

**O/1207/23**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3508526**

**BY TENTON LIMITED**

**TO REGISTER A TRADE MARK IN CLASS 42**

**AND**

**OPPOSITION No. 421922**

**BY FACEBOOK INC.**

## FINAL DECISION IN OPPOSITION No. 421922

1. This opposition is directed at an application by Tenton Limited (“Tenton”) to register **lossbook** as a trade mark in relation to:

Class 42: Software as a service; Software as a service [SAAS] services; Software as a service [SaaS]; Software as a service [SaaS] featuring computer software platforms for artificial intelligence; Software as a service [SaaS] featuring software for deep learning; Software as a service [SaaS] featuring software for deep neural networks; Software as a service [SaaS] featuring software for machine learning; Software as a service [SaaS] services featuring software for machine learning, deep learning and deep neural networks; Application service provider (ASP) services, namely, hosting computer software applications of others; Application service provider [ASP], namely, hosting computer software applications of others; Platform as a service [PaaS] featuring software platforms for transmission of images, audio-visual content, video content and messages; Platforms for artificial intelligence as software as a service [SaaS]; all of the aforesaid for use exclusively in relation to the adjustment and analysis of insurance losses.

2. The opposition, brought by Facebook Inc. (“Facebook”), is based on four earlier trade marks, three of which are earlier EU trade marks. As a consequence of the transitional provisions established when the UK left the EU, these EU marks remain entitled to protection in the UK against applications (such as this one) filed before the date the UK finally left the EU. One of the earlier EU trade marks is for the word FACEBOOK. The other two are for the word BOOK alone. The fourth earlier trade mark is a registered UK trade mark consisting of the word FACEBOOK.

3. On 16th December 2021, I issued a provisional decision on behalf of the registrar in which I provisionally concluded:

*“103. The grounds of opposition based on the earlier FACEBOOK marks have failed.*

*104. The section 5(2)(b) grounds of opposition based on the earlier EUTMs for BOOK (i.e. EU018075708 and EU018075717) will succeed if one or both of those marks is, or remains, registered and protected in the UK in relation to the goods/services listed at the end of paragraph 82 above, or other terms covering the same sorts of goods/services.*

*105. This is a provisional decision. A final decision will be made once the final outcome of the opposition/cancellation proceedings at the EUIPO directed at either of EU018075708 or EU018075717 is known. These proceedings are suspended until such time.”*

4. I have been informed that the cancellation proceedings brought by a third party against earlier EU trade mark EU018075717, which were pending at the date of my provisional decision, have now been concluded: the cancellation application was rejected by the EUIPO as inadmissible. Therefore, the earlier EU trade mark remains entitled to protection vis-à-vis Tenton’s UK trade mark application.

5. Consequently, for the reasons given in my provisional decision, Tenton’s UK trade mark application is refused.

## **COSTS**

6. Having been successful in its opposition, Facebook would normally be entitled to a contribution towards its costs based on the registrar’s published scale of contributory costs. However, the applicant’s representatives filed written submissions arguing that each side should bear its own costs. According to Tenton, Facebook filed a large volume of irrelevant evidence going to the reputation of the FACEBOOK mark. Further, the opponent refused to engage in settlement discussions with the applicant, despite attempts by the applicant to limit its specification of services so as to avoid any conflict with the earlier marks.<sup>1</sup> Moreover, Tenton had not anticipated that the registrar would treat Facebook’s earlier BOOK marks as distinctive and afford them the protection he did.

---

<sup>1</sup> The final sentence of the specification at paragraph 1 above is the latest version of the amended specification.

7. For its part, Facebook denies that it failed to engage in settlement negotiations with the applicant. On the contrary, it reached out to find out about the applicant's actual business with a view to settlement: it just proved impossible to reach a settlement. As regards Facebook's evidence of reputation, the opponent says it was all necessary and points out that I accepted FACEBOOK had a strong reputation. Consequently, Facebook maintains that it is entitled to an award of costs.

8. Costs cannot be denied to Facebook on the basis that it failed to reach a negotiated settlement with the applicant. The applicant knew the risks of proceeding to a decision and accepted the inherent risks of an adverse costs order.

9. Facebook's evidence of reputation could have been better focused and clearer about the services for which the mark had a reputation. However, it served its purpose of establishing the reputation claimed (notwithstanding the fact that the opposition based upon that mark did not ultimately succeed). I will not withhold or adjust costs on this basis. More importantly, the opponent only succeeded on the basis of the earlier BOOK marks, which were not subject to proof of use. The case based on EU018075717 succeeded mainly on a comparison of the marks, the services for which they are registered, or proposed to be registered, and an assessment of the distinctive character of the BOOK and lossbook marks in relation to those services. Facebook's evidence of reputation was, therefore, irrelevant to the success of the opposition.

10. Further, as explained in paragraphs 80 – 82 of my provisional decision, I received very little assistance from Facebook's limited submissions in establishing the extent of the identity or similarity of the respective services. I do not propose to compensate Facebook for work that I largely had to do for myself. On the other hand, Facebook had to deal with Tenton's poorly focused evidence of third party registrations and use of BOOK derivative marks, which went to the distinctiveness of BOOK in relation to the services at issue. Facebook also had to contend with Tenton's initial amendments to its specification of services, some of which I found to be impermissible and ineffective. As my provisional decision records, arguments about this occupied part of the hearing.

11. Taking these matters into account, I assess appropriate costs as follows:

£200 for the official fee for a Notice of Opposition;

£400 for completing and filing the Notice and considering Tenton's counterstatement;

£400 for considering Tenton's evidence about the claimed lack of distinctiveness of BOOK;

£200 for considering Tenton's amended specification of services;

£600 for filing a skeleton argument and taking part in the hearing;

£100 for responding to Tenton's submissions about costs.

12. I therefore order Tenton Ltd to pay Facebook Inc. the sum of £1900 as a contribution towards its costs. 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).

### **STATUS OF THIS DECISION**

13. This is a final decision. The period for appeal runs from the date shown below.

**Dated this 21<sup>st</sup> day of December 2023**

**Allan James**

**For the Registrar**