



Neutral Citation Number: [2022] EWHC 1220 (Ch)

Case No: CH-2022-000006

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)

ON APPEAL FROM THE REGISTRAR OF TRADE MARKS
OF THE UNITED KINGDOM INTELLECTUAL PROPERTY OFFICE
DECISION NO. O-917-21

The Rolls Building
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Fetter Lane
London EC4A 1NL

Date: Wednesday, 18th May 2022

Before:

MRS JUSTICE FALK

Between:

TIK TOK INTERNATIONAL LIMITED

Appellant
(Registrant)

- and -

**TIKTOK INFORMATION TECHNOLOGIES UK
LIMITED**

Respondent
(Applicant for
Cancellation)

MR JONATHAN D.C. TURNER (instructed by **Richard Slade and Company Limited**) for
the **Appellant (Registrant)**

MR JAMIE MUIR WOOD (instructed by **Taylor Wessing LLP**) for the **Respondent**
(Applicant for Cancellation)

APPROVED JUDGMENT

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MRS JUSTICE FALK:

Introduction and background

1. This is an appeal by Tik Tok International Limited against a decision dated 16 December 2021 of June Ralph, the Hearing Officer for the Registrar of Trade Marks (the "Decision"). In the Decision, the Hearing Officer upheld an application by the Respondent to the appeal, TikTok Information Technologies UK Limited, that the registration of the Appellant's UK trade mark, no. 3272003 (the "Mark"), should be declared invalid.
2. The Appellant carries on business as an IT Consultancy. The Respondent is a member of a group of companies that operates a well-known internet platform on which members of the public can post short videos on any topic, including, but not limited to, music videos. The Mark was filed on 20 November 2017 and registered on 20 April 2018. Its registration is for "compilation of information relating to information technology", in Class 42.
3. The Respondent relied on its own UK trade mark no. 917891401 (the "Earlier Mark"). That was filed as a European trade mark application on 23 April 2018, but claiming a priority date of 23 October 2017, related to an Indian trade mark. The Earlier Mark was added to the register on 29 November 2018, and "cloned" to a UK mark on 31 December 2020. The Earlier Mark is registered for a variety of goods and services in Classes 9, 38 and 41, of which the following were relied on by the Hearing Officer in her findings of similarity, and are relevant to this appeal:
 - Class 9: "application software; application software for smart phone; downloadable computer software applications; downloadable smart phone application (software)";
 - Class 38: "providing access to search services of smart phone applications; providing access to peer-to-peer (P2P) sharing services"; and
 - Class 41: "electronic publication of information on a wide range of topics".
4. Before the Hearing Officer, the Respondent's challenge was made solely under section 5(2)(a) of the Trade Marks Act 1994, which provides:
 - "A trade mark shall not be registered if because —
 - (a) it is identical with an earlier trade mark and is to be registered for goods or services 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."

5. The Appellant acknowledged that the Earlier Mark and the Mark were identical, but denied that its services were similar to the goods or services for which the Earlier Mark was registered. The Hearing Officer found that:
 - i) the Earlier Mark was inherently distinctive to a high degree;
 - ii) the goods and services referred to above were similar to at least a low degree;
 - iii) the average consumer would pay at least a medium degree of attention during the purchasing act; and
 - iv) there was a likelihood of direct confusion.
6. There are five grounds of appeal. In essence, these are: that the Hearing Officer was wrong to find that the Earlier Mark was distinctive to a high degree (Ground 1); that there was similarity between any of the relevant goods and services (Grounds 2-4); or that there was a likelihood of confusion (Ground 5).

The approach on an appeal

7. The approach to take on an appeal from the Registrar is well established. I was referred to the summary by Morgan J in *Yellow Bulldog v. AP & Co. Ltd.* [2020] EWHC 3558 (Ch); [2021] ECC 10 at [29]-[34] by way of example. The principles are not in dispute. In particular, there is no suggestion that this court should go beyond conducting a review of the Decision, and there is no suggestion of procedural or other irregularity. The court will therefore only allow the appeal if the Decision was wrong.
8. Where the court is asked to review an evaluative judgment based on a multi-factorial comparison, such as the similarity of marks or the existence of a likelihood of confusion, there will be real reluctance (but it has been said, "not the very highest degree of reluctance") to interfere in the absence of a distinct error of principle. A significant degree of respect is shown to a Hearing Officer's specialised experience.
9. Morgan J relied on the following helpful summary by the Court of Appeal in *Re Sprintroom Ltd.* [2019] BCC 1031 at [76]:

"So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, 'such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion'."

Evidence

10. I first need to make a point about the evidence. Mr Turner submitted that a number of the findings of the Hearing Officer were not founded on evidence, and also made the point that the burden of proof was on the Respondent to this appeal.
11. I make two answers to the point about evidence. First, the key issues are similarity and likelihood of confusion. Both of those, it is well-established, are determined by

reference to the notional average consumer. The court is well placed to undertake that exercise, and one has to ask what, in many cases, evidence could realistically add to that.

12. Secondly, and importantly, a complaint about lack of evidence should have been raised at first instance. Only one point about evidence was raised on behalf of the Appellant at first instance. I was taken to it in the transcript, and it does not amount to raising a general complaint about the absence of evidence.

Ground 1: distinctiveness

13. Mr Turner submitted that the Hearing Officer was wrong to find, at paragraph 13 of the Decision, as the basis for her conclusion that the Earlier Mark is inherently distinctive to a high degree, that the Earlier Mark was invented, and had no meaning in relation to the goods and services for which it was registered. On the contrary, Mr Turner said, the Earlier Mark represents a widely-used onomatopoeic term, referring to the operation of a metronome or clock. It is descriptive of the Respondent's service of providing a platform for posting short videos of musical and/or dance performances on the internet. The services or goods relating to it are encompassed in the goods and services for which the Earlier Mark is registered. The burden of proof was on the Respondent, and its claim of distinctiveness was not made out.
14. Mr Muir Wood, for the Respondent, submitted that this point had not been raised at first instance and it was not open for the Appellant to raise it for the first time on appeal. The only submissions to the Hearing Officer on the issue had been made by the Respondent, rather than the Appellant, to which no response had been made by the Appellant. In any event, Mr Muir Wood submitted that the Earlier Mark was not descriptive of the goods and services on which the Hearing Officer based her decision.
15. As to whether to allow a new point to be taken on appeal, the principles are well-established, and were relatively recently summarised by Haddon-Cave LJ in *Singh v Dass* [2019] EWCA (Civ) 360 at [16]-[18]. Applying those principles, I am prepared, in this instance, to allow this point to be argued. Whilst caution is required, it is not a point that, for example, would have necessitated new evidence or affected the way the case was run. It has been raised as a ground of appeal and the Respondent has had adequate time to deal with it.
16. But, in any event, I have to agree with the Respondent on this ground. The point being made is a point related to an aspect of the business of the Respondent's owners, so far as it relates to music videos, rather than the goods and services which were the basis of the Decision. The question of distinctiveness is not determined simply by a broad inquiry about the nature of the business of one of the parties.
17. The Hearing Officer's conclusions reflected the Respondent's written submissions to her. I note that the Respondent's counsel had also made a point in his skeleton argument before the Hearing Officer that TikTok is a distinctive combination of two well-known sounds, associated with time, albeit misspelt, and that it has a high degree of inherent distinctive character. There is no indication that that submission was challenged at the hearing. That is understandable.

18. To the extent that the Earlier Mark is or may be evocative of the sound of a metronome or clock, the clearly deliberate misspelling is an element of distinctiveness. It also follows from the misspelling that the phrase is invented.
19. Further, whilst the Earlier Mark is, or could be, regarded as descriptive of time, and certainly sounds like “tick tock” spelt in the conventional way, it is not descriptive, as such, of music or music videos. At most it is descriptive of pulse, rather than rhythm or music, or videos, and certainly not of the particular goods and services relied on by the Hearing Officer in reaching the Decision. Common sense tells you that the Earlier Mark is inherently distinctive, and highly so.
20. I conclude that the Hearing Officer was clearly entitled to reach the conclusion that the Earlier Mark is inherently distinctive.

Grounds 2-4: similarity

21. I turn to Grounds 2-4, which deal with similarity. I am prepared to consider these grounds, although Mr Muir Wood did make the point that he did not think that they were properly set out as grounds of appeal, rather simply as disagreements with the Decision. Some further detail is at least provided in relation to Ground 2, and I have considered all of them.
22. The Hearing Officer concluded that there was at least a low level of similarity in respect of each of the goods and services for which the Earlier Mark is registered that I have set out. Grounds 2-4 challenge this conclusion in respect of the relevant goods and services in classes 9, 38 and 41 respectively.
23. As regards Class 9, the Hearing Officer agreed, at paragraph 24, with the Respondent's contention that the software products referred to were IT products, and found that they could be used for any purpose as their specification was unrestricted. She concluded that the specified software products "... could have the functionality of gathering and compiling information on any subject including those which relate to information technology topics", such that there was some overlap in nature, purpose and users and similarity existed, "at least to a low degree".
24. The Appellant says that the possibility of use in the provision of services specified in the Respondent's registration was insufficient to establish similarity, and used the analogy of a nail not being similar to a picture, despite its possible use to hang a picture on a wall. In oral submissions, Mr Turner also submitted that because goods were being compared with services, the analysis must really proceed based on complementarity, and he referred to the well-known reference to wine glasses not being similar to wine, because complementarity was not established in the correct sense.
25. In respect of Class 38, the Hearing Officer considered the list of services specified in the Respondent's registration, and at paragraph 26 drew a distinction between services related to the transmission of information, and what she described as "access services", being the services that I have set out. The Hearing Officer concluded that there was a low degree of similarity with the Appellant's services of gathering information in one place. The Appellant simply denies this and says this is a bizarre conclusion to have reached.

26. In relation to Class 41, the Hearing Officer considered that the specification for "electronic publication of information on a wide range of topics" was not quite on all fours with the Appellant's compilation services, publication being about the presentation of information and a "step away" from compilation, such that the nature or purpose of the services were not the same. However, the Hearing Officer considered that there may be some overlap of users, and overall a low degree of complementarity, on the basis that consumers may think that the same undertaking would be responsible for both gathering and publishing information on a particular topic.
27. Again, the Appellant denies this, and asserts that the Hearing Officer erred in principle in her findings about complementarity, relying on factual assumptions not supported by evidence. Mr Turner also submitted that the Hearing Officer erred by ignoring the fact that the burden of proof was on the Respondent, such that findings that there may be an overlap of users, or that consumers may think that the same undertaking would be responsible, were not sufficient. He further submitted that the reference to "publication on a wide range of topics" meant only publications covering a wide range; he gave the example of a newspaper that might publish on a wide range of topics, as distinct from publication on a single or specialised topic, like information technology.
28. I do not consider that the Hearing Officer misdirected herself as to the law as regards similarity of goods and services. She set out in some detail the principles to be applied in interpreting terms in a specification of goods and services for which a mark is registered, including Arnold LJ's summary in *Sky v Skykick* [2020] EWHC 990 at [56]:

"In summary, therefore, the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

I note that an appeal against that decision was allowed in part, but not in respect of this issue.

29. I have not detected any error of principle in the Hearing Officer's decisions on similarity. Rather, and after carefully directing herself as to the law, these were evaluative decisions that she was entitled to reach.
30. As regards Class 9, I am satisfied that the Hearing Officer's conclusion was based on similarity in the conventional sense, rather than complementarity, a particular aspect of similarity. That is clear from paragraph 32 of the Decision, but I think also from the

way that paragraph 24 is framed. The Hearing Officer was entitled to reach that conclusion. It is well-established that goods can be similar to services.

31. As regards nails and pictures, I would make the comment that application software can clearly be used to do the job of compilation. That was essentially what the Hearing Officer was saying at paragraph 24: "... software products could have the functionality of gathering and compiling information." The Hearing Officer was entitled to reach the conclusion she did.
32. In relation to Class 38, I do find the Hearing Officer's conclusion more difficult, but this is not a case where I should simply substitute my own decision. I am not sufficiently persuaded that the Hearing Officer is wrong. In any event, it was not necessary to her decision to find that there was a similarity in respect of the Class 38 specification.
33. As regards Class 41, the Hearing Officer relied on complementarity. She set out the principle, established by case T325/06 *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, where 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".
34. Again, although some of the language used, in particular the use of the word "may", may be a little infelicitous, I cannot conclude that the Hearing Officer's conclusion, at paragraph 27, was wrong. I find Mr Turner's argument about the meaning of "a wide range of topics" quite a difficult argument to follow, but even taking it at face value, it is not an argument that I think is properly open to the Appellant. It was indicated for the first time today, without any real opportunity for the Respondent to respond to it.
35. I would make the point that publishing information would usually require, as a first step, gathering information for that purpose. Similarly, information is generally gathered together for the purpose of disseminating it in some form. On that basis, the decision as to complementarity was one that the Hearing Officer was entitled to reach.

Ground 5: likelihood of confusion

36. Turning to Ground 5, the Appellant asserts that the conclusion that there was a likelihood of confusion relied on the erroneous view that the Earlier Mark is inherently distinctive and was also not supported by evidence. I have dealt with both of those points already. I would elaborate a bit on the Appellant's argument. What, as I understand it, the Appellant is saying is that the Earlier Mark is descriptive of a central element of the Respondent's business, being music videos, and that the Hearing Officer exaggerated its distinctiveness and overlooked its descriptive nature. However, in my view, the Hearing Officer did not misdirect herself, and she was entitled to reach the decision she did. In my view, TikTok, spelt in the way it is in the Earlier Mark, is clearly highly distinctive, and further, and in particular, the identity between the Earlier Mark and the Mark is also very significant in offsetting any low degree of similarity.

Therefore, the conclusion that there was a likelihood of confusion was not wrong; indeed, it was the correct conclusion.

Conclusion

37. In conclusion, therefore, I dismiss the appeal.

(For continuation of proceedings: please see separate transcript)
