

**O/334/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003369340**

**BY MY SHADOW LIMITED**

**TO REGISTER THE TRADE MARK:**

**Black Tack**

**IN CLASSES 1 AND 17**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 416598 BY**

**BOSTIK LIMITED**

## BACKGROUND AND PLEADINGS

1. On 23 January 2019, My Shadow Limited (“the applicant”) applied to register the trade mark **Black Tack** in the UK. The application was published for opposition purposes on 15 March 2019 and registration is sought for the goods shown in paragraph **45** below.

2. On 14 June 2019, Bostik Limited (“the opponent”) opposed the application based upon sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3) of the Act the opponent relies upon UK registration no. 1130819 for the trade mark **BLU-TACK**. The opponent’s mark was registered on 22 March 1980 and the opponent relies upon all of the goods for which it is registered, namely:

Class 16      Adhesive materials (stationery).

3. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion because the respective marks are similar, and the goods are identical or similar.

4. Under section 5(3), the opponent claims that it has a reputation for all of the goods for which the mark is registered and that use of the applicant’s mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier mark.

5. Under section 5(4)(a), the opponent claims that the sign **BLU-TACK** has been used throughout the UK since at least 1970 in respect of:

“Adhesive materials (stationery); removable and reusable adhesive putty.”

6. Under section 3(6), the opponent states:

“The application was filed in bad faith because the Applicant sought to abuse the trade mark system and because the applicant had no intention to use the mark in relation to the goods covered in the application.

The Opponent's BLU-TACK product has many (innumerable) uses, including holding photographic equipment in place. The Applicant uses its Black Tack product in this area, as clearly stated on their website [...]

The Applicant avoided filing in class 16 and excluded "household or stationery" in multiple places in the class 1 and class 17 specifications. The Applicant was clearly aware of the Opponent's rights and sought to evade detection and challenge by filing in different classes and by excluding goods that might conflict with the Opponent's registration. The application as filed, does not reflect the true intention of the Applicant. The Applicant uses the mark on a product that is, by the Applicant's own admission, a BLU-TACK substitute but filed a tactical application to mask this. The application was clearly filed in bad faith both because it was an attempt to abuse the trade mark system and because there was no bona fide intention to use the mark in relation to the goods covered."

7. The applicant filed a counterstatement denying the claims made.

8. Both parties filed evidence in chief. The opponent filed evidence in reply. A hearing took place before me on **1 June 2020**, by video conference. The opponent was represented by Ms Amy Reynolds of Field Fisher LLP and the applicant was represented by Mr Michael Coyle of Lawdit Solicitors. Both parties filed skeleton arguments in advance of the hearing.

## **EVIDENCE**

### **The Opponent's Evidence in Chief**

9. The opponent filed evidence in chief in the form of the witness statement of Amy Denise Reynolds dated 12 November 2019 and the witness statement of Matthew Whitehouse dated 7 November 2019. Mr Reynolds is the opponent's representative in these proceedings and Mr Whitehouse is the opponent's Marketing Director. I have read both statements in their entirety and summarise them only to the extent that I consider necessary below.

10. Ms Reynolds' statement serves to introduce two decisions of the EUIPO opposition division. I will return to these cases where appropriate below.

11. Mr Whitehouse explains that the opponent has been using the trade marks BLU-TACK and BLU TACK in the UK since at least 1970 in relation to adhesive materials and removable and reusable adhesive putty.

12. Mr Whitehouse has provided a sample of 4 invoices which display the BLU-TACK mark.<sup>1</sup> These are dated 16 October 2018, 22 April 2016, 11 December 2017 and 6 December 2017. They relate to products described as "BLU-TACK HANDY PACK/C12", "BLU TACK HANDY WHITE WALLETS/C12", "BOSTIK BLU TACK ECONOMY PACKS/C12" and "BLU-TACK CLASSMATE". In total, these relate to over 22,000 units of BLU TACK/BLU-TACK branded products, which are to be delivered to locations around the UK.

13. A copy of a Product Catalogue, which Mr Whitehouse states was published in 2011, lists "Blu-Tack Handy", "Blu-Tack Economy" and "Blu-Tack White" as products available for purchase.<sup>2</sup>

14. A Smart Brochure, which Mr Whitehouse states was produced by the opponent in 2014, refers to BLU-TACK being invented in 1970.<sup>3</sup> It is described as "a removable and reusable adhesive putty" which "can be used everywhere in the home, office and workshop to secure articles in place on all types of surfaces".

15. Mr Whitehouse confirms that the opponent's BLU-TACK branded products have a 71% market share of the adhesive putty market in the UK. Mr Whitehouse has confirmed that starting with the year 2012-2013 to the year 2018-2019 UK sales in respect of Blu-Tack branded products have amounted to over £4.5million per year. For the years 2010-2011 and 2011-2012 UK sales amounted to over £3.5million per year. Mr Whitehouse notes that these figures are particularly high given that the goods themselves sell for only around £0.35 to £0.70 each.

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<sup>1</sup>Exhibit MW04

<sup>2</sup> Exhibit MW07

<sup>3</sup> Exhibit MW08

16. Mr Whitehouse notes that the opponent has had a long-standing relationship with well-known cycling event, the Tour de France. Mr Whitehouse has provided figures for television viewers in relation to the event, that appears to confirm 34million viewers followed the event in 2018.<sup>4</sup> These figures relate to “France 2” and “France 3”. It is not apparent to me what these references relate to, although the printout generally appears to relate to a French television channel (France.TV Sport). In any event, it is clearly correct that the Tour de France attracts a high number of viewers each year. However, I note that the majority of articles relating to this partnership refer to the opponent, but not to the mark relied upon.<sup>5</sup> The only article that does describe the mark in issue in relation to the event (“Bostik, the maker of Blu Tack”) is one taken from the opponent’s own website.<sup>6</sup>

17. Mr Whitehouse also refers to the opponent’s sponsorship of the IDEA19 Exhibition in Miami in March 2019.<sup>7</sup> Firstly, this took place after the relevant date and does not, therefore, assist the opponent. Secondly, the article provided to demonstrate this, again, refers to the opponent being a sponsor but makes no mention of the mark in issue.

18. Mr Whitehouse states that the opponent engaged in an £750,000 TV advertising campaign in the UK entitled “#BluHacks” aimed at exploring the different ways in which the opponent’s products could be used. Mr Whitehouse states that this was aired on Sky TV Channels. However, no information is provided about when this campaign took place.

19. Mr Whitehouse confirms that the opponent was involved in a competition aired on Big City Radio in December 2014 for a ‘Bostik Decorating Pack’. A copy of the exert from the radio show has been provided.<sup>8</sup> The radio presenter explains that the prize is a pack of Bostik products including Blu Tack, and the question that must be

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<sup>4</sup> Exhibit MW12

<sup>5</sup> Exhibit MW13, MW14 and MW16

<sup>6</sup> Exhibit MW15

<sup>7</sup> Exhibit MW17

<sup>8</sup> Exhibit MW20

answered to win is “Which colour comes below the word Tack to make the name of the most famous Bostik product, is it a) black b) blue or c) beige?”.

20. Mr Whitehouse has provided examples of the BLU TACK/BLU-TACK marks being used in publications.<sup>9</sup> These include articles from Insider Media (October 2018), Leicestershire Live (April 2018), thetimes.co.uk (January 2017 and December 2017), Daily Mail (September 2016), Grimsby Telegraph (July 2016), Manchester Evening News (June 2016), The Scotsman (May 2016) and The Independent (May 2016).

21. Mr Whitehouse notes that the colour of the opponent’s products has not been limited to the colour blue. Mr Whitehouse explains that, over the years, the opponent has changed the colour of Blu-Tack branded products for specific reasons. An article from 2008 confirms that “Blu Tack Pink” products were sold to help raise money for a breast cancer campaign.<sup>10</sup> Mr Whitehouse has also provided an undated screenshot which shows “Blu Tack White” available for sale.<sup>11</sup>

22. A publication from Superbrands is provided, which Mr Whitehouse states was published in 2004, identifying Blu-Tack as commanding a 94% market share of the “office adhesives re-usable tack market”.<sup>12</sup> The article goes on to note that “within ten years of the launch of the product, Blu-Tack had become a household name”. The article describes the largest promotional campaign in relation to Blu-Tack was one involving the RSPCA and the World Snooker Champion at the time.

23. Mr Whitehouse has provided an article which confirms that in 2007 an artist exhibited a sculpture made entirely of Blu Tack at ZSL London Zoo.<sup>13</sup>

### **The Applicant’s Evidence in Chief**

24. The applicant filed evidence in chief in the form of the witness statement of Mr Chris Burton dated 29 January 2020, which is accompanied by 1 exhibit. I have read

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<sup>9</sup> Exhibit MW22

<sup>10</sup> Exhibit MW23

<sup>11</sup> Exhibit MW24

<sup>12</sup> Exhibit MW25

<sup>13</sup> Exhibit MW28

Mr Burton's statement in its entirety and have summarised it only to the extent that I consider necessary.

25. Mr Burton is a Director of the applicant, a position he has held since August 2010. Part of Mr Burton's statement contains submissions regarding various aspects of the case. I will refer to these submissions below where necessary.

26. Mr Burton notes that the opponent's evidence shows its products being sold in flat rectangular packaging. Mr Burton has filed examples of his own product, which is sold in an oblong box.<sup>14</sup> Mr Burton points to other differences between the parties' respective products such as the temperatures they can withstand, whether they are waterproof and the weight that they are capable of holding. The packaging describes the product as "extra strong reusable putty" and states:

"We'll let you into a little secret the pro's use... this unique putty fixes Action Cameras, Props and other objects almost anywhere!

This 'get out of jail' accessory is an invaluable extra in anyone's toolbox, and will stick your camera in some really unusual places. It's been used worldwide by TV crews on Racing Bikes, Formula 1 Cars, Plane Wings... the list is endless."

27. Mr Burton also refers to UK registration no. 2151868 registered for the mark UHU WHITE-TACK. Mr Burton notes that this mark has been registered since 1998 and yet was not challenged by the opponent.

28. Mr Burton has also provided three emails dated 28 January 2020 from individuals who purchase the applicant's product.<sup>15</sup> These are not provided in the correct evidential format. The first of these emails confirms that the sender has purchased both the applicant's goods and the opponent's goods and that they are used for entirely different purposes, apparently relating to the weight each can hold. The

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<sup>14</sup> Exhibit CB1

<sup>15</sup> Exhibit CB1

second of these emails is from a sender who appears to be based outside of the UK and uses the applicant's goods. The sender confirms that they have never heard of Blu-Tack. The third of these emails is from an individual who uses the applicant's goods in order to fix equipment such as microphones in place. The sender confirms that Blu Tack has an entirely different function and doesn't carry the same weight as Black Tack products.

### **Opponent's Evidence in Reply**

29. The opponent filed evidence in reply in the form of the second witness statement of Mr Whitehouse dated 26 March 2020 and the second witness statement of Ms Reynolds dated 1 May 2020.

30. Mr Whitehouse has provided screenshots from the websites of Homebase, Wickes, Tooled Up, Robert Dyas and Hobbycraft, all of which are taken in February 2020.<sup>16</sup> These all display BLU TACK branded products available for sale.

31. Mr Whitehouse argues that use of the opponent's product is not limited to stationery. Mr Whitehouse has provided printouts from the opponent's UK Facebook page which shows the ways in which consumers have used BLU-TACK products.<sup>17</sup> These examples are undated, but include uses such as holding photography props in place, stopping leaks and holding pieces of furniture together.

32. Mr Whitehouse has also filed a laboratory report prepared by the opponent in December 2019, which details the strength of the BLU-TACK product.<sup>18</sup> Mr Whitehouse disputes Mr Burton's claim that Black Tack is stronger than BLU-TACK.

33. Ms Reynolds' second witness statement was filed after the deadline for filing evidence in reply (2 April 2020). However, the deadline for filing the opponent's evidence in reply fell within the period of interrupted days declared by this office due

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<sup>16</sup> Exhibit MW29

<sup>17</sup> Exhibit MW30

<sup>18</sup> Exhibit MW32



to the coronavirus pandemic in accordance with rule 75 of the Trade Marks Rules 2008. Consequently, on 12 May 2020, this office wrote to the parties as follows:

“The Tribunal’s preliminary view is that the witness statement filed on 1 May 2020 be admitted into proceedings. This is because, as the opponent says, we are still in a period of interrupted days.

If either party wishes to challenge this preliminary view, they should do so within the next 7 days. If the preliminary view is challenged, it will be dealt with as a preliminary point at the hearing.”

34. At the hearing, Mr Coyle confirmed that there was no challenge to the preliminary view. Consequently, the second witness statement of Ms Reynolds is admitted into these proceedings.

35. Ms Reynolds’ evidence confirms that both the opponent’s products and the applicant’s products are available to purchase through online retailers such as Amazon and eBay.<sup>19</sup> The printouts provided by Ms Reynolds are dated 28 April 2020. Ms Reynolds points to the way in which the applicant seeks to describe its product by reference to the opponent’s mark i.e. “like blue tack, but a lot stronger & stickier”.

## **PRELIMINARY ISSUES**

36. As noted above, Mr Burton’s witness statement exhibits a number of emails from the applicant’s customers or associates regarding the fact that they have either not heard of the opponent’s mark or do not consider it confusingly similar to the applicant’s mark. They also note the different ways in which the goods are used in practice. At the hearing, Ms Reynolds submitted that these exhibits should be treated as hearsay evidence. I agree. Section 1 of the Civil Evidence Act 1995 (“the CE Act 1995”) provides that hearsay evidence is not inadmissible in civil proceedings. However, I must undertake an assessment of the weight to be attributed to these emails. Ms Reynolds submitted that little weight should be placed upon the content of these

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<sup>19</sup> Exhibit ADR1

emails, in particular because the full email chain has not been provided and we cannot know the background to these emails being sent. In response to the criticisms made by Ms Reynolds, and questions I raised at the hearing, Mr Coyle acknowledged the issues with the emails but stated that it would not have been “feasible or practical” for witness statements to be obtained. He further submitted:

“In my submission, they should be treated as genuine customers who have expressed some general comments as to the question that was posed, whether or not they see any issue regarding BLACK TACK and BLU-TACK. [...] we were trying to communicate to the Registry that the consumer cannot possibly be confused based on the iconic nature of the BLU-TACK brand and to generate three e-mails from customers, who have no axe to grind, who do not necessarily wish to provide formal statements. [...]”

37. Section 4 of the CE Act 1995 states as follows:

“(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following –

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.”

38. I see no reason why it would not have been reasonable and practicable for these individuals to have given formal witness statements in these proceedings, if the applicant wished to rely upon their evidence. The fact that it may have been too time consuming to have done so or that there was reluctance on the part of the individuals concerned to provide formal statements, is not an acceptable reason to file evidence in an incorrect format. The emails were all dated 28 January 2020, after these proceedings had been commenced. The evidence does not involve multiple hearsay. We have no reason to believe that these individuals had any reason to conceal or misrepresent matters, other than their association with the applicant. As Ms Reynolds noted at the hearing, the email chains have not been provided. We do not, therefore, know what questions were asked of these individuals to illicit these responses. However, the content of the emails suggest that these individuals were aware of the background to the ongoing dispute and that these emails were sent for the purpose of countering the opposition brought by the opponent. Taking all of this into account, I consider that little weight should be attributed to these emails, not least because it seems to me that there is no reason for formal statements not to have been given and the context in which these emails were sent is not available to me.

39. The applicant has made reference to the fact that there are other marks on the register which contain the word TACK, specifically UHU WHITE-TACK. In his witness statement, Mr Burton noted:

“This application is a clear direct conflict with the Opponent and yet was not challenged by the Opponent in the way of an opposition. I would like to submit to the Office that the Opponent’s omission to act in this circumstances creates

a strong impression that it is not concerned as to the impact on its business with colour variants.”

40. At the hearing, Ms Reynold submitted:

“[...] the opponent takes its rights very seriously and does take action against third parties which use or attempt to use or register a mark which it feels is confusingly similar. In the current case, the similarities between the goods and the marks in question are so high that the opponent was compelled to take action.”

41. I do not consider the opponent’s decision not to oppose an entirely separate trade mark application to be indicative of the merits of the present case. There are any number of reasons why action may not have been taken in that case, including commercial agreements between the parties concerned. The issue to be decided in this case, relates only to the marks applied-for/registered.

## **DECISION**

### **Section 5(2)(b)**

42. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

43. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the opponent's mark had completed its registration process more than 5 years before the application date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act. However, as the applicant did not request that the opponent prove use of its mark, it is entitled to rely upon all of the goods for which the mark is registered.

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

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

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

### **Comparison of goods**

45. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<u>Class 16</u> Adhesive materials (stationery).	<u>Class 1</u>

	<p>Non permanent rubber strong adhesive used to connect objects; Butyl tape used as adhesive to connect objects; Butyl tape used as adhesive to mount photographic and scientific equipment; Adhesive compositions for use in industry; Adhesive materials for the building industry; Adhesive substances for use in industry; Adhesive substances used in industry; Adhesives for industrial purposes; Adhesives for industrial use; Adhesives for paperhanging; Adhesives for the building industry; Adhesives for the construction industry; Adhesives for use in bonding materials [industrial]; Adhesives for use in building; Adhesives for use in construction; Adhesives for use in industry; Adhesives for use in photography; Adhesives for use in science; Adhesives for use in the building industry; Adhesives for use in the construction industry; Adhesives for use in the mechanical industry; Adhesives for waterproofing; Adhesives of synthetic origin for industrial use; Adhesives, other than for stationery or household purposes; Adhesives used in industry; Chemical bonding agents [other than for household or stationery use]; Chemicals for use in photography; Chemicals for use in the electrical industry; Chemicals for use in the gas industry; Chemicals used in</p>
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	<p>photography; Coatings for weatherproofing [chemicals]; Commercial adhesives [other than for stationery or household use]; Commercial glues [other than for stationery or household use]; Composition of adhesives and fillers for repairing seals; Filler for automotive body repair; Fillers for automobile bodies; Fillers for rubber; Glaziers' putty; Glazing putty; Gums [adhesives], other than for stationery or household purposes; Industrial adhesives; Industrial adhesives for use in building; Industrial adhesives for use in coating and sealing; Industrial adhesives for use in metal working; Industrial adhesives for use in plumbing; Roofing adhesive; Rubber adhesives for industrial use; Rubber adhesives [other than for household or stationery use]; Rubber based adhesives for industrial use; Rubber based adhesives [other than for household or stationery use]; Rubber based cements [adhesives] for industrial use; Rubber based cements adhesives, other than for household or stationery use; Rubber compounds for industrial use; Sealing compounds for use in building [chemical]; Structural adhesives for automotive use; Structural adhesives for building use.</p>
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Class 17

Flexible adhesive rubber tape to fix objects together temporally; Non permanent rubber strong adhesive used to connect objects; Butyl tape used as adhesive to connect objects; Butyl tape used as adhesive to mount photographic and scientific equipment; Anti-vibration tape; Articles made of rubber for jointing purposes; Articles made of rubber for sealing; Butyl rubber (Liquid -); Caulking; Caulking compounds; Caulking materials; Chemical compositions for preventing leaks; Chemical compositions for repairing leaks; Duct tape; Duct tapes; Dust proofing sealants; Electrical insulating materials; Fluid seals; Fluoro rubber; Gaffer tape; Glazing tapes; Impervious adhesive strips for edging of roofs; Impervious adhesive strips for ridge tiling; Impervious adhesive strips for valley channels; India rubber; Joint filling compounds; Joint packing; Joint packings; Joint sealants; Joint sealing compounds; Jointing compound; Non-metallic sealing compounds for joints; Non-metallic seals [not stamps]; Rubber; Rubber for electrical insulation; Rubber for use in manufacture; Rubber in liquid form; Rubber (Liquid -); Rubber sealants for joints; Rubber (Synthetic -); Rubber tape for insulating; Sealants for

	buildings; Sealants for joints for building purposes; Sealants for sealing joints; Sealants for seams in vehicle bodywork; Sealing agents for use in the building industry; Sealing agents for use in the construction industry; Sealing compounds; Sealing elements consisting of rubber; Sealing putty; Sealing strips made of synthetic rubber; Self-adhesive tapes [other than for stationery, household or medical purposes]; Self-adhesive tapes, other than stationery and not for medical or household purposes; Silicone rubber; Tapes (Adhesive -), other than stationery and not for medical or household purposes; Waterproof membranes of rubber.
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46. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

47. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

48. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

49. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

50. I note Mr Burton’s submissions regarding the products sold by the parties in practice. He is, of course, correct that the packaging appears to differ and it may indeed be the case that the products are used for different purposes. That will, at least in part, be apparent from the terms used in their respective specifications. However, as Ms Reynolds noted at the hearing, it is necessary to compare the goods that are covered by the parties’ specifications rather than how the goods are sold commercially. I am required to undertake a notional assessment based upon those terms in the respective specifications. The products on which the marks are used in practice are irrelevant, as is the way in which they are packaged. Similarly, the line of argument that there might be overlap in trade channels due to both parties’ goods being sold through general retailers such as Amazon or eBay is not compelling. Firstly, general retailers such as these (whether online or physical stores) sell such a broad range of goods that the mere fact that they sell two types of goods is not sufficient to find similarity, particularly if the goods would in fact be sold in different departments of such retailers. Secondly, the parties’ actual trade channels are only relevant to the extent that they would apply to the goods actually applied-for/registered.

#### Class 1

51. “Non permanent rubber strong adhesive used to connect objects”, “Butyl tape used as adhesive to connect objects” and “Adhesives for paperhanging” in the applicant’s specification all overlap in use with the opponent’s goods to the extent that they are all adhesives, intended to stick one object to another. There may also be an overlap in user as they are all broad enough that they may cover goods used by the general public. There may be overlap in nature and method of use. For example, the applicant’s goods would include tape-type adhesives for stationery which would

overlap in nature and method of use with the applicant's butyl tape. There may be a degree of overlap in trade channels, although I recognise that any such overlap is likely to be limited. Taking all of this into account, I consider the goods to be similar to at least a medium degree.

52. The following goods in the applicant's specification are all adhesives, with specific purposes that differ from those of the opponent's goods:

Butyl tape used as adhesive to mount photographic and scientific equipment; Adhesive compositions for use in industry; Adhesive materials for the building industry; Adhesive substances for use in industry; Adhesive substances used in industry; Adhesives for industrial purposes; Adhesives for industrial use; Adhesives for the building industry; Adhesives for the construction industry; Adhesives for use in bonding materials [industrial]; Adhesives for use in building; Adhesives for use in construction; Adhesives for use in industry; Adhesives for use in photography; Adhesives for use in science; Adhesives for use in the building industry; Adhesives for use in the construction industry; Adhesives for use in the mechanical industry; Adhesives for waterproofing; Adhesives of synthetic origin for industrial use; Adhesives, other than for stationery or household purposes; Adhesives used in industry; Chemical bonding agents [other than for household or stationery use]; Commercial adhesives [other than for stationery or household use]; Commercial glues [other than for stationery or household use]; Gums [adhesives], other than for stationery or household purposes; Industrial adhesives; Industrial adhesives for use in building; Industrial adhesives for use in coating and sealing; Industrial adhesives for use in metal working; Industrial adhesives for use in plumbing; Roofing adhesive; Rubber adhesives for industrial use; Rubber adhesives [other than for household or stationery use]; Rubber based adhesives for industrial use; Rubber based adhesives [other than for household or stationery use]; Rubber based cements [adhesives] for industrial use; Rubber based cements adhesives, other than for household or stationery use; Structural adhesives for automotive use; Structural adhesives for building use.

These goods will all overlap in purpose with the opponent's goods to the extent that they are all forms of adhesives. However, the specific purpose will differ as the applicant's goods are intended for specific uses (such as industrial or structural uses) which do not overlap with the general stationery uses to which the opponent's goods relate. I recognise that the opponent has argued that its goods have actually been used for a broader range of purposes (such as to fix leaks or secure photography equipment) but that cannot be said to be the core purpose of the goods covered by the specification. Although there may be a small amount of overlap in user in respect of some of these goods (such as amateur photographers), in the majority of cases, the user will differ. The nature of the goods may overlap in some cases, in that both parties' specifications may cover goods that are made of rubber-based materials. However, the method of use and trade channels will be different. Taking this into account, I consider the goods to be similar to only a low degree.

53. "Composition of adhesives and fillers for repairing seals", "Filler for automotive body repair", "Fillers for automobile bodies", "Fillers for rubber", "Glaziers' putty", "Glazing putty" and "Sealing compounds for use in building [chemical]" in the applicant's specification may all include an adhesive ingredient to enable them to stick to the surfaces on which they are being used. However, their main purpose is either to seal or to fill a gap. This is not the same as an adhesive, the purpose of which is to stick two objects or materials together. These goods do not, therefore, share the same use as the opponent's goods. They will also differ in method of use and trade channels. They are also unlikely to overlap in user, as the opponent's goods will be targeted at the general public, whilst the applicant's goods will be aimed at professional consumers (although I accept there may be some overlap in some cases). There may be a degree of overlap in nature. Taking all of this into account, I consider the goods to be dissimilar.

54. That leaves "Chemicals for use in photography", "Chemicals for use in the electrical industry", "Chemicals for use in the gas industry", "Chemicals used in photography" and "Coatings for weatherproofing [chemicals]" in the applicant's specification. At the hearing, Ms Reynolds suggested that the key element of overlap in respect of these goods was that they could all cover rubber-based products. Consequently, Ms Reynolds submitted that there was overlap in nature with the

opponent's goods. In this regard, Ms Reynolds directed me to the decision of the EUIPO in *Industrias Quimicas Lowenberg, S.L. v KBM Spolka z o.o.* (Opposition No. B 1 656 993). In that case, the EUIPO considered the similarity of goods such as "chemicals used in industry" and "adhesives of all kinds", both in class 1. The following finding was made:

"The contested goods [...] are similar to the opponent's goods [...]. The adhesives have or can have a chemical origin and the same or similar composition and their main purpose is to be used in different industrial processes for the manufacture of a wide variety of goods (foodstuffs, paints, metals etc). The priming preparations and the impregnating agents are also chemical products which can be used in parallel with the adhesives. They may be manufactured and trade by the same undertakings and distributed through the same channels. Therefore, it is clear that these goods are at least similar."

Firstly, decisions of the EUIPO are not binding on this Tribunal. Secondly, I note that the adhesives being considered in that case were those registered in class 1, which would not include the stationary adhesives for which the opponent's mark is registered. However, I recognise that the same argument with regard to a degree of overlap in nature may still apply to the opponent's goods. I do not consider that any overlap in trade channels, user, purpose or method of use is likely to exist. Taking all of this into account, I consider the goods to be dissimilar.

### Class 17

55. The following goods in the applicant's specification are all types of adhesive:

Flexible adhesive rubber tape to fix objects together temporally; Non permanent rubber strong adhesive used to connect objects; Butyl tape used as adhesive to connect objects; Duct tape; Duct tapes; Gaffer tape; Self-adhesive tapes [other than for stationery, household or medical purposes]; Self-adhesive tapes, other than stationery and not for medical or household purposes; Tapes (Adhesive -), other than stationery and not for medical or household purposes;

These goods will overlap in use with the opponent's goods to the extent that they are all intended to stick one object or material to another. There may also be overlap in user, as these terms are broad enough to cover goods that may be used by the general public. Further there may be overlap in nature and method of use. There may be a degree of overlap in trade channels, although any such overlap is likely to be limited. Taking all of this into account, I consider the goods to be similar to at least a medium degree.

56. "Butyl tape used as adhesive to mount photographic and scientific equipment", "Impervious adhesive strips for edging of roofs", "Impervious adhesive strips for ridge tiling" and "Impervious adhesive strips for valley channels" in the applicant's specification all overlap in purpose with the opponent's goods to the extent that they are all adhesives. However, their specific purposes are clearly different. They are unlikely to overlap in user, as the applicant's goods are aimed at professionals. However, I recognise that there may be some overlap to the extent that the general public may use the goods for hobbies or DIY. There may be some overlap in nature, but the method of use and trade channels are likely to differ. Taking this into account, I consider the goods to be similar to a low degree.

57. That leaves the following goods in the applicant's specification:

Anti-vibration tape; Articles made of rubber for jointing purposes; Articles made of rubber for sealing; Butyl rubber (Liquid -); Caulking; Caulking compounds; Caulking materials; Chemical compositions for preventing leaks; Chemical compositions for repairing leaks; Dust proofing sealants; Electrical insulating materials; Fluid seals; Fluoro rubber; Glazing tapes; India rubber; Joint filling compounds; Joint packing; Joint packings; Joint sealants; Joint sealing compounds; Jointing compound; Non-metallic sealing compounds for joints; Non-metallic seals [not stamps]; Rubber; Rubber compounds for industrial use; Rubber for electrical insulation; Rubber for use in manufacture; Rubber in liquid form; Rubber (Liquid -); Rubber sealants for joints; Rubber (Synthetic -); Rubber tape for insulating; Sealants for buildings; Sealants for joints for building purposes; Sealants for sealing joints; Sealants for seams in vehicle bodywork; Sealing agents for use in the building industry; Sealing agents for use in the



construction industry; Sealing compounds; Sealing elements consisting of rubber; Sealing putty; Sealing strips made of synthetic rubber; Silicone rubber; Waterproof membranes of rubber.

I recognise that there may be some degree of overlap with the opponent's goods in respect of their nature. For example, the opponent's specification could cover adhesive tapes, which would overlap in nature with "anti-vibration tape". Similarly, the opponent's specification could cover rubber-based adhesives, which would overlap in nature with some of the applicant's rubber-based goods (or that could include rubber-based goods such as "jointing compound"). However, this is not sufficient on its own for a finding of similarity. The purpose, user, method of use and trade channels of these goods is likely to differ. There will be no competition or complementarity. Taking all of this into account, I consider the goods to be dissimilar.

58. As some degree of similarity between the goods is necessary to engage the test for likelihood of confusion<sup>20</sup>, the opposition must fail in respect of those goods that I have found to be dissimilar.

### **The average consumer and the nature of the purchasing act**

59. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

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<sup>20</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

60. The average consumer for the goods will be either a member of the general public or a trade professional. The cost of the purchase is likely to vary significantly from stationary adhesives (which will be of a fairly low cost) to industrial adhesives (which may be significantly more expensive). Similarly, the frequency of the purchase is likely to vary. In all cases, I consider that various factors will be taken into account such as the strength of the product, its nature (such as whether it is a tape or liquid adhesive) and whether it is suitable for the user’s particular requirements. Consequently, I consider that a medium degree of attention will be paid during the purchasing process. However, I recognise that for some of the goods I have found to be similar (such as those that may be used in building construction) the level of attention paid will be higher due to the need to ensure that the necessary safety standards are complied with.

61. The goods are likely to be purchased by self-selection from the shelves of a retail outlet, or their online or catalogue equivalents. The purchasing process will, therefore, be predominantly visual. However, I recognise that advice may be sought from retailers or orders may be placed by telephone. Consequently, I do not discount that there may also be an aural component to the purchase of the goods.

### **Comparison of trade marks**

62. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means

of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

63. 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.

64. The respective trade marks are shown below:

<b>Opponent's trade mark</b>	<b>Applicant's trade mark</b>
BLU-TACK	Black Tack

65. The applicant's mark consists of the words Black Tack, presented in title case. The overall impression of the mark lies in the combination of these words. The opponent's mark consists of the words BLU-TACK, presented in upper case. The overall impression of the mark lies in the combination of these words.

66. Visually, the marks overlap in that both end with the word TACK/Tack. They also both begin with the letters BL-. They differ in that these letters are followed by -U in the opponent's mark and -ACK in the applicant's mark. There is also a hyphen in the opponent's mark which is absent from the applicant's mark. In this regard, Ms Reynolds directed me to a number of authorities. In particular, I note the judgment of Lewison J, in *International Business Machines Corporation and Another v Web-Sphere Ltd and Others* [2004] EWHC 529 (Ch), in which he considered whether the presence of a hyphen prevented marks from being considered identical. In that case, he made the following finding:

“I regard the presence of the hyphen in the sign as an insignificant difference which would go unnoticed by the average consumer.”

I consider that the presence of the hyphen in the opponent’s mark in this case will similarly be overlooked by the average consumer. Registration of a word only mark covers use of that word in any standard font or case and so I do not consider that the presentation in upper case and title case amounts to a visual difference between the marks. I consider the marks to be visually similar to between a medium and high degree.

67. Aurally, the opponent’s mark will be pronounced BLOO-TAKK. The applicant’s mark will be pronounced BLAK-TAKK. The second syllable will be pronounced identically, as will the first part of the first syllable. The marks differ in the pronunciation of the end of the first syllable (AK/OO). I consider the marks to be aurally similar to between a medium and high degree.

68. Conceptually, I consider that the word TACK/Tack in both marks will be viewed as a reference to something that is sticky or the action of securing something in place. The word BLACK in the applicant’s mark will clearly be recognised as a colour. I consider that the word BLU in the opponent’s mark is likely to be recognised as a misspelling of the colour BLUE. Taking this into account, I consider the marks to be conceptually similar to between a medium and high degree.

### **Distinctive character of the earlier trade mark**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

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

71. I will begin by assessing the inherent distinctive character of the earlier mark. The word "tack" is clearly allusive for adhesive goods. However, in my view, it is not a word that would be directly descriptive (such as GLUE or ADHESIVE). The word "BLU", although a misspelling, is likely to be seen as indicating the colour of the products sold under the mark. I do not consider that the use of a hyphen contributes to the mark's distinctive character. Taking all of this into account, I consider the mark to be inherently distinctive to between a low and medium degree.

72. I turn now to the question of whether the distinctive character of the mark has been enhanced through use. At the hearing, Mr Coyle made the following submission:

"I appreciate that my position makes it somewhat more difficult than the opponent, based on the fact that we all know that the opponent's mark is a

famous mark, is a mark of repute, is an iconic mark. There is little point in denying or disputing that. Everybody knows BLU-TACK. Everybody.”

73. There does, therefore, appear to be an admission on the part of the applicant that the opponent’s mark has acquired at least some distinctive character through use. Further, the admission that the opponent’s mark is ‘iconic’ would suggest that the admission is that the distinctiveness of the opponent’s mark has been enhanced to a high degree through use. In any event, I consider that the opponent’s evidence is supportive of that finding.

74. The opponent’s evidence shows that in 2004 the BLU-TACK brand enjoyed a 94% market share of the “office adhesives re-usable tack market”. By the time of Mr Whitehouse’s statement, he confirms that the opponent enjoys a 71% market share of the “adhesive putty market” in the UK. This is, clearly, a significant market share. The opponent has provided a sample of 4 invoices showing 22,000 units sold to locations across the UK and Mr Whitehouse confirms that annual UK sales in the years 2012-2013 to 2018-2019 were £4.5million and for the years 2010-2011 to 2011-2012 were £3.5million. Clearly, these are not insignificant sums. However, as noted by Mr Whitehouse, they represent significant unit sales given that the products sold under the BLU-TACK mark sell for between £0.35 and £0.70 each.

75. I do note that the opponent’s evidence regarding marketing and advertising expenditure has some flaws, with a number of exhibits not referring to the mark relied upon, being dated after the relevant date or not clearly referring to advertising in the UK. However, there are examples of the mark relied upon being used in a range of publications (including some national publications) such as The Times in December 2017, The Daily Mail in September 2016 and The Independent in May 2016. A publication from Superbrand described the opponent’s mark as “a household name” and noted that the brand had, by 2004, been engaged in publicity campaigns involving the RSPCA and the World Snooker Champion. Further in 2007, an artist made a sculpture made entirely of the opponent’s product, which was displayed at the popular tourist destination ZSL London Zoo. There is also an example of the opponent’s mark being referred to as part of a Big City Radio competition. Taking all of the evidence

into account, I am satisfied that the distinctive character of the opponent's mark has been enhanced to at least a fairly high degree through use.

### **Likelihood of confusion**

76. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

77. I have found the marks to be visually, aurally and conceptually similar to between a medium and high degree. I have found the earlier mark to have between a low and medium degree of inherent distinctive character, which has been enhanced to at least a fairly high degree through use. I have identified the average consumer to be a member of the general public or a trade professional who will generally pay a medium degree of attention during the purchasing process. However, I recognise that for some of the goods a higher degree of attention may be paid. I consider that the purchasing process will be predominantly visual, although I do not discount an aural component. I have found the parties' goods to vary from being similar to at least a medium to similar to a low degree (except for those that I have found to be dissimilar).

78. At the hearing, Ms Reynolds suggested that there is evidence that confusion has already occurred because the opponent's and applicant's products are listed on Amazon as commonly being viewed or purchased together (or by the same

consumers). However, in my view, this is not evidence of confusion per se. It may be evidence that consumers consider the products to be comparable, but we have no way of knowing merely from that evidence, whether the consumers in question considered the goods to originate from the same or economically linked undertakings. I do not, therefore, consider this line of argument to be of assistance to the opponent.

79. Similarly, as noted above, the applicant has filed email evidence from customers who state that they do not consider the marks or goods in issue to be confusingly similar. One of these individuals has never heard of the opponent's mark. I have already concluded that little weight should be attributed to these emails. However, even if I am wrong, I do not consider them to be of assistance to the applicant in demonstrating that there is no likelihood of confusion. The absence of actual confusion in the marketplace may be for any number of reasons, such as the way in which the marks are presented in practice or the goods on which they have been used.<sup>21</sup> In any event, such a small number of emails cannot be said to be indicative of the perception of the average consumer.

80. At the hearing, Mr Coyle made several references to the fact that the opponent's brand was particularly well-known. There seemed to be some suggestion on the part of the applicant, that this would make it less likely that there could be confusion amongst consumers i.e. because such an iconic brand would not wish to change its mark to include a different colour (such as the applicant's mark). For example, Mr Coyle submitted:

“Taking the combined words and the addition of the hyphen for the opponent and no hyphen for the applicant and the fact that there are two distinct colours, in my view, highlights the importance of the lack of likelihood of confusion, especially when you highlight and underline the iconic nature of the BLU-TACK brand and how consumers visualise and see this brand.”

81. The case law is clear that the higher the degree to which the distinctive character of a mark has been enhanced through use, the more likely it is that there will be a

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<sup>21</sup> *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220



likelihood of confusion. Inevitably, marks that are very well known will enjoy a greater penumbra of protection than those that are not. Whilst I can understand the logic behind the submission that the more time and money invested in a mark, the less likely it is that a business will divert from or vary that mark, such an approach would be to hold the reputation of its mark against the opponent. This cannot be the correct approach to take. I do not, therefore, consider that this line of argument assists the applicant.

82. Clearly, there are visual, aural and conceptual similarities between the marks. Both marks begin with a colour (albeit a misspelling of a colour in the opponent's case) that begin with the letters BL- and end with the word TACK. The presence of the hyphen in the opponent's mark is likely to be overlooked by the average consumer. Bearing in mind the principle of imperfect recollection, I consider it likely that the average consumer will misremember or mistakenly recall the marks. It is entirely possible, that the average consumer will recall that the mark is a colour plus the word TACK, but not remember the exact colour used. For that reason, I consider there to be a likelihood of direct confusion for those goods that are similar to at least a medium degree. I recognise that for goods such as those to be used in construction, where a higher degree of attention will be paid, there is unlikely to be direct confusion. Further, I consider that where the goods are similar to only a low degree, the differences between the goods will be sufficient to offset the similarities to between the marks and to avoid a likelihood of direct confusion.

83. Both marks are a combination of a colour and the word TACK, which although allusive cannot be said to be a direct descriptor of the products in question (such as GLUE or ADHESIVE). I am mindful that it is the distinctiveness of the common elements that are key.<sup>22</sup> Inherently, the combination of a colour and a word which is allusive is only distinctive to between a low and medium degree. However, the distinctiveness of that combination has been enhanced to at least a fairly high degree through use. I recognise that the opponent has pointed to examples of its products being used in different colours. However, these are referred to as Blu Tack Pink or Blu Tack White rather than Pink Tack/White Tack. I do not, therefore, consider that there

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<sup>22</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

is any evidence that the opponent has already used such variant marks. However, it is that pattern (colour plus the word TACK) which is present in the applicant's mark and, in my view, it is entirely likely that such a mark would lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. For example, the use of a different colour may be seen as indicating a different product range, such as goods of different strength or for different uses. In my view, there is a likelihood of indirect confusion in respect of those goods that are similar to at least a medium degree. Where the goods are similar to only a low degree, I consider that the differences between them will be sufficient to offset the similarities between the marks. For goods that I have found to be similar to only a low degree, there is no likelihood of confusion.

84. The opposition based upon section 5(2)(b) succeeds in respect of the following goods:

Class 1      Non permanent rubber strong adhesive used to connect objects; Butyl tape used as adhesive to connect objects; Adhesives for paperhanging.

Class 17      Flexible adhesive rubber tape to fix objects together temporally; Non permanent rubber strong adhesive used to connect objects; Butyl tape used as adhesive to connect objects; Duct tape; Duct tapes; Gaffer tape; Self-adhesive tapes [other than for stationery, household or medical purposes]; Self-adhesive tapes, other than stationery and not for medical or household purposes; Tapes (Adhesive -), other than stationery and not for medical or household purposes.

#### **Section 5(4)(a)**

85. Section 5(4)(a) states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

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

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

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

87. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and referred to the following summary of the position as set out by Mr Allan James, acting for the Registrar, in *SWORDERS TM O-212-06*:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see

Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

88. In this case, the applicant does claim to have been using their mark prior to the relevant date. Indeed, the use that the applicant has made of its mark forms part of the basis of the opponent’s case. However, it is not clear to me when that use started. Mr Burton states that he has been a Director of the applicant since 2010, but it is not clear whether the mark was already in use by that time or whether it came into use some time later. I will consider the position as at the application date i.e. 29 January 2020 (the First Relevant Date) and will return to consider whether the position would have been any different at the earliest date mentioned in the evidence i.e. August 2010 (the Second Relevant date).

## **Goodwill**

89. I bear in mind the guidance set out in the judgment of the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), by Pumfrey J in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC) and by Floyd J (as he then was) in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat).

90. Goodwill arises as a result of trading activities. It is clear to me from the evidence filed that the opponent has been trading for a number of years. The opponent has filed evidence of sales in the form of invoices dated prior to the relevant date and has given information about annual sales in the UK, which amount to millions of pounds each year. Taking all of this into account, I am satisfied that the opponent has at least a fairly significant degree of goodwill in the UK for adhesive materials for stationery purposes. There is also evidence of both the signs BLU-TACK and BLU TACK (presented in different cases) being used by the opponent throughout its evidence. I do not consider that the addition of the hyphen impacts upon this finding. The sign BLU-TACK was clearly distinctive of the opponent’s goodwill at the First Relevant

Date. Given the evidence about the length of time that the opponent has been trading under the sign and the evidence of sales figures over a number of years and marketing activities undertaken as early as 2004, I do not consider that the position would have been any different at the Second Relevant Date.

### **Misrepresentation and damage**

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

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

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

92. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here. Where the goods for which the opponent has shown goodwill are similar to at least a medium degree to the goods of the applicant, I consider that a substantial number of members of the relevant public would be misled into purchasing the applicant’s goods in the mistaken belief that they are the goods of the opponent. This is because both marks share the common element TACK plus a colour beginning with BL-. Damage through diversion of sales is easily foreseeable. However, in the case of those goods that are similar to only a low degree or are dissimilar, I consider that this distance between the parties’ respective fields of activity will offset the similarity of the marks. The differences between the goods means that it is difficult to envisage any logical damage arising.

93. The opposition based upon section 5(4)(a) of the Act succeeds in relation to the following goods:

Class 1        Non permanent rubber strong adhesive used to connect objects; Butyl tape used as adhesive to connect objects; Adhesives for paperhanging.

Class 17       Flexible adhesive rubber tape to fix objects together temporally; Non permanent rubber strong adhesive used to connect objects; Butyl tape used as adhesive to connect objects; Duct tape; Duct tapes; Gaffer tape; Self-adhesive tapes [other than for stationery, household or medical purposes]; Self-adhesive tapes, other than stationery and not for medical or household purposes; Tapes (Adhesive -), other than stationery and not for medical or household purposes.

### **Section 5(3)**

94. Section 5(3) of the Act states:

“5(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 repute of the earlier trade mark.”

95. As noted above, the opponent’s mark qualifies as an earlier trade mark by virtue of its filing date.

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

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

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

(i) 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*).

97. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the types of damage claimed will occur and/or that the applicant's mark will, without due cause, take unfair advantage of the reputation and/or distinctive character of the reputed mark. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the date of the application - 23 January 2019.

## **Reputation**

98. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take into account all of the evidence including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it."

99. I summarised the opponent's evidence of use at paragraphs **74 and 75** above. Clearly, the opponent has sold a significant number of units under the mark in issue, given the extent of sales made and the low cost of each individual product. Further, there is evidence of goods being sold around the country and a significant market share for the particular sector within which the opponent operates. I recognise that there are some issues with the opponent's evidence regarding marketing and

advertising. However, the opponent's mark was referenced in a number of national newspapers and, in Mr Coyle's words, has become "iconic". Taking all of this into account, I consider that the opponent has demonstrated at least a fairly strong reputation in adhesives for stationery purposes.

## **Link**

100. 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

For the reasons set out earlier, I consider the marks to be visually, aurally and conceptually similar to between a medium and high degree.

### 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

I have found that the goods vary from being dissimilar to similar to at least a medium degree.

### The strength of the earlier mark's reputation

The opponent's mark has at least a fairly strong reputation in the UK.

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

The opponent's marks have a low to medium degree of inherent distinctive character which has been enhanced to at least a fairly high degree through use.

### Whether there is a likelihood of confusion

I have found there to be a likelihood of confusion in respect of those goods that are similar to at least a medium degree.

101. I find that a significant part of the public concerned with the goods will make a link between the earlier mark and the application. Even where the applicant's specification covers goods that are dissimilar, there is still some overlap in either nature or purpose. Taking this into account, I consider that the strength of the opponent's reputation is such that the requisite link will still be made.

### **Damage**

102. I must now assess whether any of the three pleaded types of damage will arise.

### Detriment to Reputation

103. In its counterstatement, the opponent states:

“Detriment will arise because the Opponent is not able to control the quality and image of the Applicant's Black Tack brand, thus facing potential damage to the BLU-TACK brand image. For example, if a consumer has a negative experience in relation to the goods covered by the Applicant's mark, they may think badly of the Opponent's mark, resulting in lost sales, lost opportunities and general damage to the brand.”

104. At the hearing, I noted that it is generally accepted that this type of hypothetical damage to reputation because of the potential for goods to be of poor quality is not sufficient to amount to damage for the purposes of section 5(3). I invited Ms Reynolds to direct me to any case law that she considered might support her case in this regard, but she was content to rely on the submissions that had already been made in her skeleton argument and at the hearing. In particular, I am mindful of the decision of Ms Anna Carboni, sitting as the Appointed Person in *United The Union v The Unite Group Plc*, Case BL O/219/13, in which she considered whether a link between an earlier

mark with a reputation and a later mark with the mere potential to create a negative association because of the identity of the applicant or the potential quality of its goods/services was sufficient to found an opposition based on detriment to reputation. She stated:

“46. Indeed, having reviewed these and other opposition cases, I have not found any in which the identity or activities of the trade mark applicant have been considered in coming to a conclusion on the existence of detriment to repute of an earlier trade mark. I can understand how these matters would form part of the relevant context in an infringement case, but I have difficulty with the notion that it should do so in an opposition. After all, many, if not most, trade mark applications are for trade marks which have not yet been used by the proprietor; some are applied for by a person or entity that intends to license them to a third party rather than use them him/itself; and others are applied for by an entity that has only just come into existence.

47. I do not exclude the possibility that, where an established trading entity applies to register a mark that it has already been using for the goods or services to be covered by the mark, in such a way that the mark and thus the trader have already acquired some associated negative reputation, perhaps for poor quality goods or services, this fact might be taken into account as relevant “context” in assessing the risk of detriment to repute of an earlier trade mark. Another scenario might be if, for example, a trade mark applicant who was a known Fascist had advertised the fact prior to the application that he was launching a new line of Nazi memorabilia under his name: I can see how that might be relevant context on which the opponent could rely if the goods and services covered by the application appeared to match the advertised activities. But I would hesitate to decide an opposition on that basis without having had confirmation from a higher tribunal that it would be correct to take such matters into account.”

105. The applicant does appear to have been trading prior to the relevant date. However, there is no suggestion and no evidence to demonstrate that its goods are of inferior quality or that the applicant (or its goods) have acquired a negative reputation.

Consequently, I do not consider that the opponent has been successful in demonstrating that use of the applicant's mark would, without due cause, lead to damage to the opponent's reputation.

### Unfair Advantage

106. Unfair advantage has no effect on the consumers of the earlier mark's goods. Instead, the taking of unfair advantage of the distinctive character of reputation of an earlier mark means that consumers are more likely to buy the goods of the later mark than they would otherwise have been if they had not been reminded of the earlier mark.

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

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

108. The opponent claims that the applicant will “be effectively using the Opponent's renowned mark as a vehicle for generating consumer interest in its own goods.”. The opponent also submits:

“The advantage for the Applicant arises in the substantial saving on investment in publicity and promotion of its own goods, since it is able to “free ride” on the efforts already undertaken in establishing the repute in the Opponent’s mark. It will be unfair since the reward for the costs of promoting, maintaining and enhancing the BLU-TACK trade mark belongs to the Opponent.”

109. Further, at the hearing, Ms Reynolds submitted:

“[...] The applicant is exploiting the widely known BLU-TACK brand to benefit their own marketing efforts and, therefore, using the BLU-TACK brand as a method for generating consumer interest in its own goods.

This obviously gives the applicant an advantage in its brand strategy, which is as a result not of its own efforts, but of the efforts and the strong reputation of the BLU-TACK brand itself. This type of behaviour is demonstrated in the evidence, [...] there are online listings for the BLACK TACK branded products on Amazon and eBay which refer to the BLU-TACK branded product as part of the product descriptions [...].”

110. As Ms Reynolds points out, there are examples in the opponent’s evidence of the applicant using the opponent’s mark to describe its products i.e. “like blue tack, but a lot stronger & stickier”. In my view, this is a clear attempt by the applicant to take unfair advantage of the opponent’s reputation. I recognise that the evidence itself was undated, but notwithstanding that, it does in my view cast light upon the applicant’s intention at the relevant date. By using the opponent’s mark to describe their goods in this way, the applicant is securing a commercial advantage by conveying a clear message to the consumer about the nature and purpose of the goods they are selling, without having to engage in costly and time consuming marketing activities. It is the strength of the opponent’s reputation that makes the comparison with its mark so beneficial and desirable for the applicant. This gives the applicant a clear advantage in both time and financial savings. As this is a clear example of an attempt to take unfair advantage on the part of the applicant, I consider that the whole application has the potential to gain from this image transfer, given that the goods all overlap in either

nature or purpose, even where they have not been found to be similar. As a result, this head of damage is made out.

111. The opposition based upon section 5(3) is successful in its entirety. As I have found in favour of the opponent under this head of damage, I do not consider it necessary to go on to consider the final head of damage (detriment to distinctive character).

### **Section 3(6)**

112. Section 3(6) of the Act reads as follows:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

113. The relevant case-law covering trade mark applications made in bad faith can be found in the following cases: *Chocoladefabriken Lindt & Sprüngli*, CJEU, Case C 529/07, *Malaysia Dairy Industries*, CJEU, Case C-320/12, *Koton*, CJEU, Case C-104/18P, *Sky v Skykick*, CJEU, Case C-371/18, *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16), *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch), *Copernicus-Trademarks v EUIPO*, General Court of the EU, Case T-82/14, *Daawat Trade Mark*, The Appointed Person, [2003] RPC 11, *Saxon Trade Mark*, [2003] EWHC 295 (Ch), *Mouldpro ApS v EUIPO*, General Court of the EU, Case T-796/17, and *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). The law appears to be as follows:

(a) While in everyday language the concept of ‘bad faith’ involves a dishonest state of mind or intention, the concept of bad faith in trade mark law must be understood in the context of trade: *Sky* CJEU.

(b) Where an applicant does not intend to engage in fair competition under the applied-for mark, but intends to use the trade mark to undermine the interests

of third parties, contrary to honest practices, then the application is made in bad faith: *Sky* CJEU.

(c) This may apply even where the applicant was not targeting a specific third party if, or to the extent that, the exclusive right was sought for purposes other than the recognised functions of a trade mark, e.g. as part of a strategy of using widely cast trade mark registrations as legal weapons for use against others in opposition proceedings and/or for the purposes of blocking applications by third parties: *Sky* CJEU (examples from *Sky* EWHC and *Copernicus-Trademarks v EUIPO*).

(d) A trade mark may be applied-for in good faith in relation to some of the goods/services covered by the application, and in bad faith as regards others: *Sky* CJEU.

(e) Applying to register a trade mark without an intention to use it is not bad faith per se. Therefore, it is not necessary for the trade mark applicant to be using, or have plans to use, the mark in relation to all the goods/services covered by the specification. However, where there is no such use, nor plans for such use, then unless there was a commercial rationale for including particular goods/services, the application may be treated as having been made wholly or partly in bad faith: *Sky* CJEU.

(f) This may apply where the applicant has included a specific term in the specification, such as 'computer games', with no intention of ever using the mark in relation to such goods. It may also apply where the applicant has included a broad term, such as 'computer software', with the intention of using the mark in relation to a particular sub-category of such goods/services, but no intention of using (and no commercial rationale for registering) the mark in relation to all the other sub-categories of goods/services covered by the broad term: *Sky* EWHC.

(g) In deciding whether the applicant had a commercial rationale for applying to register the trade mark in relation to any particular term, it is necessary to bear



in mind that trade mark proprietors have a legitimate interest in seeking protection in respect of goods or services in relation to which they may wish to use the trade mark in question in future (even if there were no plans to use the mark in relation to the goods/services at issue at the time of filing the application): *Sky EWHC*. It is therefore relevant to consider how similar (or not) the goods/services in the contested application are to those for which the mark has been used, or for which the applicant had plans to use the mark.

114. The following points are apparent from earlier case law about registering trade marks in bad faith:

(a) Although it may be a relevant factor, the mere fact that the applicant knew that another party was using the trade mark in another territory does not establish bad faith: *Malaysia Dairy Industries*.

(b) Similarly, the mere fact that the applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55). The applicant may have reasonably believed that it had the right to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.

(c) However, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat*, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited*.

(d) An application may also have been filed in bad faith where the applicant acted in breach of a general duty of trust as regards the interests of another party, including his or her own (ex) company or (ex) partners, or a party with whom there is, or had recently been, a contractual or pre-contractual

relationship, such as a licensor, prospective licensor or overseas principal: *Saxon, Mouldpro*; or where a legal agreement prohibits such a filing.

115. The correct approach to the assessment of bad faith claims requires the following points to be taken into account:

(i) The applicant's intention is a subjective factor which must be determined objectively by the competent authority. An overall assessment is required, which must take account of all the factual circumstances relevant to the particular case: *Lindt*.

(ii) The matter must be judged at the relevant date, which is the date of the application for registration: *Lindt*.

(iii) It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull*. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani*.

(iv) A statement on the application form that the mark is in use, or there is a bona fide intention to use it may, if untrue, provide evidence supporting a bad faith case, but is not sufficient by itself to justify the refusal or cancellation of the registration: *Sky* CJEU.

(v) An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

116. The opponent's 3(6) case appears to me to have two key limbs: 1) that the applicant applied for goods that it has not used and has no intention to use and 2) the applicant has filed for the goods that it has in an attempt to avoid detection by the opponent which amounts to an abuse of the trade mark system. The opponent claims that the applicant specifically avoided filing in class 16 (which it claims would be the

more appropriate class given the goods which the applicant is actually selling) to attempt to avoid detection by the opponent.

117. In its counterstatement, the applicant states:

“23. It is denied that the Application was filed in bad faith and it is also denied that the Applicant has no intention of using the Application for the applied goods. The Applicant has been using the goods in the Application for over 5 years.”

118. In his skeleton argument, Mr Coyle submitted:

“28. The Opponent has been unable to present a case that the Applicant’s only objective in filing the Application was to undermine the Opponent’s business. The contrary, the Applicant is a specialist provider of goods and does not seek to undermine any business, not least those of third parties such as the Opponent. The Applicant has sought registration in respect of its specialist goods, which its class specification expressly reflects.”

119. There is certainly an argument that class 16 would have been the most appropriate class given the goods that the evidence shows the applicant is actually selling. However, as Mr Coyle submitted at the hearing, there are examples of goods covered by the applicant’s specification which relate to the product actually being sold by the applicant. For example, I note that “adhesives for paperhanging” and “adhesives for use in photography” in class 1 appear to fairly squarely cover the goods sold by the applicant under its mark. This does not, therefore, appear to me to be a case of a specification which is entirely unrelated to the goods being sold by the applicant, but rather whether the correct class has been selected. That is not, in itself, bad faith. The applicant may currently only be using its mark in relation to a limited number of the goods covered by its specification, but it may have some intention to use those goods in the future or, indeed, some other reasonable commercial rationale for applying for the goods that it has. I recognise that some of the goods covered by the applicant’s specification are somewhat further removed from the goods it is actually using but they are not entirely unrelated.

120. That brings me on to the question of whether the applicant's decision not to file in class 16 (the same class in which the opponent's mark is registered) amounts to an attempt to avoid detection by the opponent and therefore an abuse of the trade mark system. I note that, despite the opponent's allegations of bad faith, no substantive explanation seems to have been put forward by the applicant about its rationale for choosing the classes it has or, indeed, the particular goods that it has. Nonetheless, the burden is on the opponent to prove its allegation of bad faith. Only once a prima facie case has been made out does the question of the applicant's rebuttal (or lack of) become relevant.

121. I consider it likely that the applicant has been particularly careful in selecting the goods and classes that it has for the purposes of its application. The decision to file in classes 1 and 17, but to avoid class 16 altogether, despite it presenting goods that might be appropriate to the applicant's business could reasonably have been taken in order to avoid potential conflict with the opponent. Further, the inclusion of limitations such as "other than for household or stationery use" could, as the opponent suggests, have been included to try to minimise conflict with the opponent's specification. However, they could also have been included to reflect the goods covered by the different classes (i.e. with class 17 specifically excluding adhesive tapes for stationery or household purposes). In my view, there is no doubt that the applicant has attempted to use the trade mark system to its full advantage. However, I am mindful that an allegation of bad faith is a serious one and one that should be properly evidenced. I do not consider that the opponent has gone far enough to successfully demonstrate a prima facie case of bad faith on the part of the applicant. Whilst it may be that the applicant has selected the goods applied for with the avoidance of conflict in mind and whilst some of those goods may be unlikely to be used by the applicant in practice, the applicant would have 5 years in which to use its mark and the goods are not so far removed from its current offering as to make it impossible for future expansion plans or some commercial rationale to be behind their selection.

122. The opposition based upon section 3(6) of the Act is unsuccessful.

## CONCLUSION

123. The opposition is successful in its entirety and the application is refused.

## COSTS

124. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£2,350**, calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£400
Preparing evidence, considering the applicant's evidence and filing evidence in reply	£950
Preparing for and attending the hearing and filing a skeleton argument	£800
Official fee	£200
<b>Total</b>	<b>£2,350</b>

125. I therefore order My Shadow Limited to pay Bostik Limited the sum of £2,350. This sum should be paid within 2 months of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 23<sup>rd</sup> day of June 2020**

**S WILSON**

**For the Registrar**