

**O/049/20**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3344871**

**BY MATTIAS INDUSTRY LP**

**AND**

**OPPOSITION No. 415404**

**BY EBAY INC.**

## Background and pleadings

1. This is an opposition filed on 11<sup>th</sup> February 2019 by eBay Inc. (“the opponent”) against trade mark application 3344871 filed on 11<sup>th</sup> October 2018 (“the relevant date”) by Mattias Industry LP (“the applicant”).
2. The applicant is a limited partnership with an address in Stirling, Scotland. The opponent is a well-known US corporation.
3. The contested trade mark looks like this:

**GamersbaY**

4. The applicant seeks to register the mark in relation to:

Class 36: Providing purchase protection services in the field of online trading of goods and services by others on the platform via a global computer network.

Class 38: Telecommunications services, namely the electronic transmission of data and information; providing access to databases; communications by computer terminals; computer aided transmission of messages and images; providing internet chatrooms and internet forums; message sending; transmission of electronic mail; transmission of digital files; wireless broadcasting; providing access to internet chatrooms and electronic bulletin boards for transmission of messages between users; providing access to Internet platforms; sending electronic messages via websites; electronic transmission of data and documents; electronic transmission of data and documents between computer users; transmission of data and information via computers and electronic communications; transmission of data and information via computers; transmission of data via computers; electronic transmission of documents; transmission of information and data via Internet; transmission of information and data via online services; providing access to electronic databases; providing access to electronic online networks for information search; sending and receiving of electronic messages; electronic transmission of data and documents via computer terminals and electronic devices. provision of access to computer databases.


Class 42: Design and development of software; computer programming; maintenance services for computer software; provision of access to global information networks and other network systems; design and development of


software applications and application programming interfaces; providing temporary use of on-line, non-downloadable computer software and software development tools for use in developing further software and software applications in the field of e-commerce; providing temporary use of online, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network; maintenance and updating of computer software for others; hosting platforms on the internet; hosting of e-commerce platforms on the internet; hosting of communication platforms on the internet; hosting websites.

5. The opponent is the proprietor of the earlier trade marks set out in the following table<sup>1</sup>.

Territory/No.	Trade Mark	Goods/services relied on	Filing or priority date	Registration date
UK2221802	EBAY	Class 38: Radio broadcasting; electronic transmission of data and information; providing telecommunications connections to data bases; electronic mail services.	9/02/00	3/11/00
EU1029198	EBAY	Class 35: Advertising services; on-line trading services.	24/12/98	22/06/00
EU825802	EBAY	Class 42: Providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network, and for	15/05/98	4/01/00

<sup>1</sup> The opponent's marks are registered for wider specifications than shown here. For ease of understanding, I have drawn the goods/services shown in the table from the annexes to the opponent's skeleton argument, which show its latest position. Additionally, I have omitted *business information and administration services* in class 35 of EU 1029198. This is because, at the hearing described below, the opponent's counsel indicated that these services are not relevant to the opposition. The words *Radio broadcasting* do not actually appear in the registered specifications. The opponent contends that these words are a fair description of the use shown of the UK 2221802 and EU 1029198 marks in relation to the registered *telecommunications services* and should, therefore, form the basis of its s.5(2) case. The words shown in italics in the list of services relied on from UK 2642722 are suggested to represent a fair description of the use shown of that mark in relation to the registered term *design and development of computer software, software applications, and application programming interfaces*.

		the collection and dissemination of statistical, quantitative and qualitative information regarding the sale and resale of items via a global computer network; providing analyses and online distribution of statistical, quantitative and qualitative information regarding the sale and resale of items via a global computer network.		
UK2642722		Class 35: On-line trading services, namely, operating on-line marketplaces for sellers and buyers of goods and services; online trading services in which sellers post products or services to be offered for sale and purchasing or bidding is done via the Internet in order to facilitate the sale of goods and services by others via a computer network; advertising and advertisement services. Class 36: Providing purchase protection services in the field of on-line trading of goods and services by others via a global computer network. Class 38: Telecommunications services, namely, the electronic transmission of data and information; electronic messaging; providing an online, interactive bulletin board for the transmission of	19/11/12	22/02/13

		<p>messages among computer users concerning hobbies, collectibles, trading, and the sale of goods and services via a global computer network.</p> <p>Class 42: Design and development of computer software, software applications, and application programming interfaces, <i>all in the context of advertising and e-commerce</i>; providing temporary use of on-line, non-downloadable computer software and software development tools for use in developing further software and software applications in the field of e-commerce; providing temporary use of online, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network; maintenance and updating of computer software for others.</p>		
<p>EU 12995833</p>		<p>Class 36: Providing credit card, debit card and other payment method purchase protection services in the field of online trading of goods and services by others via a global computer network.</p> <p>Class 42: Design and development of computer software, software applications, and application programming interfaces;</p>	<p>13/06/14</p>	<p>30/10/14</p>

		<p>providing temporary use of on-line, non-downloadable computer software and software development tools for use in developing further software and software applications in the field of e-commerce; providing temporary use of online, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network; maintenance and updating of computer software for others.</p>		
--	--	--	--	--

6. The opponent claims that:

- The contested mark naturally breaks down into GAMERS and BAY;
- GAMERS prefix is low in distinctiveness in relation to services connected with computer gaming and, therefore, BAY is the most distinctive element of the contested mark;
- BAY is a distinctive element of EBAY;
- The contested mark is therefore similar to the earlier marks;
- The distinctive character of EBAY has been enhanced to a high level through extensive use in the UK and EU;
- The respective goods are identical or similar;
- There is a likelihood of confusion on the part of the public, particularly through the likelihood of association;
- EU 1029198 has a substantial reputation in the EU in relation to *advertising services, on-line trading services* and use of the contested mark would, without due cause, take unfair advantage of the reputation of the earlier mark.

7. In light of the above, the opponent claims that registration of the contested mark would be contrary to ss.5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”), which are as follows.

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

*(a) -*

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

*“3) A trade mark which-*

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

8. The opponent also initially objected that registration of the contested mark would be contrary to s.5(4)(a) of the Act on the basis of its earlier unregistered rights in EBAY. However, by the time of the hearing described below the opponent (rightly) accepted that this added nothing to its case under ss.5(2)/5(3). Consequently, there is no need for me to say any more about this aspect of the opponent’s original case. Similarly, the opponent initially objected that use of the contested mark would be detrimental to the reputation and/or distinctive character of EBAY. However, at the hearing, the opponent was content to base its s.5(3) case solely on the contested mark taking unfair advantage of the earlier EBAY mark. There is therefore no need for me to deal with any other aspect of the original s.5(3) case either.

9. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof that:

- BAY is distinctive of the opponent’s services;

- EBAY has been put to extensive use and acquired a reputation, as claimed.

10. Additionally, as four of the five earlier trade marks on which the opponent relies had been registered for more than 5 years by the relevant date, the opponent was called upon to provide proof of use of those marks in the period 12<sup>th</sup> October 2013 to 11<sup>th</sup> October 2018 (“the relevant period”). This is in accordance with s.6A of the Act which states as follows:

*“(1) This section applies where*

- (a) an application for registration of a trade mark has been published,*
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and*
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period .*

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

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

*(3) The use conditions are met if –*

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or*
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.*



*(4) For these purposes -*

*(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and*

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

*(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.*

*(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.*

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

11. The opponent’s fifth earlier mark (EU 12995833) is not subject to proof of use because it had been registered for less than 5 years at the relevant date.

## **Representation**

12. The applicant was originally represented by a firm of UK trade mark attorneys. However, by the time the applicant filed its evidence on 3<sup>rd</sup> September 2019 it was

no longer represented by trade mark attorneys. At a hearing held on 23<sup>rd</sup> December 2019, the applicant was represented by Ms Mariia Feigina, who works for the applicant. Ms Feigina appeared via a video link to the applicant's office in Malta. Mr Christopher Hall appeared as counsel for the opponent, instructed by Cameron McKenna Nabarro Olswang LLP.

### **The correct approach in opposition proceedings**

13. As the applicant is not represented by trade mark lawyers, I endeavoured at the hearing to explain the correct approach in law to the matters before me. However, I am not sure that the applicant's representative fully appreciated that applying the correct legal tests meant that many of the points she made on behalf of the applicant were irrelevant. Therefore, before turning to the evidence (and the applicant's application to file additional evidence), I will explain some of the matters I am required to take into account, or to exclude, in my assessment of the likelihood of confusion and/or whether the contested mark would take unfair advantage of the EBAY mark.

### The scope of protection of the earlier marks

14. It is necessary to consider the earlier marks to have been used in relation to all the goods/services covered by the registered specification or, if a new specification has been arrived at as a result of a challenge to the use of the earlier mark, that specification. In *Roger Maier and Another v ASOS*<sup>2</sup>, Kitchen L.J. described the required approach like this:

*"78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in Canon at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used*

---

<sup>2</sup> [2015] EWCA Civ 220

*at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”*

15. This means that the opponent is entitled to rely on earlier mark EU 12995833, which is not subject to proof of use, in relation to, for example, *providing credit card, debit card and other payment method purchase protection services in the field of online trading of goods and services by others via a global computer network* in class 36. The fact that there is no evidence of any use of this mark makes no difference. I must assess the likelihood of confusion as though the earlier mark is in “*normal and fair*” use in relation to any and all of the services for which it is registered (to the extent that the opponent relies on those services). The same applies to any descriptions of services covered by the other four earlier marks which are subject to proof of use, where the opponent’s evidence shows that there was genuine use of the marks in relation to those categories of services during the relevant period.

#### The lack of relevance of the opponent’s marketing strategy

16. Matters extraneous to the earlier mark itself are not to be taken into account. So, for example, the fact that the opponent currently trades via its various ebay websites is not relevant. As the Court of Justice of the European Union (“CJEU”) explained in *Devinlec Développement Innovation Leclerc SA v OHIM*<sup>3</sup>:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

---

<sup>3</sup> Case C-171/06P

## The lack of relevancy of the applicant's marketing strategy

17. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*<sup>4</sup> the CJEU stated that when assessing the likelihood of confusion it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. So the fact that the contested mark is currently only used via the applicant's website is also irrelevant.

18. Further, the application must be assessed in relation to all the services described in it, not just those services currently provided by the applicant. So, for example, I must assess the consequences of use of the contested mark in relation to *hosting of e-commerce platforms on the internet*, which covers hosting platforms offering buyers and sellers the opportunity of trading in any goods/services. Further, the fact that the applicant's existing website has particular features which enable computer gamers to purchase add-ons and tools for use in such games from other gamers, cannot limit the scope of my assessment to just this specific use of the contested mark. Similarly, the look and feel of the applicant's website, and any contrast between this and the look and feel of the ebay website, cannot be relied upon as factors which militate against a likelihood of confusion. On the other hand, unless the applicant contends otherwise (which it does not), or the evidence shows something different (which it does not), the applicant's existing use of the contested mark in relation to services in classes 36, 38 & 42 for computer gamers can be regarded as an example of normal and fair use of the mark<sup>5</sup>.

### **The opponent's evidence**

19. The opponent's evidence consists of a witness statement dated 8<sup>th</sup> July 2019 by Ms Amber Leavitt, the Senior Director, Global IP, at eBay Inc. By the time of the hearing, the applicant accepted that the EBAY marks have a substantial reputation in the UK/EU. I have read all the evidence. However, given the applicant's concession it is not necessary to go into very much of the opponent's evidence about the scale

---

<sup>4</sup> Case C-533/06, at paragraph 66 of the judgment

<sup>5</sup> *Premier Brands v Typhoon* [2000] FSR 767; *Open Country* [2000] RPC 477 CA

of EBAY's reputation. I will, however, cover this briefly and also examine what the reputation is for.

20. The opponent operates online marketplaces under the sign EBAY. It first started trading via its UK ebay website in 1996. It also has dedicated ebay websites for Austria, France, Germany, Ireland, Italy, the Netherlands, Poland and Spain. Ms Leavitt says that the goods and services advertised on the sites range from antiques and art, to crafts, toys, clothing, furniture, consumer electronics, courier services, and website design services. She points out that EBAY is also a marketplace through which 'gamers' buy and sell a wide range of products, including 'in-game' products. I understand that these are typically tools that gamers use to go further and be more successful in e-games, e.g. a magic sword. Usually these have to be earned through achievements in the game, but in some games they can also be 'unlocked' through a code. This has created a market for 'in-game' products. Exhibit AL-02 provides some examples, including some examples from the US ebay website in which sellers offer various in-game tools for use in a game called World of Warcraft. A search for 'gamers' on the opponent's UK website in June 2019 returned 29,650 hits, although most (if not all) of these were for games and gaming equipment rather than in-game products.

21. Ms Leavitt explains that by registering an eBay user can act as either a purchaser or seller (and advertiser) of goods using eBay's online marketplace websites. Being a seller requires a user to maintain a more active profile on eBay's websites. This type of involvement includes creating listings (or advertisements) for products/services on eBay, photographing or describing items available for purchase, maintaining a positive seller's profile on eBay in order to attract purchasers to its products, communicating with potential buyers regarding products, and eventually shipping products to purchasers who may be located anywhere in the world. Sellers may be individuals or businesses who set up virtual 'shop fronts' on ebay.

22. Registered users also have access to eBay's online features such as the ability to monitor bids and prices of selected goods, a watch service for hard-to-find goods, maintaining virtual storefronts for the sale of products, as well as accessing online

community resources such as chat rooms, discussion boards, and training tools for advertising, selling and purchasing goods on eBay. eBay's users also benefit from payment protection which means that they can trade on eBay's platform without being exposed to serious risk of losing money.

23. In 2017, there were over 25 million users of the UK ebay website who made 500 million transactions via the website resulting in the sale of over \$14 billion worth of goods. That year, the opponent spent more than \$150m advertising and promoting its UK business. In February 2018, ebay.co.uk was the 9<sup>th</sup> most visited website in the UK.

24. The opponent relies on the evidence of use of EBAY in relation to its core services to show genuine use of the EBAY marks in relation to *advertising services* and *on-line trading services* in class 35.

25. As regards the services in class 36 relied on, Ms Leavitt says that:

*“24. Since as early as 2010, eBay has offered a payment protection service as part of its offering. This service is a fundamental aspect of our platform and is a key reason why our customers trust our platform as the place to buy and sell goods. The purchase protection service protects both buyers and sellers from losing money in certain circumstances. Buyers are protected from sending money to sellers and not receiving their items or receiving faulty items and the seller will not accept a refund. Sellers are protected from fraudulent returns and false claims by buyers.*

*25. Attached as Exhibit AL-07 are print outs dated before the Application Date showing the use of the EBAY mark in relation to the provision of the above financial services. The services described above have been offered since as early as April 2010 in the UK and were provided throughout the entire five-year period prior to the Application Date.”*

26. As regards the services in class 38 relied on, Ms Leavitt says that:

*“(a) Since as early as 1999, when the platform was first launched in the UK, there has existed a communication service built into the eBay platform which allows users to communicate with each other without it being necessary to disclose private email addresses and other contact information between users. Customers use the service by clicking on the "Contact Seller" button within each listing. The customer can then send a secure message to the seller which will appear in the messages section of his private "My eBay" area. A copy of the message is also sent by eBay to the user's email account.*

*(b) eBay Community (see <https://community.ebay.co.uk/>). This community platform, available since as early as September 2010, consists of a number of forums and online discussion boards on which eBay members can discuss a range of topics, share knowledge and receive news about eBay products and services. eBay provides the platform on which the information and data is shared between members.*

*(c) eBay Radio (see <https://community.ebay.com/t5/eBay-Radio/gp-p/g-232>). This is an online radio show for and about selling and growing a business on eBay, which was first available as early as 2012. The service is a communication by radio service. The radio show is hosted on eBay's main website at [www.ebay.com](http://www.ebay.com), but it is available to and is accessed by customers in the UK.”*

27. Examples of such services are provided in exhibit AL-08.

28. As regards the services in class 42 relied on, Ms Leavitt says that:

*“eBay has been providing the class 42 service of an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network since the very beginning of the launch of its business. This service goes to the essence of what the eBay platform is all about. The same is true of the service of providing temporary use of on line, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network. Therefore all of the evidence submitted with this witness statement is evidence of the use of the eBay Marks for these services. The [www.ebay.co.uk](http://www.ebay.co.uk) website*

*provides users with temporary use of eBay's e-commerce software to allow them to conduct electronic transactions on eBay's online marketplace via a global computer network. The eBay Website provides an online, interactive bulletin board on which users post and promote their items and services for sale. Further, eBay developed its mobile application as least as early as 2008, which was made available in the UK the same year, and which eBay has updated and maintained throughout the entire five-year period prior to the Application Date.”*

29. Examples of such services are provided in exhibit AL-09.

30. Ms Leavitt also provides screenshots from the applicant's website which show that the applicant refers to itself as “*a freelance marketplace of gaming services.*”

#### Proof of use of earlier marks

31. In *Walton International Ltd & Anor v Verweij Fashion BV*<sup>6</sup>, Arnold J. summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*

---

<sup>6</sup> [2018] EWHC 1608 (Ch)



[EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

32. The burden is on the opponent to show what use it has made of the earlier marks which are subject to proof of use<sup>7</sup>.

33. There is no dispute that the opponent has provided an online marketplace under the EBAY mark through which goods are bought and sold. The opponent says that this justifies protection of EU1029198 in relation to *online trading services*. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*<sup>8</sup>, Mr Justice Carr summed up the law relating to partial revocation as follows.

*“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; Thomas Pink Ltd v Victoria's Secret UK Ltd [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].*

*iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; Thomas Pink at [53].*

*v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in Pan World Brands v Tripp Ltd (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; Thomas Pink at [53].*

*vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot*

---

<sup>7</sup> Section 100 of the Act.

<sup>8</sup> [2016] EWHC 3103 (Ch)

*reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. Maier v Asos Plc [2015] EWCA Civ 220 ("Asos") at [56] and [60].*

*vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46."*

#### *Class 35*

34. I find that *online trading services* is a very wide description which covers categories of services that are not provided under the EBAY mark. For example, it could cover retail services where EBAY itself is the seller. In my view, an average consumer would describe the core element of EBAY's services as *provision of an online marketplace for the buying and selling of goods*. I find that this is a fair description of this aspect of the opponent's services and falls within the wider category of *online trading services*.

35. As regards *advertising services*, Mr Hall fairly accepted at the hearing that EBAY does not provide the services of an advertising agency: it does not devise advertising campaigns or provide bespoke marketing advice. It provides advertising space on its website, associated online tools to help its users to advertise their goods, and access to its databases for third parties to help them to advertise their goods/services. In my view, an average consumer would regard *provision of advertising space; provision of online tools for advertising purposes; access to databases for advertising purposes* as a fair description of such services.

36. Therefore, EU1029198 was put to genuine use during the relevant period, and is entitled to protection in class 35, in relation to *provision of an online marketplace for the buying and selling of goods; provision of advertising space; provision of online tools for advertising purposes; access to databases for advertising purposes.*

37. I find that UK2642722 is entitled to protection in relation to similar services in class 35. However, as the specification relied on in relation to UK2642722 is narrower than EU1029198, and UK2642722 is no more similar to the contested mark than EU1029198 (arguably it is a little less similar because of the multi-colour element of UK2642722), there is no point in assessing the case in class 35 based on UK2642722 any further.

#### *Class 36*

38. As regards UK2642722, Mr Leavitt gives evidence that EBAY has always provided payment purchase protection as part of its online marketplace services. Exhibit AL07 includes examples of the mark in use in relation to such services during the relevant period. Some of these show that the mark was used in the colours in which it is registered. It is true that there are no separate sales figures for use of the mark in relation to financial services. However, given the scale of the EBAY business, there is no doubt that these services were provided on a substantial scale. I therefore find that the opponent has established use of UK2642722 in relation to *providing purchase protection services in the field of on-line trading of goods by others via a global computer network* in class 36.

#### *Class 38*

39. As regards UK2221802 and UK2642722, Ms Leavitt gives evidence about the provision of communication services built into the eBay platform consisting of:

- (i) the means for users to communicate with each other without it being necessary to disclose private email addresses and other contact information between users;
- (ii) forums and online discussion boards.

40. Again, there are no separate figures for sales of these services. This is because the services are provided as part of eBay's online marketplace services. Exhibit AL-08 includes examples of the use EBAY (in black and white and in the colours in which UK 2642722 is registered) in relation to such services during the relevant period. Accordingly, there does not appear to be much doubt that such services were offered to eBay's UK users during the relevant period, and on a substantial scale.

41. As regards UK2221802, the opponent submits that a fair description of the services in class 38 shown in the evidence is *electronic transmission of data and information; providing telecommunications connections to data bases; electronic mail services*. I see no evidence that EBAY has been used in relation to *providing telecommunications connections to data bases* as a telecommunication service in class 38. Ms Leavitt mentions no such service in paragraph 22 of her witness statement. EBAY may allow its users access to its own databases, but that is not a telecommunications service within the ordinary meaning of that term. *Electronic transmission of data and information* is a wide term that covers many more categories of telecommunications services than the opponent provides under EBAY. In my view, an average consumer of EBAY's services would regard *electronic transmission of data and information; electronic mail services; all for e-commerce purposes* as a fair description of the services provided under UK2221802 in class 38.

42. As regards UK2642722, the opponent submits that *Telecommunications services, namely, the electronic transmission of data and information; electronic messaging; providing an online, interactive bulletin board for the transmission of messages among computer users concerning hobbies, collectibles, trading, and the sale of goods and services via a global computer network* is a fair description of the services provided under the mark in class 38. I accept this submission so far as it relates to *providing an online, interactive bulletin board for the transmission of messages among computer users concerning hobbies, collectibles, trading, and the sale of goods via a global computer network*. I find that *electronic transmission of data and information; electronic messaging* are wide terms covering more categories of telecommunications services than are provided under UK2642722. In my view, an average consumer of EBAY services would regard *electronic transmission of data and information; electronic messaging; all for e-commerce purposes* as a fair

description of the services in question. Therefore, I find that UK2642722 has been used in relation to *electronic transmission of data and information; electronic messaging; all for e-commerce purposes; providing an online, interactive bulletin board for the transmission of messages among computer users concerning hobbies, collectibles, trading, and the sale of goods via a global computer network* in class 38.

43. The opponent's claim to have used UK2221802 in relation to *radio broadcasting* is based on the eBay online radio service which Ms Leavitt says was introduced in 2012. The service is provided via the opponent's ebay.com website rather than its UK website. Ms Leavitt says that service is available to UK users and is accessed by them. However, she provides no evidence about the number or frequency of UK users of this online radio service.

44. In *Pammer v Reederei Karl Schlüter GmbH & Co. KG and Hotel Alpenhof GesmbH v Heller*<sup>9</sup>, the CJEU interpreted the national court as asking, in essence, *"on the basis of what criteria a trader whose activity is presented on its website or on that of an intermediary can be considered to be 'directing' its activity to the Member State of the consumer's domicile ... , and second, whether the fact that those sites can be consulted on the internet is sufficient for that activity to be regarded as such"*. The court held that it was not sufficient for this purpose that a website was accessible from the consumer's Member State. Rather, *"the trader must have manifested its intention to establish commercial relations with consumers from one or more other Member States, including that of the consumer's domicile"*. In making this assessment national courts must evaluate *"all clear expressions of the intention to solicit the custom of that state's customers"*. Such a clear expression could include actual mention of the fact that it is offering its services or goods *"in one or more Member States designated by name"* or payments to *"the operator of a search engine in order to facilitate access to the trader's site by consumers domiciled in various member states"*. Finally, the court concluded:

*"The following matters, the list of which is not exhaustive, are capable of constituting evidence from which it may be concluded that the trader's activity*

---

<sup>9</sup> Joined Cases C-585/08 and C-144/09

*is directed to the Member State of the consumer's domicile, namely the international nature of the activity, mention of itineraries from other Member States for going to the place where the trader is established, use of a language or a currency other than the language or currency generally used in the Member State in which the trader is established with the possibility of making and confirming the reservation in that other language, mention of telephone numbers with an international code, outlay of expenditure on an internet referencing service in order to facilitate access to the trader's site or that of its intermediary by consumers domiciled in other Member States, use of a top-level domain name other than that of the Member State in which the trader is established, and mention of an international clientele composed of customers domiciled in various Member States. It is for the national courts to ascertain whether such evidence exists."*

45. The CJEU adopted a broadly similar approach in *L'Oreal v eBay*<sup>10</sup>, when asked whether goods bearing a trade mark and offered for sale on an online marketplace were being offered for sale in a particular territory. Therefore use of a mark on the internet does not count as use in the UK (or the EU) unless it is targeted in some way at UK (or EU) consumers.

46. In my view, the opponent has not done enough to show that the online radio service provided via its ebay.com website was targeted, even in part, at UK users of EBAY. This is because of the paucity of specific information about the service or its users, combined with the fact that the opponent plainly operates its UK business via its UK (not .com) website. Additionally, the opponent has not provided evidence which explains why, if its online radio service was partly targeted at UK users, it was not made available on (or promoted via) the ebay.co.uk website. Consequently, I find that there is no evidence of use of UK2221802 in the UK in relation to radio broadcasting services.

---

<sup>10</sup> Case C-324/09



## Class 42

47. As regards EU825802, the opponent submits that *providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network* is the core of the services provided under EBAY. I accept that submission.

48. The opponent also contends that the evidence shows use of EBAY in relation to *the collection and dissemination of statistical, quantitative and qualitative information regarding the sale and resale of items via a global computer network*. Ms Leavitt does not specifically identify any services of this description. She mentions a mobile application that has been available in the UK since 2008, but she does not explain what this does or which descriptions of registered services it is said to support. The mobile application appears to be downloadable software rather than an information service. As the onus is on the opponent to show what use has been made of EU825802, I find that it has not shown use of EBAY in relation to the services mentioned at the beginning of this paragraph.

49. As regards UK2642722, the opponent claims that the evidence shows use of that mark in relation to *providing temporary use of online, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network*. Ms Leavitt says that the ebay.co.uk website provides users with temporary use of eBay's e-commerce software to allow them to conduct electronic business transactions in online marketplaces. I accept this evidence. The mark registered under UK2642722 appears prominently on the ebay.co.uk website. I therefore accept that there was use of this mark, during the relevant period, in relation to the services mentioned above.

50. It is clear from exhibit AL-09 that during the relevant period the opponent also provided an application programming interface ("API") which allows users to link their listings of goods on their own websites with their listings on ebay and, for example, update stock levels on both websites. Further, EBAY also provides software that allows users to build links to EBAY on their own websites in order to drive enquiries to the EBAY website. The relevant pages on the ebay.co.uk website relating to these

offerings show use of the EBAY mark, including in the form in which it is registered under UK2642722, during the relevant period<sup>11</sup>.

51. The opponent submits that this use of the mark justifies its protection in relation to:

*Design and development of computer software, software applications, and application programming interfaces, all in the context of advertising and e-commerce; providing temporary use of on-line, non-downloadable computer software and software development tools for use in developing further software and software applications in the field of e-commerce; providing temporary use of online, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network; maintenance and updating of computer software for others.*

52. In my view, *design and development of computer software, software applications, and application programming interfaces, all in the context of advertising and e-commerce* and *providing temporary use of on-line software development tools for use in developing further software and software applications in the field of e-commerce* cover more categories of services than the use shown. For example, *design and development of computer software* is a very broad description covering the design and development of many types of computer software. The suggested addition of *all in the context of advertising and e-commerce* is too vague and unclear to be an acceptable form of limitation. In any event, it is unlikely to be sufficient for the amended description of services to represent a fair description of the types of services actually provided under the mark from the perspective of the relevant average consumer. The same applies to *providing temporary use of on-line, non-downloadable computer software and software development tools for use in developing further software and software applications in the field of e-commerce*.

53. There is no specific evidence that the opponent provides *maintenance and updating of computer software* under UK2642722 as a service “for others.”

---

<sup>11</sup> See pages 2 and 14 of exhibit AL-09

54. In my view, an average consumer would regard the following as a fair description of the use shown of UK2642722 in class 42.

*Design and development of computer software, software applications, and application programming interfaces, all for use in conjunction with websites hosting online marketplaces; providing temporary use of on-line, non-downloadable computer software and software development tools for use in developing further software and software applications for use in conjunction with websites hosting online marketplaces; providing temporary use of online, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network.*

55. The applicant has not argued that the use shown of the earlier marks in relation to services in classes 36, 38 and 42 is not genuine because the services are not specifically charged for. Nevertheless, I have asked myself whether the provision of these services under the marks is in accordance with the commercial *raison d'être* of the marks, which is to create or preserve an outlet for the goods or services that bear those marks, or whether the use is analogous with the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter, as in *Silberquelle*.

56. The fact that the services are not charged for separately is not decisive. The same can be said of *retail services*, for which the CJEU has held that trade marks are registrable<sup>12</sup>. A similar approach was taken by the CJEU in *Antartica Srl v OHIM, The Nasdaq Stock Market, Inc.*<sup>13</sup>. The court dismissed a complaint by an appellant that there was no genuine use of an earlier mark because certain services provided under it were not charged. The court stated that:

*“29. It is sufficient to note in that respect that, even if part of the services for which the earlier mark is registered are offered by The Nasdaq Stock Market free of charge, that does not of itself mean that that commercial company will*

---

<sup>12</sup> See *Praktiker Bau*, Case C-418/02

<sup>13</sup> Case C-320/07P

*not seek, by such use of its trade mark, to create or maintain an outlet for those services in the Community, as against the services of other undertakings.”*

57. The opponent’s services in classes 36, 38 and 42 are certainly ancillary to its core services in class 35, but they are mostly part and parcel of the same commercial offering. The use of the earlier marks is intended to generate a market for these services, as well as for the opponent’s core online marketplace services in class 35. The use of the marks is therefore distinguishable from the distribution of promotional items as a reward for the purchase of other goods, as in *Silberquelle*. Therefore, taking all the relevant criteria into account, I find that the use shown of the earlier marks in relation to services in classes 36, 38 and 42, is genuine use.

58. This means that the earlier marks which are subject to proof of use are entitled to protection for the goods/services shown in the following table.

<b>Trade mark</b>	<b>Services for which the trade marks are entitled to protection on the basis of the use shown during the relevant period</b>
EU1029198	<i>Class 35: Provision of an online marketplace for the buying and selling of goods; provision of advertising space; provision of online tools for advertising purposes; access to databases for advertising purposes.</i>
UK2642722	<i>Class 36: Providing purchase protection services in the field of on-line trading of goods by others via a global computer network. Class 38: Electronic transmission of data and information; electronic messaging; all for e-commerce purposes; providing an online, interactive bulletin board for the transmission of messages among computer users concerning hobbies, collectibles, trading, and the sale of goods via a global computer network. Class 42: Design and development of computer software, software applications, and application programming interfaces, all for use in conjunction with websites hosting online marketplaces; providing temporary use of on-line, non-downloadable computer software and software development tools for use in developing further software and software applications for use in conjunction with websites hosting online marketplaces; providing temporary use of online, non-downloadable e-commerce software to allow</i>

	<i>users to conduct electronic business transactions in online marketplaces via a global computer network.</i>
UK2221802	<i>Class 38: Electronic transmission of data and information; electronic mail services; all for e-commerce purposes.</i>
EU825802	<i>Class 42: Providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network.</i>

### **The Applicant's evidence**

59. The applicant's evidence consists of a witness statement dated 3<sup>rd</sup> September 2019 by Mariia Feigina (with 3 exhibits). Ms Feigina says that the facts in her witness statement come from her personal knowledge or from the applicant's records.

60. Ms Feigina says that the applicant operates an "*online freelance marketplace of gaming services*" located at gamersbay.com. The service operates by connecting those wishing to buy digital content for use in playing games (which the applicant calls 'customers') with those wishing to sell such content (which the applicant calls 'boosters'). Customers and boosters pay the applicant a commission on digital content bought and sold via the applicant's website.

61. The applicant's main markets are the USA, UK and EU. At the date of Ms Feigina's statement, the applicant had 2530 UK users and over 78k users worldwide.

62. Ms Feigina's statement includes a number of arguments about the lack of similarity between the marks and differences between the services actually provided by the parties under their marks. To the extent that these are relevant as a matter of law, I will return to them below. However, I note the following evidence about the meaning of the -BAY element of the applicant's mark.

*"The word that is common to the parties' marks (BAY) has a number of well-known meanings, the most obvious ones being a body of water partially enclosed by land but giving access to the sea, or a storage area, such as a loading bay, or short for bay window.*

*The "BAY" element in the Gamersbay sign means a body of water partially enclosed by land but giving access to the sea or an open, curving indentation made by the sea or a lake into a coastline.*

*"Gamersbay" has a suggestive meaning in connection with Mattias Industry LP's services. In fact, "Gamers bay" is a name which means a place (curving indentation made by the sea or a lake into a coastline) for playing games, or game place."*

63. Exhibit 3 to Ms Feigina's statement consists of the results of an 'internal survey' the applicant conducted amongst its own employees as to whether the actual services provided by the applicant are similar to those provided by EBAY. It is not clear how many people were included, but 100% are recorded as saying 'no'. For the reasons given above, the question asked in this survey is irrelevant to the legal assessment I am required to undertake. In any event, the applicant's employees are hardly likely to be representative of average consumers of the parties' actual services, let alone the wider descriptions of services covered by their registrations and application. This survey is therefore irrelevant. The applicant may have recognised that it was unlikely to assist its case because Ms Feigina mentioned in passing (in the body of her witness statement) that the applicant was conducting a survey of its users to establish the likelihood of confusion with EBAY. However, no application was made at that time for an extension of time to file such additional evidence.

64. The opponent decided not to file evidence in reply to the applicant's evidence. The parties were therefore told, on 24<sup>th</sup> September 2019, that the evidence rounds were closed. They were given the opportunity of requesting a hearing. On 3<sup>rd</sup> October 2019, the opponent requested a hearing. The hearing was initially listed for 20<sup>th</sup> November 2019. However, the opponent requested a postponement, to which the applicant agreed. The hearing was therefore re-appointed for 23<sup>rd</sup> December 2019.

## **Applicant's application to file additional evidence**

65. On 22<sup>nd</sup> October 2019, the applicant enquired whether it was possible to file 'written submissions', if the applicant also intended to take part in the hearing. The procedure for filing skeleton arguments was explained to the applicant. Following further email communications it became clear, on 27<sup>th</sup> November 2019, that the applicant in fact wished to file additional evidence in the form of an online survey of its users about the likelihood of confusion between the parties' trade marks. In accordance with Rule 20(4) of the Trade Mark Rules 2008, the applicant was advised (on the same day) that additional evidence could only be filed with the leave of the registrar, and that a specific application was necessary to obtain such leave. The applicant responded by email later the same day, saying on the one hand, that it did not wish to file additional evidence but, on the other hand, it wished to file the survey evidence mentioned in its email and in Ms Feigina's existing witness statement.

66. The registrar responded on 29<sup>th</sup> November stating that:

*"The applicant appears to be requesting to file additional evidence in the form of the results of a survey. The Tribunal has issued a Practice Notice stating that survey evidence should not be filed without prior agreement from the registrar about the size, target respondents, locations, and questions for the survey. This is because survey evidence has often been found to be flawed and/or irrelevant to the relevant legal test(s). The registrar must therefore give a provisional 'no' to the applicant's request. However, if the applicant wishes to persist with its request to file additional survey evidence it should present it ASAP and explain (a) why the evidence was not filed with the applicant's existing evidence, (b) why the applicant thinks it is relevant to the opposition, (c) who conducted the survey, (d) who was sent questions, (e) how the respondents were selected, (f) where the respondents were located, (g) how many people were questioned, (h) how many responded, (i) what those people were shown or sent, (j) the questions they were they asked, (k) how their answers were recorded."*

67. On 11<sup>th</sup> December 2019 the applicant made a request to file additional evidence in the form of a second witness statement by Ms Feigina with 9 exhibits. Four of these exhibits set out the results of the survey of its users foreshadowed in the applicant's previous communications. Four of the other 5 exhibits were intended to illustrate 'real world' differences between the way that EBAY is used and run and the way that the applicant's online marketplace is used and run. The ninth exhibit supported additional evidence from Ms Feigina about the applicant's choice of trade mark. In particular, Ms Feigina stated that:

*"The name of GAMERSBAY mark and, accordingly, the name of GAMERSBAY Web Platform correspond to the title of the video games tournament and technology convention found in 2016 - Gamers Bay (Attached and marked Exhibit 9). The Applicant's choice of similar name was justified by the fact that the said convention has always been extremely popular in gaming community and gathered many Applicant's potential consumers. Therefore, usage of element "BAY" in the name of Mattias Industry LP's trademark, along with usage of its actual lexical meaning ("harbor", "gulf), is aimed at engaging its target audience (which, as stated before, does not match with the Opponent's average consumers) and is not related initially to EBAY mark."*

68. It appears from exhibit 9 to her second statement that GAMERS BAY is the name of a video game and technology convention held in the Cayman Islands since 2016.

69. As to the applicant's reasons for filing additional evidence after the evidence rounds had closed, the applicant's request explained that it had not been possible to set up and conduct the online survey by the time the applicant's evidence was due on 9<sup>th</sup> September 2019. No explanation was provided for the delay in filing evidence about the parties' businesses or the applicant's choice of trade mark.

70. As regards the applicant's user survey, it explained that:



- The survey results were meant to be representative of the average consumer of its services;
- The survey was conducted by the applicant;
- The questions were sent to registered users of the applicant's gamersbay.com website located in the UK or EU;
- The questions were sent via email or pop-up boxes on the website;
- 22676 users were invited to participate;
- 101 users did so;
- The questions sent to users were sent under a header entitled "*We need your vote!*";
- The questions asked were "*Do you visit Gamersbay's platform as a result of any association with eBay brand?*" and "*When visiting Gamersbay's platform, do you receive an impression that the Gamersbay is a marketplace for sale of tangible goods, their shipping and delivery?*"

71. Due to the proximity between the applicant's request to file additional evidence and the scheduled hearing date, the applicant's request had to be considered as a preliminary matter at the hearing on 23<sup>rd</sup> December 2019.

72. The opponent objected to the admission of the applicant's additional evidence, primarily on the grounds that it was irrelevant and/or of no evidential value. In this connection, my attention was drawn to the guidance given by Carr J. in *Property Renaissance Ltd v Stanley Dock Hotel and Others*<sup>14</sup> which directs attention to:

- (i) The materiality of the evidence to the issues to be determined;
- (ii) The justice and fairness of subjecting the opposite party to the burden of the evidence at the stage that the registry proceedings had reached, including the reasons why the evidence was not filed earlier;
- (iii) Whether the admission of the further evidence would prejudice the opposite party in ways that could not be compensated for in costs (e.g. excessive delays); and

---

<sup>14</sup> [2016] EWHC 3103 (Ch)

- (iv) The fairness to the applicant of excluding the evidence, including prejudice to the applicant if it was unable to rely on it.

74. Tribunal Practice Notice 2/2012 requires those wishing to file survey evidence to seek directions before doing so. The survey evidence filed in this case illustrates why this is necessary. I need go no further than the following. Firstly, as the applicant has applied to register its mark in the UK, the views of average UK consumers are paramount. However, only 4 UK users responded to the survey: far too few to be representative of the relevant UK public. Secondly, the target audience was artificially narrowed by the decision to invite only existing users of the applicant's services to participate. Thirdly, the way the responses were obtained, (i) by the applicant itself, and (ii) under a communication headed "*We need your vote!*", was manifestly intended (and likely) to skew the results in the applicant's favour. Fourthly, the questions are flawed. The first question does not test whether respondents made any association between the contested mark and EBAY, only whether any such association was the reason for visiting the applicant's website. So, for example, the responses may not capture instances where respondents associated the contested mark with EBAY, but only after they had visited the applicant's website. The second question is irrelevant because it is limited to 'real world' differences which are not reflected in the descriptions of services for which the earlier marks are entitled to protection, or in the applicant's specification of services.

75. The survey evidence is therefore of no material value as evidence and must be rejected for this reason alone, without it being necessary to examine the merits of the applicant's explanation for the late filing of this evidence.

76. No explanation has been provided for the late filing of the remainder of the evidence contained in Ms Feigina's second witness statement. There does not appear to be any reason why it could not have been included in her first statement.

77. The evidence setting out 'real world' differences in the way the parties operate is irrelevant for the reasons explained above.

78. The evidence about the applicant's choice of trade mark could be relevant to the opponent's claim that use of the contested mark would take unfair advantage of EBAY's reputation. This is because an intention to take unfair advantage of EBAY is a factor that can be considered in deciding whether any advantage that would be gained is unfair. However, I do not consider that Ms Feigina's evidence on this point is likely to be of assistance for four reasons. Firstly, although Ms Feigina says that the decision to adopt the contested mark "*was justified by the fact that the said convention has always been extremely popular in gaming community and gathered many Applicant's potential consumers*" (emphasis added), she does not specifically say that this was the reason why the contested mark was chosen. Secondly, Ms Feigina does not say that she was involved in choosing the contested mark; nor has she provided documents from the applicant's records recording the reasons for the choice of trade mark. Thirdly, if Ms Feigina is really in a position to give evidence that the name of a gaming tournament in the Cayman Islands was the reason (or, at least, a reason) why the contested mark was chosen, she does not explain why she did not mention this in her first statement. Fourthly, Ms Feigina's first statement included an argument that average consumers would understand the word GAMERS in GAMERSBAY as referring to the users of computer games, and the BAY element as describing a natural feature of coastline. That argument does not sit easily with the evidence in her second statement that gamers would recognise the word GAMERSBAY as being based on the name of a gaming tournament which has taken place in the Cayman Islands since 2016. Therefore, Ms Feigina's additional evidence about the applicant's choice of trade mark raises more questions than it answers. Consequently, it appears unlikely to be important evidence. Further, it would be unfair to admit the additional evidence without giving the opponent a chance to ask to cross examine Ms Feigina on it. Given the timing of the request to file additional evidence, that may have required an adjournment of the hearing, or the opponent to forego making such a justifiable request in order to avoid an adjournment and further delay.

79. Taking all of the above points into account, I decided at the hearing to refuse the applicant's request to file additional evidence. Consequently, I will not take the contents of Ms Feigina's second statement into account.

**The s.5(2)(b) ground – likelihood of confusion**

Identity/similarity of the services

80. I have set out on the left side of the following table the services covered by the opposed trade mark and, on the right, the services for which the earlier marks are entitled to protection. So far as the latter are concerned, I have limited these to the closest marks/services, i.e. the opponent’s best case.

<p>Class 36: Providing purchase protection services in the field of online trading of goods and services by others on the platform via a global computer network.</p> <p>Class 38: Telecommunications services, namely the electronic transmission of data and information; providing access to databases; communications by computer terminals; computer aided transmission of messages and images; providing internet chatrooms and internet forums; message sending; transmission of electronic mail; transmission of digital files; wireless broadcasting; providing access to internet chatrooms and electronic bulletin boards for transmission of messages between users; providing access to Internet platforms; sending electronic messages via websites; electronic transmission of data and documents; electronic transmission of data and documents between computer users; transmission of data and information via computers and electronic</p>	<p>EU1029198 Class 35: Provision of an online marketplace for the buying and selling of goods; provision of advertising space; provision of online tools for advertising purposes; access to databases for advertising purposes.</p> <p>EU12995833 Class 36: Providing credit card, debit card and other payment method purchase protection services in the field of online trading of goods by others via a global computer network.</p> <p>UK2642722 Class 38: Electronic transmission of data and information; electronic messaging; all for e-commerce purposes; providing an online, interactive bulletin board for the transmission of messages among computer users concerning hobbies, collectibles, trading, and the sale of goods via a global computer network.</p> <p>UK2221802 Class 38: Electronic transmission of data and information; electronic mail services; all for e-commerce purposes.</p>
---	---

communications; transmission of data and information via computers; transmission of data via computers; electronic transmission of documents; transmission of information and data via Internet; transmission of information and data via online services; providing access to electronic databases; providing access to electronic online networks for information search; sending and receiving of electronic messages; electronic transmission of data and documents via computer terminals and electronic devices. Provision of access to computer databases.

Class 42: Design and development of software; computer programming; maintenance services for computer software; provision of access to global information networks and other network systems; design and development of software applications and application programming interfaces; providing temporary use of on-line, non-downloadable computer software and software development tools for use in developing further software and software applications in the field of e-commerce; providing temporary use of online, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network; maintenance and updating of computer software for others; hosting platforms on the internet; hosting of e-commerce platforms on the internet; hosting of communication platforms on the internet; hosting websites.

EU12995833

Class 42: Design and development of computer software, software applications, and application programming interfaces; providing temporary use of on-line, non-downloadable computer software and software development tools for use in developing further software and software applications in the field of e-commerce; providing temporary use of online, non-downloadable e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network; maintenance and updating of computer software for others.

EU825802

Class 42: Providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network.

81. In *Gérard Meric v OHIM*<sup>15</sup>, the General Court stated that:

---

<sup>15</sup> Case T- 133/05

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

The same principle applies to comparisons of services.

82. Applying this guidance, I find that:

- The services covered by class 36 of the contested application are identical to the services in class 36 covered by EU12995833;
- The services covered by class 38 of the contested application are identical to the services in class 38 covered by UK2221802, except for *providing access to internet chatrooms and electronic bulletin boards for transmission of messages between users; providing access to Internet platforms; providing access to electronic databases; providing access to electronic online networks for information search; provision of access to computer databases;*
- The services shown in italics in the preceding bullet point are identical to the services in class 38 covered by UK2642722;
- The services covered by class 42 of the contested application are identical to the services in class 42 covered by EU12995833, except for *provision of access to global information networks and other network systems; hosting platforms on the internet; hosting of e-commerce platforms on the internet; hosting of communication platforms on the internet; hosting websites;*
- *Provision of access to global information networks and other network systems* in class 42 of the contested application is identical to *providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network* in class 42 of EU825802.

83. The CJEU provided guidance in *Canon*<sup>16</sup> about the factors to be considered in assessing the similarity of goods/services, as follows:

*“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”.*

84. In *Kurt Hesse v OHIM*<sup>17</sup> the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*<sup>18</sup> the General Court stated that “complementary” means:

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

85. Applying this guidance I find that the following services are similar to a low-to-medium degree to those for which EU1029198 (i.e. provision of an online marketplace etc.) is protected in class 35 because they are complementary services in the sense described in the case law:

- All the services covered by class 36 of the contested application;
- All the services covered by class 38 of the contested application, except for *wireless broadcasting*;
- All the services covered by class 42 of the contested application, except for *maintenance services for computer software; maintenance and updating of computer software for others*.

---

<sup>16</sup> Case C-39/97

<sup>17</sup> Case C-50/15 P

<sup>18</sup> Case T-325/06

86. This is because all of the services covered by the contested application which I have found to be complementary to the services covered by class 35 of EU1029198 are important for the use of *an online marketplace for the buying and selling of goods; provision of advertising space; provision of online tools for advertising purposes; access to databases for advertising purposes* and consumers may think that the responsibility for those services lies with the same undertaking.

87. Applying the same guidance, I find that *hosting platforms on the internet; hosting of e-commerce platforms on the internet; hosting of communication platforms on the internet; hosting websites* in class 42 of the contested application are similar to a medium degree to *providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network* for which EU825802 is protected in class 42. This is because the respective services involve the provision of the technical means of accessing e-commerce platforms on the internet.

#### The average consumer and the selection process

88. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*<sup>19</sup>.

89. The relevant average consumer is likely to be a member of the UK public using an online marketplace or the various technical services in classes 36, 38 or 42. It could also be a business using these services. In either case, I see no reason to believe that average consumers will pay an unusually high, or low, level of attention when selecting the services in question. I therefore find that average consumers will pay a normal level of attention when selecting the services at issue.

---

<sup>19</sup> CJEU, Case C-342/97



90. The services are likely to be selected primarily by eye, e.g. from advertisements on the internet. However, word-of-mouth recommendations may also play a part in the selection process, so the sound of the marks must also be considered.

#### The distinctive character of the earlier marks

91. The opponent points out that even though 'E' may be understood as a reference to 'electronic', and therefore has a relevant meaning in relation to e-commerce related services, the word BAY is likely to bring to mind a natural feature of coastline, which has no descriptive meaning in the context of the services at issue. According to the opponent, EBAY has a normal or medium level of inherent distinctive character, but has become highly distinctive through use.

92. I accept that the earlier marks have a medium level of inherent distinctive character.

93. The applicant accepts that EBAY is well known as an electronic marketplace.

94. Given the scale of the opponent's use of EBAY in relation to its core services, there is no doubt that EBAY (whether in black and white or colours) is highly distinctive in relation to the services for which it is registered in class 35. Additionally, I find that *providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network* in class 42 is so closely connected with EBAY's core services that the mark is also highly distinctive in relation to these services. The same applies to *providing purchase protection services in the field of on-line trading of goods by others via a global computer network* in class 36. Indeed, the provision of these services appears to be one of the key reasons identified in the evidence as to why EBAY has become so successful. I do not consider that the evidence establishes that EBAY has become highly distinctive through use in relation to the balance of the services covered by the earlier marks, e.g. transmission of data about e-commerce.

Comparison of the marks

95. The CJEU stated in *Bimbo SA v OHIM*<sup>20</sup> 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.”

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

96. The respective trade marks are shown below:

 <p>The image shows three variations of the eBay logo. At the top, the word 'EBAY' is written in a simple, black, sans-serif font. Below it, the word 'ebay' is written in its characteristic multi-colored font (e: red, b: blue, a: yellow, y: green). At the bottom, the word 'bay' is written in the same multi-colored font.</p>	 <p>The image shows the contested trade mark 'GamersbaY'. The word is written in a bold, dark blue, sans-serif font. The 'Y' is significantly larger and has a small upward-pointing arrow integrated into its top right stroke.</p>
Earlier trade marks	Contested trade mark

97. The first earlier mark is registered in standard upper-case letters, indicating that the mark consists of the word EBAY as such, rather than any particular form of presentation. Therefore, the use of upper/lower case letters in the contested mark makes no difference. Visually, I note that the contested mark is much longer than the

<sup>20</sup> Case C-591/12P, at paragraph 34 of the judgment

earlier EBAY mark (9 versus 4 letters). The prefixes are different: 'E-' versus 'Gamers-'. The contested mark also has a visual flourish added to the letter 'Y', however, it is not suggested that much weight should be attached to this as a distinguishing feature. I think this is right. The visual flourish borders on being negligible in impact. It does nothing to disguise the fact that the contested mark is GamersbaY.

98. I note that the suffix of the earlier mark is also -BAY. As a general rule, the prefixes of marks make more impact than the ends. However, the opponent submits that because neither E- nor Gamers- are distinctive in relation to the services at issue, the baY/BAY suffixes of the marks are the dominant and distinctive elements.

99. Ms Feigina accepted in her first witness statement that the 'E' in EBAY is likely to be understood as a reference to "*something electronic*" or "*indicating the involvement of the Internet*" and BAY is likely to be understood as referring to a natural feature of coastline. She also accepted that Gamers- is likely to be understood, at least in the context of the applicant's actual services, as describing the intended users of the services.

100. I therefore accept the opponent's submission that the baY/BAY suffixes are the most distinctive parts of the marks. This means that the suffixes of the marks are unlikely to be overlooked, or given less attention than the prefixes. The fact that both Gamers- and E- appear to qualify the -baY/BAY suffixes also makes unlikely that average consumers will focus primarily on the prefixes of the marks. However, this does not mean that the different prefixes, and the different overall lengths, of the marks will not assist consumers to distinguish them. Plainly they will. Therefore, comparing the marks as wholes, I find that they are visually similar to a low-to-medium degree.

101. The opponent submits that EBAY will be pronounced as EE-BAY. The applicant does not dispute this. The contested mark is likely to be pronounced as GAME-ERS-BAY. The start of the marks is therefore quite different to the ear, and the contested mark has an extra syllable compared to EBAY. The final syllable in both cases –

BAY - is the same. Comparing the marks as wholes, I find that they are aurally similar to a low-to-medium degree.

102. Although the Gamers- and E- prefixes are likely to be regarded as descriptive, the meaning of those elements is quite different. The inherent meaning of -baY/BAY is the same in both marks, i.e. a natural feature of coastline. This means that the marks as wholes convey the idea of a bay for gamers and an electronic bay, respectively. Therefore, the marks as wholes are conceptually different, but the concept of a bay is shared by both marks. In my view, this introduces a certain degree of conceptual similarity between the marks.

103. Turning to the comparison with earlier mark UK2642722 – ebay in colours – Mr Hall submitted that the colours were not something that I should give particular weight to. Although it is necessary to consider the effect of the use on the contested mark in any colour, I am doubtful that ‘normal and fair’ use of the mark would extend to using it in the same multi-colour get-up in which UK2642722 is registered. Consequently, it would not be appropriate to take account of the possible use of the contested mark in the same colour scheme as UK2642722.

104. Subject to one point, my findings about the similarity between EBAY and the contested mark apply equally to UK2642722. The difference is that the multiple colours in which UK2642722 is registered are not a feature of the contested mark. That difference must therefore be included in my assessment. However, the colour scheme is clearly a secondary element of UK2642722. The dominant and most distinctive element of the mark is the word ebay. Consequently, although the colour scheme slightly reduces the degree of visual similarity with the contested mark (compared to EBAY in one colour or no colour), I find that the degree of visual similarity is not materially different, i.e. UK2642722 is also visually similar to the contested mark to a low-to-medium degree.

105. Turning next to the comparison with EU12995833 (‘bay’ in three colours), I note that the contested mark is much longer than the earlier mark (9 versus 3 letters), but in the context of services aimed at players of computer games, the most distinctive element of the contested mark is the word BAY, which is also the dominant and most

distinctive element of the earlier mark. The presence of the Gamers- prefix in the contested mark, the absence of contrasting colours for the letters in which it is written, and the addition of a visual flourish on the letter 'Y', all help to distinguish the contested mark visually from EU12995833. On the other hand, the fact that EU12995833 has no E- prefix means that there is a little less to distinguish it from the contested mark (compared to EBAY). Overall, I find that the marks are visually similar to a medium degree.

106. As I noted earlier, the contested mark has three syllables. The earlier mark has only one, which is the same as the third syllable of the contested mark. In my view, the marks are aurally similar to a low-to-medium degree.

107. The inherent meaning of -baY/BAY is the same in both marks, i.e. a natural feature of coastline. This means that the marks as wholes convey the idea of a bay for gamers and a bay, respectively. Therefore, the marks as wholes are conceptually different, but the concept of a bay is shared by both marks. In my view, this means that there is a certain degree of conceptual similarity between the marks.

#### Global assessment

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

#### *The principles*

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

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

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

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

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

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

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

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

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

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

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

109. I find that the visual and aural differences between the parties' marks are sufficient to rule out a likelihood of direct confusion, i.e. consumers mistaking or misremembering the contested mark for one of the earlier marks. As I understand it, that is not really the opponent's case. The opponent's case (or at least its primary case) is that there is a likelihood of indirect confusion, or 'association' to use the language of s.5(2) of the Act.

110. In *L.A. Sugar Limited v By Back Beat Inc.*<sup>21</sup>, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

---

<sup>21</sup> Case BL O/375/10

111. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element: it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion<sup>22</sup>, which is what ‘association’ means in s.5(2) of the Act.

112. The question, therefore, is whether normal and fair use of the contested mark in relation to the services covered by the application is likely to cause average consumers of those services to believe that the contested mark is a development of the EBAY marks and used by the opponent, or with the opponent’s consent.

113. The opponent’s best case in relation to the application to register the contested mark for services in class 36 is based on EU12995833 (‘bay’ in colours). The respective services must be treated as identical: both are payment protection services for online trading. Although there is no evidence of use of EU12995833, and therefore no enhancement of the distinctive character of that mark, it is inherently distinctive to a medium degree. That distinctiveness resides in the word ‘bay’ (i.e. the common element with the contested mark). The payment protection services covered by the opposed application are specifically *in the field of online trading of goods and services by others*. This includes those trading in computer games, in relation to which the word Gamers- is non-distinctive. In these circumstances, I find that the common ‘bay’ element of the marks is likely to lead average consumers to believe that the payment protection services offered under the contested mark are a specific version of the general payment protection services for which EU12995833 is entitled to protection. Further, the similarity between the marks is likely to lead a significant proportion of average consumers to believe that the services are offered by the same undertaking, or by economically related undertakings<sup>23</sup>. There is a therefore a likelihood of confusion through association.

114. The opponent’s best case in relation to the application to register the contested mark for services in class 42 is also based on EU12995833. The respective services

---

<sup>22</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., also as the Appointed Person

<sup>23</sup> There is no single meaning rule. It is sufficient if a significant proportion of consumers are confused: see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch), Mann J.



are identical, except for *provision of access to global information networks and other network systems; hosting platforms on the internet; hosting of e-commerce platforms on the internet; hosting of communication platforms on the internet; hosting websites*. So far as identical services are concerned, I reach the same conclusion I reached in relation to the class 36 services, for the same reasons. In this case the Gamers- prefix of the contested mark is liable to be seen as descriptive of the users or purpose of the software services at issue.

115. So far as the application to register the contested mark in relation to *provision of access to global information networks and other network systems* is concerned, the opponent's best case is EU825802 (EBAY in standard characters). This mark is entitled to protection in relation to *providing an online, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network* in class 42, which I have found to cover identical services. The services for which this earlier mark is protected are also similar to a medium degree to *hosting platforms on the internet; hosting of e-commerce platforms on the internet; hosting of communication platforms on the internet; hosting websites*. The earlier mark is highly distinctive in relation to the services mentioned above because of the extensive use made of the mark in relation to these services. Therefore, although the earlier EBAY mark is a little less similar to the contested mark (compared to 'bay' in colours), I find that average consumers are likely to believe that the Gamers- prefix of the contested mark identifies a website or network specifically for gamers, whereas the 'E-' prefix of the earlier mark indicates the provision of online services for general e-commerce purposes. In these circumstances, I find that a significant proportion of average consumers are likely to regard the common -baY/BAY suffixes of the marks as denoting that the services at issue are offered by the same undertaking, or by economically related undertakings. There is therefore a likelihood of confusion through association.

116. Turning to the application to register the contested mark for services in class 38, the opponent's best case is based on UK2221802 and UK2642722. The services in class 38 of the opposed application are identical to the services covered by UK2221802, except for *providing access to internet chatrooms and electronic bulletin boards for transmission of messages between users; providing access to Internet*

*platforms; providing access to electronic databases; providing access to electronic online networks for information search; provision of access to computer databases.* These services are identical to the services in class 38 covered by UK2642722. The marks are visually and aurally similar to a low-to-medium degree. The distinctive character of the earlier marks has not been materially enhanced through use in relation to these services, but they have a medium degree of inherent distinctiveness. The most distinctive element of all the marks is the common word baY/BAY. In these circumstances, the Gamers- prefix of the contested mark is likely to be understood by average consumers as identifying the subject matter of the data being communicated, or the contents of the databases to which access is being provided. The 'E-' prefix of the earlier marks is likely to be understood as denoting the provision of services for general e-commerce purposes. In these circumstances, I find that a significant proportion of average consumers are likely to regard the common -baY/BAY suffixes of the marks as denoting that the services at issue are offered by the same undertaking, or by economically related undertakings. There is therefore a likelihood of confusion through association.

117. These findings are not undermined by the fact that there is no evidence of actual confusion as a result of the applicant's existing use of the contested mark in relation to an online marketplace in gaming services. As Kitchen L.J. (as he then was) stated in *Roger Maier and Another v ASOS*:

*"80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in Specsavers at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has*

*been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”*

118. It is clear from Ms Feigina’s evidence that the applicant has only operated on a limited scale in the UK to date. Further, the evidence shows use of the contested mark in relation to only a sub-set of the services included in the application. In any event, the absence of evidence of confusion does not necessarily mean that there has been no confusion. If consumers are satisfied with the service provided to them they are unlikely to complain, even if they realise that they were confused about the provider of the service. And if they are completely confused, they may not even realise that they are. Additionally, as I have already noted, earlier mark EU12995833 is entitled to protection against the likelihood of confusion in the provision of services in classes 36 and 42, even though there is no evidence of any use of that mark to date, and therefore no possibility of confusion. Accordingly, no weight can be given to the absence of evidence of confusion with EU12995833.

119. The above findings mean that the s.5(2)(b) ground of opposition succeeds. However, for the sake of completeness, and in case any of the above findings are wrong, I will also briefly consider the s.5(2)(b) ground based on EU1029198 (EBAY standard characters) in class 35. The services for which this mark is registered (i.e. provision of an online marketplace etc.) are complementary and similar to a low-to-medium degree to:

- All the services covered by class 36 of the contested application;
- All the services covered by class 38 of the contested application, except for *wireless broadcasting*;
- All the services covered by class 42 of the contested application, except for *maintenance services for computer software; maintenance and updating of computer software for others*.

120. As the services shown in italics in the previous paragraph are not similar to the services in class 35 for which EU1029198 is registered, the opposition under

s.5(2)(b) based on this mark cannot succeed in relation to these services. This is because some similarity of services is a prerequisite for the application of s.5(2)(b)<sup>24</sup>.

121. The EBAY mark is highly distinctive through use in relation to the services in class 35 for which EU1029198 is entitled to protection. This increases the likelihood of confusion, including the likelihood of confusion through association.

122. In my view, it is likely that a significant proportion of average consumers will:

- Believe that similar services offered under the contested mark are complementary services to *an online marketplace for the buying and selling of goods; provision of advertising space; provision of online tools for advertising purposes; access to databases for advertising purposes* and that the same undertaking could be responsible for those services;
- Wrongly assume that the contested mark is a development of the EBAY mark, targeted specifically on services for computer gamers;
- Be confused into thinking that the users of the contested mark and EBAY are the same or economically related undertakings.

123. It follows that the opposition under s.5(2)(b) based on EU1029198 succeeds, except in relation to *wireless broadcasting* in class 38 and *maintenance services for computer software; maintenance and updating of computer software for others* in class 42.

124. However, as the opposition under s.5(2)(b) based on EU12995833, UK2221802, UK2642722 and EU825802 succeeds against all the services covered by the application, the application will be refused in full.

---

<sup>24</sup> See *Waterford Wedgwood plc v OHIM*, Case C-398/07P, CJEU

### **The s.5(3) ground of opposition – unfair advantage**

125. Mr Hall indicated at the hearing that the opponent did not intend to press its case on detriment to the reputation/distinctive character of EBAY. Therefore, it is only necessary for me to examine the case based on unfair advantage.

The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. 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; *General 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 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*).

### Reputation

126. It is common ground that EBAY has a substantial reputation in relation to services providing an online marketplace for the trading of goods.

127. I find that EBAY has a huge reputation for *provision of an online marketplace for the buying and selling of goods; provision of advertising space; provision of online tools for advertising purposes*.

### Link

128. 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*

129. As noted above, there is a low-to-medium degree of visual and aural similarity between the contested mark and EBAY and a certain degree of conceptual similarity.

*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*

130. Most of the services covered by the application are similar to a low-to-medium degree to those in class 35 for which EBAY has a reputation. The services which are not similar - *wireless broadcasting; maintenance services for computer software; maintenance and updating of computer software for others* – are not wholly distant from EBAY’s services, in the same way as, for example, chemicals or re-processing of plastics. Indeed, even though they are dissimilar services, the opponent’s evidence shows that it does in fact engage in wireless broadcasting, at least to its US users.

*The strength of the earlier mark’s reputation*

131. The earlier mark has a huge reputation for the services at issue.

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

132. The EBAY mark is inherently distinctive to a medium degree, but has become highly distinctive through use in relation to the services in class 35. The inherent distinctiveness of the mark is distributed mainly on the -BAY element, the E- prefix being relatively non-distinctive for services provided through electronic means.

*Whether there is a likelihood of confusion*

133. I have held that there is a likelihood of confusion, if the contested mark is used in relation to similar services.

134. Taking all the relevant factors into account, I find that average consumers of the parties’ services are likely to make a link between the contested mark and EBAY, even if the former is used in relation to the dissimilar services at issue.

## Unfair advantage

135. At the hearing, Mr Hall sought to rely on the fact that the user survey included in the applicant's proposed additional evidence found that 15% of those surveyed (which was in fact just 15 people) said they visited the applicant's gamersbay.com website because of an association with eBay. However, as I pointed out at the hearing, having successfully objected to the admittance of this evidence, it was not open to the opponent to seek to rely on it. In any event, none of the 4 UK-based respondents indicated that they associated the applicant's website with eBay. Further, given the likely difference of first language, it would not be safe to infer from the fact that 15% of EU-wide respondents made such an association that this is likely to be the reaction of average UK consumers.

136. However, my finding that there is a likelihood of indirect confusion between, on the one hand, EBAY and the services for which it has a reputation in class 35 and, on the other hand, the contested mark and the services covered by the application, (except for those mentioned in paragraph 130 above), points towards the contested mark taking unfair advantage of EBAY. Mr Hall relied particularly on EBAY's image as a trustworthy online marketplace on which to do business. There is ample evidence of this, and of its importance to the success of the opponent's business<sup>25</sup>.

137. If a significant proportion of average UK consumers believe that the similar services offered under the contested mark are a spin-off from EBAY, or are provided by a related undertaking, then there is obvious scope for EBAY's reputation as a trustworthy online marketplace to benefit the contested mark by attracting more UK consumers.

138. Further, even if consumers are not confused into thinking that there is an economic connection with EBAY, the use of a similar mark is sufficient, in my view, for the image of trustworthiness associated with EBAY to transfer to the contested mark. This is likely to be sufficient to cause a significant proportion of average

---

<sup>25</sup> See, for example, the copy of an article from the Observer newspaper dated September 2015 in exhibit AL-12, page 82.



consumers to use the services offered under the contested mark, when they may not otherwise have done so. And this finding extends to *wireless broadcasting; maintenance services for computer software; maintenance and updating of computer software for others*.

139. The applicant has not specifically claimed to have ‘due cause’ to use the contested mark. However, if the applicant’s submission that GamersbaY will be understood as a bay (as in a feature of coastline) on which games are played is intended to provide due cause, I disagree that it does. It is true that the concept of ‘due cause’ covers more than there being objectively overriding reasons for using a mark<sup>26</sup>. Nevertheless, the onus is on the applicant to establish that it has due cause to use the mark. In my view, the applicant has not done so. Even accepting that the contested mark is targeted at computer gamers, I see no reason why a trader in the services in classes 36, 38 and 42 covered by the application would need to adopt a mark that calls to mind the idea of playing games in a (coastline) bay. After all, this is not a location where computer games are typically played.

140. I therefore find that the s.5(3) ground of opposition also succeeds.

### **Overall outcome**

141. The opposition is successful. The application will be refused in full.

### **Costs**

142. The opponent has been successful and is entitled to a contribution towards its costs. I assess these as follows:

£200 – official fee for filing Notice of Opposition

£400 for filing a statement of grounds and considering the applicant’s counterstatement;

£1200 for filing evidence;

---

<sup>26</sup> *Leidseplein Beheer BV v Red Bull*, Case C-65/12, CJEU

£300 for dealing with the applicant's request to file additional evidence;  
£700 for attending a hearing and filing a skeleton argument.

143. I therefore order Mattias Industry LP to pay eBay Inc. the sum of £2800 as a contribution towards the cost of the proceedings. This to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal)

**Dated 24<sup>th</sup> January 2020**

**Allan James  
For the Registrar**