

O/1067/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003495302

BY KINKABU LTD TO REGISTER:



AS A TRADE MARK IN CLASS 10

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 421170 BY CYBERNET ENTERTAINMENT LLC

AND IN THE MATTER OF TRADE MARK NOS.
UK00003239866, UK00914520795 AND UK00003250778
IN THE NAME OF CYBERNET ENTERTAINMENT LLC
FOR THE FOLLOWING TRADE MARKS:

KINK

IN CLASSES 5, 9, 10, 14,
16 & 25

Kink

IN CLASSES 5 & 10

KINK

IN CLASSES 35, 40 & 41

AND

THE APPLICATIONS FOR DECLARATIONS OF INVALIDITY
UNDER NOS. 503993, 503994 AND
503995 BY KINKABU LTD

BACKGROUND AND PLEADINGS

1. These are consolidated proceedings between KINKABU LTD (“Kinkabu”) and CyberNet Entertainment LLC (“CyberNet”). I will first set out the background regarding the parties’ marks before setting out the basis of each parties’ respective proceedings.

Kinkabu’s mark

2. On 31 May 2020, Kinkabu applied to register the following trade mark in the UK:



(“Kinkabu’s mark”)

3. The mark was published for opposition purposes on 19 June 2020. Kinkabu seeks to register its mark for the following goods:

Class 10: Condoms; Condoms for hygienic purposes; Condoms for medical purposes; Condoms for prophylactic purposes; Condoms having spermicidal properties; Adult sexual aids; Artificial penises [adult sexual stimulation aids]; Artificial penises, being adult sexual aids; Artificial vaginas, being adult sexual aids; Benwa balls, being adult sexual aids; Inflatable life-sized dolls used in sexual activity; Love dolls [sex dolls]; Penis enlargers, being adult sexual aids; Sex aids; Sex toys; Sexual activity apparatus; Sexual activity articles; Sexual activity devices; Vibrators, being adult sexual aids; Abdominal corsets; Anal plugs; Massage (Gloves for -); Massage apparatus [for medical purposes]; Massage apparatus for eyes; Massage apparatus, electric or non-electric; Massage appliances; Massage beds for medical purposes;

Massage chairs; Massage chairs with built-in massage apparatus; Massage mitts; Back massage apparatus; Battery-operated scalp massagers; Body massagers; Electric massage rollers; Electric scalp massagers for commercial use; Electric scalp massagers for household use; Foam massage rollers; Foot massage apparatus; Gloves for massage; Instruments for massage; Thermal massage pads; Vibration generating apparatus for massage.

CyberNet's marks

4. CyberNet is the registered proprietor of the following three UK trade mark registrations:

KINK

UK registration no. 3239866

Filing date 27 June 2017; registration date 10 November 2017

Registered for the following goods:

Class 5: Hygienic lubricants, sexual creams, sexual stimulants, sexual gels.

Class 9: Downloadable recordings in the field of adult entertainment; Digital recordings in the field of adult entertainment.

Class 10: Adult sexual stimulation aids in the nature of bondage goods namely restraints made of leather, metal, or plastic, rope made for restraining a person for sexual purposes as well as accessory items for restraints in the nature of gags, harnesses, hoods, spreader bars, blindfolds, strait jackets and spreader bars; Adult sexual stimulation aids; Vibrators, massaging tool for personal use, sex toys, sexual apparatus.

Class 14: Watches, Jewelry.

Class 16: Printed magazines and books in the field of adult entertainment.

Class 25: Articles of Clothing, headgear.

("CyberNet's first mark");

Kink

UK registration no. 914520795

Filing date 1 September 2015; registration dated 22 December 2015

Registered for the following goods:

Class 5: Hygienic lubricants; Vaginal lubricants; Orgasm creams; Contraceptive preparations; Contraceptive foams; Contraceptive sponges; Sexual stimulant gels.

Class 10: Vibrators, being adult sexual aids; Massage apparatus, electric or non-electric; Massaging apparatus for personal use; Condoms; Benwa balls, being adult sexual aids; Sex aids; Non-chemical contraceptives; Sex toys.

("CyberNet's second mark"); and

KINK

UK registration no. 3250778

Filing date 16 August 2017; registration dated 17 November 2017

Registered for the following services:

Class 35: Mail-order retail, retail and wholesale services in relation to adult sexual stimulation aids, sexual lubricants, bondage goods, whips, harnesses, sex toys, vibrators, body massagers, massage creams, sexual stimulation creams and gels, condoms, digital recordings, printed magazines and books, mugs, ceramics, watches, jewelry, clothing and headgear.

Class 40: Custom manufacture of adult sexual stimulation aids and bondage goods; custom manufacture of sex toys, vibrators, penetrative toys, lotions, lubricants, creams, massage creams, condoms, watches, jewelry, clothing and headgear.

Class 41: Entertainment and educational services, namely, providing photographic, audio, video and prose presentations, educational workshops, seminars and tutorial sessions, and non-downloadable videos, all in the field of adult entertainment, via a website.

("CyberNet's third mark")

CyberNet's opposition

5. On 13 August 2020, Kinkabu's mark was opposed by CyberNet. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is aimed at all of Kinkabu's goods. CyberNet relies on its first mark and only relies upon those goods registered in classes 5 and 10 of its specification.
6. CyberNet claims that as a result of the parties' identical or otherwise highly similar class 10 goods, the considerable overlap between Kinkabu's goods and its own class 5 goods and the high similarity of the marks, there is a risk of consumer confusion amongst the targeted UK public.
7. Kinkabu filed a counterstatement denying the claims made.

Kinkabu's invalidation applications

8. On 14 July 2021, Kinkabu applied to invalidate all three of CyberNet's marks on the basis that they are objectionable under sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Act. Prior to the hearing in this matter, Kinkabu confirmed that it no longer relied upon its 3(1)(d) ground, leaving only the 3(1)(b) and 3(1)(c) grounds.

9. Kinkabu's pleaded case under its 3(1)(c) ground is that CyberNet's marks consist exclusively of signs or indications which serve in trade to designate the kind, intended purposes and/or other characteristics of the goods and services for which they are registered. Kinkabu relies upon this same argument under its 3(1)(b) ground and claims that by being directly descriptive, CyberNet's marks are devoid of distinctive character.
10. CyberNet filed counterstatements denying the claims that its marks are descriptive and that they are, at most, vaguely suggestive of characteristics that are not precisely tangible.
11. Upon the filing of CyberNet's counterstatements to the invalidation applications, the Tribunal wrote to the parties on 14 October 2021 and confirmed that under Rule 62 of the Trade Marks Rules 2008 ("the Rules"), the proceedings would be consolidated.
12. Only Kinkabu filed evidence in chief with CyberNet electing to file evidence in reply. A hearing took place before me on 22 September 2022, by video conference. Kinkabu was represented by Mr Jamie Muir Wood of Hogarth Chambers. Mr Muir Wood was instructed by Trade Mark Wizards Limited, who have represented Kinkabu throughout these proceedings. CyberNet was represented by Mr Andrew Lomas of One Essex Court. Mr Lomas was instructed by Greyhills Rechtsanwälte Partnerschaftsgesellschaft mbB, who have represented CyberNet throughout these proceedings.
13. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

14. Kinkabu's evidence in chief came in the form of the witness statement of Ashley Harrison dated 14 December 2021. Ashley Harrison is the director of Kinkabu and their statement is accompanied by 33 exhibits, being those labelled AH1 to AH33.
15. While CyberNet elected not to file evidence in chief in furtherance of its own claims, it did file evidence in reply, being the witness statement of Peter Ackworth dated 30 March 2022. Mr Ackworth is the founder and CEO of CyberNet and held the position of CEO from 1997 until 2018 before resuming the position again in the Autumn of 2021. Mr Ackworth's statement is accompanied by four exhibits, being those labelled Exhibits PA1 to PA4.
16. I note that a significant amount of both parties' evidence consists of submissions and not evidence of fact. I do not propose to summarise the parties' evidence and submissions here. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

PRELIMINARY ISSUES

17. Aside from the issue that the evidence filed consists of a significant volume of submissions, there is also a wide range of evidence filed that is of no relevance to these proceedings. I consider it necessary to address this point briefly before proceeding to the substantive decision itself.
18. I note that a lot of evidence has been filed in respect of decisions relating to the descriptive nature of the word 'KINK' in other jurisdictions including the United States and Europe. For example, the United States' office's decision was that 'KINK' was descriptive whereas the EUIPO's decision was that it is not. Of course, each party wishes to rely on the decisions that support its arguments, a point that was acknowledged by the representatives at the hearing. For the avoidance of doubt, the decisions are noted but they are not binding upon me and, therefore, have no bearing on the decision I must make.

19. I also note that CyberNet's evidence made reference to a range of signs on the UK register that are registered for words that are adjectives describing human habits, feelings, attitudes or emotional states of minds for a range of different goods and services. Of these, I note that CyberNet has referred to marks such as 'JOYFUL', 'BIZARRE', 'Outlandish' and 'GROTESQUE', amongst others. In discussing these marks, CyberNet sets out that its own marks cannot be denied any distinctive character, any more than the comparable designation for the marks discussed above. The fact that these marks were accepted and now exist on the UK trade mark register is not a relevant factor when considering the claim of the issue of descriptiveness/lack of distinctive character of CyberNet's marks.

MY APPROACH

20. In the event that Kinkabu's applications for revocation are successful, CyberNet's marks will be invalidated and treated as if they had never been registered. Therefore, CyberNet will not be permitted to rely on its first mark for the basis of the opposition against Kinkabu's mark and, as a result, the opposition will fall away. Alternatively, if the invalidation applications fail or are only partially successful (to the extent that some goods relied upon in the opposition remain), then the opposition will proceed.

21. Given that the continuation of the opposition is dependent upon the outcome of the invalidation applications, I will consider those first. If necessary, I will then proceed to consider the opposition.

DECISION

Kinkabu's invalidation applications

22. Section 3(1) of the Act has application in invalidation proceedings pursuant to section 47 of the Act, which reads as follows:

"47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

23. Section 3(1) of the Act provides as follows:

“3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

24. The relevant date for determining whether CyberNet’s marks are objectionable under the above provisions is their filing dates, being 27 June 2017, 1 September 2015 and 16 August 2017.

25. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at paragraph 25. However, in the present case, Kinkabu’s pleaded case under 3(1)(b) relies upon the same argument put forward under 3(1)(c). Therefore, I do not consider it possible for these grounds to have differing outcomes in the present proceedings.

26. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.¹ At the hearing, there was discussion surrounding the identity of the average consumer. I note that CyberNet’s position is that care should be taken when constructing the identity of the consumer in that some goods do not target adult only consumers and that even those goods used for sexual activity such as condoms, a minor between the age of 16 and 18 would fall within the class of

¹ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

consumer. Kinkabu's position is that to divide the goods and services up into those that are used by specific subcategories of over 18s or minors is an over-complication. While I am conscious not to unnecessarily over-complicate the identity of the average consumer, I do not consider that such a distinction will do so. In the present case, a range of the goods and services at issue are aimed at members of the general public at large, such as clothing, watches and even condoms, for example. However, I acknowledge that there are also some goods and services present that are directly aimed at those over 18, such as downloadable recordings or entertainment services, both of which exclusively relate to the field of adult entertainment. As a result, I conclude that for some goods and services, the average consumer will be a member of the general public at large, however, for some other goods and services, the average consumer will be a member of the general public over the age of 18.

27. The level of attention was also discussed in some detail at the hearing. Kinkabu's position is that the level of attention will be much more than average on the basis that the goods will be applied either to the surface of the body or, in some circumstances, inside of the body. Alternatively, CyberNet's position is that the level of attention will be on a more ordinary level on the basis that they are goods and services that will, for the most part, be those that are bought online without hassle or on the high street and that someone is unlikely to agonise for hours over or analyse in exquisite detail. Ultimately, I am inclined to agree with CyberNet and hereby find that the level of attention paid for the goods and services will be medium. While I appreciate that a majority of the goods will be used on or in the human body, this does not automatically result in a high degree of attention being paid. The consumer will, of course, want to ensure that such goods are safe for use but that alone does not warrant a higher degree of attention.

28. Given that Kinkabu's pleaded case under 3(1)(b) relies on the same arguments that it ran under the 3(1)(c) claim, I will address the 3(1)(c) ground first.

Section 3(1)(c)

29. Section 3(1)(c) prevents the registration of marks which designate the kind, intended purpose or other characteristic of the goods and services. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the Court of Justice of the European Union (CJEU) in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P)

[2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

30. CyberNet's marks are all word only marks consisting of the word 'KINK'. Two of the marks are displayed in upper case whereas the other is displayed in title case. I do not consider that this will alter the understanding of the marks so will, therefore, assess them all together.

31. Before moving to assess the meaning of the word 'KINK', I will address the evidence filed. At the hearing, CyberNet set out that much of Kinkabu's evidence is based on academic papers on ensuring access to medical care for the 'kink community' or explainers to the general public on what the term 'KINK' means. CyberNet argues that these documents do not point to a widespread understanding or association of the word by average consumers in the UK. The issue raised by CyberNet is one that I am inclined to agree with. A number of the papers provided were published by organisations outside of the UK and there is nothing that points to the reach of these articles in the UK. Even for those papers published by UK

organisations, these are somewhat specialist in nature (being exploratory studies into the health care of the kink communities² or into new kink activities, such as 'pup play',³ for example) and there is nothing to suggest that they were targeted at or accessed by members of the average consumer base. Even if there were some users in the UK that accessed these articles, I am not convinced that they would make up a significant proportion of average consumers. While the various studies provided are noted, I am not convinced that they have any relevance to the present proceedings.

32. While on the topic of the evidence, I note that there is a document that sets out that only 10-15% of the population of the United States of America had practiced a kink activity.⁴ CyberNet takes issue with this evidence in that it relates to the USA and that no equivalent number is offered for the UK and even if it had and was roughly the same as the US figure, it would only represent a non-significant or substantial minority. There was discussion at the hearing on the basis that if you were to extrapolate this figure to the UK population, it would equate to around 10 million people, which would, in Kinkabu's submissions, make up a large proportion of people. While the evidence and submissions around this point are noted, they are of no relevance to the proceedings on the basis that, firstly, it is not appropriate to extrapolate the figures in this way and, secondly, as Kinkabu's representative pointed out at the hearing, the issue at present is the understanding of the term 'KINK', not how many people have practiced such activities. On this point, it is plausible to suggest that some who have practiced those types of activities may be unaware of their categorisation as 'kink' activities. This evidence is, therefore, of no assistance to the position that I must assess.

33. At the hearing, I was taken to a wide range of evidence including print-outs from various websites including Bondara.co.uk, With a Passion, Lovehoney.co.uk, Amazon.co.uk, Bellesa Boutique, and Etsy, amongst others.⁵ I note that the majority of the products all appear to have 'KINK' as a keyword in their description on a range of sex toys, ropes, bindings and clothing (with a number using the word

² Exhibit AH5

³ Exhibit AH6

⁴ Exhibit AH7

⁵ Exhibits AH11 and AH12

'KINKY' as opposed to 'KINK'). Notably, I was taken to products which were referred to as 'Doc Johnson Kink Stinger Electro-Ploy...'⁶ and 'Silicone Kink Black Vented Ball Gag'.⁷ At the hearing, Kinkabu's submission was that this evidence shows 'KINK' being used in a repeated and descriptive manner. While noted, I am not convinced that this is the case. As an example, I accept that 'KINK' may be allusive to the fact it is something that would be used during sexual activity, the actual descriptive aspect of the aforementioned ball gag, for example, is in my view the words 'VENTED BALL GAG', not the word 'KINK'. In any event, these print-outs are all dated after the relevant date and even where they are capable of pointing to activities from prior to the print-out dates (the Etsy print-outs, for example, show dated reviews for previous sales), none of them demonstrate the position as at the relevant dates at issue. I note that the same issue applies to a range of Google searches shown in that they were undertaken on 12 December 2021, being some 4 years after the latest relevant date.⁸ I have nothing further to suggest the widespread nature of these results as at the print-out date was consistent with the position as at the relevant date.

34. There is also a range of evidence that shows a number of retailers that use the word 'KINK' in their names, such as 'Jossies Kink Store', 'Kink Shoppe', 'Coffee, Cake & Kink' and 'The Kinksters'.⁹ These print-outs are all undated and while I note that one shop refers to activity from 2012,¹⁰ this is a store based in Philadelphia, USA and does not, therefore, reflect the position in the UK. These print-outs are, therefore, of no assistance to the present case.

35. For the reasons set out above, I do not consider that the bulk of Kinkabu's evidence in support of its position is of any real assistance to the issue I must now consider. As above, the evidence of academic papers is not capable of pointing to an understanding of the term by the UK average consumer. Additionally, the evidence showing the word 'KINK' on a range of goods or shops is all dated after the relevant date and does not point to the position as at the relevant dates, being the dates at

⁶ Page 85 of AH11

⁷ Page 86 of AH11

⁸ Exhibits AH13 and AH15

⁹ Exhibit AH16

¹⁰ Page 155 of Exhibit AH16

which my current assessment must be based. In any event, I do not consider that 'KINK' on these print-outs necessarily points to descriptive use. On this point, I refer to Kinkabu's submissions at the hearing that there is no requirement of use of the sign as at the date of the registration but that, if the marks are descriptive, then that is enough to mean that they should not be registered. I agree that this is the case and while I have found that the evidence filed is of no real assistance to Kinkabu, this is not fatal to its case. I will now proceed to consider the meaning of the word 'KINK' before going on to determine whether it is descriptive of the kind, purpose or other characteristic of the goods and services at issue.

36. While the word 'KINK' has a multitude of meanings, it is clear that both parties accept that one of these meanings relates to sexual preferences. I note that Kinkabu provided a wide range of print-outs from online dictionaries showing various meanings of the word 'KINK'.¹¹ While the print-outs are all dated after the relevant date, I am content to conclude that the meanings provided are not new meanings and would have been in use prior to the relevant dates at issue. The dictionary print-outs show a number of different specific meanings of the word in the context of sexual activity. For the sake of these proceedings, I will refer to just one of those meanings. I do not consider this to be a controversial approach on the basis that the definitions all, essentially, mean the same thing but are simply worded differently. Going forward, I will take 'KINK', in this context, to mean a *person's unusual sexual preference*.¹² I note that the evidence provides an additional definition in relation to sexual activity in that it also means a *person with unusual sexual tastes*.¹³ While this understanding may be known to some average consumers, I do not consider that this will make up a significant proportion of the same. This is on the basis that the majority of consumers will understand 'KINK', in this context, to being a trait that a person has rather than a defining term for someone *being a kink*.

37. At the hearing, CyberNet raised issues surrounding the fact that the meanings provided point to either an American slang term¹⁴ or one that is an informal British

¹¹ Exhibit AH1

¹² See Page 10 of Exhibit AH1, being Lexico.com, a website dedicated to meanings and definitions in UK English

¹³ Page 9 of Exhibit AH1

¹⁴ Page 6 of Exhibit AH1

word.¹⁵ Firstly, I am of the view that the presence of British English entries in the print-outs means that I am able to accept those meanings as having effect in the UK and, therefore, do not need to rely upon the American definitions. Secondly, the fact that the term may be categorised as informal does not mean that it will not be understood by a majority (or at least a significant proportion) of average consumers in the UK. Therefore, the issue raised by CyberNet is of no assistance to its position.

38. I note that CyberNet's position via its skeleton arguments is that the above meaning is not one that is mainstream and that the evidence on this point filed by Kinkabu does not point to a widespread understanding or association of the word with non-standard sexual practices. I accept that the other meanings would also be known by the average consumers but this does not mean that the above meaning would not be. I appreciate CyberNet's point regarding the evidence filed, however, I am of the view that such a meaning is known across members of the average consumer base in the UK, particularly given the sexual nature of the majority of the goods and services at issue. My primary position is that a majority of average consumers would be aware of this meaning but even if I am wrong on this point, it would constitute, at worst, at least a significant proportion of the average consumer base. Whilst on the topic of the average consumer's understanding of 'KINK', I am of the view that there is a separate but also significant proportion of average consumers that may not necessary be aware that 'KINK' is a word on its own but will, instead, identify it as a play on the word 'kinky'. In this scenario, I am of the view that the understanding of 'KINK' will remain as discussed above on the basis that the definition of 'kinky' is that it is a slang term *given to unusual, abnormal or deviant sexual practices*.¹⁶

39. Kinkabu's pleaded case is that 'KINK' is descriptive of the kind, intended purpose or other characteristic of CyberNet's goods and services. In its skeleton argument filed prior to the hearing, Kinkabu argued that it may act to indicate that the goods and/or services are designed to be used by the 'kink community'. It is not clear whether it was Kinkabu's intention to rely on the latter argument as being the 'other

¹⁵ Page 4 of Exhibit AH1

¹⁶ <https://www.collinsdictionary.com/dictionary/english/kinky>

characteristic' mentioned. While the 'other characteristic' argument was pleaded at the outset of the invalidation, Kinkabu did not elaborate on this until the filing of its skeleton arguments prior to the hearing. I am of the view that such a specifically targeted argument should have been raised in the applications for invalidations and that it would not be appropriate to consider this argument given that it was raised at such a late stage in these proceedings.

40. I will first consider the claim that 'KINK' is descriptive of the kind of goods and services at issue. Kink or kinky (where the consumer does not identify 'kink' as its own word but, instead, a play on 'kinky') are not descriptive of any specific activities but are subjective terms that can be used to describe any sexual preference that is considered unusual. Due to its subjective nature, it is not possible to pin down precisely what sort of sexual preference would be considered a kink/kinky or not by members of the average consumer base. Regardless of the specific activity involved, I find that if a kink or something that is kinky are, as above, subjective terms that describe an unusual sexual preference then it does not follow that 'KINK' can also be descriptive of the kind of good or service that may be used in the course of these acts. For example, if using restraints or sex toys during sexual intercourse are considered to be kinks/kinky, then the kind of goods involved would simply be that of a restraint used during sexual activity or a toy that is used as a sexual aid or stimulant. These goods are not items that would be described as a *kink*. While I accept that, for the most part, 'KINK' will be understood as alluding to the fact that such items are likely being used to satisfy the user's unusual sexual preference or their *kink*, this does not directly describe what kind of goods they are. While my above reasonings were made in relation to sex toys and goods that restrain, I consider that the same outcome would apply to all goods or services in CyberNet's specification. As a result, I do not accept that 'KINK' is descriptive of the kind of the goods or services at issue.

41. I turn now to consider the intended purpose of the goods at issue. As above, 'KINK' is a subjective term used to make reference to an unusual sexual preference. Using the same example as above, if one was to participate in a sexual activity to satisfy their kink and was to use a leather restraint or some type of sex toy in the course of the same, the purpose of these goods would be to either restrain the user or to

be placed on/inserted into the user's genitalia for sexual pleasure. To say that the purpose of such goods is *to kink* has no real application or meaning in the present circumstances. If it were the case that the marks at issue were 'SEXUAL PLEASURE' then they would, of course, be descriptive of such a purpose as the goods, at their core, are intended to provide sexual pleasure (be that via restraint or vibration of a sex toy, for example). However, this is not the matter at issue and I consider that even if the average consumer, upon seeing 'KINK' on these goods, were to undertake a mental process to get to an understanding for 'KINK', it would be an elaborate one. For example, the user would need to understand that the goods are used to restrain the user or be placed on/inserted into genitalia in order to provide sexual pleasure and that said sexual pleasure derives from the user's need or urge to satisfy their kink. Such a mental process results in an understanding that is too far removed from an understanding that 'KINK' is directly descriptive. Even if the play on the word 'kinky' is identified, I consider that the same finding applies in that it is the activity itself that will be considered 'kinky'. While the leather restraint or sex toy may be used in the course of such activity, this does not mean that 'KINK' directly describes their specific purposes. For the avoidance of doubt, I consider that the same or similar findings will apply to all of those goods and services at issue. As a result, I do not accept that 'KINK' is descriptive of the purpose of any of CyberNet's goods or services.

42. I have set out above that it is not my intention to consider Kinkabu's specific argument that 'KINK' is descriptive of an 'other characteristic', namely of the fact that it indicates goods or services designed for the 'kink community'. Even if I were to give due consideration to this argument, I do not consider that it would assist Kinkabu. My reasons follow.

43. While I accept the existence of a group of people that are referred to as the 'kink community', I have nothing before me to suggest the size of this community in the UK or the general awareness of its existence across the average consumer base. In the absence of anything to the contrary, I am of the view that the 'kink community' makes up only a very small part of the average consumer base and its existence would not necessarily be known by a significant proportion of the same. Even if it were the case the members of the 'kink community' were selecting the goods and

services at issue, I am not satisfied that they would understand the goods or services as being designed for them, particularly given that they would understand that 'KINK' has its own independent meaning. On this basis, I am unable to conclude that the average consumer, upon being confronted with 'KINK' on the goods and services at issue, would make the connection that the goods/services are designed for a specific community. Even where 'KINK' is viewed as a play on 'kinky', this same reasoning applies.

44. While it was not pleaded by Kinkabu, nor was it an issue raised during the hearing, I note that some of CyberNet's goods relate to massage, namely "massaging tool for personal use", "massage apparatus, electric or non-electric" and "massaging apparatus for personal use". I have given consideration as to the application of section 3(1)(c) of the Act specifically in relation to these goods also on the basis that 'KINK' can also be taken to mean '*crick in the neck or similar muscular spasm*'.¹⁷ It is my view that it could be said by the average consumers that massage tools are used to massage the kink in a user's neck or back. While that may be the case, I do not consider that this is descriptive of the kind of and/or intended purpose (or other characteristic, for that matter) of these goods. They are massage tools that will not be described using the term kink and while their purpose may be to massage out the kinks, this is merely alluding to the purpose of the goods and is not, therefore, directly descriptive of the same.

45. For the avoidance of doubt, I have found that 'KINK' is not descriptive of the kind or intended purpose (or other characteristic, for that matter) of CyberNet's goods or services that relate to sexual activity or adult entertainment. If it is not descriptive of these type of goods or services then I see no basis as to why it would be descriptive of the kind and/or intended purpose (or other characteristic) of those goods and services that do not expressly relate to sexual activity such as clothing or jewellery, for example. Even if it could be said that those goods or services may have application during sexual activities (I note that the evidence refers to a vibrator earring¹⁸ and clothing worn during sexual activity¹⁹), the same reasoning as

¹⁷ Page 4 of Exhibit AH1

¹⁸ Page 102 of Exhibit AH12

¹⁹ Exhibit AH14

discussed throughout this assessment applies and I consider 'KINK' is not descriptive of these goods either.

46. I note that it is Kinkabu's argument that 'KINK' must be kept free so that all traders can use the word. I have found above that 'KINK' is not descriptive of any of the goods or services at issue or any characteristics thereof. Therefore, I do not consider that the general interest of keeping signs free so that they may be used by all traders offering such goods or services applies in the present circumstances.

47. To conclude, I find that CyberNet's marks are not objectionable under section 3(1)(c) of the Act and I, therefore, consider that Kinkabu's invalidations insofar as they rely on this ground fail in their entirety.

Section 3(1)(b)

48. Moving to consider Kinkabu's 3(1)(b) ground, I am of the view that I can deal with this relatively swiftly. This is on the basis that Kinkabu's pleaded case under 3(1)(b) is that CyberNet's marks are devoid of distinctive character on the basis that they are descriptive in accordance with the 3(1)(c) ground. Given my findings above, it follows that as the invalidations reliant upon the 3(1)(c) ground have failed, Kinkabu's reliance upon the 3(1)(b) ground must also fail.

49. Given that CyberNet's marks remain valid for all of the goods and services in its specifications, I will now proceed to consider CyberNet's opposition.

CyberNet's opposition

Section 5(2)(b): legislation and case law

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

“(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 or association with the earlier trade mark.”

51. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

52. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (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 the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

53. The competing goods are as follows:

CyberNet's goods	Kinkabu's goods
<p><u>Class 5</u> Hygienic lubricants, sexual creams, sexual stimulants, sexual gels.</p> <p><u>Class 10</u> Adult sexual stimulation aids in the nature of bondage goods namely restraints made of leather, metal, or plastic, rope made for restraining a person for sexual purposes as well as accessory items for restraints in the nature of gags, harnesses, hoods, spreader bars, blindfolds, strait jackets and spreader bars; Adult sexual stimulation aids; Vibrators, massaging tool for personal use, sex toys, sexual apparatus.</p>	<p><u>Class 10</u> Condoms; Condoms for hygienic purposes; Condoms for medical purposes; Condoms for prophylactic purposes; Condoms having spermicidal properties; Adult sexual aids; Artificial penises [adult sexual stimulation aids]; Artificial penises, being adult sexual aids; Artificial vaginas, being adult sexual aids; Benwa balls, being adult sexual aids; Inflatable life-sized dolls used in sexual activity; Love dolls [sex dolls]; Penis enlargers, being adult sexual aids; Sex aids; Sex toys; Sexual activity apparatus; Sexual activity articles; Sexual activity devices; Vibrators, being adult sexual aids; Abdominal corsets; Anal plugs; Massage (Gloves for -); Massage apparatus [for medical purposes]; Massage apparatus for eyes; Massage apparatus, electric or non-electric; Massage appliances; Massage beds for medical purposes; Massage chairs; Massage chairs with built-in massage apparatus; Massage mitts; Back massage apparatus;</p>

	Battery-operated scalp massagers; Body massagers; Electric massage rollers; Electric scalp massagers for commercial use; Electric scalp massagers for household use; Foam massage rollers; Foot massage apparatus; Gloves for massage; Instruments for massage; Thermal massage pads; Vibration generating apparatus for massage.
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54. 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”.

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

56. The General Court confirmed in *Gérard Meric v OHIM*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

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

57. I have submissions from both parties in respect of the goods comparison. I do not intend to reproduce these here but will, if necessary, refer to them below.

58. “Condoms”, “condoms for hygienic purposes”, “condoms for medical purposes”, “condoms for prophylactic purposes” and “condoms having spermicidal properties” in Kinkabu’s specification have no direct counterpart in CyberNet’s specification. They are neither bondage goods, sexual aids, sex toys or sexual apparatus. However, I do consider that they share a level of similarity with some of CyberNet’s goods, namely “hygienic lubricants, sexual creams, sexual stimulants, sexual gels”. The nature of these goods is clearly different and while the method of use is not directly the same, both parties’ goods are commonly applied on the

users' genitalia prior to sexual intercourse. The common purpose of condoms is that they can be used to prevent unwanted pregnancies or to prevent the transmission of diseases whereas the common purpose of CyberNet's goods is to make sexual intercourse more pleasurable. On the face of it, this may point to a difference in purpose, however, I note that condoms can also be used to make intercourse more pleasurable, such as ribbed condoms, for example. In addition, it is my understanding that there are sexual gels that consist of spermicidal ingredients and, therefore, used to prevent unwanted pregnancies in the same way that condoms do. Further, in respect of condoms for medical purposes, it is possible that hygienic lubricants can be used for medical purposes i.e. to prevent infection. While not particularly pronounced, I do consider that these points result in some overlap in purpose between the goods. As for users, I consider that these overlap too in that someone using a sexual lubricant or gel, for example, may also use a condom. I also consider that there is an overlap in trade channels in that it is common in the trade for an undertaking that produces and sells condoms to also produce and sell the various creams and gels covered by CyberNet's terms. Further, the goods are likely to be placed in close proximity in physical stores or be found in the same sections of retailers' websites. While the goods are not complementary, there is a degree of competition in that a user may wish to use a ribbed condom for pleasure over a sexual stimulant gel, for example. Overall, I consider that these goods are similar to a high degree.

59. Kinkabu's specification includes a wide range of goods that will be considered sex toys or sexual stimulation aids. These are "adult sexual aids", "penis enlargers, being adult sexual aids", "sex aids", "anal plugs", "benwa balls, being adult sexual aids", "artificial penises [adult sexual stimulation aids]", "artificial penises, being adult sexual aids", "artificial vaginas, being adult sexual aids", "vibrators, being adult sexual aids", "inflatable life-sized dolls used in sexual activity", "love dolls [sex dolls]", "sex toys", "sexual activity apparatus" and "sexual activity devices". All of these goods can be said to fall within the broader categories of "adult sexual stimulation aids", "sex toys" or "sexual apparatus", all of which are present in CyberNet's specification. In my view, these goods are identical under the principle outlined in *Meric*.

60. It is my view that “sexual activity articles” in Kinkabu’s specification cover items or objects that are used specifically for sexual activity. This is a very broad term and can, in my view, include “sex toys” and other types of items used for sexual practice such as “accessory items for restraints in the nature of gags, harnesses, hoods, spreader bars, blindfolds, strait jackets and spreader bars”. Given that these goods are covered by CyberNet’s specification, I consider that there is a level of identity between them. This on the principle outlined in *Meric* in that Kinkabu’s goods either fall within the goods of CyberNet or are broad enough to encompass the more specific goods in CyberNet’s specification. Either way, I find that these goods are identical.

61. “Massage (gloves for -)”, “massage apparatus [for medical purposes]”, “massage apparatus for eyes”, “massage apparatus, electric or non-electric”, “massage appliances”, “massage beds for medical purposes”, “massage chairs”, “massage chairs with built-in massage apparatus”, “massage mitts”, “back massage apparatus”, “battery-operated scalp massagers”, “body massagers”, “electric massage rollers”, “electric scalp massagers for household use”, “foam massage rollers”, “foot massage apparatus”, “gloves for massage”, “instruments for massage”, “thermal massage pads” and “vibration generating apparatus for massage” in Kinkabu’s specification are all types of massage tools that cover those for personal use. Therefore, I consider that they all fall within CyberNet’s term of “massaging tool for personal use” and are, therefore, identical under the principle outlined in *Meric*.

62. Lastly, I note that Kinkabu’s specification includes “electric scalp massagers for commercial use”. These cannot be said to be identical with CyberNet’s “massaging tool for personal use” on the basis that they are reserved for commercial use whereas CyberNet’s are for personal use. However, they are still similar to a degree. Despite being for different specific purposes (in that one is personal and the other is commercial), there is still a general overlap in end purpose in that, inevitably, both goods will be used to massage a user. Further, the goods share an overlap in nature, method of use and trade channels. While the immediate user of the goods may differ in that those for commercial use will be bought by business users, there still may be an overlap in end user in that those massage tools will still

ultimately be used for personal use by members of the general public who attend a spa or a salon, for example. Taking all of this into account, I consider that the goods are similar to a high degree.

The average consumer and the nature of the purchasing act

63. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Insc 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 “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

64. At paragraph 26 above, I made an assessment of the average consumer for the purpose of my section 3 assessment of all of the goods and services in CyberNet's marks. While the assessment I must make now relates only to the goods in classes 5 and 10 of CyberNet's first mark and also includes Kinkabu's goods, I consider that the same finding applies here. This is on the basis that the range of goods at issue are broadly the same as those assessed above. For completeness, my finding is that for some goods such as condoms and massage tools, the average consumer will be a member of the general public at large, however, for some other goods, such as the range of sexual apparatus and devices at issue, the average consumer will be a member of the general public over the age of 18. As for those goods reserved for commercial use, I consider that the average consumer for these will be business users.

65. Those goods that are selected by the general public at large will be available via general retailers either in physical stores or their online equivalents. As for those goods that are selected by members of the general public over the age of 18, they are likely to be available via more specialist stores or their online equivalents. Lastly, those goods selected by business users will also be available via specialist retailers (albeit a different specialist to that discussed above) and their online equivalents. The selection process for all of the goods at issue will be primarily visual. While I do not discount an aural component playing a part by way of word of mouth recommendation or advice from sales staff, I consider that this will be somewhat lessened for some goods due to their sexual nature. I make this finding on the basis that, in my view, a large number of average consumers may consider these somewhat taboo or embarrassing purchases that they will not wish to speak about.

66. The frequency of selection and the costs of the goods at issue are likely to vary. This is on the basis that some goods, such as condoms, are relatively inexpensive and will be bought somewhat frequently. However, I appreciate that terms such as sex toys and sex apparatus may include more elaborate goods that are likely to be more expensive and bought less frequently. I am also of the view that the considerations of the average consumers will vary depending on the goods selected. For example, the consideration for condoms is likely to differ from those of massage tools which are also likely to differ from those of sex toys and vibrators. While some of the goods are used on or in the human body, I echo my findings at paragraph 27 above in that this does not necessarily mean that the average consumer will pay a higher degree of attention. Of course they will give consideration to things such as safety of the goods, materials/ingredients used and suitability but this does not mean that the attention paid will be any higher than medium. To conclude, I find that the average consumer will pay a medium degree of attention during the selection process, regardless of the type of goods being bought.

Comparison of the marks


67. It is clear from *Sabel 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 the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

68. 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.”

69. 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.

70. The respective trade marks are shown below:

CyberNet's mark	Kinkabu's mark
KINK	

71. As was the case with the goods comparison above, the parties' have made detailed submissions in respect of the similarity of the marks at issue. I do not intend to reproduce them here but confirm that I have taken both parties' submissions into account in making the following comparisons.

Overall Impression

72. CyberNet's mark is a word only mark, consisting solely of the word 'KINK'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself. As for Kinkabu's mark, this consists of the word 'KINKABU' presented in a white, standard typeface. While the horizontal line in the letter 'A' has been removed, it will not affect the understanding of the letter or the word as a whole. This word sits on a black background. At the hearing, CyberNet submitted that 'KINK' is the dominant element of Kinkabu's mark. While I am conscious that the average consumer will assess a mark as a whole, I am required to bear in mind the distinctive and dominant components of a mark. In the present case, 'KINKABU' is displayed as one word and is clearly the dominant element of Kinkabu's mark. It is not presented in any way that would lead the average consumer to consider it to be made up of two elements, being 'KINK' and 'ABU'. This is, in my view, an artificial dissection of the mark. As a result, I disagree with CyberNet's submissions and consider that it is word 'KINKABU' as a whole that will dominate the overall impression of the mark with the background and the stylisation element of the letter 'A' playing much lesser roles.

Visual Comparison

73. Visually, the marks coincide in that the word elements in each mark share the letters 'KINK'. This is the only element of CyberNet's mark and is the first four letters of the word element of Kinkabu's mark. The marks differ in the presence of the letters 'ABU', which is presented at the end of 'KINK' in Kinkabu's mark and has no counterpart in CyberNet's mark. While this element sits at the end of the word element of Kinkabu's mark, it is still an important part of the mark's dominant element and is, therefore, a prominent point of difference. The marks differ further in the fact that 'KINKABU' is displayed in a different (but still standard) typeface in

white on a black background. Such differences are of very little impact on the basis that CyberNet's mark may also be displayed in the same (or similar) typeface in white by virtue of being registered as a word only mark in black and white. While I acknowledge that the shared element of the marks sit at the beginning of Kinkabu's mark (and is also the sole element in CyberNet's mark), being where average consumers tend to focus,²⁰ I am of the view that the differences will not be overlooked due to the importance of 'ABU' in Kinkabu's mark. Overall, I am of the view that the marks are similar to between a medium and high degree.

Aural Comparison

74. At the hearing, CyberNet submitted that 'KINK' will dominate the aural impression of Kinkabu's mark on the basis that it starts and ends with a 'K' and as this results in a hard consonant sound, it will be more striking. It is my view that 'KINKABU' will, in all circumstances, be pronounced as a whole and I fail to see why more emphasis will be placed on the 'KINK' element over 'ABU' simply because it consists of two K's. I do not consider that 'KINK' will be pronounced with any greater enthusiasm than the 'ABU' element and, therefore, disagree with the CyberNet's position.

75. Aurally, CyberNet's mark consists of one syllable that will be pronounced in the ordinary way. As for Kinkabu's mark, this consists of three syllables that will be pronounced as either 'KINK-UH-BOO' or 'KINK-AH-BOO'. The entirety of the aural element of CyberNet's mark is identical to the first syllable of Kinkabu's mark, however, the remaining syllables in Kinkabu's mark have no counterpart in CyberNet's mark. These are, in my view, substantial points of difference. I bear in mind what I have said about average consumers tending to focus on the beginnings of marks, however, I also note that CyberNet's mark is a short mark. On this point, I remind myself that while there is no special test which applies to the comparison of 'short' marks,²¹ I am of the view that in the present case the shortness of 'KINK' means that the average consumer is more likely to notice the differences. Overall, I am of the view that the marks are similar to a medium degree.

²⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

²¹ See paragraph 44 of *BOSCO*, BL O/301/20

Conceptual Comparison

76. I have discussed the meaning of 'KINK' in detail when considering Kinkabu's invalidation applications. The same meaning will apply here in that, in the present context, 'KINK' will be understood as meaning a person's unusual sexual preference or, alternatively, as a play on the word kinky. In addition, I note that some of the goods at issue are for use as massage tools and, in this context, I have found that 'KINK' may be understood as a reference to a '*crick in the neck or similar muscular spasm*'. As for Kinkabu's mark, I am conscious that even though average consumers do not artificially dissect marks, they would see the word 'KINKABU' and view it as a play on the words 'kink' or 'kinky'. Therefore, the same concept as discussed above will carry through Kinkabu's mark. That being said, the addition of the letters 'ABU' will be viewed as a point of conceptual difference in that they will be seen as creating a novel word that will be attributed no obvious meaning (outside of its reference to 'kink' or 'kinky'). In this scenario, I find that the reference to 'KINK' results in the marks being conceptually similar to a medium degree.

Distinctive character of CyberNet's mark

77. 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-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 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).”

78. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, 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 made of it. In the present case, CyberNet did not plead that its mark enjoys an enhanced distinctive character and neither did it file evidence of such. Therefore, I have only the inherent position to consider.

79. Where the goods at issue relate to sexual activity, the word ‘KINK’ will, in my view, be allusive to the fact that those goods are going to be used either before or during sexual activity in order to satisfy the user’s kink. Even for goods that are not necessarily considered those used in the course of kinky activities (such as condoms, for example), the sentiment will remain in that ‘KINK’ will still allude to the sexual nature of the goods. In such circumstances, I am of the view that the distinctive character of CyberNet’s mark will be low. While the same reasoning does not apply directly to those goods used for massage on the basis that they are not used in the course of sexual activity, I still consider that the distinctiveness of the mark for those goods remains low. I make this finding on the basis that one of the meanings of ‘KINK’, as set out above, is that of a crick in the neck or similar muscular spasm. On a massage tool, I consider that ‘KINK’ will, therefore, be allusive to the fact that the massage tool is used to massage out the ‘kinks’ in the user’s neck or back, for example.

Likelihood of confusion

80. 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier 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.

81. I have found Kinkabu's goods to either be identical or similar to a high degree with CyberNet's goods. I have found that the average consumer for the goods is made up of members of the general public at large, those over 18 or, for massage goods for commercial use, business users, all of whom will select the goods through primarily visual means, although I do not discount an aural component (which will be somewhat lessened due to the sexual nature of a majority of the goods). I have concluded that the average consumer will pay a medium degree of attention when selecting the goods at issue. In regard to the similarity of the marks, I have found them to be visually similar to between a medium and high degree, aurally similar to a medium degree and conceptually similar to a medium degree. I have found that CyberNet's mark is inherently distinctive to a low degree. While that may be the case, I am reminded of the fact that the low distinctive character of an earlier mark does not preclude a likelihood of confusion.²²

²² *L'Oréal SA v OHIM*, Case C-235/05 P

82. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that the differences between the marks are sufficient to avoid the average consumer misremembering or mistakenly recalling one mark for the other. While I note that the entirety of CyberNet's mark is present within Kinkabu's mark, I do not consider that the addition of the letters 'ABU' at the end of Kinkabu's mark will be overlooked. Those letters do not contribute to the overall impression of the mark to any lessened degree simply due to the fact that they sit at the end of the word element. I find that, regardless of their position, they form part of the dominant element of Kinkabu's mark and will be considered a point of significant difference by the average consumers that will assist them in accurately recollecting or remembering which mark was which. I make this finding whilst also bearing in mind the level of similarity between the marks. Consequently, I do not consider that there is a likelihood of direct confusion between the marks, even on goods that are identical. I will now proceed to consider indirect confusion.

83. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., as the Appointed Person, explained that:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

84. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor K.C (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

85. At the hearing, CyberNet submitted that Kinkabu’s mark would be appreciated as either a sub-brand or brand extension of CyberNet’s mark. In response to this point, Kinkabu argued that this was not the case and that the addition of ‘ABU’ after ‘KINK’ does not fall within any of the categories set out in *L.A. Sugar* (cited above). Further, Kinkabu state that there is no additional explanation as to why ‘KINKABU’ would fall into any other separate type of category not specified in *L.A. Sugar* (being categories (a) to (c) reproduced in full above). In giving its submissions in reply, CyberNet elaborated on its argument further in that to be caught by one of the

categories of indirect confusion, the indicator of a sub-brand does not need to be something along the lines of 'International', 'Lite' or any other kind of qualifier but that it only needs to be recognisable whilst also being slightly different. While I agree with CyberNet's point that it is not necessary that the additional element is along the lines of those examples given, I do not agree that for indirect confusion to apply there only needs to be something recognisable whilst also being slightly different. This argument is, in my view, very vague and too widely encompassing. Instead, I am guided by categories (a) to (c) of *L.A. Sugar* (whilst bearing in mind that the examples cited are not exhaustive).

86. Upon being confronted with the parties' marks, I find it likely that the average consumer would view 'KINK' and 'KINKABU' as being separate indicators that the marks at issue originate from different and unconnected undertakings. I do not consider that the word 'KINK' in CyberNet's mark is so strikingly distinctive that the average consumer would assume that only CyberNet used it. On the contrary, I consider that due to its low distinctive character, the average consumer would consider that shared use of 'KINK' on goods used for sexual activity/massage would be purely coincidental. I have found throughout this decision that 'ABU' is a prominent point of difference across the marks and it is not, in my view, a non-distinctive element that points to 'KINKABU' being a sub-brand, brand extension or rebranding of 'KINK'. It is my view that the addition of 'ABU' is an element that has no meaning and, therefore, I see no plausible reason why it would be considered as being a logical or consistent indicator suggestive of 'KINK' creating a sub-brand or brand extension, or that it has re-branded its mark. While the factors set out in *L.A. Sugar* are not exhaustive, I note that (as Kinkabu's submissions referenced above mention) CyberNet has offered no additional explanation of a likelihood of indirect confusion outside of these categories. In the absence of any specific argument, I see no reason as to why the differences between the marks would give rise to a finding of indirect confusion on any other basis. Lastly, even if the average consumer views Kinkabu's mark and calls to mind CyberNet's mark, this is not sufficient for indirect confusion and is, instead, mere association.²³ Consequently,

²³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

I do not consider that there is a likelihood of indirect confusion between the marks at issue, even where they are displayed on identical goods.

87. Given my findings above, CyberNet's opposition fails in its entirety.

CONCLUSION

88. Kinkabu's applications for invalidity have failed in their entirety meaning that CyberNet's marks may remain on the register for all goods and services for which they are registered. Additionally, CyberNet's opposition against Kinkabu's mark has also failed in its entirety and Kinkabu's mark may, therefore, proceed to registration for all goods applied for.

COSTS

89. Given the outcomes of the applications for invalidity and the opposition, I am of the view that the parties have enjoyed an equal measure of success in the course of these proceedings and consider it appropriate that both parties are to bear their own costs. I, therefore, make no order as to costs.

Dated this 6th day of December 2022

A COOPER

For the Registrar