 (“the Act”).
3. Having originally relied upon three marks for its opposition, in its submissions of 26 September 2023 the opponent withdrew one of its marks¹ and confirmed that it was relying upon its two remaining marks as follows:

UK00003362772, filed on 21 December 2018 and registered on 22 March 2019.

ALICE

Registered for the following goods and services:

Class 9 Apparatus for recording, transmission or reproduction of sound or images; audio apparatus; signal-mixing apparatus and instruments; sound recording and sound reproducing apparatus and instruments; signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting.

¹ The withdrawal of the mark in question - UK00002252684 – means that the question of proof of use does not need to be considered in this case.

Class 37 Repair, maintenance and refurbishment of apparatus for recording, transmission or reproduction of sound or images, audio apparatus, signal-mixing apparatus & instruments, sound recording apparatus & instruments, and sound reproducing apparatus & instruments.

UK00003884907, filed on 3 March 2023 and registered on 2 June 2023

ALICE

Registered for the following goods and services:

Class 9 Audio apparatus; Apparatus for recording, mixing, transmission or reproduction of sound or images; Signal-mixing apparatus and instruments; Sound recording and sound reproducing apparatus and instruments; Signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting; Mixing boards; Audio mixing boards; Visual mixing boards; Audio-visual mixing boards; Audio limiters for use in recording and transmitting audio data; Audio equalisers; Audio transformers; Audio amplifiers; Timecode distribution amplifiers; Microphone pre-amplifiers; Audio measuring and monitoring equipment; Transmitting and receiving apparatus for radio broadcasting; Transmitting and receiving apparatus for television broadcasting; Transmitting apparatus for radio broadcasting; Transmitting apparatus for television broadcasting; Broadcasting equipment; Apparatus for broadcasting sound, data or images; parts and accessories for the aforesaid goods.

Class 42 Technical design of apparatus for recording, transmission or reproduction of sound or images; technical consultancy in

relation to apparatus for recording, mixing, transmission or reproduction of sound or images; technical design of signal-mixing apparatus and instruments; technical design of sound reproducing apparatus and instruments; Testing of apparatus for recording, mixing, transmission or reproduction of sound or images; calibration of apparatus for recording, mixing, transmission or reproduction of sound or images; technical consultancy relating to product development of apparatus for recording, mixing, transmission or reproduction of sound or images; technical consultancy relating to product development, namely, in relation to choice of appropriate apparatus for recording, mixing, transmission or reproduction of sound or images.

4. The opponent is reliant upon all of the goods and services in both of its marks. It confirmed in its submissions of 26 September 2023, that its opposition under section 5(2)(b) is directed solely against a subset of the applicant's Class 9 goods as follows:

Class 9 Photographic, cinematographic, optical, measuring, signalling, checking (supervision) apparatus and instruments; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; headphones; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; radios, including mobile and portable radios; music recordings; vinyl records; compact discs; audio recordings; video recordings; Recorded and downloadable media; digital music downloadable online; data processing equipment, computers; computer software; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; digital telecommunication apparatus and instruments; digital tablets; tablet computers;

computer hardware; computer application software; computer software downloadable from the Internet; recorded computer software; software applications; mobile software applications, downloadable applications for multimedia devices; software applications for mobile telecommunications devices; computer software applications, downloadable; USB flash drives; PDAs (Personal Digital Assistants); pocket PCs; mobile telephones; smartphones; laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; computer software recorded onto CD Rom; cameras; camera lenses; MP3 players; audio tapes, audio cassettes; audio discs; audio-video tapes; audio-video cassettes; audio-video discs; video tapes; video cassettes; video discs; CDs, DVDs; downloadable image files; downloadable music files; magnetic cards; encoded cards; mobile phone application software; software for telecommunication; downloadable ring tones for mobile phones; loudspeakers; magnetic data media; television apparatus; audio, video and audiovisual mixers; parts and fittings for all the aforesaid goods.

5. The opponent confirmed in its submissions of 26 September 2023, that its opposition under section 3(6) is directed at a subset of the applicant's Class 9 goods as follows:

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data.

6. The applicant filed a Form TM8 and counterstatement in defence of the opponent's claims.
7. Both parties filed submissions and evidence, detailed below.
8. The opponent is represented by Downing IP Limited, and the applicant is represented by Insanity Talent Management Limited.
9. A hearing was held before me on 9 July 2024. The opponent did not attend the hearing, filing submissions in lieu which were its submissions of 26 September 2023. At the hearing, the applicant was represented by Joshua Marshall of Counsel, instructed by Insanity Talent Management Limited, who had filed skeleton arguments prior to the hearing.

Submissions and evidence

10. The opponent filed submissions dated 26 September 2023. It also filed evidence in the form of a witness statement from Michale Downing, a Chartered Trademark Attorney practising via Downing IP Limited, the opponent's representatives, signed and dated 26 September 2023. Filed along with the witness statement were two exhibits, MD1 and MD2.
11. The applicant filed submissions dated 27 November 2023. It also filed evidence in the form of a witness statement from Alice Liveing, a director of the applicant, signed and dated 27 November 2023. Filed along with the witness statement were 12 exhibits, AVL/1 to AVL/12.
12. The opponent filed evidence in reply in the form of a witness statement from Hazel MacLean, a Chartered Trademark Attorney practising via Downing IP Limited, the opponent's representatives, signed and dated 29 January 2024. Filed along with the witness statement was one exhibit, HM1.

13. At the hearing, Mr Marshall referred me to *El Corte Ingles SA v OHIM*, Case T-39/10, paragraph 55, where it was confirmed that whether a name is commonplace or unusual will have a bearing on its distinctive character, as will whether the person seeking to register a trade mark in their name is well known.
14. It is the applicant's contention that the name Alice Liveing is highly distinctive because the surname is an unusual one, but also because the person seeking to register the mark in their name is well known. The applicant has filed evidence that it considers to be sufficient for a finding of enhanced distinctiveness and Mr Marshall argued before me that average consumer "will see ALICE LIVEING to be a person's name, as being distinctive in the sense that it denotes the person standing behind the goods being offered and therefore a highly distinctive trade mark, whether inherently or through, as I have tried to explain on the evidence, having acquired distinctive character."
15. I make the following points about the applicant's evidence:
1. The reputation of an applied for mark is not relevant to the likelihood of confusion. As per the decision of the General Court of the EU in *Associazione Calcio Milan SpA (AC Milan) v EUIPO*, Case T-353/20:

"113.with regard to the applicant's argument based on the reputation of the mark applied for in Germany, it should be noted, as EUIPO rightly pointed out, that only the reputation of the earlier mark, and not that of the mark applied for, must be taken into account in order to assess whether the similarity of the goods designated by the two marks is sufficient to give rise to a likelihood of confusion (see, to that effect, judgment of 3 September 2009, *Aceites del Sur-Coosur v Koipe*, C-498/07 P, EU:C:2009:503, paragraph 84 and the case-law cited). That case-law is in line with the objective of Article 8(1)(b) of Regulation No 207/2009, which is to provide adequate protection for the proprietors of earlier rights against subsequent applications for identical or similar European Union trade marks (judgment of 29

January 2019, *The GB Foods v EUIPO – Yatecomeré (YATEKOMO)*, T-336/17, not published, EU:T:2019:840, paragraph 49).

114. Therefore, the applicant’s argument based on the alleged reputation of the mark applied for is entirely irrelevant.”

2. It could be argued that the *Messi*² case represents an exception to the general principle that the reputation of an applied for mark is not relevant to the likelihood of confusion:

“47. However, as the Court has held, account must also be taken of the possible notoriety of the person applying for his name to be registered as a trade mark, since that reputation may obviously , have an influence on the perception of the mark by the relevant public (see, to that effect, judgment of 24 June 2010, *Becker v Harman International Industries*, C-51/09 P, paragraph 37).

48. It follows that the General Court was right to consider, in paragraph 62 of the judgment under appeal, that the notoriety of Mr Messi Cuccittini constituted a relevant factor in order to establish a difference at the conceptual level between the term ‘messi’ and the term ‘massi’.”

However, the *Messi* case set a high bar in respect of a name being well-known: it applied to people whose names were “notorious” – famous. I do not consider the evidence that has been filed shows that that bar has been reached such that my conceptual comparison should be affected.

16. For completeness, I will also say that if the applicant’s evidence was to be taken to be offered in support of an argument that the applicant has an earlier unregistered right, that is not a valid defence. If that was the case, the proper course of action would be to seek to invalidate the earlier marks.

² *Lionel Andrés Messi Cuccittini v EUIPO*, joined cases C-449/18P & C-474/18P

17. Given that I have set out the extent to which the applicant's evidence does not assist me, it follows that the opponent's evidence in reply does not assist. In any event, the opponent's evidence in reply is flawed. This is because the search results for the word "LIVEING" offered in evidence default to include results for the word "LIVING" and so they are not search results for the word "LIVEING" alone.

DECISION

Section 5(2)(b)

18. 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.

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

"5(2) A trade mark shall not be registered if because-

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

20. By virtue of their earlier filing dates, the opponent's marks constitute earlier marks in accordance with section 6 of the Act. As they were registered less

than five years prior to the date that the contested mark was filed, these marks are not subject to proof of use in accordance with section 6A of the Act.

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

22. The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(a) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(b) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(c) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(d) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

- (e) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (f) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (g) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (h) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (i) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (j) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the goods and services

23. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature,

their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

24. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

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

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a

specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

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

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

27. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-133/05, the General Court (“GC”) 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 für 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.”

28. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

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

29. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

While on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

30. The goods and services for comparison are as follows:

Opponent's goods and services	Applicant's goods
Class 9	Class 9
<p>UK00003362772: Apparatus for recording, transmission or reproduction of sound or images; audio apparatus; signal-mixing apparatus and instruments; sound recording and sound reproducing apparatus and instruments; signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting.</p> <p>UK00003884907: Audio apparatus; Apparatus for recording, mixing, transmission or reproduction of sound or images; Signal-mixing apparatus and instruments; Sound recording and sound reproducing apparatus and instruments; Signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting; Mixing boards; Audio mixing boards; Visual mixing boards; Audio-visual mixing boards; Audio limiters for use in recording and transmitting audio data; Audio equalisers; Audio transformers; Audio amplifiers; Timecode distribution amplifiers; Microphone pre-amplifiers;</p>	<p>Photographic, cinematographic, optical, measuring, signalling, checking (supervision) apparatus and instruments; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; headphones; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; radios, including mobile and portable radios; music recordings; vinyl records; compact discs; audio recordings; video recordings; Recorded and downloadable media; digital music downloadable online; data processing equipment, computers; computer software; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; digital telecommunication apparatus and instruments; digital tablets; tablet computers; computer hardware; computer application software; computer software downloadable from the Internet; recorded computer software; software applications; mobile</p>

<p>Audio measuring and monitoring equipment; Transmitting and receiving apparatus for radio broadcasting; Transmitting and receiving apparatus for television broadcasting; Transmitting apparatus for radio broadcasting; Transmitting apparatus for television broadcasting; Broadcasting equipment; Apparatus for broadcasting sound, data or images; parts and accessories for the aforesaid goods.</p>	<p>software applications, downloadable applications for multimedia devices; software applications for mobile telecommunications devices; computer software applications, downloadable; USB flash drives; PDAs (Personal Digital Assistants); pocket PCs; mobile telephones; smartphones; laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; computer software recorded onto CD Rom; cameras; camera lenses; MP3 players; audio tapes, audio cassettes; audio discs; audio-video tapes; audio-video cassettes; audio-video discs; video tapes; video cassettes; video discs; CDs, DVDs; downloadable image files; downloadable music files; magnetic cards; encoded cards; mobile phone application software; software for telecommunication; downloadable ring tones for mobile phones; loudspeakers; magnetic data media; television apparatus; audio, video and audiovisual mixers; parts and fittings for all the aforesaid goods.</p>
<p>Class 37</p>	
<p>UK00003362772: Repair, maintenance and refurbishment of apparatus for recording, transmission</p>	

<p>or reproduction of sound or images, audio apparatus, signal-mixing apparatus & instruments, sound recording apparatus & instruments, and sound reproducing apparatus & instruments.</p>	
<p>Class 42</p>	
<p>UK00003884907: Technical design of apparatus for recording, transmission or reproduction of sound or images; technical consultancy in relation to apparatus for recording, mixing, transmission or reproduction of sound or images; technical design of signal-mixing apparatus and instruments; technical design of sound reproducing apparatus and instruments; Testing of apparatus for recording, mixing, transmission or reproduction of sound or images; calibration of apparatus for recording, mixing, transmission or reproduction of sound or images; technical consultancy relating to product development of apparatus for recording, mixing, transmission or reproduction of sound or images; technical consultancy relating to product development, namely, in relation to choice of appropriate apparatus for recording, mixing, transmission or reproduction of sound or images.</p>	

31. The applicant has set out the following table, at paragraph 7 of its submissions, arguing that the goods in the right-hand column are identical to the goods in the left-hand column:

TABLE 1	
<i>Specification of the Earlier Rights of Alice Ltd</i>	<i>Specification of The Application</i>
Apparatus for recording, transmission or reproduction of sound or images; audio apparatus; sound recording and sound reproducing apparatus and instruments (the 772 Mark)	Photographic, cinematographic... apparatus and instruments; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; headphones; radios, including mobile and portable radios; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; digital telecommunication apparatus and instruments; mobile telephones; smartphones; cameras; camera lenses; MP3 players; loudspeakers; television apparatus; audio, video and audiovisual mixers; parts and fittings for all the aforesaid goods.
Audio apparatus; Apparatus for recording, mixing, transmission or reproduction of sound or images; parts and accessories for the aforesaid goods (the 907 Mark)	
Signal-mixing apparatus and instruments; Broadcasting equipment; Apparatus for broadcasting sound, data or images; parts and accessories for the aforesaid goods (the 907 Mark)	audio, video and audiovisual mixers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus

32. The opponent has responded as follows at paragraph 15 of its submissions:

“It is accepted that the goods in the specification of the Application in class 9 as identified in Table 1 are identical to at least one of the goods for which the Earlier Marks are registered as set out in Table 1 in the Opponent's written submissions.”

33. Consequently, it is common ground between the parties that those of the applicant's goods that are listed in Table 1 are identical.

34. The opponent argues that the remaining goods are either highly similar (Table 2 in its submissions) or of medium to high similarity (Table 3 in its submissions). The applicant critiques the opponent's arguments in respect of claimed complementarity between those goods that it has grouped together in Table 2 and questions the opponent's basis for finding similarity in respect of those goods that it has grouped together in Table 3. However, the applicant does not specify what level of similarity the goods in Table 2 and Table 3 have or say that they are dissimilar.

35. I will now conduct my analysis of the remaining goods which are:

Magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; music recordings; vinyl records; compact discs; audio recordings; video recordings; Recorded and downloadable media; digital music downloadable online; data processing equipment, computers; computer software; digital tablets; tablet computers; computer hardware; computer application software; computer software downloadable from the Internet; recorded computer software; software applications; mobile software applications, downloadable applications for multimedia devices; software applications for mobile telecommunications devices; computer software applications, downloadable; USB flash drives; PDAs (Personal Digital Assistants); pocket PCs; computer software recorded onto CD Rom; audio tapes, audio cassettes; audio discs; audio-video tapes; audio-video cassettes; audio-video discs; video tapes; video cassettes; video discs; CDs, DVDs; downloadable image files; downloadable music files; magnetic cards; encoded cards; mobile phone application software; software for telecommunication; downloadable ring tones for mobile phones; magnetic data media; parts and fittings for all the aforesaid goods.

36. The applicant's "... computers", "digital tablets", "tablet computers", "PDAs (Personal Digital Assistants)" and "pocket PCs" can all be said to be apparatus for the recording, transmission or reproduction of sound or images. As such, the applicant's goods are Meric identical to the opponent's

“apparatus for recording, transmission or reproduction of sound or images” or are at least highly similar.

37. In respect of the applicant’s “magnetic data carriers, recording discs”, “compact discs, DVDs and other digital recording media”, “music recordings”, “vinyl records”, “compact discs”, “audio recordings”, “video recordings”, “Recorded and downloadable media”, “digital music downloadable online”, “USB flash drives”, “audio tapes”, “audio cassettes”, “audio discs”, “audio-video tapes”, “audio-video cassettes”, “audio-video discs”, “video tapes”, “video cassettes”, “video discs”, “CDs, DVDs”, “downloadable image files”, “downloadable music files”, “magnetic cards”, “encoded cards”, and “magnetic data media”, the applicant is keen to point out at paragraph 21 part b of its submissions that:

“... the Opponent has been forced to insert the word "blank" (which doesn't appear in the Application) in order to conceive of a scenario in which a consumer might purchase recording apparatus at the same time as an audio cassette, a CD, a DVD or an audio-visual tape. If the latter contains content (for example, music, a film or a television programme), the Opponent's submission collapses in its entirety.”

38. Mr Marshall made the same point in his skeleton arguments and before me. However, I disagree to the extent that the word “blank” does not need to be inserted in order for a finding of similarity to be arrived at when comparing the above goods with the opponent’s “apparatus for recording, transmission or reproduction of sound or images”. If such media are blank, then the opponent’s goods can be used for recording sound or images. But if such media are recorded, then they can be played on the opponent’s apparatus i.e. they can be used to “reproduce” sound or images.

39. While their precise natures, purposes and methods of use differ, the goods would be sold through the same trade channels, and they are complementary. The applicant’s goods are important to the opponent’s goods as a means of

recording or playing content and customers may think the responsibility for the goods lies with the same undertaking. I find the respective goods to be of a medium level of similarity.

40. I make the same finding for the applicant's "downloadable ring tones for mobile phones" by comparison with the opponent's "apparatus for recording, transmission or reproduction of sound or images". Mobile phones are a type of apparatus for the recording, transmission or reproduction of sound or images and mobile phones are indispensable to downloadable ring tones for mobile phones.
41. I compare "mobile software applications, downloadable applications for multimedia devices", "software applications for mobile telecommunications devices", "mobile phone application software" and "software for telecommunication" with the opponent's "apparatus for recording, transmission or reproduction of sound or images".
42. The applicant's software is indispensable to the functioning of mobile phones and multimedia devices, being types of apparatus for the recording, transmission or reproduction of sound or images, and its "software for telecommunication" is essential to the opponent's apparatus for the transmission of sound or images. While their precise natures, purposes and methods of use differ, the goods would be sold through the same trade channels, and they are complementary. The applicant's goods are indispensable to the opponent's goods and customers may think the responsibility for the goods lies with the same undertaking. I find the respective goods to be of a medium level of similarity.
43. I compare "computer application software", "computer software downloadable from the Internet", "recorded computer software", "software applications", "computer software applications, downloadable" and "computer software recorded onto CD Rom" with the opponent's "apparatus for recording, transmission or reproduction of sound or images".

44. The opponent's apparatus will typically be reliant upon software to function, and such software is included in the applicant's software at large. There is complementarity between these goods where software is essential to the functioning of the opponent's apparatus and in these cases, customers may think the responsibility for the goods lies with the same undertaking. However, while the trade channels overlap, they do not always coincide. I find these goods to be of a low level of similarity.
45. I compare "data processing equipment ..." and "computer hardware" with the opponent's "apparatus for broadcasting ... data ..."
46. The opponent's apparatus will be reliant upon data processing equipment and computer hardware to function. There is complementarity between these goods. However, while the trade channels overlap, they do not always coincide. I find these goods to be of a low level of similarity.

Average consumer and the purchasing act

47. It is necessary for me to determine who the average consumer is for the goods in question; I must then determine the manner in which the goods are likely to be selected by the average consumer in the course of trade.
48. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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. described the average consumer in these terms:

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

49. The average consumer for the competing goods – apparatus for the recording, transmission or reproduction of sound or images, and for the broadcasting of data and associated recordable and recorded media, software, devices, and hardware – would be members of the public, but also professionals in the audio, video and broadcasting industries.
50. Both members of the public and professionals would pay attention to the specifications of the goods to ensure that they were capable of carrying out the functions that they were looking to carry out and that it would be done to a particular quality standard. While prices could be high for professional standard equipment, prices would not be at the very top end in the context of an individual’s or a professional’s budget. Overall, I consider the level of attention paid during the purchasing process would be of a medium level.
51. Visual factors would be important as members of the public and professionals perused catalogues or their online equivalents, or physically inspected the relevant goods on the shelves of stockists. However, verbal considerations would also be significant as consumers would often want to know more about the technical specifications of the goods concerned.

Comparison of the marks

52. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the

visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

53. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

54. The respective trade marks are shown below:

Earlier marks	Contested mark
UK00003362772 ALICE	ALICE LIVEING
UK00003884907 ALICE	

Overall impression

55. The opponent's marks are both the plain word "ALICE". There is no other element that contributes to the overall impression made by these marks.

56. The applicant's mark consists of the plain words "ALICE LIVEING". I will find later in this decision that these words will be seen as a forename and a surname by the average consumer. On that basis, they would see the applicant's mark as a unit in line with the example set out at paragraph 20 of *White & Mackay* "...where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER)."³

57. Given that the two words form a unit, the overall impression of the mark lies in that unit.

Visual comparison

58. Visually, the marks share the word "ALICE", but the applicant's mark has the additional word "LIVEING". I find these marks to be of a medium degree of visual similarity.

Aural comparison

59. Aurally, the marks are "ALISS" v "ALISS LIV-ING", the second word in the applicant's mark being pronounced like the dictionary word "living". I find these marks to be of a medium degree of aural similarity.

³ *Whyte & Mackay Ltd v Origin Wine UK Ltd* [2015] FSR 33

Conceptual comparison

60. On page 3 of its statement of grounds, which is not paragraph numbered, the opponent says: “The second word ‘Liveing’ is a very uncommon surname, which to a large portion of consumers is likely to be understood as A) a created word, B) a play on the word ‘Living’ and ‘Live’, or C) even misread simply as the word “Living”. Due to the rarity of the surname in the UK the second word in this mark is unlikely to be automatically recognised as a surname.”

61. The opponent then argues at paragraphs 16 and 17 of its submissions that:

“The Opponent denies the Applicant's assertion ... that "LIVEING" is the dominant and/or distinctive element of the word mark ALICE LIVEING. You can record "live" music or "live" shows, you can broadcast "live" to an audience, and therefore this term which appears to be a play on the word "live" is highly allusive in relation to Class 9 goods, especially apparatus for recording, transmission or reproduction of sound or images, audio apparatus, and apparatus that could be used for broadcasting.

62. The Opponent denies that "LIVEING" would be immediately understood as a surname as it is a very uncommon surname. The Opponent contends the mark "ALICE LIVEING" is likely to be understood not as a forename and surname but as the brand "ALICE" and a sub-brand or particular range of products, possibly for "live" use.”

63. Before me, Mr Marshall said that what the opponent is arguing would require the average consumer to go through a series of “mental gymnastics” whereby “ALICE” would be seen as denoting origin, and “LIVEING” would be seen as an invented word which at the same time alludes to the word “LIVE”, and that the applicant’s mark would be seen as a sub-brand of “ALICE”. Mr Marshall said, “if what you were trying to do was allude to the idea of "live" or "live

music" you would just use the word "live". You would not conjure up a fictional word to try and allude to that at all."

64. I agree with Mr Marshall on this point. I find it highly unlikely that if a company was seeking to refer to the word "LIVING" or the word "LIVE" in creating a sub-brand, that it would misspell the word "LIVING" or add -ing to the word "LIVE".

65. Further, Mr Marshall said that the opponent is advancing a convoluted argument to "to avoid the obvious conclusion, which is when the average consumer sees ALICE LIVEING, they understand it is a forename and a surname, a person, an individual. In my submission that is exactly what the average consumer will do. They will see ALICE LIVEING to be a person's name".

66. The applicant has also put forward evidence that the word "LIVEING" is not a dictionary word at paragraph 16 of Alice Liveing's witness statement. This is supported by two exhibits, AVL/9 and AVL/10, AVL/9 showing that there are no results for the word "liveing" when searching collinsdictionary.com and AVL/10 showing that the Oxford English Dictionary only has the word "liveing" as an obsolete variant of the word "living" dating from the 1330s and Old English.

67. I have considered the parties' arguments. I note that the word "LIVEING" is not spelt like any dictionary word and is preceded by a forename, and I find that it would be seen by the average consumer as a surname.

68. The marks at issue would be perceived by the average consumer as names. I remind myself that Philip Harris, sitting as the Appointed Person in *Georgine Ratelband v Walmart Apollo, LLC* (BL O/1212/23) considered the question of the conceptual comparability of names. He held that conceptual comparison between names is perfectly possible, even where the names do not give rise to a concept over and above that of their being recognised as names.

69. While the marks share the concept of the forename Alice, the applicant's mark also gives rise to the concept of the surname Liveing. I find these marks to be of a medium degree of conceptual similarity.

Distinctive character of the marks

70. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, 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 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).”

71. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

72. The earlier marks are both the word mark, "Alice" which the average consumer would see as a commonplace forename. The name is not suggestive of the goods and services for which the marks are registered. I find the mark to be inherently distinctive to a medium degree.

73. No evidence has been filed by the opponent as to enhanced distinctiveness.

Likelihood of confusion

74. 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 trade marks, the average consumer for the goods at issue 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 trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

75. I have found the parties' marks to be visually, aurally and conceptually similar to a medium degree. I have found that the average consumer of the goods at

issue would pay a medium degree of attention during the purchasing process. Visual factors would be important during the purchasing process, but verbal considerations would also be significant.

76. I have found that the applicant's goods, by comparison with the opponent's goods to range from a low degree of similarity to being identical.

77. I have found the earlier marks to have a medium level of inherent distinctive character, the opponent not having filed any evidence in respect of enhanced distinctiveness.

78. While the marks share the word "ALICE", the applicant's mark also has the word "LIVEING" which is longer than the word "ALICE". Its presence in the applicant's mark would not go unnoticed by the average consumer and so there is no likelihood of direct confusion in this case.

79. I also consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

80. The opponent has filed evidence of audio products adopting the formula of house brand/sub brand in support of the contention that “LIVEING” is a plausible sub-brand of the house brand “ALICE”.

81. Mr Downing lists the following examples from argos.co.uk at paragraph 4 of his witness statement:

4. Exhibit MD 2 shows audio equipment is sold in the UK using a house brand followed by a sub-brand, including the following examples:

<u>House Brand:</u>	<u>Sub-Brand:</u>
Bose	QuietComfort
Sonos	Move
JLB	Encore
JLB	Charge
Skullcandy	Crusher
Roberts	Revival
Roberts	Rambler
Roberts	Zen
Bose	Soundlink Revolve II

82. I do not consider it likely that the average consumer would see a mark that is the single word “ALICE” as a house brand with “ALICE LIVEING” as a sub-brand. In that regard, I concur with Mr Marshall’s quoting of the Pia Hallstrom⁴ case at paragraph 34 of his skeleton arguments:

34. Again, in *Pia Hollstrom* at [15], Mr Daniel Alexander KC stated (emphasis added):

“...if the term “PIA” on its own is perceived to be a name, it does not follow that the average consumer would imagine that the only person with such a name would be the person behind (or the person after whom) the opponent’s business was named. Thus, the mere fact that the name “JOHN” is likely to be perceived by most people as a name does not thereby mean that an average consumer would automatically or probably suppose that goods branded “JOHN SMITH” would come from the same trade source as those branded “JOHN”. In some contexts and depending on the particular evidence in a case, such a finding might be warranted but I do not consider that there is a general rule.”

⁴ *Pia Hallstrom*, BL O-303-17

83. Nor would the average consumer see the second word of the applicant's mark, "LIVEING", as an invented word that was suggestive of the word "LIVE". Rather, because the word "LIVEING" is not spelt like any dictionary word and is preceded by a forename, it would be seen as a surname and the mark as a whole would be seen as a unit with the consequence that the word "ALICE" is not independently distinctive within the mark.

84. The average consumer would see the presence of the forename Alice in the opponent's marks and the applicant's mark as coincidental and not the result of any economic connection between them.

85. I conclude that there is no likelihood of indirect confusion in this case even where the goods at issue are identical.

86. Subject to any appeal, the opposition under section 5(2)(b) of the Act fails in its entirety.

Section 3(6)

87. Section 3(6) of the Act is as follows:

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

88. In *Skykick UK Ltd & Anor v Sky Ltd & Ors* (Rev1), [2024] UKSC 36, the Supreme Court considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, *Sky plc & Ors v Skykick UK Limited & Anor*, Case C-371/18, *AS v Deutsches Patent- und Markenamt*, Case C-541/18, *Malaysia Dairy Industries Pte. Ltd v Ankenævnet for Patenter Varemærker* Case C-320/12, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, *Hasbro, Inc. v EUIPO*, Case T-663/19, *pelicantravel.com s.r.o. v OHIM*, Case T-136/11, and *Psytech*

International Ltd v OHIM, Case T-507/08. Lord Kitchin summarised the law as follows:

“240. The general principles are these:

- (i) ...
- (ii) The date for assessing whether an application to register an EU trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).
- (iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation in the European Union, and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*Malaysia Dairy*, para 29; *Sky* CJEU, para 73).
- (iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the EU law of trade marks, namely the establishment and functioning of the internal market, and a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; *Koton*, para 45).
- (v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the

aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky* CJEU, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*Hasbro*, paras 39 and 40; *Koton*, para 47).

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

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

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky* CJEU, para 76; *Deutsches Patent- und Markenamt*, para 22).

- (x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/04 (*Sky* CJEU, para 77).
- (xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky* CJEU, para 77).
- (xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky* CJEU, para 78).
- (xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky* CJEU, para 81).
- (xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of

the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

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

89. Further relevant points arising from the case law are the following:

- a) An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies. However, Arnold J (as he then was) said that “coherent evidence is required due to the seriousness of the allegation”. This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited & Anor* [2012] EWHC 1929 (Ch), paragraph 133;
- b) It is necessary to ascertain what the applicant knew at the relevant date: see *Red Bull*, paragraph 137; and
- c) Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2008] EWHC 3032 (Ch), paragraph 167.

The parties' arguments

The opponent

90. In its Form TM7, the opponent stated the following:

“The Applicant does not intend to use the mark for many of the goods and services included in the Application. The Applicant seeks to monopolise a mark for goods and services they have no intention to provide where other traders may have a legitimate interest, this unfairly disadvantages other traders and undermines the trade mark system. Including goods and services in a trade mark application with no intention to offer them under the mark constitutes bad faith in respect of those particular goods and services.”

91. Having originally listed a larger range of goods and services, by the time that the opponent came to file its submissions of 26 September 2023, its allegation of bad faith was confined to the following Class 9 goods which it listed at paragraph 5:

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data.

92. In its submissions, at paragraph 21, the opponent refers to the breadth of the applicant's specification as a whole: “The Applicant applied [for] goods and services stretching over seven pages. There is no particular length at which it could be presumed there is not an intention to offer all of the goods and

services within a specification. Instead, by looking at the list one may draw reasonable conclusions as to whether the specification reflects a breadth of goods and services that an undertaking could feasibly offer.” I am struggling to see the relevance of these arguments given that the opponent has confined its section 3(6) objections to specific Class 9 goods.

93. Its objections to the Class 9 goods are stated as follows:

“20. The Opponent maintains some of the Class 9 goods were filed in bad faith as there is no intention to offer these goods.

...

22. ... [T]he Applicant has included large sections of the Nice Class headings in the Application ... Class headings such as Class 9 ... present a disparate list and it is unlikely all of the following goods would be provided by the same undertaking ...

The Opponent proposes the above goods [the Class goods objected to] have simply been included because they form part of the Class heading, rather than because the Applicant has a bona fide intention to offer these goods. The Opponent invites the Applicant to specify the types of nautical apparatus and instruments they would be offering, and also the types of life-saving apparatus and instruments or, alternatively, to revisit the specification and remove any goods which they do not actually have an intention of providing.

...

24. It is highly unlikely the Applicant intends to offer (at least) any nautical or lifesaving apparatus and instruments in Class 9. It is most likely that these goods, which form part of the Class heading, have simply been included in the Application as a catch all along with the kitchen sink with

no actual intention to offer these particular goods or services to UK customers.

...

27. The Opponent maintains their objection under Section 3(6) of the Trade Marks Act 1994 in respect of the Class 9 goods listed in paragraph 5. In light of the analysis above the Opponent suggests the burden of proof be shifted to the Applicant to demonstrate a bona fide intention of use the applied for mark in respect of the Class 9 goods in paragraph 5.”

The applicant

94. In his skeleton arguments, having cited the relevant section of the Manual of trade marks practice and the relevant case law in respect of the presumption of good faith, Mr Marshall says the following:

“43. ... The Opponent’s case is based solely on its belief that the goods listed ... are broad such that no business could feasibly offer those goods. That is all. Worse, the Opponent has not submitted any evidence to support that bald assertion.

46. The Applicant’s subjective intention as to use of the Applicant’s Mark over the next 5 years in relation to those goods in class 9 is set out in [paragraphs 12 to 13 of Alice Living’s witness statement] ... The Applicant and/or Ms Liveing have every intention to continue to expand the goods and services offered under the Applicant’s Mark, including into the phone application space. It is clear that the commercial logic of the Application is to cover a broad range of goods in class 9 in relation to which the Applicant’s Mark may be used. That is more than sufficient to satisfy the relevant legal test ...

47. It is submitted that the Opponent's case falls drastically short of discharging the burden it bears of establishing bad faith and/or a rebuttable presumption thereof."

My analysis

95. I note that the opponent has filed no evidence in support of its submissions. The best that can be said is that its Form TM7 can be deemed to be evidential in that it includes a statement of truth.⁵
96. Given that a claim to bad faith is a serious allegation, the question for me to determine is whether the opponent has sufficiently raised a prima facie case in its Form TM7 and its submissions which requires its case to be rebutted by the applicant. The case law confirms that applying for a trade mark without an intention to use it for particular goods is not in itself bad faith without showing something else.
97. It is also clear from the caselaw that the burden of proving bad faith lies with the opponent. The applicant is not required to provide a positive case of good faith, unless and until the opponent has presented evidence from which "a rebuttable presumption of lack of good faith" can be drawn. Furthermore, it is clear from the decision in Skykick CJEU that there is no requirement for the applicant to use or intend to use the mark for all the Class 9 goods at issue at the time that it made its application.
98. I have nothing before me to suggest any dishonest behaviour on the applicant's part.
99. I am not satisfied that a prima facie case of bad faith has been established that requires rebuttal from the applicant.

⁵ Per *Soundunit Limited v Korval Inc.*, BL/0468/12.

100. The opposition under section 3(6) fails.

CONCLUSION

101. The opposition under section 5(2)(b) and section 3(6) fails in its entirety and the full application may proceed to registration.

COSTS

102. The applicant has been entirely successful in this case, and I award costs accordingly in line with Tribunal Practice Notice 1 of 2023 as follows:

Preparing a statement and
considering the other side's statement: £250

Preparing evidence and considering
and commenting on the other side's evidence: £750

Preparing for and attending a hearing: £750

Total: £1750

103. I order Alice Ltd to pay ALICE LIVEING LIMITED the sum of £1750. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of July 2025

**John Williams
For the Registrar**

Annex 1

The applicant's full specification:

Class 3 Perfumes; perfumery; eau de toilette and eau de Cologne; deodorants for human beings or for animals; incense; joss sticks; air fragrancing preparations; sachets for perfuming linen; air fragrance reed diffusers; scented room sprays; extracts of flowers [perfumes]; potpourris [fragrances]; essential oils for personal use; oils for toilet purposes; henna [cosmetic dye]; make-up; eye shadow; cosmetic pencils; eyeliner; foundation; foundation creams; make-up powder; pressed face powder; creamy face powder; face powder [for cosmetic use]; talcum powder, for toilet use; blusher; lipsticks; lipstick cases; lip glosses; non-medicated lip balms; cocoa butter for cosmetic purposes; mascara; sunscreen preparations; sun-tanning preparations [cosmetics]; skin bronzing creams; self-tanning creams; sun-tanning creams and lotions; after-sun creams and preparations; sun protectors for lips [cosmetics]; cosmetic preparations to protect against sunburn; nail polish; nail polish removers; nail glitter; beauty masks; facial scrubs [cosmetic]; skin exfoliants; face creams for cosmetic purposes; cosmetic body creams; cosmetic creams; pomades for cosmetic purposes; cosmetic preparations for slimming purposes; creams for cellulite reduction for cosmetic use; hair sprays; cosmetic hair lotions; hair bleaching preparations; hair dyes; hair colouring preparations; hair rinses [shampoo-conditioners]; hair lighteners; hair conditioners; hair moisturizers; preparations for the permanent waving of hair; gels, sprays, mousses and balms for hair styling and hair care; brilliantine; depilatory preparations; depilatory creams; hair straightening preparations; tissues impregnated with make-up removing preparations; phytocosmetic preparations; nail art stickers; false nails; adhesives for cosmetic purposes; nail conditioners; cotton sticks for cosmetic purposes; pre-moistened or impregnated cleansing pads, tissues or wipes; cosmetic patches containing sunscreen and sun block

for use on the skin; facial concealer; under-eye enhancers; non-medicated foot creams; skin whitening creams; bleaching preparations [decolourants] for cosmetic purposes; massage gels, other than for medical purposes; cleansing milk for toilet purposes; hair mascara; gel eye masks; decorative transfers for cosmetic purposes; cotton wool for cosmetic purposes; cloths impregnated with a detergent for cleaning spectacles; eye-washes, not for medical purposes; antiperspirants [toiletries]; make-up removing preparations; micellar water; body paints for cosmetic purposes; cotton wool impregnated with make-up removing preparations; cosmetics; hand soap; cosmetic soap; facial soaps; non-medicated soap; skin cleansing creams; skin cleansing lotions; shower gel; bubble bath for cosmetic use; bath oils, not for medical purposes; bath pearls, not for medical purposes; bath salts, not for medical purposes; cosmetic creams and lotions for face and body care; shaving balms; shaving creams; shaving soap; after-shave balms; after-shave cologne; after-shave lotions; hair shampoos; bath preparations, not for medical purposes; cleansers for intimate personal hygiene purposes, non medicated; mouthwashes, not for medical purposes; non-medicated dentifrices; cosmetic preparations for the care of mouth and teeth; breath freshening preparations for personal hygiene; laundry starch; laundry soap; stain removers; cleaning preparations; rust removing preparations; carpet shampoos; cloths impregnated with a detergent for cleaning; emery; pumice stone; polishing powder; shoe polish; shoe wax; shoe cream; creams for leather; leather bleaching preparations; preparations for cleaning, protecting and preserving vehicle surfaces; massage candles for cosmetic purposes; scented room sprays; reed diffusers; fragrance refills for reed diffusers; oils for perfumes and scents; scented oils; scented wax melts.

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for

conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; headphones; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; docking stations; radios, including mobile and portable radios; music recordings; vinyl records; compact discs; audio recordings; video recordings; Recorded and downloadable media; podcasts; digital music downloadable online; data processing equipment, computers; computer software; fire-extinguishing apparatus; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; digital telecommunication apparatus and instruments; digital tablets; tablet computers; computer hardware; computer application software; computer software downloadable from the Internet; recorded computer software; software applications; mobile software applications, downloadable applications for multimedia devices; software applications for mobile telecommunications devices; electronic games for mobile telecommunications devices; computer games; computer game software; computer software applications, downloadable; computer games programs; USB flash drives; PDAs (Personal Digital Assistants); pocket PCs; mobile telephones; selfie sticks [hand-held monopods]; smart rings; smartphones; smartwatches; laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; computer software recorded onto CD Rom; glasses, sunglasses; cameras; camera lenses; MP3 players; audio tapes, audio cassettes; audio discs; audio-video tapes; audio-video cassettes; audio-video discs; video tapes; video cassettes; video discs; CDs, DVDs; downloadable electronic publications; downloadable image files; downloadable music files; mouse mats; magnets; mobile telephone covers; mobile telephone cases; cases and covers for mobile telecommunication devices and laptop computers; hands free kits for

phones; magnetic cards; encoded cards; mobile phone application software; software for telecommunication; downloadable ring tones for mobile phones; loudspeakers; magnetic data media; television apparatus; audio, video and audiovisual mixers; parts and fittings for all the aforesaid goods; none of the aforesaid connected with or relating to the medical field, medicine, medical research or other fields of interest to healthcare and medical institutions or professionals.

Class 14 Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments; clocks and watches; watch straps; jewellery boxes and watch boxes; costume jewellery; imitation jewellery; works of art, models, badges, made of or coated with precious or semi-precious metals or stones, or imitations thereof; tie clips, tie pins, pins, cuff links, lapel pins; ornamental pins made of precious metal; medals and medallions; coins; key rings and key chains, and charms therefor; key fobs; key holders [trinkets or fobs]; bracelets; brooches [jewellery]; lockets; rings [jewellery]; earrings; pendants; necklaces; jewellery charms; body jewellery; parts and fittings for all the aforesaid goods.

Class 16 Paper and cardboard; printed matter; photographs; stationery and office requisites, except furniture; adhesives for stationery or household purposes; drawing materials and materials for artists; paintbrushes; instructional and teaching materials; educational supplies; notepaper; writing paper; envelopes; transfers; decalcomanias; labels; trading cards; post cards; notepads; stickers; posters; pictures; prints; albums; paintings [pictures], framed or unframed; canvas pictures and prints; periodical publications; newspapers; magazines; annuals [printed publications]; poster magazines; printed programmes; binders; books; booklets; book markers; book ends; photo albums and collectors' albums; philatelic stamps; rulers; pencil sharpeners; erasers; flags of paper; pennants of paper; calendars; paper coasters; works of art and figurines of paper, cardboard and papier mache; stationery cases;

pencil cases; writing and drawing instruments; files; folders and folios; personal organisers; address books; diaries; jotters; autograph books; autograph albums; cards; birthday cards; greeting cards; bags and articles for packaging, wrapping and storage of paper, cardboard or plastics; paper weights; tissues; paper handkerchiefs; towels of paper; gift bags and gift wrap; gift tags; gift vouchers; money holders; holders for chequebooks; none of the aforesaid connected with or relating to the medical field, medicine, medical research or other fields of interest to healthcare and medical institutions or professionals; Books.

Class 18 Leather and imitations of leather; leather belts; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; articles of luggage; cases; suitcases; handbags; purses; bags; travel bags; backpacks; duffel bags; boot bags; sports bags; gym bags; school bags and satchels; holdalls; wallets; credit card cases and holders; toiletry bags; belts for luggage; shoulder belts; luggage tags; shoes bags; swim bags; rucksacks; umbrella covers; clothing for animals; collars and covers for animals; parts and fittings for all of the aforesaid goods.

Class 25 Clothing, footwear, headwear; outerclothing; leisurewear; loungewear; sportswear; sports clothing; track suits; training suits; knitwear; suits; sweatshirts; sweaters; pullovers; jumpers; tops; hooded tops; shirts; t-shirts; jerseys; rugby tops; bottoms; trousers; shorts; skirts; dresses; gowns; bathrobes; dungarees; lounge pants; socks; underclothing; underwear; boxer shorts; vests; stockings; lingerie; hosiery; nightwear; pyjamas; dressing gowns; one-piece suits; jackets; coats; waterproof outerclothing; weatherproof clothing; thermal clothing; anoraks; rainwear; cagoules; ponchos; romper suits; sleepsuits; smocks; salopettes; overalls; aprons; fancy dress costumes; shoes; boots; sandals; slippers; swimwear; ties; cravats; pocket squares; gloves; scarves; ear muffs; belts [clothing]; braces for clothing; wrist bands; sweatbands; collar protectors; inner soles; hats; caps; visors.

Class 35 Advertising; business management; advertising services provided via the Internet; provision and rental of advertising space, time and media; provision of space on websites for advertising goods and services; marketing and promotional services; event marketing; public relations and publicity services; merchandising; organisation, arrangement and conducting of exhibitions and events for advertising and promotional purposes; organisation, arrangement and conducting of competitions and prize draws for commercial or advertising purposes; production of television and radio advertisements; information, advisory and consultancy services relating to all of the aforesaid services; none of the aforesaid connected with or relating to the medical field, medicine, medical research or other fields of interest to healthcare and medical institutions or professionals.

Class 38 Telecommunications services; broadcasting services; television and radio broadcasting, transmission and communication services; broadcasting and transmission of radio or television programmes; transmission of sound and/or pictures; broadcasting services, namely, uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network; news agency services; webcasting services; providing digital program distribution of audio and video broadcasts over a global computer network; providing access to a video sharing portal for entertainment and education purposes; electronic communication services; radio broadcasting, digital radio broadcasting and television broadcasting services; televisual communication services; broadcasting over the Internet or other computer network; electronic transmission of streamed and downloadable audio and video files via electronic and communications networks as well as by means of a global computer network; electronic mail services; providing of access to on-line chat rooms and bulletin boards; telecommunication of information including web pages,

computer programs, text and any other data; transmission of messages, data and content via the Internet and other computer and communications networks; online forums, chat rooms, journals, blogs, and listservers for the transmission of messages, comments and multimedia content among users; providing access to digital music websites on the Internet or other computer network; delivery of digital music by telecommunications; webstreaming being the transmission of data, information and audio-visual data via the Internet or other computer network; news agency services; transmission of written and digital communications; leasing and rental services in connection with telecommunications apparatus and equipment; operation of chat rooms; provision of news and news information via a computer network and/or the Internet; provision of on-line forums; really simple syndication (rss) feeds relating to music, news, films, celebrities and television programmes; advisory and consultancy services relating to the aforesaid; none of the aforesaid connected with or relating to the medical field, medicine, medical research or other fields of interest to healthcare and medical institutions or professionals.

Class 41 Entertainment; sporting activities; academies [education]; arranging and conducting of colloquiums; arranging and conducting of concerts; arranging and conducting of conferences; arranging and conducting of congresses; arranging and conducting of seminars; arranging and conducting of symposiums; arranging and conducting of workshops [training]; club services [entertainment or education]; nightclub and discotheque services; dj and compere services; dance club services; hosting of musical events; electronic desktop publishing; entertainer services; entertainment information; organisation of shows for entertainment purposes; film production, other than advertising films; gambling; game services provided on-line from a computer network; providing online entertainment, namely providing sound and video recordings in the field of music and music based entertainment; fan clubs; development and dissemination of educational materials of

others in the field of music and entertainment; news reporters services; organization of shows [impresario services]; organization of sports competitions; party planning [entertainment]; personal trainer services [fitness training]; physical education; production of music; production of radio and television programmes; production of shows; providing karaoke services; providing on-line electronic publications, not downloadable; publication of books; publication of electronic books and journals on-line; publication of texts, other than publicity texts; radio entertainment; recording studio services; providing recreation facilities; television entertainment; theatre productions; ticket agency services [entertainment]; interactive entertainment services; electronic games services provided by means of any communications network; entertainment services provided by means of telecommunication networks; provision of news information; television production services; television programming services; television production and television programming services provided by means of Internet protocol technology; entertainment in the nature of ongoing television programs in the field of music and entertainment; entertainment, namely a continuing music and entertainment show distributed over radio, television, satellite, audio, and video media; provision of musical events; entertainment club services; presentation of live performances; entertainment in the nature of live concerts and performances by dj's, performers, musical artists and groups; entertainment services, namely personal appearances by dj's, performers, musical groups, musical artists and celebrities; entertainment services, namely, providing on-line reviews of music, musical artists and music videos; entertainment services, namely, providing prerecorded music, information in the field of music, and commentary and articles about music, all on-line via a global computer network; entertainment services namely live, televised and movie appearances by a professional entertainer; providing digital music from the Internet or other computer network; providing digital music from Internet websites; downloading of radio and television programmes, films, videos, sound, images or data from the Internet or

other computer network; conducting entertainment exhibitions in the nature of music festivals; rental of music venues and stadiums; ticket reservations for entertainment, sporting and cultural events; ticket information services for entertainment, sporting and cultural events; ticket agency services for entertainment, cultural and sporting events; provision of on-line computer games; computer amusement services; publishing services; arranging, organising and conducting of competitions, games and quizzes; organisation of awards; conducting of phone-in competitions; booking agency services connected with the issuing of tickets for events; rental of music and audiovisual recordings; television programming; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network; none of the aforesaid connected with or relating to the medical field, medicine, medical research or other fields of interest to healthcare and medical institutions or professionals; Training related to nutrition; Education services relating to nutrition; Health and wellness training; Health and fitness training; Provision of educational health and fitness information; Physical health education; Dietary education services; Instruction in diet [not medical]; Physical fitness education services; Book publishing.

Class 44 Advisory, information and consultancy services relating to cosmetics, hair care, diet, nutrition, beauty, beauty care, beauty treatment, health, skin care; Aesthetician services; Beauty care; Beauty consultancy; Beauty salon services; Cosmetic and plastic surgery; Cosmetic dentistry services; Cosmetic electrolysis; Cosmetic facial and body treatment services; Cosmetic laser treatment of skin; Cosmetic skin tanning services for human beings; Cosmetic treatment; Hair care services; Hair dressing salon services; Hair treatment services; Hairdressing services; Health advice and information services;

Hygienic and beauty care; Make-up consultation and application services; Make-up consultation services provided on-line or in-person; Manicure and pedicure services; Massage services; Nail care services; Nail salon services; Spa services; Spray tanning salon services; Spray tanning services; Therapeutic treatment of the body; None of the aforesaid connected with or relating to the medical field, medicine, medical research or other fields of interest to healthcare and medical institutions or professionals.