

O/1171/25

TRADE MARKS ACT 1994

IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. WO0000001725710
DESIGNATING THE UK OF INTEROJO INC.
FOR THE FOLLOWING TRADE MARK:

Clalen O2O2

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 446011
BY O2 WORLDWIDE LIMITED

BACKGROUND AND PLEADINGS

1. International trade mark no. WO0000001725710 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is INTEROJO INC. The IR is registered with effect from 16 March 2023. With effect from 27 September 2023, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the IR in relation to the following goods:

Class 9: *Contact lenses; carrying cases and containers for contact lenses.*

2. The request to protect the IR was published on 01 December 2023. On 23 February 2024, O2 Worldwide Limited (“the opponent”) opposed the protection of the IR in the UK based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under both grounds, the opponent relies upon the three earlier marks shown below:

UK00003862223 (“the first earlier mark”)



Filing date: 23 December 2022

Registration date: 12 May 2023

Class 9: Scientific, surveying, measuring, signalling, checking (supervision), life-saving apparatus and instruments none being goods relating to liquids or gases; nautical, photographic, cinematographic, optical, weighing, teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, 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; computer games; computer game software; computer software applications, downloadable; computer games programs; PDAs (Personal Digital Assistants); pocket PCs; mobile telephones; selfie sticks [hand-held monopods]; smart rings; smartphones; smartwatches; wearable technology, namely wearable communication apparatus, telecommunication apparatus, smart phones, watches, monitors, displays, computer hardware, activity trackers, audio equipment, video display monitors, digital electronic devices capable of providing access to the Internet; laptop computers; linear actuators [electric]; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; protective clothing; protective helmets; televisions; headphones; global positioning system [GPS] apparatus; satellite navigation devices; sensors none being goods relating to liquids or gases; Internet of Things [IOT] electronic devices, sensors and gateways; computer hardware and software for use in and with Internet of Things [IOT] devices none being goods relating to liquids or gases; computer software recorded onto CD Rom; SD-Cards (secure digital cards); smart meters; glasses; spectacle glasses; sunglasses; protective glasses and cases therefor; contact lenses ; 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; hands free kits for phones; magnetic cards; encoded cards; mobile phone application software; software for telecommunication; software for the processing of financial transactions; electronic notice boards; electric batteries; battery chargers; security alarms; security cameras; security warning apparatus; security control apparatus; security surveillance apparatus; computer software for security

purposes; computer software for insurance purposes; SIM cards; interactive touch screen terminals; aerials; alarms; electric cables; chemistry apparatus and instruments; recorded computer operating programs; computer peripheral devices; data processing apparatus; diagnostic apparatus, not for medical purposes; distance measuring apparatus; distance recording apparatus; downloadable ring tones for mobile phones; electronic tags for goods; eyepieces; goggles for sports; magnetic identity cards; intercommunication apparatus; loudspeakers; magnetic data media; mathematical instruments; modems; electric monitoring apparatus; television apparatus; testing apparatus not for medical purposes; telecommunication transmitters; mobile device management apparatus; software for mobile device management; middleware for management of software functions on electronic devices; computer virus software; computer antivirus software; smart home software; smart home devices, namely, smart doorbells, smart speakers, smart televisions, smart radios, smart alarms, smart security systems, smart video monitors, smart monitoring apparatus and instruments, smart telephones, smart meters, smart locks and padlocks, smart door locks; home automation devices; in-car entertainment systems; privacy protection software; printers; printer programmes, servers, sharers, cables, hubs and converters; photo printers; downloadable virtual goods, namely, digital art, photographs, videos, or audio recordings; downloadable digital artwork and images; downloadable software for providing access to, and related to, digital art and collectibles, crypto-collectibles, non-fungible tokens nfts, application tokens, and digital currencies; downloadable software for use in electronically buying, selling, receiving, sending, storing, trading, and processing transactions to and related to digital art and collectibles, crypto-collectibles, nfts, application tokens, and digital currencies; downloadable software for providing information, communications, and authentications for social media, digital art and collectibles, crypto-collectibles, nfts, application tokens, and digital currencies; downloadable software for downloading, receiving, sending, and storing software, data, links, video files, and image files from the internet; downloadable software for providing access to digital marketplaces and auctions; computer application software for blockchain-based platforms; parts and fittings for all the aforesaid goods.

Class 38: *Telecommunications; cable television broadcasting; cellular telephone communication; communications by computer terminals; communications by fiber [fibre] optic networks; communications by telephone; computer aided transmission of messages and images; electronic bulletin board services [telecommunications services]; electronic mail; facsimile transmission; information about telecommunication; message sending; paging services [radio, telephone or other means of electronic communication]; providing access to databases; providing internet chatrooms; providing telecommunication channels for teleshopping services; providing telecommunications connections to a global computer network; providing user access to global computer networks; radio broadcasting; rental of access time to global computer networks; rental of message sending apparatus; rental of modems; rental of telecommunication equipment; rental of telephones; satellite transmission; telecommunications routing and junction services; teleconferencing services; telegraph services; telephone services; television broadcasting; telex services; transmission of digital files; transmission of greeting cards online; transmission of telegrams; voice mail services; wire service; wireless broadcasting; telecommunications services; mobile telecommunications services; telecommunications portal services; access to content, websites and portals; providing access to platforms and portals on the Internet; provision of access to content, websites and portals; telecommunication services provided via platforms and portals on the Internet and other media; mobile telecommunications network services; fixed line telecommunication services; provision of broadband telecommunications access; broadband services; wireless communication services; digital communication services; broadcasting services; television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; Internet access services; email and text messaging services; telecommunications information provided via telecommunication networks; services of a network provider, namely rental and handling of access time to data networks and databases, in particular the Internet; communications services for accessing a database; leasing of access time to a computer database; providing access to computer databases; rental of access time to a computer database; operation of a network, being telecommunication services; providing electronic bulletin board services; providing access to weblogs; providing access to podcasts; chatroom*

services for social networking; providing online forums; forums for social networking; providing electronic telecommunication connections; routing and connecting services for telecommunications; rental of telecommunications equipment; providing access to computer databases in the fields of social networking, social introduction and dating; leasing of mobile phones; 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; telematics services; information and advisory services relating to the aforesaid services provided over a telecommunications network.

Class 41: *Education; providing of training; entertainment; sporting and cultural activities; academies [education]; amusement parks; amusements; 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]; arranging of beauty contests; booking of seats for shows; cinema presentations; club services [entertainment or education]; coaching [training]; discotheque services; education information; educational examination; electronic desktop publishing; entertainer services; entertainment information; organisation of fashion shows for entertainment purposes; film production, other than advertising films; gambling; game services provided on-line from a computer network; games equipment rental; health club services [health and fitness training]; holiday camp services [entertainment]; music-halls; news reporters services; organization of shows [impresario services]; organization of sports competitions; party planning [entertainment]; personal trainer services [fitness training]; physical education; practical training [demonstration]; production of music; production of radio and television programmes; production of shows; providing amusement arcade services; providing karaoke services; providing on-line electronic publications, not downloadable; providing sports facilities; 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; sport camp services; subtitling; television entertainment; theatre productions; ticket agency services [entertainment]; timing of sports events; tuition;*

interactive entertainment services; electronic games services provided by means of any communications network; entertainment services provided by means of telecommunication networks; education, training, entertainment, sporting and cultural activities information 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; provision of musical events; entertainment club services; discotheque services; presentation of live performances; night clubs; rental of music venues and stadiums; casino services; ticket reservations for entertainment, sporting and cultural events; ticket information services for entertainment, sporting and cultural events; ticket agency services for entertainment, sporting and cultural events; provision of on-line computer games; rental of computer games programs; computer and video game amusement services; provision of information, news and commentary in the field of computer games; arranging, organising and conducting computer game competitions; publishing 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; arranging, organising and conducting of competitions, games and quizzes; arranging, organising and conducting of competitions, games and quizzes for entertainment, recreational, cultural and educational purposes; organisation of awards; career advisory services; conducting of phone-in competitions; booking agency services connected with the issuing of tickets for entertainment events; employment training; 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; music recordings, concerts, performances, productions, publishing, instruction, competition services and composition services; musical performances and entertainment; live music services, concerts, shows and performances; music library services; recording of music; music entertainment services; music publishing and music recording services; music group services; tuition and teaching of music; music mixing services; music transcription services; musical performance, education and instruction services; musical composition for others; organisation of music concerts; entertainment services performed by musicians; consultancy on film and music

production; rental of phonographic and music recordings; providing digital music [not downloadable] from the internet; ticket reservation and booking services for music concerts; education and training related to an online marketplace for the creation, display, sale, and transfer of non-fungible token (nft) artwork; education and training related to an online marketplace for buyers and sellers of nfts and crypto-collectibles; virtual reality arcade services; providing on-line non-downloadable images; provision of exhibitions via virtual reality and augmented reality; information and advisory services relating to the aforesaid services provided over a telecommunications network.

UK00003587066 (“the second earlier mark”)¹



Filing date: 29 January 2021

Registration date: 01 October 2021

EU filing date: 24 January 2020 (whole)²

EU filing date: 07 January 2020 (whole)³

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 for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, 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;*

¹ This case is filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union and the EU filing date was 07/01/2020.

² This is the EU filing dates of the EUTMs from which the Art. 59 application claim is made (EUTM no. 018187776)

³ This is the EU filing dates of the EUTMs from which the Art. 59 application claim is made. (EUTM PO no. 018176369)

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; computer games; computer game software; computer software applications, downloadable; computer games programs; PDAs (Personal Digital Assistants); pocket PCs; mobile telephones; selfie sticks [hand-held monopods]; smart rings; smartphones; smartwatches; wearable technology, namely wearable communication apparatus, telecommunication apparatus, smart phones, watches, monitors, displays, computer hardware, activity trackers, audio equipment, video display monitors, wearable digital electronic devices capable of providing access to the Internet; laptop computers; linear actuators [electric]; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; protective clothing; protective helmets; televisions; headphones; global positioning system [GPS] apparatus; satellite navigation devices; sensors; IOT devices, namely computer hardware capable of Internet of Things [IOT] connectivity, sensors and gateways; computer hardware and software for use in and with Internet of Things [IOT] devices; computer software recorded onto CD Rom; SD-Cards (secure digital cards); smart meters; glasses; spectacle glasses; sunglasses; protective glasses and cases therefor; contact lenses; 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; hands free kits for phones; magnetic cards; encoded cards; mobile phone application software; software for telecommunication; software for the processing of financial transactions; electronic notice boards; electric batteries; battery chargers; security alarms; security cameras; security warning apparatus; security control apparatus; security surveillance apparatus; computer software for security purposes; computer software for insurance purposes; SIM cards; interactive touch screen terminals; aerials; alarms; electric cables; chemistry apparatus and instruments; recorded computer operating programs; computer peripheral devices; data processing apparatus; diagnostic apparatus, not for medical purposes; distance measuring apparatus;

distance recording apparatus; downloadable ring tones for mobile phones; electronic tags for goods; eyepieces; goggles for sports; magnetic identity cards; intercommunication apparatus; loudspeakers; magnetic data media; mathematical instruments; modems; electric monitoring apparatus; television apparatus; testing apparatus not for medical purposes; telecommunication transmitters; mobile device management apparatus; software for mobile device management; middleware for management of software functions on electronic devices; computer virus software; computer antivirus software; smart home software and devices; home automation devices; in-car entertainment systems; privacy protection software; parts and fittings for all the aforesaid goods.

Class 35: Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; retail services and online retail services connected with the sale of 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 for recording, transmission or reproduction of sound or images; retail services and online retail services connected with the sale of magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, mechanisms for coin-operated apparatus, cash registers, calculating machines, 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; retail services and online retail services connected with the sale of digital telecommunication apparatus and instruments, digital tablets, computer hardware, computer application software, computer software downloadable from the Internet, recorded computer software, software applications, mobile software applications, downloadable applications for multimedia devices, computer games, computer game software, computer games programs, PDAs (Personal Digital Assistants); retail services and online retail services connected with the sale of pocket PCs, mobile telephones, laptop computers, telecommunications network apparatus, drivers software for

telecommunications networks and for telecommunications apparatus, protective clothing, protective helmets, televisions, headphones, global positioning system [GPS] apparatus, satellite navigation devices, computer software recorded onto CD Rom, SD-Cards (secure digital cards), glasses, spectacle glasses, sunglasses; retail services and online retail services connected with the sale of protective glasses and cases therefor, contact lenses, 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; retail services and online retail services connected with the sale of hands free kits for phones, magnetic cards, encoded cards, mobile phone application software, software for telecommunication, software for the processing of financial transactions, electronic notice boards, electric batteries, battery chargers, security alarms, security cameras, security warning apparatus, security control apparatus, security surveillance apparatus, computer software for security purposes; retail services and online retail services connected with the sale of computer software for insurance purposes, SIM cards, aerials, alarms, electric cables, chemistry apparatus and instruments, recorded computer operating programs, computer peripheral devices, data processing apparatus, diagnostic apparatus, not for medical purposes, distance measuring apparatus, distance recording apparatus, downloadable ring tones for mobile phones, electronic tags for goods; retail services and online retail services connected with the sale of electronic tags for goods, eyepieces, goggles for sports, magnetic identity cards, intercommunication apparatus, loudspeakers, magnetic data media, mathematical instruments, modems, electric monitoring apparatus, television apparatus, testing apparatus not for medical purposes, telecommunication transmitters, paper, cardboard, printed matter, photographs, stationery; retail services and online retail services connected with the sale of office requisites, instructional and teaching material, packaging material, educational equipment, writing implements, writing instruments, writing materials, books, catalogues, cards, instruction manuals, magazines, mail order catalogues, newspapers, pamphlets, periodical publications, calendars, diaries, labels, maps, printed publications, postcards, posters, printed tariffs, printed forms;

retail services and online retail services connected with the clothing, footwear, headgear, household or kitchen utensils and containers, cookware, tableware, food cooking equipment, cutlery, cleaning articles, gardening articles, jewellery, horological and chronometric instruments, musical instruments, apparatus for lighting, textiles, household textile articles, furniture, furnishing, bags, luggage, toiletries, cosmetics, pharmaceutical preparations, cleaning preparations; retail services and online retail services connected with the sale of bags, luggage, games and playthings, gymnastic articles, sporting articles, sporting equipment, meat, fish, poultry, game, food, foodstuffs, confectionery, desserts, baked goods, delicatessen products, fruit, flowers, coffee, tea, cocoa, sugar, rice, beers, mineral waters, aerated waters and other non-alcoholic drinks, alcoholic beverages, matches, tobacco; retail services and online retail services relating to interactive touch screen terminals, selfie sticks [hand-held monopods], smart rings, smartphones, smartwatches, automobile accessories, automobile parts, vehicles, fuels, building materials, metal hardware, electronic components, recorded content; business management of retail outlets; arranging subscriptions to telecommunications for others; compilation and systemisation of information into computer databases; compilation of statistics; cost price analysis; arranging of competitions for advertising purposes; recruitment services; employment recruitment; employment consultancy; employment agencies; providing employment information; providing employment information in connection with youth programme schemes; commercial administration of the licensing of the goods and services of others; commercial information and advice for consumers [consumer advice shop]; opinion polling; personnel recruitment; price comparison services; procurement services for others [purchasing goods and services for other businesses]; rental of advertising space; rental of advertising time on communication media; sales promotion for others; sponsorship search; negotiation of business contracts for others; information and advisory services relating to the aforesaid services; 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.

Class 36: *Insurance; financial affairs; monetary affairs; real estate affairs; financial information and advice relating to tariffs; information and advice relating to finance and insurance; financial payment services; payment processing services; electronic payment services; automated payment services; payment collection agencies; processing of payment transactions via the Internet; money transfer services; electronic funds transfer services; bill payment services; Internet banking; mobile phone banking services; issuing of phone card services; issuing of vouchers and coupons; issuing tokens of value, namely gift cards; issuing of tokens of value in relation to customer loyalty schemes; sponsorship of sports, sports teams and sports events; insurance administration; insurance for telecommunication apparatus and instruments; insurance for mobile telecommunication apparatus and instruments; insurance for digital apparatus and instruments; insurance for digital tablets; insurance for computer software and hardware; travel insurance; vehicle insurance; home insurance; charitable fund raising; credit card services; debit card services; debt collection agencies; financial sponsorship; repair costs evaluation [financial appraisal]; building leasing; financial evaluation [insurance, banking, real estate]; housing agents; real estate management services relating to office premises; leasing of offices; property leasing; leasing of shopping premises; leasing of real estate; leasing of office space; real estate agencies; real estate appraisal; real estate management; rent collection; rental of offices [real estate]; renting of flats; stamp appraisal; financial leasing; property and building management services; estate management; leasing of mobile phones, computers and tablet computers; hire purchase financing; information and advisory services relating to the aforesaid services; 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.*

Class 38: *Telecommunications; cable television broadcasting; cellular telephone communication; communications by computer terminals; communications by fiber [fibre] optic networks; communications by telephone; computer aided transmission of messages and images; electronic bulletin board services [telecommunications services]; electronic mail; facsimile transmission; information about*

telecommunication; message sending; paging services [radio, telephone or other means of electronic communication]; providing access to databases; providing internet chatrooms; providing telecommunication channels for teleshopping services; providing telecommunications connections to a global computer network; providing user access to global computer networks; radio broadcasting; rental of access time to global computer networks; rental of message sending apparatus; rental of modems; rental of telecommunication equipment; rental of telephones; satellite transmission; telecommunications routing and junction services; teleconferencing services; telegraph services; telephone services; television broadcasting; telex services; transmission of digital files; transmission of greeting cards online; transmission of telegrams; voice mail services; wire service; wireless broadcasting; telecommunications services; mobile telecommunications services; telecommunications portal services; access to content, websites and portals; providing access to platforms and portals on the Internet; provision of access to content, websites and portals; telecommunication services provided via platforms and portals on the Internet and other media; mobile telecommunications network services; fixed line telecommunication services; provision of broadband telecommunications access; broadband services; wireless communication services; digital communication services; broadcasting services; television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; Internet access services; email and text messaging services; telecommunications information provided via telecommunication networks; services of a network provider, namely rental and handling of access time to a computer database, global computer networks and database servers; communications services for accessing a database; leasing of access time to a computer database; providing access to computer databases; rental of access time to a computer database; operation of a network, being telecommunication services; providing electronic bulletin board services; providing access to weblogs; providing access to podcasts; chatroom services for social networking; providing online forums; forums for social networking; providing electronic telecommunication connections; routing and connecting services for telecommunications; rental of telecommunications equipment; providing access to computer databases in the fields of social networking, social introduction and dating; 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; telematics services; information and advisory services relating to the aforesaid services provided over a telecommunications network; leasing of mobile phones.

Class 41: *Education; providing of training; entertainment; sporting and cultural activities; academies [education]; amusement parks; amusements; 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]; arranging of beauty contests; booking of seats for shows; cinema presentations; club services [entertainment or education]; coaching [training]; discotheque services; education information; educational examination; electronic desktop publishing; entertainer services; entertainment information; organisation of fashion shows for entertainment purposes; film production, other than advertising films; gambling; game services provided on-line from a computer network; games equipment rental; health club services [health and fitness training]; holiday camp services [entertainment]; music-halls; news reporters services; organization of shows [impresario services]; organization of sports competitions; party planning [entertainment]; personal trainer services [fitness training]; physical education; practical training [demonstration]; production of music; production of radio and television programmes; production of shows; providing amusement arcade services; providing karaoke services; providing on-line electronic publications, not downloadable; providing sports facilities; 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; sport camp services; subtitling; television entertainment; theatre productions; ticket agency services [entertainment]; timing of sports events; tuition; interactive entertainment services; electronic games services provided by means of any communications network; entertainment services provided by means of telecommunication networks; education, training, entertainment, sporting and cultural activities information 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; provision of musical events; entertainment club services; presentation of live performances; night clubs; rental of music venues and stadiums; casino services; ticket reservations for entertainment, sporting and cultural events; ticket information services for entertainment, sporting and cultural events; ticket agency services for entertainment, sporting and cultural events; provision of on-line computer games; rental of computer games programs; computer and video games amusement services; provision of information, news and commentary in the field of computer games; arranging, organising and conducting computer game competitions; publishing services; arranging, organising and conducting of competitions, games and quizzes; arranging, organising and conducting of competitions, games and quizzes for entertainment, recreational, cultural and educational purposes; organisation of awards; career advisory services; conducting of phone-in competitions; booking agency services connected with the issuing of tickets for entertainment events; employment training; 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.

UK00003346463 ("the third earlier mark")

O2

Filing date: 18 October 2018

Registration date: 15 March 2019

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 for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; aerials; alarms; apparatus for the transmission of sound and image;*

audio cassettes; audio discs; audio tapes; battery chargers; camera lenses; cameras; CDs, DVDs; chemistry apparatus and instruments; computer antivirus software privacy protection software; computer application software; computer game software; computer games; computer games programs; computer hardware; computer peripheral devices; computer software applications, downloadable; computer software downloadable from the Internet; computer software for insurance purposes; computer software for security purposes; computer software recorded onto CD Rom; computer virus software; contact lenses; data processing apparatus; diagnostic apparatus, not for medical purposes; digital tablets; digital telecommunication apparatus and instruments; distance measuring apparatus; distance recording apparatus; downloadable electronic publications; downloadable image files; downloadable music files; downloadable ring tones for mobile phones; drivers software for telecommunications networks and for telecommunications apparatus; electric batteries; electric cables; electric monitoring apparatus; electronic notice boards; electronic tags for goods; encoded cards; eyepieces; glasses; global positioning system [GPS] apparatus; goggles for sports; hands free kits for phones; headphones; interactive touch screen terminals; intercommunication apparatus; laptop computers; loudspeakers; magnetic cards; magnetic data media; magnetic identity cards; magnets; mathematical instruments; middleware for management of software functions on electronic devices; mobile device management apparatus; mobile phone application software; mobile software applications, downloadable applications for multimedia devices; mobile telecommunication apparatus; mobile telecommunications handsets; mobile telephone cases; mobile telephone covers; mobile telephones; modems; mouse mats; MP3 players; PDAs (Personal Digital Assistants); pocket PCs; protective clothing; protective glasses and cases therefor; protective helmets; recorded computer operating programs; recorded computer software; satellite navigation devices; SD-Cards (secure digital cards); security alarms; security cameras; security control apparatus; security surveillance apparatus; security warning apparatus; selfie sticks [hand-held monopods]; SIM cards; smart rings; smartphones; smartwatches; software applications; software for mobile device management; software for telecommunication; software for the processing of financial transactions; spectacle glasses; sunglasses; tablet computers; telecommunication

transmitters; telecommunications apparatus; telecommunications network apparatus; television apparatus; televisions; testing apparatus not for medical purposes; video cassettes; video discs; video tapes; parts and fittings for all the aforesaid goods.

Class 35: *Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; retail services and online retail services connected with the sale of 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 for recording, transmission or reproduction of sound or images; retail services and online retail services connected with the sale of magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, mechanisms for coin-operated apparatus, cash registers, calculating machines, 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; retail services and online retail services connected with the sale of digital telecommunication apparatus and instruments, digital tablets, computer hardware, computer application software, computer software downloadable from the Internet, recorded computer software, software applications, mobile software applications, downloadable applications for multimedia devices, computer games, computer game software, computer games programs, PDAs (Personal Digital Assistants); retail services and online retail services connected with the sale of pocket PCs, mobile telephones, laptop computers, telecommunications network apparatus, drivers software for telecommunications networks and for telecommunications apparatus, protective clothing, protective helmets, televisions, headphones, global positioning system [GPS] apparatus, satellite navigation devices, computer software recorded onto CD Rom, SD-Cards (secure digital cards), glasses, spectacle glasses, sunglasses; retail services and online retail services connected with the sale of protective glasses and cases therefor, contact lenses, 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; retail services and online retail services connected with the sale of hands free kits for phones, magnetic cards, encoded cards, mobile phone application software, software for telecommunication, software for the processing of financial transactions, electronic notice boards, electric batteries, battery chargers, security alarms, security cameras, security warning apparatus, security control apparatus, security surveillance apparatus, computer software for security purposes; retail services and online retail services connected with the sale of computer software for insurance purposes, SIM cards, aerials, alarms, electric cables, chemistry apparatus and instruments, recorded computer operating programs, computer peripheral devices, data processing apparatus, diagnostic apparatus, not for medical purposes, distance measuring apparatus, distance recording apparatus, downloadable ring tones for mobile phones, electronic tags for goods; retail services and online retail services connected with the sale of electronic tags for goods, eyepieces, goggles for sports, magnetic identity cards, intercommunication apparatus, loudspeakers, magnetic data media, mathematical instruments, modems, electric monitoring apparatus, television apparatus, testing apparatus not for medical purposes, telecommunication transmitters, paper, cardboard, printed matter, photographs, stationery; retail services and online retail services connected with the sale of office requisites, instructional and teaching material, packaging material, educational equipment, writing implements, writing instruments, writing materials, books, catalogues, cards, instruction manuals, magazines, mail order catalogues, newspapers, pamphlets, periodical publications, calendars, diaries, labels, maps, printed publications, postcards, posters, printed tariffs, printed forms; retail services and online retail services connected with the clothing, footwear, headgear, household or kitchen utensils and containers, cookware, tableware, food cooking equipment, cutlery, cleaning articles, gardening articles, jewellery, horological and chronometric instruments, musical instruments, apparatus for lighting, textiles, household textile articles, furniture, furnishing, bags, luggage, toiletries, cosmetics, pharmaceutical preparations, cleaning preparations; retail

services and online retail services connected with the sale of bags, luggage, games and playthings, gymnastic articles, sporting articles, sporting equipment, meat, fish, poultry, game, food, foodstuffs, confectionery, desserts, baked goods, delicatessen products, fruit, flowers, coffee, tea, cocoa, sugar, rice, beers, mineral waters, aerated waters and other non-alcoholic drinks, alcoholic beverages, matches, tobacco; retail services and online retail services relating to interactive touch screen terminals, selfie sticks [hand-held monopods], smart rings, smartphones, smartwatches, automobile accessories, automobile parts, vehicles, fuels, building materials, metal hardware, electronic components, recorded content; business management of retail outlets; arranging subscriptions to telecommunications for others; compilation and systemisation of information into computer databases; compilation of statistics; cost price analysis; arranging of competitions for advertising purposes; recruitment services; employment recruitment; employment consultancy; employment agencies; providing employment information; providing employment information in connection with youth programme schemes; commercial administration of the licensing of the goods and services of others; commercial information and advice for consumers [consumer advice shop]; opinion polling; personnel recruitment; price comparison services; procurement services for others [purchasing goods and services for other businesses]; rental of advertising space; rental of advertising time on communication media; sales promotion for others; sponsorship search; negotiation of business contracts for others; information and advisory services relating to the aforesaid services; 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.

Class 36: *Insurance; financial affairs; monetary affairs; real estate affairs; financial information and advice relating to tariffs; information and advice relating to finance and insurance; financial payment services; payment processing services; electronic payment services; automated payment services; payment collection agencies; processing of payment transactions via the Internet; money transfer services; electronic funds transfer services; bill payment services; Internet banking; mobile phone banking services; issuing of vouchers and coupons; issuing tokens of value,*

namely gift cards; issuing of tokens of value in relation to customer loyalty schemes; sponsorship of sports, sports teams and sports events; insurance administration; insurance for telecommunication apparatus and instruments; insurance for mobile telecommunication apparatus and instruments; insurance for digital apparatus and instruments; insurance for digital tablets; insurance for computer software and hardware; travel insurance services; vehicle insurance services; home insurance services; charitable fund raising; credit card services; debit card services; debt collection agencies; financial sponsorship; repair costs evaluation [financial appraisal]; information and advisory services relating to the aforesaid services; 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.

Class 38: *Telecommunications; cable television broadcasting; cellular telephone communication; communications by computer terminals; communications by fiber [fibre] optic networks; communications by telephone; computer aided transmission of messages and images; electronic bulletin board services [telecommunications services]; electronic mail; facsimile transmission; information about telecommunication; message sending; paging services [radio, telephone or other means of electronic communication]; providing access to databases; providing internet chatrooms; providing telecommunication channels for teleshopping services; providing telecommunications connections to a global computer network; providing user access to global computer networks; radio broadcasting; rental of access time to global computer networks; rental of message sending apparatus; rental of modems; rental of telecommunication equipment; rental of telephones; satellite transmission; telecommunications routing and junction services; teleconferencing services; telegraph services; telephone services; television broadcasting; telex services; transmission of digital files; transmission of greeting cards online; transmission of telegrams; voice mail services; wire service; wireless broadcasting; telecommunications services; mobile telecommunications services; telecommunications portal services; access to content, websites and portals; providing access to platforms and portals on the Internet; provision of access to content, websites and portals; telecommunication services provided via platforms*

and portals on the Internet and other media; mobile telecommunications network services; fixed line telecommunication services; provision of broadband telecommunications access; broadband services; wireless communication services; digital communication services; broadcasting services; television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; Internet access services; email and text messaging services; telecommunications information provided via telecommunication networks; services of a network provider, namely rental and handling of access time to data networks and databases, in particular the Internet; communications services for accessing a database; leasing of access time to a computer database; providing access to computer databases; rental of access time to a computer database; operation of a network, being telecommunication services; providing electronic bulletin board services; providing access to weblogs; providing access to podcasts; chatroom services for social networking; providing online forums; forums for social networking; providing electronic telecommunication connections; routing and connecting services for telecommunications; rental of telecommunications equipment; providing access to computer databases in the fields of social networking, social introduction and dating; 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.

Class 41: *Education; providing of training; entertainment; sporting and cultural activities; academies [education]; amusement parks; amusements; 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]; arranging of beauty contests; booking of seats for shows; cinema presentations; club services [entertainment or education]; coaching [training]; discotheque services; education information; educational examination; electronic desktop publishing; entertainer services; entertainment information; organisation of fashion shows for entertainment purposes; film production, other than advertising films; gambling; game services provided on-line*

from a computer network; games equipment rental; health club services [health and fitness training]; holiday camp services [entertainment]; music-halls; news reporters services; organization of shows [impresario services]; organization of sports competitions; party planning [entertainment]; personal trainer services [fitness training]; physical education; practical training [demonstration]; production of music; production of radio and television programmes; production of shows; providing amusement arcade services; providing karaoke services; providing on-line electronic publications, not downloadable; providing sports facilities; 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; sport camp services; subtitling; television entertainment; theatre productions; ticket agency services [entertainment]; timing of sports events; tuition; interactive entertainment services; electronic games services provided by means of any communications network; entertainment services provided by means of telecommunication networks; education, training, entertainment, sporting and cultural activities information 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; provision of musical events; entertainment club services; discotheque services; presentation of live performances; night clubs; rental of music venues and stadiums; casino services; ticket reservations for entertainment, sporting and cultural events; ticket information services for entertainment, sporting and cultural events; ticket agency services for entertainment, sporting and cultural events; provision of on-line computer games; rental of computer games programs; computer amusement services; provision of information, news and commentary in the field of computer games; arranging, organising and conducting computer game competitions; publishing 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; arranging, organising and conducting of competitions, games and quizzes; arranging, organising and conducting of competitions, games and quizzes for entertainment, recreational, cultural and educational purposes; organisation of awards; conducting of phone-in competitions; booking agency services connected

with the issuing of tickets for entertainment events; employment training; 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.

3. Under Section 5(2)(b), the opponent relies upon the goods I have underlined in the table above (i.e. the class 9 goods in relation to the first, the second and the third earlier mark), whereas under Section 5(3), it claims reputation for all the goods and services I have listed in the same table (i.e. the goods and services in classes 9, 35, 36, 38 and 41).

4. By virtue of their earlier filing dates, the trade marks relied upon by the opponent are “earlier marks” in accordance with Section 6 of the Act. As the opponent’s earlier marks had not been registered for five years or more at the designation date of the IR,⁴ they are not subject to the use conditions under Section 6A of the Act. Consequently, under Sections 5(2)(b) and 5(3) the opponent may rely upon all of the goods it has identified without demonstrating that it has used the marks.

5. Under Section 5(2)(b), the opponent claims there is a likelihood of confusion because the parties’ goods in class 9 are identical or highly similar, and the marks are highly similar phonetically, visually and conceptually.

6. Under Section 5(3), the opponent claims that it has developed a massive reputation in its ‘O2’ trade marks throughout the UK in relation to its core telecommunication goods and services, and its entertainment, financial and software services. Further, the opponent claims that use of the IR by the holder would, without due cause, take unfair advantage of the distinctive character or repute of the earlier marks. In particular, the opponent states that *“if the opponent is, through its O2 trade marks, portrayed as a young, trendy, healthy, cool and high tech brand to its consumers, then the fact that the [holder] has adopted the opponent’s trade mark in its application takes unfair advantage of the distinctive character and/or repute of the opponent’s mark”*

⁴ See paragraph 2 of Schedule 2 of the Trade Marks (International Registration) Order 2008 which gives the filing date for Article 3ter(2) designations as the date the request for extension was recorded in the International Register.

and submits that “*when customers view the [IR], the opponent’s earlier marks are brought to mind in view of the nature and extent of the opponent’s reputation identified above, and this is enough for the [holder to gain an] unfair advantage*”. Furthermore, or in the alternative, the opponent claims that consumers seeking the IR may also believe that it is one of the opponent’s trade marks, giving the holder an unfair advantage. Lastly, the opponent claims that use of the IR could result in detriment to the distinctive character of the opponent’s marks, which would likely result in a change in the economic behaviour of the average consumer, for example, the opponent says that the strength of its marks could be weakened, resulting in the relevant consumer being less likely to associate the goods and services immediately with the opponent, and its reputation, or the quality of the goods provided by the holder could be poor, resulting in detriment to the distinctive character or repute of the earlier marks.

7. The holder filed a defence and counterstatement, denying the opponent’s claims.

8. The opponent is represented by Stobbs, and the holder is represented by Venner Shipley LLP.

9. Both parties filed evidence. Neither party requested a hearing, but they both filed written submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

EVIDENCE

11. The opponent's evidence-in-chief came in the form of a witness statement from Carlos Gomez Bassy dated 1 July 2024 and accompanied by 17 exhibits, being those labelled CGB1 to CGB17. Mr Bassy is the O2 Brand Lead of one of the subsidiary companies which forms part of the Telefónica Group of Companies, the latter including O2 Worldwide Limited (i.e. the opponent) which is a UK company and an IP holding entity. In this connection, Mr Bassy explains that the "O2 Group of Companies" includes the opponent and other companies who use the 'O2' brand under a licence. Mr Bassy's evidence goes to the use of the brand 'O2' and is aimed at substantiating the opponent's claim that the earlier marks have a reputation in the UK.

12. The holder's evidence-in-chief came in the form of a witness statement from Vivek Patel dated 3 September 2024 and accompanied by three exhibits, being those labelled VP1 to VP3. Mr Patel is an employee of Venner Shiple, the holder's representative in these proceedings and his witness statement is only a vehicle for introducing state of the register evidence.

13. I do not intend to summarise the evidence (or submissions) beyond what I have set out above. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Section 5(2)(b)

14. Section 5(2)(b) of the Act reads 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.”

15. 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:

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

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

“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.”

17. 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.

18. 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 General Court (“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 that the responsibility for those goods lies with the same undertaking.”

19. 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. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/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.”

20. Whilst 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.”

21. In *Gérard Meric v OHIM*, Case T- 133/05, the 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 fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

22. The contested goods in class 9 are as follows:

Class 9: *Contact lenses; carrying cases and containers for contact lenses.*

23. Whilst the opponent initially relied, under each mark, upon a long list of goods in class 9, on 8 May 2024 the Registry directed under Rule 62 of the Trade Mark Rules 2008, that the opponent indicates its best case at the filing of its evidence, making clear submissions as to which particular goods in Class 9 are identical and/or similar to the holder's specification. On 8 July 2024, the opponent filed its evidence along with the following submissions as to the identity/similarity of the goods and services:

“In addition to the submission of this evidence, the Office has asked that we provide an example of the Opponent's similar/identical terms in class 9. I can confirm that the Opponent has the terms “glasses” and “contact lenses” in class 9 of [the first earlier mark] as well as [the second] and [third earlier mark]. It is clear that these terms are either identical to the applied for terms or highly similar”

24. It is true that all of the earlier marks cover *contact lenses*. These goods are self-evidently identical to the holder's *Contact lenses*.

25. Whilst the earlier marks do not cover goods which are identical to the holder's *carrying cases and containers for contact lenses*, the latter are specifically used for the purposes of carrying and storing the opponent's *contact lenses* and are highly complementary. In addition, the goods target the same users and are distributed through the same trade channels. However, they have a different nature, purpose and method of use and are not in competition. These goods are similar to a medium degree.

26. Although it is not strictly necessary for me to identify additional overlaps between the parties' goods, in its submissions in lieu the opponent points out that the holder's *carrying cases and containers for contact lenses* are also similar to the opponent's *Protective glasses and cases therefor* because they are both cases for types of eyewear that have the same uses, users, a very similar physical nature, and identical or similar trade channels. Whilst I am not convinced that the goods necessarily target the same users, it is not impossible that someone looking for cases for protective glasses also wear contact lenses and seeks to purchase cases and containers for contact lenses; further, I am not convinced that the goods are distributed through the

same channels as contact lenses (and cases for contact lenses) would normally be offered by opticians, whilst protective glasses are designed to protect the eyes from various hazards and would (along with the cases for storing and carrying them) be sold by DIY shops. Nevertheless, the goods have a similar nature insofar as they are cases for different types of eyewear, and I consider them to be similar to a low degree.

27. Lastly, the opponent contends that the earlier “*parts and fittings for all the aforesaid goods*” include parts and fittings for contact lenses which would include cases for contact lenses. I disagree, as the core meaning of parts and fittings for contact lenses does not include *carrying cases and containers for contact lenses*, the latter not being an integral part or a fitting for contact lenses.

Average consumer

28. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective 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. (as he then was) described the average consumer in these terms:

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

29. The holder’s goods are ordinary consumer goods that will be selected by members of the general public. The goods will likely be sold through a range of opticians and online retailers, and the purchase of contact lenses is likely to require a valid prescription. The selection of the goods at issue will be primarily visual, and the marks will be encountered online, on catalogues, marketing material and product packaging;


however, aural considerations cannot be discounted completely, in the form, for example, of advice sought from an optician or word of mouth recommendations. In my view, the average consumer will pay, at least, a medium level of attention when purchasing the goods, due to the importance of selecting the correct prescription and the most suitable type of contact lenses.

Comparison of marks

30. 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.”

31. It would be wrong, therefore, to artificially dissect the trade marks, 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. The respective marks are shown below:

The holder's mark	The opponent's marks
<p>Clalen O2O2</p>	

Overall impression

32. The holder's mark consists of the word 'Clalen' presented in title case in a standard font, followed by the letter 'O' and the number 2 duplicated once which will be perceived as one single element 'O2O2'. The holder states that the element 'Clalen' will be seen as the dominant and distinctive element of the of the IR because (a) as a general rule, the beginning of a mark tends to make more impact on consumers than its ending; (b) the word 'Clalen' is highly distinctive for the goods at issue, being an invented word with no meaning and (c) whilst the element 'O2O2' is not negligible, generally speaking consumers are more likely to perceive words as denoting trade origin (i.e. in the present case, the word 'Clalen'), while numbers or numbers and letters (such as 'zero-two-zero-two' or 'O-2-O-2') will be seen as a reference to a series or a product's code/characteristic.

33. The opponent states that *"the dominant and distinctive part of both marks is the O2 element in each of each of them – this is where the relevant consumer will lay greatest emphasis, and find the greatest degree of similarity between the marks"*. In the alternative, the opponent state that the 'O2' element of the holder's IR has its own independent role within the mark. As to why the opponent states that the element 'O2' is the most distinctive part of the holder's mark, it is because of its reputation. It states:

"Visually, there is identity in the O2 element of the marks, though this element is repeated in the Applicant's mark. The Clalen element of the Applicant's mark will be perceived as separate and distinct from the O2O2 element given the particular presentation of the mark, and given that the relevant consumer will recognise the O2 element within the Applicant's mark as more familiar, drawing

the consumer's eye to it as such. Overall there is a medium level of similarity visually."

34. Accordingly, the opponent says that given the reputation of the earlier mark 'O2', the average consumer will focus on this element of the holder's IR. I reject the submission. Whilst the reputation of a mark can influence the likelihood of confusion, it cannot increase the similarity with a later trade mark. In legal terms, the similarity between two marks is assessed based on a visual, phonetic, and conceptual comparison and the reputation of a trade mark (or the familiarity with it) is not a factor in determining the similarity of the marks. In this connection, in Case C-115/19 P, *China Construction Bank Corp v Groupement des cartes bancaires*, the CJEU stated that the reputation of a trade mark cannot be taken into account when assessing the overall impression and the similarity between the marks:

"61. In that regard, it must be noted that although the identification of the dominant element of a sign may be relevant for the purpose of comparing signs at issue (judgment of 22 October 2015, *BGW*, C-20/14, EU:C:2015:714, paragraph 37 and the case-law cited), it does not follow that the reputation and the degree of distinctive character of that sign, which concern it as a whole, make it possible to determine which component of that sign is dominant in the perception of the relevant public.

62. On the contrary, Regulation No 207/2009 cannot be understood as meaning that the reputation or the high level of distinctive character of a trade mark may lead to a finding that one of its constituent elements dominates over another of its elements for the purposes of assessing the similarity of signs at issue.

63. In paragraph 52 of the judgment under appeal, the General Court stated that the reputation of the earlier mark 'may influence the perception of the connections between the various elements' of that mark. However, the reputation of a highly stylised word mark, such as the earlier mark at issue, is exactly based on the knowledge of a significant part of the relevant public of all the elements, both verbal and figurative, which make up that mark.

64. It follows that, by holding that the First Board of Appeal of EUIPO was entitled to infer from the reputation and highly distinctive character of the earlier mark that it would be perceived as being the word element CB, that that word element was therefore dominant and that it must, in turn, dominate the assessment of the similarity of the signs at issue, the General Court erred in law as described in paragraph 59 of this judgment. The first part of the first ground of appeal is therefore well founded.”

35. Having clarified that the reputation of the earlier mark cannot be taken into account in determining the weight to be given to the element ‘O2’ in the IR, I agree with the holder that the most distinctive and dominant element of the IR is the word ‘Clalen’ because it is inherently highly distinctive (being it an invented word) and it is placed at the beginning of the mark. Whilst I think it is arguable whether the element ‘O2O2’ will be seen as a number (as the letter ‘O’ will be seen as a letter rather than as a zero) I agree with the holder that this element is likely to be seen as a product code. But even if I am wrong, the average consumer will still perceive ‘O2O2’ as a unitary combination of letters and numbers and will not extrapolate from it the element ‘O2’ into an independent element.

Visual similarity

36. The IR consists of two elements, namely a six-letter word followed by a sequence of one-letter and a number repeated once for a total of 8 letters and two numbers.

37. The opponent’s figurative mark consists of the larger letter ‘O’ and a smaller number 2 all presented in blue, whereas the opponent’s word-only mark consists of the letter ‘O’ followed by the number 2.

38. Given (a) the differences in the beginning and length of the respective marks; (b) the fact that the element ‘O2’, is subsumed within the unitary element ‘O2O2’ in the IR - this means that it is unlikely that the element ‘O2’ is perceived independently in the IR; (c) the fact that the element ‘O2’ is placed at the end of the IR where the consumer’s attention is less focused, (d) the different size, colour and positioning of the letter ‘O’

and the number 2 in the figurative mark meaning that there is not an identical shared element, I find that the opponent's figurative mark and the IR are visually dissimilar.

39. Turning to the opponent's word-only mark, though the element 'O2' (which consists of the entirety of the earlier mark) is identically contained within the IR, my finding that this element will not be perceived independently in the IR means that there is no visual similarity between the marks. However, for the sake of completeness, I will proceed on the basis that there is a low degree of similarity between the IR and the earlier word-only mark.

Aural similarity

40. The IR will be articulated as 'CLA-LEN OH-TWO OH-TWO', whereas the earlier word-only mark and the earlier figurative mark will be pronounced as 'OH-TWO'. There is a low degree of aural similarity between the respective marks.

Conceptual similarity

41. Conceptually, I agree with the holder that the IR has no recognisable meaning while the earlier word-only mark and the earlier figurative mark are likely to be understood as a reference to the chemical symbol for oxygen; this is confirmed by Cambridge online dictionary which contains the following definition:

"Oxygen

a chemical element that is a gas with no smell or colour. Oxygen forms a large part of the air on earth, and is needed by animals and plants to live:

.....

The symbol for the most common form of oxygen is O₂."

42. The marks are conceptually dissimilar.

Distinctive character of the earlier mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section 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).”

44. Registered trade marks possess various 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.

45. As it will be recalled, I have concluded that the opponent’s earlier marks will convey the concept of the chemical symbol for oxygen. The holder states that the concept of oxygen is relevant in relation to the goods at issue and makes the earlier marks inherently low in distinctiveness. It states:

“The combination “O2” is widely recognised as the chemical symbol for oxygen. In the context of contact lenses, oxygen plays a critical role in maintaining corneal health. Contact lenses inherently limit the amount of oxygen that reaches the cornea, which can lead to conditions such as oxygen deprivation syndrome. To address this, a key feature of contact lenses is their oxygen permeability - the ability of the lens material to allow oxygen to pass through to the eye.

Given the above, the term “O2” clearly alludes to a fundamental property of “contact lenses” (and related products). A significant proportion of relevant average consumers will recognise the meaning of “O2” as describing the symbol for oxygen and will associate that meaning to a characteristic of the goods (namely, contact lenses that allow oxygen to reach the eyes). Therefore, the Applicant submits that the inherent distinctiveness of the Opponent’s marks for the relevant goods (“contact lenses”) should be deemed weak, at best.”

46. There is no evidence that one of the properties of contact lenses is to allow oxygen to reach the eyes. Even if that is true, there is no evidence that it is a well-known fact or that the average consumer of contact lenses will be aware of it and will understand the opponent’s mark as a reference to a quality of the goods. Accordingly, I find that the earlier marks are inherently distinctive to a medium degree.

47. The holder also provided state of the register evidence aimed at showing that there are other marks on the register which contain the element ‘O2’ and cover goods in class 9, a fact which the holder argues, results in the earlier marks not being strikingly distinctive. In *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, the CJEU found that:

“65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

48. In *Zero Industry Srl v OHIM*, Case T-400/06, the GC stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71). “

49. Accordingly, state of the register evidence is not enough to establish that the distinctive character of a mark (or of an element of a mark) has been weakened because of the use by other traders of the same or a similar sign in relation to the relevant goods. Although the holder has also filed copies of websites showing some of the registered marks in use, they are undated and do not assist in establishing how many marks were in use at the relevant date and/or how extensive use of these marks has been.

50. Lastly, the opponent has filed evidence of use, which mostly relates to the provision of telecommunications services. In this connection, the holder accepts that the earlier figurative mark may have acquired a reputation in relation to the provision of telecommunication services in class 38, but does not accept that the opponent has a

reputation for “contact lenses” or any other goods in class 9. The opponent, on its part, states that *“the O2 mark enjoys a significant reputation in connection with telecommunications and related services”* and that *“the O2 trade mark is associated with a wide range of goods and services, including telecommunications, mobile and fixed broadband services, entertainment, and sponsorship of high-profile events”*.

51. I think it is clear from the evidence filed, and it appears to be common ground between the parties, that the opponent’s main business is in the field of mobile telecommunication and network and that it is in relation to telecommunication services that the opponent’s earlier marks enjoy a reputation. Without needing to go through all of the evidence filed, the most significant evidence before me is as follows:

- i. The opponent’s UK mobile customer base reached 27 million in 2020.
- ii. The opponent has become one of the most important players in the mobile telecommunications field in the UK. The customer base consists of people with Pay Monthly contracts with the opponent (post-pay) and those who have signed up to the Pay As You Go (pre-pay) service.
- iii. “Service Revenue” for the years 2006 to 2021 were constantly around £6,000 - 7,000 million per year.
- iv. Annual advertising expenditure in the UK for the years 2016 – 2020 were between £60 and £65 million.
- v. Brand Awareness studies relating to mobile phones operators for the period 2017-2019 show that O2 comes second with 25%, only marginally behind their competitor EE (27%).
- vi. O2 was awarded Superbrand status in 2004 in the UK.
- vii. In 2012, the O2 trade marks received entries in the annual Consumer Superbrands survey ranking 122 and 137. In 2014, O2 was listed as a Qualifying Consumer Superbrand (one of the five brands listed in the

telecommunications and broadband category). O2 continued to be listed as a Qualifying Consumer Superbrand in the surveys of 2015, 2016, 2017 and 2018, 2019.

- viii. O2 was also considered the 4th most valuable brand in the UK in 2009, after Vodafone, Tesco and HSBC. In 2020, the O2 brand was valued at \$5,164,000, ranking 10th most valuable brand in the UK.
- ix. Previous decisions of the EUIPO and UK High Court acknowledges the reputation of the opponent's O2 trade mark in the UK for mobile phone and telecommunication services. Whilst there is also a reference to reputation being in relation to telecommunication goods in class 9, neither the evidence nor the previous decision mention use (or reputation) of the mark O2 in relation to contact lenses and related accessories.

52. I have no doubt that the earlier marks have acquired a reputation in relation to mobile telecommunication services (and related goods such as for example mobile devices) and that such reputation means that the distinctiveness of the earlier marks has been enhanced through use. The level of distinctiveness enjoyed by the earlier mark is very high.

53. As regards the relevance of the earlier marks' enhanced distinctiveness for the purpose of assessing the Section 5(2)(b) ground of opposition, whilst the opponent relies on mobile phones in class 9 (in relation to which the distinctiveness of the earlier marks has been enhanced) these are not relevant goods, because they are not similar to the contested goods (the latter being *Contact lenses; carrying cases and containers for contact lenses*). The same goes in relation to the claimed *entertainment, and sponsorship of high-profile events*, in relation to which I am not persuaded the opponent has any reputation. In this connection, it is important to bear in mind that the any increase in the likelihood of confusion as a result of enhanced distinctiveness through reputation inevitably diminishes as one moves away from the core products in relation to which the mark has been used.⁵

⁵ ROJA DOVE Trade Mark, BL-O- 016-10

Likelihood of confusion

53. 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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

54. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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 recognized 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 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)."

55. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

56. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

57. Earlier in this decision I found that:

- The IR and the earlier word-only mark are visually similar to, at best, a low degree. They are also aurally similar to a low degree and conceptually different.

The IR and the earlier figurative mark are visually dissimilar, aurally similar to a low degree and conceptually different.

- The competing goods are identical or similar to a medium degree.
- The average consumer will select the goods mainly visually, with a medium degree of attention.
- The earlier marks are inherently distinctive to a medium degree. Whilst the distinctiveness of the earlier marks has been enhanced to very high in the context of the relied upon mobile phones in class 9, these goods are not those which I found to be similar to the contested goods (and I find them to be dissimilar).

58. Bearing in mind the above, I consider that given the low degree of visual and aural similarity and the conceptual dissimilarity between the IR and the word-only mark, there cannot be any likelihood of direct confusion notwithstanding the fact that some of the goods covered by the contested IR are identical to those covered by the earlier mark. In this connection, as I have noted above, the high degree of distinctiveness of the earlier mark is not particularly helpful, because it relates to goods which are not similar to the contested goods.

59. I reach the same conclusion in relation to indirect confusion. First, the overall impression created by the contested mark is dominated by the distinguishing element 'Clalen' on which the consumer concerned will to a very great extent focus their attention and, second, the element 'O2' in 'O2O2' does not retain an independent role, meaning that the common component 'O2' will not be perceived independently within the applied-for IR. Added to this, the contested goods are not goods in relation to which the opponent has used the mark 'O2', nor are they closely similar to such products and, as it will be recalled, any increase in the likelihood of confusion as a result of enhanced distinctiveness through reputation inevitably diminishes as one moves away from the core products in relation to which the mark has been used; consequently, the opponent's argument that the familiarity with the earlier mark will trigger an association

in the mind of the public between the IR and the mark 'O2' cannot apply in this case. This is because the consumer is not familiar with the earlier mark being used in relation to the contested *Contact lenses; carrying cases and containers for contact lenses* and, as noted by Mr Iain Purvis KC in *ROJA DOVE* (BL-O- 016/10), the trigger is not simply familiarity with the mark, but familiarity with the mark in a particular context, which is not the case here. Lastly, the addition of the dominant word 'Clalen' and the subsuming of the element 'O2' within the element 'O2O2' are not consistent with a brand extension in which one would expect an element which was the dominant and distinctive element in the original mark to remain dominant and independent in the brand extension.

60. The position in relation to the figurative mark is even worse, as it is visually dissimilar.

61. There is no likelihood of confusion. The opposition based on Section 5(2)(b) fails.

Section 5(3)

62. Section 5(3) states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

63. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

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

64. I can deal with this ground very briefly. As it will be recalled, I have concluded that the earlier marks have acquired a reputation in relation to mobile telecommunication services in class 38 (and related goods such as for example mobile devices in class 9) at the relevant date (i.e. the filing date of the IR). The opponent's case is based on the argument that the holder's mark 'CLALEN O2O2' incorporates the earlier mark 'O2' and that the inclusion of the instantly recognisable 'O2' element in the contested IR creates a link with the opponent's well-known 'O2' trade marks. Given (a) the, at best, low degree of visual similarity between the marks; (b) what I have said about the element 'O2' not retaining an independent distinctive role within the applied-for IR, and (c) the fact that the contested goods are not goods in relation to which the opponent has used the mark 'O2' (which means that there is not the trigger of the familiarity with the earlier marks in a particular context) the element 'O2' will not be recognised independently within the IR and no link will be made in the mind of the average consumer. If I am wrong, and a link is made, it will be so fleeting not to cause any damage.

65. The opposition based on Section 5(3) also fails.

COSTS

66. The holder has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the holder the sum of £1,200 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing counterstatement and considering the notice of opposition: £400

Considering the other party's evidence

And filing its evidence: £500

Submissions in lieu: £300

Total: £1,200

67. I therefore order O2 Worldwide Limited to pay INTEROJO INC. the sum of £1,200. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of December 2025

TERESA PINTO

For the Registrar