O/1194/25

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. UK00003868717, UK00003868712 AND UK00003868724

IN THE NAME OF NICKEY GOWER

FOR THE FOLLOWING TRADE MARKS:

POP DIGITAL

POP FIGURES

IN CLASSES 9, 28 AND 35

AND CONSOLIDATED OPPOSITIONS THERETO

UNDER NOS. 442592, 442593 AND 442594

BY FUNKO, LLC

BACKGROUND AND PLEADINGS

1. On 17 January 2023, Nickey Gower ("the applicant") applied to register the following trade marks in the UK:

UKTM no. 3868717
("the First Application")

POP DIGITAL
UKTM no. 3868712
("the Second Application")

POP FIGURES
UKTM no. 3868724
("the Third Application")

(together "the applications")

2. The applications were published for opposition purposes on 19 May 2023 and protection is sought for the goods and services set out in Annex 1 to this decision.

3. On 18 August 2023, the applications were opposed by Funko LLC ("the opponent") based upon sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 ("the Act"). The opposition against the First Application also relies upon section 5(4)(b) of the Act.

4. Under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade marks:[1]

UKTM no. 801262216
Filing date 13 July 2015; registration date 29 June 2016
Priority date: 29 June 2015 (USA)
Class 28 Collectable toy figures.
("the First Earlier Mark")

POP!

IR designating the UK no. 1260907
International registration date: 13 July 2015
Designation date: 13 July 2015
Date protection granted in the UK: 19 February 2016
Class 28 Dolls and toy figures.
("the Second Earlier Mark")

5. Under section 5(2)(b) of the Act, the opponent relies upon all goods and services for which the earlier marks are registered, as set out above. The section 5(2)(b) oppositions are directed at the goods and services underlined in Annex 1 only. The opponent claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

[1] The opponent also originally relied upon IR designating the UK no. 1685842. However, as that mark was declared dead on 25 October 2024, it is no longer relied upon in these proceedings.

6. Under section 5(3) of the Act, the opponent relies upon all goods for which the earlier marks are registered and opposes all of the goods and services in the applications. The opponent claims that use of the applicant's marks would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of the earlier marks.

7. Under section 5(4)(a) of the Act, the opponent claims to have used the following signs throughout the UK since 2015 in relation to "games, toys and playthings; toy figures; collectible toy figures; dolls; cases for collectible toy figures" and "online retail services relating to Games, toys and playthings; toy figures; collectible toy figures; dolls; cases for collectible toy figures":

POP!

8. In relation to the oppositions against the First and Second Applications, the opponent also claims to have used the following sign throughout the UK since 2021 in relation to "games, toys and playthings; toy figures; collectible toy figures; dolls; cases for collectible toy figures", "digital collectables and NFTs; downloadable digital artwork and images; digital trading cards; downloadable virtual goods" and "online retail services relating to toys, collectible figures, digital collectables and NFTs":

9. The opponent claims that use of the applications would be contrary to the law of passing off.

10. Under section 5(4)(b) of the Act, the opponent claims to be the owner of the copyright in the sign shown in paragraph 8 above. The opponent states that the work was created by an employee of the opponent on 8 July 2021. As such, the opponent claims that use of the First Application is liable to be prevented by virtue of its earlier right.

11. Under section 3(6) of the Act, the opponent claims that the applicant is a former employee of one of its retail partners who would have direct knowledge of the opponent's business. Specifically, the opponent claims that the applicant was instrumental in building the website of the retail partner that was used for retailing the opponent's branded goods. As such, the opponent submits that the applicant has intentionally filed the applications with knowledge of the opponent's use to 1) benefit from the opponent's reputation or 2) to block the opponent's ability to secure registered trade mark rights for its signs. As such, the opponent claims that the applications have been filed in bad faith.

12. The applicant filed counterstatements denying the grounds of opposition and putting the opponent to proof of use of the earlier marks.

HEARING AND REPRESENTATION

13. A hearing took place before me, by video conference, on 23 October 2025. The applicant was represented by Nicholas Caddick KC of Counsel, instructed by Trade Mark Wizards LLP and the opponent was represented by Victoria Jones of Counsel, instructed by Burges Salmon LLP. Both parties filed skeleton arguments in advance of the hearing.

EVIDENCE

14. The opponent's evidence in chief consists of:

a. The witness statement of Tracy D Daw dated 8 February 2024, which is accompanied by 34 exhibits (TD1 to TD34). Mr Daw is the Chief Legal Officer of the opponent.

b. The witness statement of Amy Salter dated 9 May 2024, which is accompanied by 3 exhibits (AS1 to AS3). Ms Salter is a Chartered Trade Mark Attorney acting on behalf of the opponent in these proceedings.

c. The second witness statement of Mr Daw dated 22 May 2024, which is accompanied by 2 exhibits (TD35 and TD36).

15. The applicant's evidence consists of:

a. The witness statement of the applicant dated 23 July 2024, which is accompanied by 1 exhibit (Exhibit NG).

b. The witness statement of Scott Whitmore dated 20 July 2024. Mr Whitmore is the Director of a business called Hysteria Brands.

c. The witness statement of Warwick Fletcher dated 21 July 2024. Mr Fletcher has been a colleague of the applicant for 15 years.

d. The witness statement of Cajvanean Constantin Alexandru dated 20 July 2024. Mr Alexandru is a freelance developer who has worked with the applicant for 10 years.

16. The opponent's evidence in reply consists of:

a. The second witness statement of Amy Salter dated 23 September 2024, which is accompanied by 3 exhibits (AS4 to AS6).

17. On 12 September 2025, the opponent filed an amended first witness statement of Mr Daw and an unredacted version of exhibit TD36. The request was that this document be substituted for the original on the basis that it corrected errors in the

original statement and provided further “clarification” of the evidence. The Tribunal responded as follows:

> “Dear Recipient,
>
> The hearing officer has reviewed your amended evidence and is of the view that, whilst the correction of the typographical error in the table at paragraph 51 is simply the correction of an error in the original statement and the decision to un-redact Exhibit TD36 is a matter for Party A, the amendments to paragraphs 23 to 26 and paragraph 51 constitute new evidence.
>
> However, it is the hearing officer’s preliminary view that the new evidence appears material and will not prejudice the other side as they will be given an opportunity to respond (both in evidence, if needed, and in submissions at the hearing). Given the materiality of the evidence, it would be unfair to Party A to exclude it. As such, the hearing officer’s preliminary view is that:
>
> 1. The amended witness statement of Tracy Daw dated 11 September 2025 should be admitted.
>
> 2. Party B will have 14 days in which to confirm if it needs to file evidence in reply to the new evidence contained therein and, if so, it will have a further 14 days in which to do so.
>
> If you disagree with this preliminary view, you can request to be heard within the next 7 days, that is on or before 24th September 2025. If a hearing is requested it will take place at 9am on Thursday 2nd October 2025.”

18. No hearing was requested and so the evidence of Mr Daw was admitted. The applicant did not request to file any further evidence.

RELEVANCE OF EU LAW

19. 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.

THE FACTUAL POSITION

20. There are a number of aspects to this case which have a bearing on each ground of opposition. Consequently, I will begin by setting out some key parts of the factual background.

The opponent's toy business

21. It is not in dispute between the parties that the opponent sells toys in the UK; the toys in question are collectible figures/dolls. Indeed, it is accepted that the opponent had a reputation and benefitted from enhanced distinctiveness for these goods at the filing date of the contested applications. I note that the applicant has not specified to what degree it accepts that the opponent has a reputation/benefits from enhanced distinctiveness. In this regard, I note the following highlights from the opponent's evidence:

a. The opponent has used the earlier marks in the UK since 2014.

b. Between 2 November 2015 to 8 November 2023, the opponent had over 7million new user visits to its website from UK-based customers.

c. The opponent's goods are sold through well known UK-retailers such as Tesco, Asda, Smyths, The Entertainer, Selfridges and Lidl, and have been sold through these retailers since at least 2018.[2]

d. In 2022, the opponent generated sales of over £60million in the UK. Even allowing for only 80-85% of this figure relating to POP! branded products, this is clearly significant.[3]

e. Between 2020 and 2022, the opponent spent over £37,000 on social media influencer advertising.[4]

f. In 2022, the opponent spent over £660,000 on direct-to-consumer online advertising in the UK.

g. A *Netflix* documentary about the opponent was released in 2018, which included the development of the POP! brand.[5]

The expansion by the opponent into the digital space

22. Mr Daw gives evidence that, in addition to physical goods, the opponent sells NFTs, which are effectively digital trading card collectibles created in representations of its characters. Customers can collect unique digital versions of their favourite characters, with trading cards sold in packs. Mr Daw states that these cards can be redeemed for a limited edition, physical collectible. Mr Daw's evidence is that the opponent has used the sign shown in paragraph 8 above, in relation to these products since August 2021.

23. The opponent sells these digital figures via 3 websites: digital.funko.com, funko.wdny.io and Droppp.io.[6] Examples of these are provided at Exhibit TD26. I accept Mr Caddick's submission that not all of the evidence in this regard is specific

[2] Exhibit TD07
[3] Paragraph 23 of Mr Daw's first witness statement.
[4] Exhibit TD20
[5] Exhibit TD25
[6] See paragraph 48 of Mr Daw's witness statement.

to the UK market. However, I note that Mr Daw does give evidence regarding the opponent's UK business. One of the opponent's websites listed above had 55,000 active UK users between 1 October 2021 and 17 January 2023 and another had 59,000 active UK users during the same period.[7]

24. At the hearing, Mr Caddick took issue with the fact that the exhibit which evidences these figures does not identify the users as being UK specific. Consequently, Mr Caddick questioned whether these were, in fact, UK users in the absence of any documentary evidence to support that claim made by Mr Daw in his narrative evidence. I bear in mind the judgment of Mr Iain Purvis KC, sitting as the Appointed Person in *Daily Ritual,* in which a similar argument was made; in that case, it was argued that the witness in question should have been able to provide documentary evidence in the form of sales receipts, invoices and the like without much difficulty and in the absence of such documents, the narrative evidence of the witness should have been disregarded for being insufficiently solid.[8] I did not understand Mr Caddick to be suggesting that Mr Daw's evidence was untrue. However, if that was the intention it is not open to Mr Caddick to ask me to make such a finding in the absence of a challenge being raised to the witness (either through a request for cross-examination or during the written procedure) prior to the hearing.[9] To the extent that the suggestion was that I should disregard the narrative evidence without supporting documentary evidence, Mr Purvis answered this point as follows:

> "I see no difficulty with an informed witness summarizing in tabular form the records of his company as to the sales of a particular brand in the UK without exhibiting the actual records. Nor do I see any difficulty with them giving a general account of the lines of products sold under a brand, with some support in the form of archived website extracts, without providing documentation showing each and every item, when it was sold and for what price."

[7] Exhibit TD28
[8] BL O/005/21
[9] BL O/167/07

25. Given that Mr Purvis did not consider any supporting documentary evidence to be necessary at all, it seems to me that it must be entirely possible for a witness to provide a webpage showing the analytics for a website and to provide further clarificatory explanation by way of narrative evidence. In the absence of any challenge to that being raised during the course of these proceedings, I accept Mr Daw's evidence that these were, in fact, UK users. Mr Daw states that the sales of these digital products to UK cardholders, in the period October 2021 to January 2023, amounted to over $399,000.

The relationship between the parties

26. It is not in dispute that a business called Hysteria Brands is an authorised retailer of the opponent's toys. The parties are in agreement that the applicant worked with Hysteria Brands since early 2020; there is some dispute as to the capacity in which he worked with them (whether as an employee or consultant), but nothing turns on this.[10] It is also in agreement that the applicant helped to develop a website called popfigures.com, through which Hysteria Brands sells the opponent's goods. The applicant claims to have originally registered the domain name for this website, along with the domain name for www.popdigital.com in 2001. I return to this point below.

27. The applicant paid a graphic designer to develop a logo for use on the popfigures.com website.[11] The logos created are as follows:

[10] See paragraph 12 of Mr Gower's statement.
[11] See paragraph 10 of Mr Gower's statement.

28. This logo was developed further by Mr Alexandru, and the following logo was created:

29. I find that, at the time he was creating the website www.popfigures.com, the applicant was aware of the opponent. I make this finding on the basis of the following evidence:

a. In the course of communications regarding the creation of the website, the applicant referred to a website called www.popinabox.co.uk as an example of a website which he wished to emulate.[12] At the time, this website sold the opponent's goods under the earlier marks.[13]

b. The applicant and Mr Fletcher shared screenshots of the popfigures.com website, which include references to the opponent.[14]

c. The applicant states that in preparing the logo discussed above, he was seeking to "differentiate this brand from [the opponent's] trade mark".[15] This suggests a prior knowledge of the opponent at the time the logo was being created.

30. Indeed, there is evidence dating back to April 2020 which displays a YouTube video posted by the applicant, and the caption reads:[16]

[12] Page 8 of Exhibit NG
[13] Exhibit AS4
[14] Page 11 of Exhibit NG
[15] Paragraph 16 of Mr Gower's statement.
[16] Exhibit AS03

> "Whether you're just starting your collection with a new found love of Vinyl Pop Figures (We're jealous of the journey you're about to embark) or you're an experienced enthusiast with a house full of these funko guys and an angry partner begging you not www.popfigures.com."

31. I note that there is also a video posted by the applicant which is described as having been posted "3 years ago". As this is as of the date of Ms Salter's evidence, this would date the video at early May 2021. The video includes reference to FUNKO (being the opponent in this case).

The applicant's activities prior to the relevant date

32. The applicant states that having seen the success that Hysteria Brands had had with the popfigures.com venture, he decided that there was a market for NFT versions of these goods. As a result, he decided to launch his own brand, called Pop Digital later on in 2020. As noted above, by this time, the applicant claims to have owned the domain name www.popdigital.com for some time. The applicant states that he has invested time and money into developing this business but has "had to hold back from launching as a result of receiving an objection from [the opponent]". I assume that the objection referred to is the present opposition proceedings. I have no other evidence regarding steps taken by the applicant to launch a business under the applications.

Section 5(3)

33. Given their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As they had completed their registration process more than 5 years prior to the filing date of the application in issue, they are subject to the use provisions in section 6A of the Act. In his skeleton argument, Mr Caddick KC accepted that the opponent has shown genuine use for the goods in respect of which the earlier marks are registered. I need not, therefore, consider it any further.

34. 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".

35. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there

is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68*;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79*.*

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

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV,* paragraph 40*.* The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial

compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure).*

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

Similarity of the marks

37. I am satisfied that the marks are similar. I have set out my detailed reasoning in relation to this at paragraphs 43 to 53 below.

Reputation

38. I bear in mind the guidance of the CJEU in *General Motors,* Case C-375/97. The applicant accepts that the opponent has a reputation for collectible figures/dolls. In light of the evidence set out above, I agree; in my view, the opponent had a strong reputation for the goods relied upon, in the UK, at the relevant date.

Link

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

The degree of similarity between the conflicting marks

40. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impression created by the trade 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."

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

42. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade marks
 (the First Earlier Mark) POP! (the Second Earlier Mark)	 (the First Application) POP DIGITAL (the Second Application) POP FIGURES (the Third Application)

Overall Impression

43. The First Earlier Mark consists of the word POP followed by an exclamation mark in capital, comic-style font. This text appears within a speech bubble. The eye is naturally drawn to the element of the mark that can be read i.e. the word POP!. This plays the greater role in the overall impression, with the speech bubble and stylisation playing a lesser role.

44. The Second Earlier Mark consists of the word POP! in a standard font. The word POP! plays the greater role in the overall impression, with the stylisation playing a much lesser role.

45. The word POP! plays the greater role in the overall impression of the First Application for the same reasons given above in relation to the First Earlier Mark. Whilst I note that this mark is presented in colour and contains the word DIGITAL in a white font on a green background, the word DIGITAL will be perceived as non-distinctive, probably indicating a digital range of goods or toys which have a digital

aspect to them (thus having very little weight in the overall impression) and the colour will play a lesser role.

46. The Second and Third Applications consist of the word POP followed by another word (DIGITAL or FIGURES). The second words are both non-distinctive. Consequently, the word POP plays the greater role in the overall impression.

Visual Comparison

47. The First Earlier Mark and the First Application overlap in the stylisation used and the word POP!, albeit one has a double border and the other does not, and the speech bubble presentation. Whilst I note that the First Application is presented in green and black, the First Earlier Mark is presented in black and white so could be used in any colour. The word DIGITAL is a point of difference, however it is non-distinctive. Consequently, as accepted by the applicant, the marks are visually highly similar.

48. The First Application and the Second Earlier Mark overlap in the presence of the word POP!. They differ in the presentation used and the speech bubble in the First Application. The word DIGITAL is also a point of difference, although not a distinctive one. In my view, the marks are visually similar to a medium degree.

49. The Second and Third Applications overlap with the First Earlier Mark to the extent that they contain the word POP. The exclamation mark, stylisation and speech bubble in the First Earlier Mark are points of visual difference, as are the words DIGITAL/FIGURES in the Second and Third Applications. Overall, I consider the marks to be visually similar to between a low and medium degree.

50. The Second and Third Applications and the Second Earlier Mark overlap in the presence of the word POP. The exclamation mark in the Second Earlier Mark and the words DIGITAL/FIGURES in the Second and Third Applications are points of visual difference, albeit the latter is non-distinctive. In my view, the marks are visually similar to a medium degree.

Aural Comparison

51. Both of the earlier marks will be pronounced in the same way and the same comparison will, therefore, apply to both.

52. All three of the applications will be pronounced as POP plus the second word (DIGITAL or FIGURES). I do not consider that anything will turn on the presence (or absence of) the exclamation mark in the First Application. Consequently, I find the marks to be aurally similar to between a medium and high degree.

Conceptual Comparison

53. The word POP may have a number of meanings in the English language, such as referring to something bursting or an explosive sound or being an abbreviation for 'popular' (as in, pop music). I accept that the former may be more likely to be understood where an exclamation mark is included. However, in my view, the absence of an exclamation mark does not automatically mean that it is the latter meaning that will be understood. In my view, whichever meaning is identified by the average consumer for the word POP, it is likely to be the same across the marks. The additional words in the applications will clearly be points of conceptual difference, although not distinctive ones. In my view, they are conceptually highly similar.

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

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

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysterne 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."

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

> "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."

56. 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.

Class 9

Downloadable virtual characters.

57. The applicant accepts that there is a "moderate" degree of similarity between these goods and the opponent's goods in class 28.

Downloadable digital artwork and images; downloadable digital collectibles.

58. Ms Jones submitted that in light of the applicant's admission in relation to the above term, the same should be applied here, because *downloadable virtual characters* would be encompassed by both of these broader terms. I agree. Consequently, I find there to be at least a moderate degree of similarity with the opponent's class 28 goods.

Downloadable virtual merchandise; downloadable virtual goods for use online and in online virtual worlds; downloadable virtual goods; digital materials including non-fungible tokens (NFTs) featuring images, videos, audios, texts, and digital media art; digital materials including cryptographic tokens featuring images, videos, audios, texts, and digital media art; digital media including digital artworks featuring blockchain-based software technology; downloadable image files containing art and cryptographic collectibles authenticated by non-fungible tokens (NFTs); Downloadable entertainment content.

59. In my view, these could also all include downloadable virtual characters. Consequently, I find there to be at least a moderate degree of similarity for the same reasons discussed above.

Downloadable electronic publications; downloadable newsletters.

60. These are types of downloadable electronic publications. However, I do not consider that these terms would encompass those in relation to which the opponent has made admissions; I do not consider that, on its ordinary meaning, a downloadable virtual character would be considered a downloadable publication. I am not satisfied that there is any overlap in nature, method of use, purpose or trade channels, nor is

there any complementarity or competition with the opponent's goods.[17] Whilst the users may overlap at a very general level, that is not sufficient on its own for a finding of similarity. I find the goods to be dissimilar.

Recorded and downloadable media, computer software, mobile application software; entertainment software; computer games software; computer software and application software to create, edit, store, operate, manipulate, record and publish virtual characters; virtual reality software; non-fungible tokens (NFTs); downloadable software and software applications in the field of non-fungible tokens (NFTs) and virtual goods; downloadable computer software in the nature of non-fungible tokens (NFTs); downloadable computer software in the nature of non-fungible tokens (NFTs) used with blockchain technology to create printable 3D figurines, action figures, characters, models, and accessories; downloadable computer software for designing, customizing, and printing 3D figurines, action figures, characters, models, and accessories; blockchain software; computer software for managing and validating cryptocurrency and nonfungible tokens (NFTs) transactions using blockchain-based smart contracts; downloadable vouchers in the form of non-fungible tokens (NFTs); downloadable tokens of value; downloadable vouchers and tokens that can be exchanged for goods or services; application software.

61. In my view, all of these goods could encompass the downloadable virtual characters for which the applicant has accepted similarity. Alternatively, they are goods which are the subject of retail services for which the opponent has accepted similarity. Consequently, I find a moderate degree of similarity also applies in relation to these goods.

Digital trading cards.

62. I bear in mind that physical trading cards are often a game which is sold by toy retailers. Consequently, I consider it likely that there will be an overlap in trade channels between the physical toys (as covered by the opponent's specification) and

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

these digital trading cards (which would include digital equivalents of the physical trading cards often sold by toy retailers). The users would plainly overlap. There will be an overlap in purpose in that they are all intended for entertainment purposes. In my view, the goods share at least a moderate degree of similarity.

Blank digital or analogue recording and storage media; computers and computer peripheral devices; computer hardware.

63. These are blank storage devices/media or computer hardware. I can see no basis for finding any similarity in nature, method of use, purpose or trade channels with the opponent's goods. There is no competition or complementarity. The user may overlap at a very general level, but that is not enough on its own for a finding of similarity. Consequently, I find the goods to be dissimilar.

CDs, DVDs, and other physical media containing software, artwork, and entertainment content.

64. These are physical goods which carry entertainment, software or artwork content. I can see no basis for finding an overlap in trade channels, nature, method of use or purpose with the opponent's goods. There is no competition or complementarity. The user may overlap at a general level, but that is not enough on its own for a finding of similarity. I find the goods to be dissimilar.

Class 28

Toy figures; collectible toy figures; toy figures capable of transforming into various shapes; action figures; electric action figures with lights and sounds; scale model figures; toy figure playsets; dolls.

65. The applicant accepts that these goods are identical or highly similar to the opponent's goods.

Games, toys and playthings; action toys; electric action toys; model toys; playsets for action figures; clothing and accessories for toy figures; doll playsets; doll clothing and

accessories; toy vehicles; model vehicles; accessories for toy model vehicles; cases for collectible toy figures; cases for action figures; cases for toy vehicles; table-top games; board games; games relating to fictional characters; apparatus for games; video game apparatus; parts and fittings for all the aforesaid goods.

66. The applicant accepts that these goods are moderately similar to the opponent's goods.

Gymnastic and sporting articles.

67. These goods may be sold through the same trade channels as the opponent's goods, where they are all sold via large toy retailers. However, they are unlikely to be sold in the same sections of those retailers. The method of use and nature of the goods is likely to differ, although they will share the same broad purpose of entertainment. The user may overlap. I do not consider there to be any competition or complementarity between them. In my view, there is a low degree of similarity.

Decorations for Christmas trees

68. These goods differ to the opponent's goods in nature, method of use, purpose and trade channels. There is no competition or complementarity. Whilst the user may overlap, I do not consider that to be sufficient on its own for a finding of similarity. Consequently, I find them to be dissimilar.

Class 35

Organising, arranging and conducting trade fairs and exhibitions relating to toys, collectible toy figures, online retail services relating to toys, collectible toy figures, retail services, online retail services and wholesale services in relation to downloadable virtual characters, downloadable computer software in the nature of non-fungible tokens (NFTs), downloadable computer software in the nature of non-fungible tokens (NFTs) used with blockchain technology to create printable 3D figurines, action figures, characters, downloadable computer software for designing, customizing, and printing 3D figurines, action figures, characters, models, and accessories,

downloadable games, toys and playthings, toy figures, collectible toy figures, toy figures capable of transforming into various shapes, action figures, action toys, electric action toys, electric action figures with lights and sounds, model toys, scale model figures, toy figure playsets, playsets for action figures, clothing and accessories for toy figures, dolls, doll playsets, doll clothing and accessories, toy vehicles, model vehicles, accessories for toy model vehicles, cases for collectible toy figures, cases for action figures, cases for toy vehicles, table-top games, board games, games relating to fictional characters, apparatus for games, video game apparatus, parts and fittings for all the aforesaid goods; advisory, consultancy and information services relating to the aforesaid services.

69. The applicant accepts that there is a moderate degree of similarity between these services and the opponent's specification. I will proceed on that basis.

Organising, arranging and conducting trade fairs and exhibitions relating to digital collectables and NFTs.

70. The applicant has accepted that there is similarity between organising, arranging and conducting trade fairs in relation to physical toys and it has accepted that there is similarity in relation to retailing of software in the nature of NFTs. With these two admissions in mind, I find it difficult to follow why there would not also be similarity in relation to this term. In my view, it must follow that these services are also similar to the opponent's specification to a moderate degree.

Facilitating the sale of the products and services of others via a metaverse or virtual community.

71. This appears to me to be a synonym for the retailing of NFTs and virtual characters that the applicant has accepted similarity for. Consequently, I find there to be a moderate degree of similarity.

Online retail services relating to digital collectables and NFTs.

72. This appears to cover services for which the applicant has already accepted similarity, or which are so clearly linked with those for which similarity has been accepted that it must also apply in relation to these. Consequently, I find there to be a moderate degree of similarity.

Retail services, online retail services and wholesale services in relation to computer software, application software, mobile application software, entertainment software, computer games software, computer software and application software to create, edit, store, operate, manipulate, record and publish virtual characters, virtual reality software, downloadable digital artwork and images, non-fungible tokens (NFTs), downloadable software and software applications in the field of non-fungible tokens (NFTs) and virtual goods, downloadable computer software in the nature of non-fungible tokens (NFTs).

73. These appear to me to all be terms which are synonyms for, or encompass, the retail services relating to software in the nature of NFTs that the opponent has accepted similarity for. Consequently, I find there to also be a moderate degree of similarity in relation to these services.

Retail services, online retail services and wholesale services in relation to recorded and downloadable media, downloadable digital collectibles, downloadable virtual merchandise, downloadable virtual goods for use online and in online virtual worlds, downloadable virtual goods, digital materials including non-fungible tokens (NFTs) featuring images, videos, audios, texts, and digital media art, digital materials including cryptographic tokens featuring images, videos, audios, texts, and digital media art, digital media including digital artworks featuring blockchain-based software technology, downloadable image files containing art and cryptographic collectibles authenticated by non-fungible tokens (NFTs), downloadable entertainment content.

74. The applicant has accepted similarity in relation to retailing of downloadable virtual characters. It seems to me that this would fall within each of these broader terms and,

consequently, any similarity should also apply here. As a result, I find there to be a moderate degree of similarity.

Retail services, online retail services and wholesale services in relation to digital trading cards.

75. I have found there to be a moderate degree of similarity between the opponent's goods and digital trading cards. The same overlap in trade channels and user will apply in relation to the retailing of those goods. Whilst the same overlap in purpose will not apply, I find there to be similarity to at least a low degree.

Retail services, online retail services and wholesale services in relation to downloadable computer software in the nature of non-fungible tokens (NFTs) used with blockchain technology to create printable models, and accessories.

76. The applicant has accepted similarity with retailing of downloadable software in the nature of NFTs used with blockchain technology to create printable characters. In my view, that term would fall within the one shown here in relation to "models" and related accessories plainly also share similarity in terms of trade channels and user. Consequently, there is a moderate degree of similarity in relation to these goods also.

Retail services, online retail services and wholesale services in relation to downloadable vouchers in the form of non-fungible tokens (NFTs), down-loadable tokens of value, downloadable vouchers and tokens that can be exchanged for goods or services, CDs, DVDs, and other physical media containing software, artwork, and entertainment content.

77. This also appears to me to encompass the services for which the applicant has accepted similarity. Consequently, I find there to be a moderate degree of similarity with the opponent's specification.

Retail services, online retail services and wholesale services in relation to blockchain software, computer software for managing and validating cryptocurrency and nonfungible tokens (NFTs) transactions using blockchain-based smart contracts.

78. Whilst I bear in mind that these services also involve retail which relates to NFTs, this appears to me to be retail of software which supports the transactions themselves (rather than retailing of NFTs per se). Consequently, I can see no point of similarity with the opponent's specification and I find them to be dissimilar.

Retail services, online retail services and wholesale services in relation to downloadable electronic publications, downloadable newsletters.

79. For the reasons given above, I do not consider downloadable electronic publications and newsletters to be similar to the opponent's specification. For the same reason, I do not consider the related services to be similar.

Retail services, online retail services and wholesale services in relation to gymnastic and sporting articles.

80. I found the goods to which these retail services relate to be similar to the opponent's goods to a low degree. In my view, there would also be a low degree of similarity between the opponent's goods and these related retail services due to an overlap in trade channels and user.

Retail services, online retail services and wholesale services in relation to decorations for Christmas trees.

81. I have found the goods to which these retail services relate to be dissimilar to the opponent's goods. For the same reasons, I also find the related retail services shown here to be dissimilar.

Retail services, online retail services and wholesale services in relation to blank digital or analogue recording and storage media, computers and computer peripheral devices, computer hardware.

82. I found the goods to which these retail services relate to be dissimilar to the opponent's specifications. For the same reasons, I find the services to be dissimilar.

Loyalty, incentive and bonus program services.

83. I can see no point of overlap in nature, method of use or purpose with the opponent's goods. I accept that retailers of toys may also offer these services and so there may be an overlap in trade channels. Plainly, the users may overlap. In my view, the goods and services are similar to a low degree.

Auctioneering services.

84. I can see no basis for finding an overlap in trade channels, nature, purpose or method of use with the opponent's goods. There is no competition or complementarity. Whilst the user may overlap, that is not enough on its own for a finding of similarity. I find the goods and services to be dissimilar.

Provision of an online marketplace for buyers and sellers of goods and services.

85. I understand this term to be an online forum in which user's can sell their own goods to other people. Consequently, this service is the provision of a platform to enable others to sell, rather than a retail service in itself. Whilst I bear in mind that users of this service may be using the platform to sell the opponent's goods, that does not result in an overlap in trade channels because it is not the provider of the marketplace that is selling those goods. There is no overlap in method of use, purpose or nature. There is no competition or complementarity. I accept that the user may overlap, but that is not enough on its own for a finding of similarity. I find the goods and services to be dissimilar.

86. Whilst in some instances, I have found the goods/services to be dissimilar, I do not consider them to be completely distant in all cases. For example, auction sites or market places might specialise in the type of goods sold by the opponent or goods in class 9 which carry content and Christmas tree decorations, whilst dissimilar, might be themed around the opponent's goods and so they are not completely unrelated. The exception to this is the class 9 goods which are hardware or blank physical media storage goods as discussed in paragraph 63 above and the related retail services. To

my mind, there does not appear to be any connection between these goods and those for which the opponent has a reputation.

The strength of the earlier mark's reputation

87. I have found the earlier marks to have a strong reputation in the UK for the goods relied upon.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

88. 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 1-2779, 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)."

89. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

90. The applicant has filed evidence in an attempt to show that the word POP is not distinctive for the goods relied upon.[18] However, there are issues with this evidence. Firstly, some of it either specifically relates to other jurisdictions or is not specific to the UK.[19] Secondly, a number of the examples provided do nothing more than show descriptive use of the word POP as part of a larger phrase (such as Pop Up Pirate, Mr Owl Pop Out Blocks).[20] Thirdly, whilst there are some references to the word POP being used in the context of pop culture, such as a reference to a "pop starlet" figurine, this does nothing more than reinforce one of the potential inherent meanings of the word POP.[21] Fourthly, some of them use the word POP as part of an invented word (such as POPPLES).[22] Fifthly, some of them appear to relate to goods/services which are not in issue in these proceedings.[23]

91. I do not consider that the word POP is descriptive/non-distinctive for the relevant goods, nor do I consider the evidence filed supports such a finding. However, I do accept that it may be allusive of goods which are themed around popular culture. The Second Earlier Mark consists of the word POP, combined with an exclamation mark. I do not consider that the exclamation mark does much to contribute to the distinctiveness of the mark. In my view, the Second Earlier Mark is inherently distinctive to between a low and medium degree. The First Earlier Mark is presented in a comic-style font on a speech bubble background. In my view, the mark as a whole is distinctive to a medium (or average) degree.

[18] Pages 12 to 35 of Exhibit NG
[19] See, for example, pages 12, 16 and 27.
[20] See, for example, pages 17, 18 and 23.
[21] See, for example, page 22.
[22] See page 31.
[23] See, for example, pages 32 and 35.

92. The applicant has accepted that the distinctiveness of the earlier marks has been enhanced through use. I have set out the highlights of the opponent's evidence above. In my view, the distinctiveness of the Second Earlier Mark has been enhanced to between a medium and high degree through use and the distinctiveness of the First Earlier Mark has been enhanced to a high degree, both in relation to the goods relied upon.

Whether there is a likelihood of confusion

93. I find that there would be a likelihood of confusion in respect of, at least, those goods/services that I have found to be similar.

Conclusions on link

94. I have borne in mind Mr Caddick's submission that the relevant public associate the Pop! logo with the opponent or the word POP with an exclamation mark, not the word POP solus (as is used in the applications). I accept Mr Caddick's submission that the opponent does not have a monopoly over the word POP; as he rightly pointed out, being a dictionary word, it would be wrong to say that any use of that word, in any context, would automatically be associated with the opponent. However, whilst I have found some of the goods and services to be dissimilar, I have also found that in most cases they are not completely distant; there remains a connection between them (with the limited exception of the goods specified in paragraph 63 above and the related services). As such, I find that the relevant public would make a link between the marks, given the similarity of the signs and the strength of the opponent's reputation in the UK.

Damage

95. I must now consider whether any type of damage pleaded will arise.

Unfair advantage

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

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

97. To the extent that the relevant public believe that the goods of the applicant are the goods of the opponent, there will plainly be unfair advantage. Further, the evidence shows that the opponent has invested in promoting its marks in the UK and so it is clear that there is potential for the applicant to gain an unfair advantage, by benefitting from that investment, without having to invest in its own marketing activities. Consequently, I find there to be a likelihood that the applicant will gain an unfair advantage.

98. As I have found unfair advantage, I do not need to consider the other pleaded heads of damage.

99. The oppositions based upon section 5(3) of the Act succeed in relation to all goods and services, with the exception of the following:

Class 9 Blank digital or analogue recording and storage media; computers and computer peripheral devices; computer hardware.

Class 35 Retail services, online retail services and wholesale services in relation to blank digital or analogue recording and storage media, computers and computer peripheral devices, computer hardware.

Section 5(4)(a)

100. Section 5(4)(a) of the Act states as follows:

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
>
> a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> aa)…
>
> b) …
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark."

101. Subsection (4A) of section 5 of the Act states:

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

102. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

103. I note that in relation to this ground, the opponent relies upon the sign shown in paragraph **7** above and, what I shall describe as, the physical toy goods in relation to its oppositions against all three applications. It relies upon the sign shown in paragraph **8** above and, what I shall describe as, the digital equivalents, in relation to its oppositions against only the First and Second Applications.

Relevant date

104. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of

> the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

105. The prima facie relevant date is the filing date of the applications i.e. 17 January 2023. However, I note that in the applicant's evidence he claims to have registered the domain name for www.popfigures.com and www.popdigital.com in 2001. It is in dispute as to whether he actually registered those domain names himself at that time. However, for the sake of completeness, I have considered whether this should be taken as "the start of the behaviour complained about".

106. I note that paragraph 5-313 of *Wadlow on the Law of Passing Off: 6th Ed.* Cites, with approval, *Barnsley Brewery v RBNB*, as follows:

> "In *Barnsley Brewery v RBNB*[24] a dispute arose as to whether the relevant date was in March 1995 (when the defendants' solicitor notified the plaintiffs that they intended to market "Barnsley Bitter" at some indeterminate time in the future) or at the end of 1996 when launch of the defendants' beer was imminent. Robert Walker J held that a quia timet action in 1995, relying only on the letter and two trade mark applications, would have been premature. The relevant date was late 1996, and the plaintiffs were therefore entitled to rely on an additional 20 months' trading and advertising."

107. This would suggest that the relevant date is when use of the applied-for mark in relation to the relevant goods/services is concrete and imminent, such as in pre-launch activities.

108. On the other hand, in *Marks & Spencer Plc v One In A Million Ltd and Others*[25] the deputy judge granted summary judgment on the basis that registration of internet domain names constituted "instruments of deception", following the judgment of Lightman J in *Glaxo Plc v Glaxowellcome Ltd*, who had reached a similar finding in

[24] [1997] FSR 462
[25] [1998] FSR 265

relation to the registration of company names.[26] The deputy judge explained the law as follows:

> "The mere creation of an 'instrument of deception', without either using it for deception or putting it into the hands of someone else to do so, is not passing off. There is no such tort as going equipped for passing off. It follows that the mere registration of a deceptive company name or a deceptive internet domain name is not passing off. In both of these cases the court granted what amounted to a quia timet injunction to restrain a threatened rather than an actual tort. In both cases, the injunctions were interlocutory rather than final, and the threat is no doubt easier to establish in that context. But even a final injunction does not require proof that damage will certainly occur. It is enough that what is going on is calculated to infringe the plaintiff's rights in future."

109. Taking these authorities into account, the registration of a domain name alone will not constitute the start of the behaviour complained about for passing off purposes. However, it may count as such if the registration is a precursor to subsequent, imminent, and potentially deceptive trading activities under the name complained about, or an express or implied threat to transfer the name to someone else to facilitate that activity. There does not appear to have been any activity on the part of the applicant in this case, other than mere registration of those domain names until 2020 when he began developing the popfigures.com website for Hysteria Brands. However, that business was an authorised retailer of the opponent and so any activities undertaken in that regard were with the consent of the opponent and cannot constitute the start of the behaviour complained of. I note that there is also reference by the applicant to a decision to start his own business (separate to that of Hysteria Brands) which would trade under the Pop Digital marks. However, there does not appear to have been any action in this regard on the part of the applicant beyond applying for the applications in issue. Consequently, I do not consider that there is an earlier relevant date.

[26] [1996] FSR 388

Goodwill

110. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

111. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

112. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

> "[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

113. I do not understand it to be in dispute that the opponent had goodwill in relation to toy figures/collectibles at the relevant date. I also do not understand it to be in dispute that the signs relied upon were distinctive of that goodwill.

114. In addition to this, I note that the opponent has filed evidence regarding its expansion into the digital space (see paragraphs 22 to 25 above) for the purposes of proving goodwill in its oppositions against the First and Second Applications. In this regard, I accept Mr Caddick's submission that some of the evidence provided is not dated prior to the relevant date and that various other parts of the evidence are not specifically directed at the UK market; there are clearly issues with parts of the evidence. However, I agree with Ms Jones that I must look at the evidence as a whole. In my view, when looking at the evidence in its entirety, the opponent has demonstrated a moderate (but protectable) goodwill in relation to digital trading cards and/or digital collectibles and NFTs.

Misrepresentation and damage

115. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341* at page 407 the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

> ".... for my part, I think that references, in this context, to "more than *de minimis* " and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may b e thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

116. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

> "64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small

in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

117. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

118. As I have discussed above, the parties are, for the most part, operating within the same field of activity or ones that are not completely distant from each other. The exception to this is the goods and services listed at paragraph 84 above. I also bear in mind that, whilst the opponent cannot rely upon the digital goods for the purposes of its opposition against the Third Application, there remains a nexus between the physical goods and the digital equivalents (and related services). The First Application is identical to one of the signs relied upon and at least reasonably similar to the others. The Second Application is also reasonably similar to the signs relied upon. I bear in mind that only the sign shown in paragraph 7 is relied upon in relation to the Third Application, and there is a reasonable degree of similarity between those. Bearing in mind these similarities, even where the opponent only has a moderate degree of goodwill, there will be a significant number of customers, or potential customers who would be likely to be deceived. Damage through diversion of sales would plainly follow.

119. The oppositions based upon section 5(4)(a) of the Act succeed in relation to the following goods and services in the First and Second Applications, with the exception of the following:

Class 9 Blank digital or analogue recording and storage media; computers and computer peripheral devices; computer hardware.

Class 35 Retail services, online retail services and wholesale services in relation to blank digital or analogue recording and storage media, computers and computer peripheral devices, computer hardware.

Section 5(2)(b)

120. I can deal with this ground relatively swiftly. The oppositions under section 5(2)(b) will plainly succeed to the extent that the goods and services are similar (as discussed above). However, they cannot succeed in relation to those goods and services that I have found to be dissimilar. With that in mind, this ground of opposition can only succeed to a lesser degree than the 5(3) and 5(4)(a) grounds and, consequently, I decline to deal with it in any further detail.

Section 5(4)(b)

121. Section 5(4)(b) of the Act states as follows:

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
>
> a) …
>
> aa)…
>
> b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (aa) above, in particular by virtue of the law of copyright or the law relating to industrial property rights.
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark".

122. Section 1 of the Copyright, Designs and Patents Act 1988 ("CDPA") provides for copyright to subsist in original artistic works. Section 4 CDPA further provides:

> "4 – Artistic works.
>
> (1) In this Part *"artistic work"* means –

(a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,

[…]

(2) In this Part –

[…]

"graphic work" includes –

(a) any painting, drawing, diagram, map, chart or plan […]"

123. The parties are in agreement that the work relied upon is not completely original. This is because the work relied upon, which was created by Mr Jamotillo on 8 July 2021 in the US (he was employed by the opponent at the time), was based upon an earlier device mark which was created in 2020. That earlier device mark is as follows (for ease of reference, I have displayed it alongside the work relied upon):

(the 2020 work)

(the work relied upon)

124. A work will be original in the sense that it is the author's own intellectual creation.[27] This is an objective test. It is apparent from the case law that relatively small changes can be said to amount to the author exercising their own creative choices. In this regard, Ms Jones drew my attention to the judgment of Her Honour Judge Michaels in

[27] *Infopaq International A/S v Danske Daglades Forening* (C-5/08) EU:C:2009:465; [2009] E.C.D.R. 16 at [34]–[37]

Conrad Lant v Plastic Head Music Distribution Limited and Another [2025] EWHC 1954 in which she considered whether the first logo shown below was original, given the existence of the second logo shown below:

125. She stated as follows:

> "36. The only question for me, therefore, is whether the work has sufficient originality over Venom Logo 1 to qualify for copyright protection. It was common ground that the test of originality has not changed substantially from the time when these works were made, when the Copyright Act 1956 was in force. The test for originality is low. The law was summarised by Joanna Smith J in *Lidl Great Britain Ltd v Tesco Stores Ltd* [2023] EWHC 873 (Ch), [2023] F.S.R.in relation to an extremely simple design which was the latest iteration of a series of logos. She held:
>
> > "282 Copyright only protects works which are original in the sense that they are the author's own creation. The test for originality was

considered by the European Court of Justice in *Infopaq International A/S v Danske Dagblades Forening* (C-5/08) EU:C:2009:465;[2010] F.S.R. 20 at [39]. A work, and its various parts, will be considered original "provided that they contain elements which are the expression of the intellectual creation of the author of the work". This EU test of originality was further elaborated upon in *Cofemel – Sociedade de Vestuario SA v G-Star Raw CV* (C-683/17) EU:C:2019:721; [2020] E.C.D.R. 9 at [29]-[31]:

> "29. The concept of "work"…[f]irst…entails that there exist an original subject matter, in the sense of being the author's own intellectual creation. Second, classification as a work is reserved to the element that are the expression of such creation…
>
> 30. As regards the first of those conditions… if a subject matter is to be capable of being regarded as original, it is both necessary and sufficient that the subject matter reflects the personality of its author, as an expression of his free and creative choices…
>
> 31. On the other hand, when the realisation of the subject matter has been dictated by technical considerations, rules or other constraints, which have left no room for creative freedom, that subject matter cannot be regarded as possessing the originality required for it to constitute a work…"

283 The court went on at [35] to observe that, where subject matter has the characteristics identified in [30], and therefore constitutes a work, "it must, as such, qualify for copyright protection… and it must be added that the extent of that protection does not depend on the degree of creative freedom exercised by its author, and that that protection is therefore not inferior to that to which any work falling with the scope of that directive is entitled". In other words, the question of protection is a matter of fact and not degree. […]

> 288 In my judgment, the act of bringing together the Lidl text with the yellow circle and the blue background was an act which involved skill and labour – the combination of colours and shapes and the orientation of the various elements. Tesco's real complaint, as I pointed out in opening, appears to be that the combination consists of insufficient skill and labour because it is too simple. However, as to that, my second reason for rejecting Tesco's argument is that simplicity of design and/or a low level of artistic quality does not preclude originality…
>
> 290… Ultimately the litmus test must be whether the [work] involves the exercise of intellectual creation involving the expression of free choice. In my judgment, it does."

126. Her Honour Judge Michaels concluded that there were significant differences between the two works shown above, as follows:

> "39. In my view it is abundantly clear that there was a sufficient degree of creativity involved in the creation of Venom Logo 2. It had original features, especially in the amendments to the shape of the V, the N and the M, which I consider to be striking, distinctive, and to add substantially to the overall design. My view of the amount of work which went into the logo is supported by some sketches produced by Mr Land, which show a variety of different forms of the logo, suggesting a wide degree of artistic freedom. There was additional evidence of use of variations of the logo. For instance, in my view, the Venom logo used on the Bloodlust single in 1982 was something of a hybrid between versions 1 and 2. In the circumstances, I have no hesitation in finding that the creation of Venom Logo 2 would not have been a purely mechanical exercise, nor was the result dictated by technical considerations, rules or other constraints which left no room for creative freedom."

127. It seems to me that there are material changes between the work in 2020 and the work relied upon by the opponent, which involved creative freedom on the part of the author (the font used, the differences to the shading used, the differing patterns contained within the text and the different wording used on each design, the inclusion

of the exclamation mark). In my view, these parts of the work are original and can be relied upon by the opponent.

128. The author of the work was Mr Jamotillo, who was an employee of the opponent at the time. As to the ownership of the work, section 11 of the CDPA states:

> "(2) Where a literary, dramatic, musical or artistic work, or a film, is made by an employee in the course of his employment, his employer is the first owner of any copyright in the work subject to any agreement to the contrary."

129. There is no suggestion that there is any agreement to the contrary. Consequently, the opponent is the owner of the work relied upon.

130. The opponent is a company incorporated in the United States. In this regard, section 22 of the Intellectual Property Act 2014 states that section 159 of the CDPA should be read as meaning that:

> "(1) Where a country is a party to the Berne Convention or a member of the World Trade Organisation, this Part, so far as it relates to literary, dramatic, musical and artistic works, films and typographical arrangements of published editions –
>
> > (a) applies in relation to a citizen or subject of that country or a person domiciled or resident there as it applies in relation to a person who is a British citizen or is domiciled or resident in the United Kingdom."

131. The United States is a party to the Berne Convention. It follows that the opponent, being the owner of the work in question, has the same rights in the UK as would a British national.

132. Section 17 of the CDPA states that:

> "(1) The copying of the work is an act restricted by the copyright in every description of copyright work; and references in this Part to copying and copies shall be construed as follows.
>
> (2) Copying in relation to a literary, dramatic, musical or artistic work means reproducing the work in any material form."

133. I note Mr Caddick's submission that the opponent can only rely upon those parts of the work which are original (i.e. that have not themselves been copied from the 2020 Work). However, given that the work is identical to the First Application, I do not consider that anything will turn on this.

134. Given the evidence set out above regarding the applicant's knowledge of the opponent's business, and the identity of the First Application and the work relied upon by the opponent, there is a clear prima facie case of copying. It strikes me that there is a complete lack of explanation from the applicant as to how he came to apply for a trade mark which is identical to the work relied upon. In the absence of a convincing explanation in that regard, I find that the First Application was copied from the opponent's copyright work and that it represents an unlawful reproduction of that work. It follows that use of the First Application would be contrary to the CDPA.

135. The opposition based upon section 5(4)(b) of the Act is successful.

Section 3(6)

136. Section 3(6) of the Act states:

> "(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

137. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

> "(i) […]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*")], para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

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

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

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive

right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

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

138. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested [applications] could not be properly filed? and

(c) Was it established that the contested [applications were] filed in pursuit of that objective?

139. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

What in concrete terms, was the objective that the applicant has been accused of pursuing?

140. It is not in dispute that the applicant worked with Hysteria Brands, the opponent's retail partner. It is also not in dispute that he developed the website used by Hysteria Brands for the purpose of selling the opponent's goods. As such, the opponent claims that the applicant had knowledge of the opponent and its business under the marks and applied for the applications in the knowledge that he did not have consent to do so. The opponent states that this was done either with the intention of benefitting from the opponent's reputation or with the intention of blocking the opponent's legitimate business activities. Consequently, the opponent claims that the applications were made in bad faith.

Was that an objective for the purposes of which the contested marks could not be properly filed?

141. The mere knowledge of another party using the same or similar mark does not, of itself, establish bad faith.[28] However, if the applications were filed to block the opponent's legitimate business activities or to benefit unfairly from the opponent's reputation then those are objectives for the purpose of which the applications could not be properly filed.

Was it established that the contested applications were filed in pursuit of that objective?

142. I have already found that the applicant knew of the opponent and its business activities in the UK by as early as 2020.

143. I have set out the evidence above regarding the opponent's expansion into digital offerings which took place as early as 2021. It seems to me that it is a reasonable inference to draw that the applicant would have been aware of this expansion by the relevant date, given that he was clearly aware of the opponent and its business prior to that time. Further, the fact that the First Application is identical to the one that the opponent uses for its digital offering (being a complex mark unlikely to have been created identically by coincidence), seems to me to support a finding that the applicant was aware of the opponent's expansion into this field. Given the similarities between the First Application and the First Earlier Mark, it seems to me that there is a very clear prima facie case of bad faith (most likely through an intention to benefit from the opponent's reputation). I have given a great deal of consideration as to whether there is also a prima facie case of bad faith in respect of the Second and Third Applications which do not carry the same "get up" as the marks used by the opponent, being word only marks. However, it seems to me that the applications for the Second and Third Applications were part of the same pattern of behaviour when viewed in the context of the applicant's behaviour as a whole. Consequently, I find that there is a prima facie case of bad faith for all three applications.

144. The applicant has, of course, filed evidence to rebut the prima facie case. The applicant accepts that he knew of the opponent and the opponent's physical toy

[28] *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12

products (albeit, he says he thought that they were called Bobbleheads). As noted above, in respect of the First Application, there is a complete lack of explanation from the applicant as to how he came to apply for a mark which is identical to the work owned by the opponent, and which is so similar to the First Earlier Mark.

145. I have considered whether the fact that the applicant had applied for domain names corresponding to the Second and Third Application prior to the opponent entering the UK market is sufficient to avoid a finding of bad faith. In this regard, Ms Jones noted that the applicant's evidence is ambiguous about when he acquired those domain names:

> "the domain name has been registered since 8th June 2001 and I still own that domain name and have maintained it and renewed it since I acquired it."
>
> "I own the domain name that was created on 13th November 2001 and I still own that domain name and have maintained it and renewed it since I acquired it."

146. I take Ms Jones' point that the applicant does not actually say that it was he who registered the domain names; rather he states that he has maintained and renewed them since he acquired them and he does not state whether this acquisition was in 2001 at the point of registration or some time since. However, even proceeding on the basis that he has owned those domain names for the duration of that period, I do not consider that it is sufficient to rebut the prima facie case of bad faith. This is because, whether or not the applicant had those domain names registered, by the time of filing the applications in question, he had direct knowledge of the opponent and its business activities. Applying for national trade marks is to seek protection of those signs to the exclusion of all others; to my mind, it would not be considered commercially acceptable practice to apply for the marks in question given the prior relationship between the parties. The complete lack of explanation from the applicant regarding the identity of the First Application and the work owned by the opponent is, in my view, telling. Taking all of this into account, I find that the applications were filed in bad faith.

147. In this regard, I have considered whether that finding extends to the applications in their entirety or whether it should only apply to those goods/services that I have found to be similar or not completely unrelated to the opponent's business. However, even in relation to those goods and services for which there is no apparent connection with the opponent's business, given that there was, in my view, an intention on the part of the applicant to take unfair advantage of the opponent's reputation/to pre-empt its business expansion into the digital field, there must have been a reason why the applicant thought he should apply for the goods/services that he did and, as a result, would benefit from a connection with the opponent. Consequently, I find that the finding of bad faith extends to the applications in their entirety.

148. The oppositions based upon section 3(6) of the Act succeed in their entirety.

CONCLUSION

149. The oppositions succeed in their entirety and, subject to appeal, the applications are refused.

COSTS

150. The opponent 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 opponent the sum of **£4,200**, calculated as follows:

Preparing Notices of opposition and considering the counterstatements	£600
Preparing and filing evidence and considering the applicant's evidence	£1,800
Preparing for and attendance at the hearing	£1,200
Official fee (x3)	£600

Total	**£4,200**

151. I therefore order Nickey Gower to pay Funko LLC the sum of **£4,200**. 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 22nd day of December 2025

S WILSON
For the Registrar

ANNEX 1

Class 9

Recorded and downloadable media, computer software, blank digital or analogue recording and storage media; application software; mobile application software; entertainment software; computer games software; computer software and application software to create, edit, store, operate, manipulate, record and publish virtual characters; virtual reality software; computers and computer peripheral devices; computer hardware; downloadable digital artwork and images; digital trading cards; downloadable digital collectibles; downloadable virtual characters; downloadable virtual merchandise; non-fungible tokens (NFTs); downloadable software and software applications in the field of non-fungible tokens (NFTs) and virtual goods; downloadable virtual goods for use online and in online virtual worlds; downloadable virtual goods; downloadable computer software in the nature of non-fungible tokens (NFTs); downloadable computer software in the nature of non-fungible tokens (NFTs) used with blockchain technology to create printable 3D figurines, action figures, characters, models, and accessories; downloadable computer software for designing, customizing, and printing 3D figurines, action figures, characters, models, and accessories; blockchain software; computer software for managing and validating cryptocurrency and nonfungible tokens (NFTs) transactions using blockchain-based smart contracts; digital materials including non-fungible tokens (NFTs) featuring images, videos, audios, texts, and digital media art; digital materials including cryptographic tokens featuring images, videos, audios, texts, and digital media art; digital media including digital artworks featuring blockchain-based software technology; downloadable image files containing art and cryptographic collectibles authenticated by non-fungible tokens (NFTs); downloadable vouchers in the form of non-fungible tokens (NFTs); downloadable tokens of value; downloadable vouchers and tokens that can be exchanged for goods or services; CDs, DVDs, and other physical media containing software, artwork, and entertainment content; downloadable entertainment content; downloadable electronic publications; downloadable newsletters.

Class 28

Games, toys and playthings; toy figures; collectible toy figures; toy figures capable of transforming into various shapes; action figures; action toys; electric action toys; electric action figures with lights and sounds; model toys; scale model figures; toy figure playsets; playsets for action figures; clothing and accessories for toy figures; dolls; doll playsets; doll clothing and accessories; toy vehicles; model vehicles; accessories for toy model vehicles; cases for collectible toy figures; cases for action figures; cases for toy vehicles; table-top games; board games; games relating to fictional characters; apparatus for games; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees; parts and fittings for all the aforesaid goods.

Class 35

Organising, arranging and conducting trade fairs and exhibitions relating to toys, collectible toy figures, digital collectables and NFTs; loyalty, incentive and bonus program services; auctioneering services; provision of an online marketplace for buyers and sellers of goods and services; facilitating the sale of the products and services of others via a metaverse or virtual community; online retail services relating to toys, collectible toy figures, digital collectables and NFTs; retail services, online retail services and wholesale services in relation to recorded and downloadable media, computer software, blank digital or analogue recording and storage media, application software, mobile application software, entertainment software, computer games software, computer software and application software to create, edit, store, operate, manipulate, record and publish virtual characters, virtual reality software, computers and computer peripheral devices, computer hardware, downloadable digital artwork and images, digital trading cards, downloadable digital collectibles, downloadable virtual characters, downloadable virtual merchandise, non-fungible tokens (NFTs), downloadable software and software applications in the field of non-fungible tokens (NFTs) and virtual goods, downloadable virtual goods for use online and in online virtual worlds, downloadable virtual goods, downloadable computer software in the nature of non-fungible tokens (NFTs), downloadable computer software in the nature of non-fungible tokens (NFTs) used with blockchain technology to create printable 3D figurines, action figures, characters, models, and accessories, downloadable computer software for designing, customizing, and printing 3D figurines, action figures, characters, models, and accessories, blockchain software, computer software for

managing and validating cryptocurrency and nonfungible tokens (NFTs) transactions using blockchain-based smart contracts, digital materials including non-fungible tokens (NFTs) featuring images, videos, audios, texts, and digital media art, digital materials including cryptographic tokens featuring images, videos, audios, texts, and digital media art, digital media including digital artworks featuring blockchain-based software technology, downloadable image files containing art and cryptographic collectibles authenticated by non-fungible tokens (NFTs), downloadable vouchers in the form of non-fungible tokens (NFTs), down-loadable tokens of value, downloadable vouchers and tokens that can be exchanged for goods or services, CDs, DVDs, and other physical media containing software, artwork, and entertainment content, downloadable entertainment content, downloadable electronic publications, downloadable newsletters, games, toys and playthings, toy figures, collectible toy figures, toy figures capable of transforming into various shapes, action figures, action toys, electric action toys, electric action figures with lights and sounds, model toys, scale model figures, toy figure playsets, playsets for action figures, clothing and accessories for toy figures, dolls, doll playsets, doll clothing and accessories, toy vehicles, model vehicles, accessories for toy model vehicles, cases for collectible toy figures, cases for action figures, cases for toy vehicles, table-top games, board games, games relating to fictional characters, apparatus for games, video game apparatus, gymnastic and sporting articles, decorations for Christmas trees, parts and fittings for all the aforesaid goods; advisory, consultancy and information services relating to the aforesaid services.