O/0897/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003999883
BY PHOTO-IMAGE LTD
TO REGISTER THE FOLLOWING TRADE MARK:

Skybank

IN CLASS 9

AND

AN OPPOSITION THERETO UNDER NUMBER OP000447197
BY SKY LIMITED

BACKGROUND AND PLEADINGS

1. On 9 January 2024, Photo-Image Ltd ("the Applicant") applied to register in the UK the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 26 January 2024 and registration is sought for the following goods:

Class 9: *Photo printers; Digital photo frames; Electronic photo albums; Computer software for organizing and viewing digital images and photographs; Downloadable digital photos; Digital picture frames; Downloadable image files; Software for processing images, graphics, audio, video and text; Computer software for scanning images and documents; Picture projectors; Computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures; Computer software for processing digital images; Image scanners; Software for processing digital images; Photographic cameras for the instant production of pictures; Digital books downloadable from the Internet.*

2. On 26 April 2024, Sky Limited ("the Opponent") opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 ("the Act").[1] The Opponent relies upon the following two trade marks:

(i) Trade mark number UK00003377563 ("the word mark")
Representation: SKY
Filing date: 2 September 2009
Registration date: 22 March 2019
Priority date: 2 March 2009
Goods relied upon: Class 9[2]

[1] 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.
[2] These are listed in Annex 1 to this decision.

(ii) Trade mark number UK00003859806 (series of two) ("the stylised mark")

Representations:

Filing date: 15 December 2022

Registration date: 10 March 2023

Goods relied upon: Class 9[3]

3. Given their earlier filing dates, the Opponent's marks are earlier marks in accordance with section 6(1) of the Act. Further, in accordance with section 6A of the Act, the Opponent's marks are not subject to proof of use and so the Opponent may rely upon both marks and all the goods it has identified for the purposes of this opposition.

4. Under section 5(2)(b), the Opponent claims that its marks are highly similar to the Applicant's mark and that the competing goods are identical or highly similar, resulting in a likelihood of confusion, including a likelihood of association.

5. In its defence and counterstatement, the Applicant broadly denied the Opponent's claims but made several submissions that have no impact on the decision I am required to make; I will deal with these – as well as the Applicant's misguided request for proof of use – as preliminary points in due course.

6. The Opponent is represented by Dentons UK and Middle East LLP; the Applicant is unrepresented.

[3] These are listed in Annex 2 to this decision.

7. Neither party filed evidence during the evidence rounds. In response to the Tribunal's 'end of evidence rounds' letter,[4] which confirmed no evidence had been filed, the Applicant seemed to suggest that it wished to file evidence and to attend a CMC to discuss the issue. The Tribunal wrote to the parties to advise that any request to file late evidence must be made on a Form TM9R.[5] No response was received and no Form TM9R was filed.

8. Neither party requested a hearing. Only the Opponent chose to file written submissions in lieu of a hearing, attached to which were 85 pages of evidence; I will deal with this as a preliminary point.

PRELIMINARY POINTS

9. In its defence and counterstatement, the Applicant has made several points that are irrelevant to the decisions I am required to make in these proceedings. I will address each of these and explain why they do not assist the Applicant.

10. The Applicant refers to the way in which it uses the mark it has applied for and the specific activities it undertakes to create the goods on which the mark is used. Assessing the likelihood of confusion is notional, based on the marks and specifications that have been rendered by the parties for the purpose of application/registration. Therefore, the only similarities/differences that form part of my assessment are those which are evident from the marks and specifications as they appear on the register.

11. The Applicant invites the Tribunal to perform searches on the internet for businesses using the terms "Skybank" and "Sky Bank" worldwide to demonstrate these terms in widespread use. The Applicant has filed no evidence to support this contention and so I place no weight on this argument.

[4] See official letter dated 13 January 2025.
[5] See official letter dated 27 January 2025.

12. The Applicant contends that it is currently using its applied for mark "without any issues". This is not an argument that has been expanded upon at any point in these proceedings. If the Applicant is suggesting that there has been no actual confusion in the marketplace, this is not persuasive. As the Appointed Person Mr Phillip Johnson recently confirmed, "it has long been established that there is no need to show actual confusion for a Hearing Officer to find there to be a *likelihood* of confusion".[6]

13. The Applicant's counterstatement also makes reference to the registrability of the Opponent's word mark. The Applicant claims that the word "sky" should have been refused registration for non-distinctiveness, on the basis that it is a word in use in everyday language. The Opponent's earlier marks are registered marks, and registered marks are deemed to be distinctive. In these proceedings it is appropriate neither to deny the distinctive character of the Opponent's trade marks nor to call into question their validity.[7] I will, however, assess the degree to which I find the earlier marks distinctive as part of my multifactorial assessment of the likelihood of confusion.

14. Lastly, the Applicant requested proof of use of the Opponent's marks in relation to specific goods that do not appear in the Opponent's specifications. As was clarified in correspondence between the Tribunal and the parties, the Opponent's marks are not subject to proof of use.[8] Even if they had been subject to proof of use, the Opponent would be expected neither to demonstrate use for goods on the basis that those were the goods the Applicant intended to provide, nor to demonstrate use for any goods that do not feature in its own marks' specifications.

15. As a final preliminary point, I return to the Opponent's submissions in lieu. The submissions themselves contain what I would consider fairly typical submissions going to the relevant law and the various assessments usually made in opposition proceedings under section 5(2)(b), i.e. a comparison of the marks and of the goods, for example. However, the Opponent attached four documents to the submissions which, in my view, constitute evidence. Attachment 1 contains online definitions of the term "image bank" and attachments 2, 3 and 4 each contain a trade mark decision of

[6] See the decision under BL O/0820/25 at paragraph 14.
[7] *Formula One Licensing BV v OHIM,* Case C-196/11P.
[8] See official letter dated 9 July 2024.

this Tribunal. On the basis that these attachments were not filed during the evidence rounds and thus the Applicant has had no opportunity to file submissions or evidence in reply, I will not take them into account in making my decision. Even so, with regards attachments 2-4, I am not bound by the first instance decisions of other Hearing Officers of this Tribunal. Each case is decided on its own facts and so even if these decisions were taken into account it is likely they would have been of little assistance.

DECISION

Section 5(2)(b)

Statutory provisions

16. 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."

Relevant case law

17. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas*

AG & Adidas Benelux BV, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

18. The goods to be compared are the Applicant's goods, as listed in paragraph 1 of this decision, and the Opponent's goods, as listed in Annex 1 and Annex 2 of this decision.

Relevant case law

19. In *Gérard Meric v OHIM,* the GC confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):[9]

"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*

[9] Case T-133/05.

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."

20. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:[10]

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

The Opponent's submissions

21. The extent of the Opponent's submissions on the comparison of goods is a table in its submissions in lieu which separates its own goods into two categories and labels them 'identical' or 'similar' to the Applicant's entire specification. The Opponent then submits that the intended purpose, channels of trade and end consumers must be the same, that the target market and consumers are the same, and that similar distribution methods and retail environments are used. Other than this very broad submission, there is no explanation as to *why* any of the Applicant's specific goods are similar or identical to the Opponent's, nor any identification of which of the Opponent's goods are the basis for such similarity/identity.

22. I bear in mind the comments of Iain Purvis KC, sitting as the Appointed Person in *SMARTX*:[11]

> "[It] is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identicality). If it fails to identify a particular combination,

[10] BL O/399/10.
[11] BL O/0911/24.

> it cannot expect the Hearing Officer to do the job for it. [This] would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made."

23. Accordingly, particularly given the length of the Class 9 specifications relied upon, it would have been helpful for the Opponent to have identified, either in its pleadings or in its subsequent submissions, which particular goods of its registrations are alleged to be similar/identical to which goods of the Applicant's specification.

24. However, given that the Opponent has made some (albeit vague) submissions on the factors to be considered, I will proceed to compare terms where I believe the similarity or identity is obvious.

Photo printers; Digital photo frames; Electronic photo albums; Digital picture frames; Picture projectors; Image scanners; Photographic cameras for the instant production of pictures

25. These applied-for goods are devices used for reproducing pictures or images. Accordingly, I find them to fall within the scope of the Opponent's *apparatus for recording, transmission, reproduction or reception of sound, images or audio visual content* in its word mark registration and *apparatus for recording, transmission or reproduction of sound or images* in its stylised mark registration. These goods are identical in line with *Meric.*

Computer software for organizing and viewing digital images and photographs; Software for processing images, graphics, audio, video and text; Computer software for scanning images and documents; Computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures; Computer software for processing digital images; Software for processing digital images.

26. These applied-for goods constitute software for organising, displaying, processing or creating either images, graphics, audio, video or text. As such, they are identical, in

line with *Meric*, to the Opponent's *computer software, devices, and hardware for transmitting, receiving, synchronizing, displaying, backing-up, monitoring, controlling, sharing, coding, decoding, encrypting, accessing, remotely accessing, creating, collecting, storing, securing, removing, transferring, disseminating, locating, organizing or otherwise utilizing data, voice, multimedia, audio, visual, music, photographs, drawings, images, audiovisual, video, text, graphics or other data, including over a global communications network* in its word mark registration and/or *software for creating, accessing, collecting, editing, organising, commenting on, modifying, transmission, storage and sharing of audio, visual and/or audio visual content, data and information* in its stylised mark registration.

Digital books downloadable from the Internet.

27. These applied-for goods fall within the meaning of the Opponent's *electronic publications (downloadable)* in its stylised mark registration and are identical in line with *Meric.* On the basis that the applied-for goods constitute texts provided by way of the Internet, I also find them to fall within the scope of the Opponent's *[…] text and information provided by a telecommunications network, by on-line delivery and by way of the Internet […]* in its word mark registration; these are identical in line with *Meric.*

Downloadable digital photos; Downloadable image files.

28. On the basis that the applied-for goods constitute images that may be provided by way of the Internet (by virtue of them being downloadable), I find them to fall within the scope of the Opponent's *[…] images, text and information provided by a telecommunications network, by on-line delivery and by way of the Internet […]* in its word mark registration; these are identical in line with *Meric.* The applied-for goods are also identical to the Opponent's *downloadable image files containing artwork, text, audio, video and/or graphics relating to audio, visual and/or audio visual content* in its stylised mark registration, in line with *Meric.*

29. That concludes my comparison of the goods. I have found all of the Applicant's goods identical to goods in both of the Opponent's marks' specifications.

The average consumer and the purchasing act

30. As the case law set out at paragraph 17 indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

31. The relevant goods are those which I have found to be identical, the average consumer of which will be either a member of the general public or a professional seeking particular software products. The goods will be subject to self-selection from either the shelves of retail establishments (particularly in the case of the devices for reproducing pictures/images) or online. Consequently, visual factors are likely to dominate the selection process. However, it would not be unusual for consumers to require specialist assistance, advice or recommendations from technical experts, either in retail establishments or over the telephone, so aural considerations cannot be ignored.

32. The goods will vary in cost, ranging from fairly inexpensive downloadable books to more expensive software packages. That said, none of the goods are prohibitively expensive. They will, however, require consumers to consider factors such as the technical specifications, the suitability for their particular needs, and the compatibility of the various devices and software. To my mind, the purchase of the relevant goods will attract a medium degree of attention during the purchasing process.

Comparison of trade marks

33. It is clear form *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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."

34. 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 trade 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.

35. The marks to be compared are as follows:

The Applicant's mark	The Opponent's marks
Skybank	<u>The word mark</u> SKY <u>The stylised mark</u> 

36. The Applicant's mark consists of the textual element "Skybank", in title case,[12] which will be seen as the two ordinary words SKY and BANK, conjoined. The overall impression of the mark lies in the two conjoined words, with neither being more dominant or distinctive. The Opponent's submissions were that SKY in the Applicant's mark is the dominant and distinctive component on the basis that BANK is descriptive of the Applicant's goods; I will discuss this in the conceptual comparison.

37. The Opponent's word mark consists solely of the textual element 'SKY', the overall impression residing in that one word. The Opponent's stylised mark consists of the word 'SKY' presented in a stylised font with the letters K and Y joined in one place. One mark in the stylised series is in colour with shades of orange, red, pink, purple and blue; the other mark in the series is in greyscale. The dominant element of the stylised mark is the textual component, with the stylisation playing a lesser role.

38. Visually, the Applicant's mark and the Opponent's word mark share the element SKY, being the only component of the Opponent's mark and the first component of the Applicant's. They differ in that the Applicant's mark contains the additional element BANK. This results in a medium level of visual similarity. The same assessment applies to the Applicant's mark and the Opponent's stylised mark, save for the stylisation, which lowers the similarity to slightly below a medium degree.

39. Aurally, the Applicant's mark and the Opponent's marks share the word SKY, which will be pronounced in the ordinary way: as the only component in the Opponent's marks and the first component in the Applicant's mark. The difference resides in the additional component BANK in the Applicant's mark, which will be pronounced in the ordinary way. The Applicant's mark is aurally similar to a medium degree to both the Opponent's marks.

40. Turning to the conceptual comparison, I am conscious that the conceptual message of a mark must be capable of immediate grasp by the average consumer to

[12] Nothing hangs on the Applicant's mark being presented in title case as protection of a word mark extends to use in upper and lower case letters.

be relevant. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM.*[13]

41. There are submissions from the Opponent that SKY has no meaning in relation to the specification in either party's marks, but that BANK is purely descriptive of the Applicant's goods on the basis that it refers to a storage bank of photographs and images. The Opponent filed evidence going to the definition of "image bank", which was not admitted into these proceedings. Even if were to take this evidence into account, the Applicant has not applied for "image bank" but "Skybank" and so the definition put forward cannot be applied equally. Whilst I do consider that BANK can refer to a place that stores things, that definition is not logical in the Applicant's mark. The combination of SKY and BANK, conjoined, does not conjure in the mind of the average consumer a clear or immediate concept beyond the ordinary meaning of the two words individually.

42. Further, the fact that the Applicant's specification relates to images/photographs does not persuade me that BANK, particularly when preceded by the unrelated word SKY, is descriptive. It has recently been confirmed that assessing the conceptual similarity of marks is usually done without reference to the goods in question and I see no reason why the approach should be different in this case.[14]

43. The Opponent's marks comprise the ordinary word SKY, which has a clear, precise meaning being the word for the space directly above the earth. Taking all of the above into account, I conclude that there is a medium degree of conceptual similarity on the basis of the common presence of the word SKY. This finding applies to both the Opponent's earlier marks.

Distinctive character of the Opponent's earlier marks

44. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

[13] [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.
[14] *EMILIANA,* BL O/054/22 at [62].

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee,* paragraph 51)."

45. 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, 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 that has been made of it.

46. The Opponent filed no evidence of use of its earlier marks and so I have only the inherent position to consider.

47. The Opponent's marks consist of the word SKY, either as word-only or presented in a stylised font. As discussed in the conceptual comparison, SKY has no meaning in relation to the goods relied upon. However, it is a common dictionary word referring to the space above the earth. I find the Opponent's word mark to have an average degree

of inherent distinctive character. The stylisation in the stylised mark does not materially alter the distinctiveness and so my finding applies equally to both earlier marks.

Likelihood of confusion

48. 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 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 he has retained in his mind.

49. I have found the Applicant's mark to be visually, aurally and conceptually similar to a medium degree to the Opponent's word mark. I have found the Applicant's mark to be aurally and conceptually similar to a medium degree and visually similar to a slightly lower than medium degree to the Opponent's stylised mark. I have found the earlier marks to possess an average degree of inherent distinctive character. I have identified the average consumer to be a member of the general public or a professional, both of whom will pay a medium degree of attention to a mainly visual purchase, though aural considerations are also relevant. I have found all of the Applicant's goods identical to goods in both of the Opponent's marks' specifications.

50. The Opponent attests to a likelihood of confusion but does not specify whether this is direct or indirect confusion, though it submits "consumers would likely mistakenly believe that the Applicant's offerings are associated with or endorsed by the

Opponent".[15] This is more akin to indirect confusion, but I will consider both for completeness.

51. The two types of confusion were described by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:[16]

> "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'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand

[15] The Opponent's submissions in lieu.
[16] BL O/375/10.

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

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

52. Despite the Opponent’s submission that the Applicant’s mark will be recalled and remembered by the word SKY,[17] I have found the word BANK not to be descriptive. As such, I find no reason why the average consumer would shorten SKYBANK to SKY. I have given thought to the Opponent’s submission that consumers pay greater attention to the beginning of marks.[18] However, that is a general rule of thumb and not always applicable. In the case before me, the Applicant’s mark contains an entire additional word (albeit conjoined), rendering the marks significantly different in length. Taking everything into account, I find that the average consumer will notice the difference between SKYBANK and the Opponent’s SKY word mark and will not be directly confused between the two. This is so even bearing in mind the interdependency principle and the identity of the goods. The same applies to the Opponent’s stylised mark. There is no likelihood of direct confusion.

53. Turning to indirect confusion, the Opponent’s position is that the word SKY in the Applicant’s mark retains an independent distinctive character. On this point, I refer to the relevant case law. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo,* Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson.*[19] The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark

[17] The Opponent’s submissions in lieu.
[18] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.
[19] This case was cited by the Opponent.

contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation 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).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

54. I have already found that SKY and BANK, do not form a unitary meaning in the Applicant's mark. Conceptually, they will be seen as the two ordinary words, individually. Accordingly, I agree with the Opponent that SKY has an independent distinctive character in the Applicant's mark, and that this component is identical to the Opponent's word mark. However, as the case law above confirms, it does not automatically follow that there is a likelihood of confusion.

55. To further inform the assessment, I remind myself of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

56. Whilst SKY has independent distinctive character, I have already found that BANK is not descriptive and will not be overlooked by the average consumer. Taking the examples in *L.A. Sugar* (though I acknowledge these are not exhaustive), SKY is not so distinctive that consumers would assume that no one other than the Opponent would use this word in their trade mark – I found SKY to have an average degree of inherent distinctiveness which, without evidence of use, has not been enhanced to a higher degree. Bearing in mind the goods applied for by the Applicant, BANK is not descriptive or non-distinctive and so it is difficult to see why consumers would see SKYBANK as a sub-brand, or brand-extension of SKY. The Opponent's submissions on this point were hung on BANK being descriptive, which I have found not to be the case.

57. The Opponent further submitted that consumers seeing SKYBANK as a brand extension of the Opponent was even more likely given how many sub-brands the Opponent has, including SKY HUB, SKY BUSINESS, SKY SPORTS and several more. However, the Opponent has not sought to rely on these marks, either individually or as a family of marks, neither has it filed evidence of use of these marks. This argument therefore does not assist the Opponent.

58. Considering all of the above, I cannot see a proper basis for indirect confusion, either falling into one of the scenarios set out in *L.A. Sugar* or otherwise. This finding applies to both the Opponent's word mark and stylised mark.

CONCLUSION

59. There is no likelihood of confusion. The opposition under section 5(2)(b) has failed. Subject to any successful appeal, the application may proceed to registration.

COSTS

60. The Applicant has been successful and would ordinarily be entitled to a contribution towards its costs. As the Applicant is unrepresented, at the conclusion of the evidence rounds the Tribunal invited the Applicant to indicate whether it wished to make a request for an award of costs and, if so, to complete a pro-forma including a breakdown of its actual costs.[20] The Applicant did not return the pro-forma. As it incurred no official fees in the defence of its application, I make no award of costs in this matter.

Dated this 26th day of September 2025

MRS E FISHER
For the Registrar

[20] See official letter dated 13 January 2025.

Annex 1 – word mark

Apparatus for recording television programmes; apparatus for recording, transmission, reproduction or reception of sound, images or audio visual content; electrical and electronic apparatus for use in the reception of satellite, terrestrial or cable broadcasts; speakers; remote controls; television receivers including a decoder; set-top boxes; digital set-top boxes; high definition set top boxes; personal video recorder; set-top boxes for use in decoding and reception of satellite, terrestrial and cable broadcasts; apparatus for decoding encoded signals including set top boxes for television reception; set top box apparatus including a decoder and an interactive viewing guide; set top box apparatus including a decoder and a recorder for recording television and audio programmes; set top box apparatus including a decoder and a recorder programmable to transfer stored recordings to storage and also to delete the older recordings; satellite dishes; computer software to enable searching of data; set top boxes for use in decoding and reception of satellite, terrestrial cable and digital subscriber line (DSL), Internet or other electronic broadcasts; apparatus for decoding encoded signals; recorded television and radio programmes; recorded programmes for broadcasting or other transmission on television, radio, mobile telephones, PDAs and on PCs; multimedia apparatus and instruments; computer hardware, apparatus and instruments all for transmitting, displaying, receiving, storing and searching electronic information; computer software and telecommunications apparatus to enable connection to databases and the Internet; computer software supplied from the Internet; wired and/or wireless computer network routers, modems, firewalls and/or bridges; music, sounds, videos, images, text and information provided by a telecommunications network, by on-line delivery and by way of the Internet and/or the world-wide web or other communications network; audio and/or video file recorders and/or players; apparatus and instruments for the reception of radio and television broadcasts including the reception of cable, satellite and digital broadcasts; communication apparatus and instruments; data carriers; data storage apparatus; electrical telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; electronic telecommunications and/or communications and/or broadcast and/or transmission and/or decoding and/or image processing and/or audio visual instruments and apparatus; film reproducing instruments and

apparatus; parts and fittings for all the aforesaid goods; downloadable media content, including video and films, television programmes, computer games, music, images and ring tones provided by Internet, telephone line, cable, wireless transmission, satellite or terrestrial broadcast service; electrical communication equipment; electronic network equipment; electronic communication equipment; computer software, devices, and hardware for transmitting, receiving, synchronizing, displaying, backing-up, monitoring, controlling, sharing, coding, decoding, encrypting, accessing, remotely accessing, creating, collecting, storing, securing, removing, transferring, disseminating, locating, organizing or otherwise utilizing data, voice, multimedia, audio, visual, music, photographs, drawings, images, audiovisual, video, text, graphics or other data, including over a global communications network; computer software, operating system software, devices, and hardware for synchronizing data, files, e-mails, contacts, calendars, task lists, text messages, photos, music, audio, visual, audio visual, video, text, graphics, programs and other information between computers and hand-held or other devices, and vice versa; communications platforms for enabling instantaneous, continuous, scheduled and perpetual synchronization of data between computers and hand-held or other devices, and vice versa; parts and fittings for all the aforesaid goods.

Annex 2 – stylised mark

Audio, visual and/or audio visual entertainment devices; set top boxes; personal video recorders; audio, visual and/or audio visual content streaming devices; streaming sticks; televisions; television apparatus; apparatus for recording, transmission or reproduction of sound or images; data processing equipment; speakers; soundbars; wireless local area network devices; hubs; routers; remote controls for set top boxes, televisions, personal video recorders and/or audio, visual and/or audio visual content streaming and entertainment devices; voice and gesture activated hardware for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content; apparatus for editing cinematographic film; apparatus for processing and editing audio, visual and/or audio visual content; recorded audio, video and/or audio visual content; downloadable audio, video and/or audio visual content, including films, trailers, clips, television series, television programmes, documentaries, interviews, reviews, commentary and podcasts; downloadable image files containing artwork, text, audio, video and/or graphics relating to audio, visual and/or audio visual content; software for audio, visual and/or audio visual content user interfaces and/or electronic programme guides; software supplied as part of or in connection with any entertainment and/or training device or service; software supplied from the internet as part of or in connection with any entertainment and/or training device or service; software supplied as part of or in connection with any telecommunications device or service; software supplied from the internet as part of or in connection with any telecommunications device or service; software for use as an application programming interface (API) for use with audio, visual and/or audio visual content user interfaces and/or electronic programme guides; software for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content; software for browsing, streaming, viewing and/or organising audio, visual and/or audio visual sports and/or esports (multi player video game competitions) content; smart home software; software for the control of voice and gesture activated hardware for browsing, streaming, viewing, recording, storing and/or organising audio, visual and/or audio visual content; software for synchronising video and audio playback across multiple devices; software for use in facilitating phone calls, video calls, voice over internet protocol (VOIP) calls, audio, visual and/or audio visual conferences, text messages, instant messages and web messages; software for social networking;

software for creating, managing, and interacting with an online community including enabling users to participate in shared viewing of content, discussions, and polls, to give comments and receive feedback, and to engage in social networking; software for creating, accessing, collecting, editing, organising, commenting on, modifying, transmission, storage and sharing of audio, visual and/or audio visual content, data and information; virtual reality entertainment software; augmented reality entertainment software; mixed reality entertainment software; software for applying animation, filters and special effects to photographs and/or images; software for creating avatars for user profiles and for use in virtual reality, augmented reality and mixed reality environments; electronic publications, magazines, and guides; electronic publications (downloadable).