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**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK REGISTRATION NO. 3272003  
IN THE NAME OF TIK TOK INTERNATIONAL LIMITED  
FOR THE TRADE MARK**

**TIK TOK**

**AND THE APPLICATION FOR INVALIDATION THEREOF  
UNDER NO. 503396  
BY  
TIKTOK INFORMATION TECHNOLOGIES UK LIMITED**

## Background and pleadings

1. Tik Tok International Limited is the registered proprietor (“RP”) of the UK trade mark no. 3272003, for the mark **TIK TOK**, which is registered in class 42 for *Compilation of information relating to information technology*. The mark was filed on 21 November 2017 and registered on 20 April 2018.

2. TikTok Information Technologies UK Limited (“the cancellation applicant”) seeks invalidation of the registered trade mark under section 5(2)(a) of the Trade Marks Act 1994 (“the Act”) and relies on its EU Trade Mark No. 17891401, the details of which are set out below.

### **TIK TOK**

Filing date: 24 April 2018

Priority date: 23 October 2017

Registration date: 29 November 2018

*Class 9: Application software; application software for smart phone; downloadable computer software applications; downloadable smart phone application (software).*

*Class 38: Providing access to internet application services for communications; SMS/application message sending services via PC (personal computer); transmission of application information via internet; Providing access to search services of smart phone applications; communication via virtual private networks [VPN]; electronic delivery of images and photographs via a global computer network; data transmission and telecommunication services; telecommunications services for providing access to data/sound or images; transmission of text/photo/video via the smart phone application; transmission of information via applications for smart phones; transmission, broadcasting and reception of audio, video, still and moving images, text and data; transfer of data via on-line services; Providing access to peer-to-peer (P2P) sharing services; providing access to a video sharing portal.*

*Class 41: Presentation of music videos via mobile device on online; providing of on-line electronic publications (not downloadable) via mobile devices; multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps, graphics, photographs, videos, music and electronic publications; electronic publication of information on a wide range of topics on-line; entertainment and amusement information via internet online.*

3. The cancellation applicant claims under section 5(2)(a) that the registered mark is identical to its earlier mark and has similar services to its own goods and services.

4. The RP filed a counterstatement in which it accepted that the respective trade marks are identical but denied that its services were similar to the goods or services of the cancellation applicant.

5. Throughout these proceedings the RP has been represented by Handsome I.P. Ltd and the cancellation applicant by Taylor Wessing LLP.

6. Both sides filed submissions and the cancellation applicant filed evidence. A hearing was requested and was held before me on 19 October 2021. The cancellation applicant was represented by Jamie Muir Wood of Counsel, appointed by Taylor Wessing LLP and the RP was represented by Victoria Jones of Counsel, appointed by Handsome I.P. Both sides filed skeleton arguments in advance of the hearing.

### **Preliminary issues**

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

### **Cancellation applicant's evidence**

8. The cancellation applicant provided evidence in the form of a witness statement from Robert Hawley, an attorney at Taylor Wessing LLP, who are the cancellation

applicant's legal representatives. Mr Hawley appended 8 exhibits. The declarant states that the evidence is intended to show a cross over between publication services and the information technology sector. To that end the exhibits consist of undated screenshots from companies such as WH Smith and magazine.co.uk, who display for sale a number of computer/IT magazines and companies such as which.co.uk and bit.ai blog which contain online articles relating to computer/IT matters. I do not find it necessary to list the exhibits in detail here but if required I shall refer to the evidence later in the decision.

### **Sections 5(2)(a)**

9. Section 5(2)(a) of the Act is as follows:

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

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

10. The leading authorities which guide me, although not all are applicable to section 5(2)(a), are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

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

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

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

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

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

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

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

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

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

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

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

### **Identity of the trade marks**

11. The RP acknowledges in its defence that the respective marks are identical.

### **Distinctiveness of the earlier mark**

12. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of the use made of it, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>1</sup>, 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-0000, 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

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<sup>1</sup> Case C-342/97

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).”

13. The cancellation applicant’s mark is invented and has no meaning in relation to the goods and services for which the mark is registered so I consider it to be inherently distinctive to a high degree.

### **Comparison of the goods and services**

14. In the judgment of the Court of Justice of the European Union in *Canon*<sup>2</sup>, the court stated at paragraph 23 of its judgment 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”.

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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

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<sup>2</sup> Case C-39/97

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *Avnet Incorporated v Isoact Limited*<sup>3</sup>, Jacob J. (as he then was) stated that:

“In my view, specification for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance as it were, the core of the possible meanings attributable to the rather general phrase”.

17. Also in *YouView TV Ltd v Total Ltd*<sup>4</sup> 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."

18. In *Sky v Skykick*<sup>5</sup> Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

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<sup>3</sup> [1998] F.S.R. 16

<sup>4</sup> [2012] EWHC 3158 (Ch)

<sup>5</sup> [2020] EWHC 990 (Ch)



- (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
- (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.
- (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.
- (4) A term which cannot be interpreted is to be disregarded.”

19. In *Kurt Hesse v OHIM*<sup>6</sup>, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*<sup>7</sup>, the General Court stated that “complementary” means:

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

20. In *Sanco SA v OHIM*<sup>8</sup>, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-O-255-13:

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<sup>6</sup> Case C-50/15 P

<sup>7</sup> Case T-325/06

<sup>8</sup> Case T-249/11

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

21. The respective goods and services to be compared are:

| <b>Cancellation Applicant’s goods and services</b>   | <b>RP’s services</b> |
|--|----------------------|
| <p><i>9: Application software; application software for smart phone; downloadable computer software applications; downloadable smart phone application (software).</i></p>   |                      |
| <p><i>38: Providing access to internet application services for communications; SMS/application message sending services via PC (personal computer); transmission of application information via internet; Providing access to search services of smart phone applications; communication via virtual private networks [VPN]; electronic delivery of images and photographs via a global computer network; data transmission and telecommunication services; telecommunications services for providing access to data/sound or</i></p> |                      |

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|--|--|
| <p><i>images; transmission of text/photo/video via the smart phone application; transmission of information via applications for smart phones; transmission, broadcasting and reception of audio, video, still and moving images, text and data; transfer of data via on-line services; Providing access to peer-to-peer (P2P) sharing services; providing access to a video sharing portal.</i></p>   |  |
| <p><i>41: Presentation of music videos via mobile device on online; providing of on-line electronic publications (not downloadable) via mobile devices; multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps, graphics, photographs, videos, music and electronic publications; electronic publication of information on a wide range of topics on-line; entertainment and amusement information via internet online.</i></p> |  |
|  | <p><i>42: Compilation of information relating to information technology.</i></p> |

22. The RP in its written submissions and skeleton arguments contends that I must have regard to the core meaning of its services, as per *Avnet*, which it states is the compilation of information, i.e. the act of bringing together a number of pieces of information into a single place. I understand the RP's submission on the point of the core meaning but I note that the specification does not state how the information is to

be compiled so it is unrestricted as to its breadth. However the specification states says that the information being compiled relates specifically to information technology and so I must have regard for the whole of the specification when making the comparison with the cancellation applicant's goods and services.

### Class 9

23. Starting with the comparison between the cancellation applicant's class 9 goods and the RP's services, the cancellation applicant contends in its written submissions:<sup>9</sup>

"The Applicant's software products are also unlimited as to subject matter, field(s) of use, or intended purpose. They are, however, undoubtedly IT products, and thus it is thus submitted by The Applicant that there is a high degree of overlap between its software products and the IT-specific services of The Proprietor, such that they are similar or, at the very least, have a high degree of complementarity".

24. I agree with the cancellation applicant's contention. The software referred to in class 9 could also be used for any purpose as the specification is unrestricted. Therefore, I find such software products could have the functionality of gathering and compiling information on any subject including those which relate to information technology topics. As such I consider there to be some overlap in nature, purpose and users between the goods and services. I find that the applicant's goods can be considered similar at least to a low degree to the RP's services.

### Class 38

25. Turning now to the comparison between class 38 and 42, the cancellation applicant, in its written submissions,<sup>10</sup> referred me to a UK IPO case, namely O-087-20 for the mark **muzmatch**, which considered the nature of the term "information provided on-line from a computer database or the internet". It submits that the hearing Officer in that case,

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<sup>9</sup> Written Submission dated 19 February 2021, paragraph 22

<sup>10</sup> Ibid, paragraphs 29-30

“found that the term 'Information provided on-line from a computer database or the Internet':

"suggests a service where information is held online and is provided in an accessible format for users to search or otherwise interrogate.

"Information" is an extremely wide term and I see no reason why it would not include the information about members of the opponent's dating/social networking services in class 45 held on a database.

Although not identical in purpose and nature, there is an overlap. The services are unlikely to be in competition as straight alternatives but it seems likely that there is a reasonably strong complementarity, as they are intrinsically linked and the provider is likely to be considered the same. They are similar to a medium degree." [emphasis added]

30. The word 'information' (within the phrase "Compilation of information") forms an integral element of the services of The Proprietor's Registration. In line with Ms Harrison's finding, the information being compiled could therefore relate to any aspect or feature of information technology; be it a product or service, or even a concept or new development or research project. “

26. Even taking the above into account, I find that the potentially closest of the cancellation applicant's services which have reference to 'information', namely *transmission of application information via internet; providing access to search services of smart phone applications; transmission of text/photo/video via the smart phone application; transmission of information via applications for smart phones; transfer of data via on-line services; providing access to peer-to-peer (P2P) sharing services; providing access to a video sharing portal* can be divided as per the transmission services and the access services. Essentially the transmission of information services to my mind takes place one step after the RP's core service of gathering information, albeit information about IT, in one place. Whereas I find the access services to be closer in nature and purpose to the RP's services of gathering data/information in one place. I do not think the current situation is quite on all fours with the **muzmatch** case. However again I find that there is a low degree of similarity

between *providing access to search services of smart phone applications; providing access to peer-to-peer (P2P) sharing services* and the RP's services.

#### Class 41

27. Finally with regard to the comparison between class 41 and 42, I find that the cancellation applicant's *electronic publication of information on a wide range of topics* which it identifies as it is closest service in this class to the RP's compilation services is not quite on fours. Publication, in my view, is about the presentation of information which is a step away from the compilation of information. I accept that the cancellation applicant's term is unlimited by subject matter as to what is being published but taking this into account, I find that the nature or purpose of the services are not the same. However, there may be some overlap of users at a general level and overall I find there is low degree of complementarity between the services as consumers may think that the same undertaking would be responsible for both gathering and publishing information on a particular topic.

#### **Average consumer and the purchasing process**

28. I next consider who the average consumer is for the contested services and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.<sup>11</sup> For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question<sup>12</sup>.

29. The average consumer for the services at issue will be a member of the general public as well as businesses or professional users, including IT professionals. The services are likely to be selected from a primarily visual means, for example by way of examining technical or more general information on technical specifications and functionality from an online or printed source, although I do not discount an aural element if advice is sought by consumers from technical sales staff. In addition, I find that as the contested services cover quite a breadth of activity, they could therefore

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<sup>11</sup> *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)

<sup>12</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97.

vary in price depending on the services. That said, consumers will need to establish as a minimum that the goods or services they are choosing meet their needs, say for example in terms of system compatibility and functionality for purpose, therefore they will be paying at least a medium degree of attention during the purchasing process.

### **Likelihood of confusion**

30. There is no scientific formula to apply in determining whether there is a likelihood of confusion. 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. It is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer and the nature of the purchasing process for the contested goods and services. In doing so, I must be aware 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 they have retained in their mind.

31. 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 and services down to the responsible undertakings being the same or related.

32. In the course of this decision I have found that,

- The marks are identical
- The earlier mark is inherently distinctive to a high degree
- The services of the cancellation applicant's classes 9 and 38 and the RP's class 42 are similar to a low degree and complimentary to a low degree between classes 41 and 42
- The average consumer will be paying at least a medium degree of attention in a primarily visual purchasing process

33. Having weighed all these relevant factors and bearing in mind the interdependency principle set out above, I reach the conclusion that there is a likelihood of direct confusion. The average consumer is likely to believe that, given the identity of the marks and the high degree of inherent distinctiveness of the earlier registration, the respective services identified above will be produced by the same or an economically linked undertaking in the information technology sector. I conclude this despite there being a low degree of similarity between the goods and the services, this is not sufficient to offset the identity of the marks in my view.

### **Conclusion**

34. The application for invalidation has succeeded in full and the RP's registered mark is declared invalid.

### **Costs**

35. As the cancellation applicant has been successful in its application to invalidate the registered mark, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. As the evidence provided by the cancellation applicant was undated and intended to be of a more illustrative nature, I do not think it appropriate to award full evidence costs on that particular element of the case. Bearing in mind the guidance given in TPN 2/2016 and the point about the evidence, I award costs as follows:

£200 Official fee for TM26(I) invalidity application

£200 Preparing statement of grounds

£400 Preparing written submissions and considering other party's submissions

£800 Hearing preparation and participation

**£1600 Total**

36. I order Tik Tok International Limited to pay TikTok Information Technologies UK Limited the sum of £1600. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.



**Dated this 16<sup>th</sup> day of December 2021**

**June Ralph  
For the Registrar,  
The Comptroller General**