

O/568/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3588214
IN THE NAME OF THE NORTH POLE PRODUCTIONS LTD
IN RESPECT OF THE TRADE MARK**

Santa's Lapland

IN CLASS 41

AND

**OPPOSITION THERETO UNDER NO. 425462
BY LUK HOLDINGS LIMITED**

Background and pleadings

1. The North Pole Productions Ltd (“the applicant”) applied to register the trade mark application no. 3588214 for the mark ‘Santa’s Lapland’ in the UK on 1 February 2021. It was accepted and published in the Trade Marks Journal on 9 April 2021 in respect of the following services:

Class 41: Theatre services; Entertainer services; Photography services.

2. LUK Holdings Limited (“the opponent”) opposes the trade mark on the basis of section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition under section 5(2)(b) and 5(3) is on the basis of its earlier UK trade marks set out in the table below:

Trade Mark	Registration number	Filing date/ Registration date	Specification relied upon
	3512404	15 July 2020/ 23 October 2020	<i>Class 41: Entertainment; cultural activities; providing online video games, online computer games, and temporary use of non-downloadable video games; production of television series and films; distribution of television series and films; theatrical performances; Provision of film clips, photographs and other multimedia materials via a website; amusement park and theme park services; live or pre-recorded shows and/or</i>

			<i>movies; providing on-line publications (non-downloadable); production of entertainment shows featuring actors, dancers and singers; organising events, exhibitions and shows for entertainment purposes; provision of non-downloadable films and television programmes via online streaming services.</i>
LAPLAND UK (“the word mark”)	3075300	03 October 2014/ 22 May 2015	<i>Class 41: Entertainment services; amusement parks; organisation of competitions; production of shows; provision of recreation facilities; entertainment; sporting and cultural activities; production, presentation and distribution of audio, video, still and moving images and data; presentation of live performances.</i>

3. By virtue of their earlier filing dates, the above registrations constitute earlier marks within the meaning of section 6 of the Act.
4. The opposition based on section 5(4)(a) of the Act is based on the earlier sign ‘LAPLAND’ which the opponent claims has been used throughout the UK since 2007 in respect of the goods below:

entertainment; cultural activities; providing online video games, online computer games, and temporary use of non-downloadable video games; production of television series and films; distribution of television series

and films; theatrical performances; Provision of film clips, photographs and other multimedia materials via a website; amusement park and theme park services; live or pre-recorded shows and/or movies; providing on-line publications (non-downloadable); production of entertainment shows featuring actors, dancers and singers; organising events, exhibitions and shows for entertainment purposes; provision of non-downloadable films and television programmes via online streaming services; organisation of competitions; production of shows; provision of recreation facilities; production, presentation and distribution of audio, video, still and moving images and data; presentation of live performances.

5. The opponent claims under section 5(2)(b) that the marks are similar and that they are filed in respect of similar or identical services, and that as such there exists a likelihood of confusion between the marks.
6. In respect of the opposition under section 5(3), the opponent states that its marks are well recognised by the consumer, and that due to the similarity between the marks, the consumer would believe that the applicant's marks are economically connected to the opponent. The opponent also claims that use of the later marks would call the earlier marks to mind, and that the applicant would unfairly benefit from the power of attraction, prestige, and reputation of the opponent. The opponent also argues that inferior services or bad publicity under the applicant's mark would result in detriment to the opponent's reputation, and that use of this mark would weaken the earlier marks capacity to distinguish the goods and services of the opponent, causing dilution and harm to its distinctive character and resulting in a loss of sales for the opponent.
7. Under section 5(4)(a) of the Act, the opponent claims it holds significant goodwill under its sign in the UK, and that there would be a misrepresentation that the contested mark is endorsed by the opponent on this basis, resulting in damage to the opponent.
8. The applicant filed a counterstatement admitting that the marks are similar but denying there will be any confusion between the marks. The applicant states it

has never heard of the opponent, and that LAPLAND is a region in Finland associated with Christmas and it is used by multiple companies. The applicant states both the applicant and the opponent may operate under the marks without any detriment to the other. The applicant did not request the opponent provides proof of use in respect of this opposition.

9. Both parties filed statements during the evidence rounds in these proceedings. The evidence filed will be summarised to the extent that it is considered necessary. The opponent filed final written submissions in lieu of a hearing. No hearing was requested and so this decision is taken following a careful perusal of the papers.
10. The applicant is not represented in these proceedings. The opponent is professionally represented by Bird & Bird LLP.
11. 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.

Evidence


12. The opponent filed its evidence in the form of a witness statement in the name of Mike Battle, the CEO and co-founder of Lapland UK. Lapland UK is described as the business behind the company LUK Holdings Limited. The statement is dated 1 December 2021 and introduces 15 exhibits, namely Exhibit MB1 – Exhibit MB15.
13. Mr Battle explains “Lapland UK is a unique immersive Christmas experience for families” based in Ascot that runs for just under two months over the festive period.¹ He explains families from all over the UK visit and stay in the area overnight, and states it includes theatrical performances, activities, workshops and more.² He states since its inception 14 years ago in 2007, Lapland UK has


¹ See paragraph 7 of the witness statement of Mike Battle

² See paragraph 7 of the witness statement of Mike Battle

had over 1,000,000 visitors and the opponent has made sales in excess of £100,000,000.³

14. Mr Battle explains the mark 'Lapland UK' has been used since its inception.⁴

Mr Battle also explains the stylised logo  has been used since at least 2018,⁵ but I also note the Instagram post at Exhibit MB-5 dated 2 June 2017 displays the stylised mark and introduces the 'new look'. Brand guidelines

are also provided at Exhibit MB-1, detailing the mark  as the primary logo and showing examples of best practice for the use of this mark, including on emails and as a social media icon. The guidelines show a 'version created' date of October 2018.

15. Financial statements are provided at Exhibit MB-3 and UK turnover is provided in Mr Battle's statement as below:⁶

Financial Year	Total turnover (GBP)
Year ending 28 February 2015	3,258,341
Year ending 29 February 2016	4,098,391
Year ending 28 February 2017	5,084,424
Year ending 28 February 2018	5,770,666
Year ending 28 February 2019	6,873,785
Year ending 28 February 2020	8,318,233
Year ending 28 February 2021	7,275,193

³ See paragraph 8 of the witness statement of Mike Battle

⁴ See paragraph 13 of the witness statement of Mike Battle

⁵ See paragraph 14 of the witness statement of Mike Battle

⁶ See paragraph 17 of the witness statement of Mike Battle

16. Ticket sales are also provided by Mr Battle, who sets these out as below:⁷

Year	Number of tickets sold
2017	65,000
2018	75,000
2019	83,000
2020	115,000
2021	155,000

17. The number of Instagram followers held under the opponent's Lapland UK page as of 28 December 2020 is provided at Exhibit MB-5 via the website 'trendhero' which shows this as 177,011 at that date. The earliest posts provided on the 'laplanduk' Instagram account date back to 2014. A number of these posts are shown at Exhibit MB-6, including a 2019 post with 28,746 views featuring Holly Willoughby, and one video listed as having 329,445 views dated from 30 September 2020, for which the following screenshot is provided:



18. Exhibit MB-8 provides a number of press articles and celebrity social media posts. The press articles reference various celebrities and their visits to Lapland UK, and online articles from the national newspaper The Daily Mail, referring to visits from the Beckhams and from Elton John, amongst others. Various celebrity Instagram posts detailing their visits to Lapland UK are also provided,

⁷ See paragraph 18 of the witness statement of Mike Battle

including, for example, a post referencing a visit to Lapland UK from footballer Harry Kane which received over 160,000 'likes'. Further press articles and reviews about Lapland UK are provided at Exhibit MB-15, including further online articles from national newspapers including The Sun, The Daily Mirror and The Daily Mail, although several of these post-date the filing date of the application of 1 February 2021.

19. Mr Battle also provides details of competitions with Heart Radio and Good Housekeeping in 2016 and 2015,⁸ and lists several awards won by the company including awards for the 100 Fastest growing companies in the UK in 2016 and Entrepreneur of the Year London and the South East award in 2018.⁹

20. Whilst I have not detailed all of the evidence and exhibits provided, this has all been fully considered.

Proof of use

21. The applicant has not requested proof of use is provided within this opposition, and as such the opponent may rely on its earlier marks as set out in its statement of grounds and reproduced at the outset of this decision.

Preliminary issues

22. Before proceeding with my decision, I find it appropriate to briefly address some of the remarks made by the applicant throughout these proceedings. The first is the applicant's admission within its counterstatement that the marks are similar. The opponent has subsequently highlighted this statement from the applicant within its submissions. Whilst I accept this admission, and will therefore treat the marks as similar, I also note that it remains open to me to determine the level of similarity between the marks. This is how I intend to proceed.

23. I also note the applicant's comments regarding the unique font used by the opponent for its LAPLAND UK mark, and the applicant's statement that it offers

⁸ See paragraphs 28 and 29 of the witness statement of Mike Battle

⁹ See paragraph 27 of the witness statement of Mike Battle

its services under a different pricing structure to the opponent, submitting this reduces the likelihood of consumer confusion between the companies. Where the earlier mark is filed as a word mark, such as in the case of the opponent's second mark LAPLAND UK, I must keep in mind the fair and notional use of that mark, which will include its use in a range of standard fonts. The same applies for the applicant's mark, which is also filed as a word mark only. Further, factors such as the decision of the parties to offer services under a particular pricing structure are not relevant to the decision I have to make, as these may be subject to change over time.¹⁰

Decision

Section 5(2)(b)

24. Section 5(2)(b) of the Act is as follows:

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

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

Section 5A

25. Section 5A of the Act is as follows:

“5A 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.”

¹⁰ See *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P in which Court of Justice of the European Union stated the Court of First Instance was fully entitled to hold that it is inappropriate to take the particular circumstances in which the goods in question were marketed into account.

The principles

Likelihood of confusion (standard case law)

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

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 might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of services

27. It is obvious that where terms are included identically within both the specification of goods/services relied upon and the specification of goods/services under the contested mark, they should be considered identical. Furthermore, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“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 für 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”.

28. The opponent relies upon the broad terms *Entertainment* under its stylised mark and *Entertainment services* under its word mark. It is my view that both of these terms encompass at least *Theatre services* and *Entertainer services* under the contested mark. The earlier marks also include more specific terms including *live or pre-recorded shows and/or movies* under its stylised mark and *presentation of live performances* under its word mark which are both clearly encompassed within *theatre services* and *entertainer services* in the contested mark. These services are identical in line with the principles set out in *Meric*.

29. That leaves *Photography services* as covered by the contested mark. The earlier stylised mark includes the term *Provision of film clips, photographs and other multimedia materials via a website* and the earlier word mark includes *presentation and distribution of audio, video, still and moving images and data*. The provision of photographs via a website, in addition to the presentation and distribution of still images are clearly encompassed within the meaning of *Photography services*, and I therefore find the earlier mark to be identical in line with the principles as set out in *Meric*.

Comparison of marks

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

31. It would be wrong, therefore, to dissect the trade marks artificially, 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.

32. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
	Santa's Lapland
LAPLAND UK	

The Stylised Mark

33. The earlier mark comprises the word LAPLAND and features considerable stylisation. The initial letter 'L' is resemblant of antlers with a bauble hanging from the same, the letter 'p' has a holly leaf protruding from the top, the second 'l' is fashioned from a stocking, and the final letter 'n' shows what looks like a small wooden door. I do not find LAPLAND to be particularly inherently distinctive for many of the services, and I will discuss this in more detail later on in this decision. Whilst the word LAPLAND is the most dominant element of the mark, I find the stylisation adds to the distinctive character of the mark itself,

and the overall impression of the mark is produced by the combination of the heavy stylisation in addition to the word LAPLAND.

34. The contested trade mark is made up of the two words Santa's Lapland, conveying the meaning of Lapland belonging to Santa.¹¹ Whilst Lapland appears therefore to be the more dominant element of the mark, the two elements of the mark hang together to create this meaning, and it is my view that the overall impression of the mark as a whole resides in the combination of these two elements.

Visual comparison

35. Visually, the marks coincide through the use of the word LAPLAND. This word is heavily stylised in the earlier mark. Whilst I acknowledge the contested mark is registered as a word mark and therefore may be used in a range of standard fonts, I find the stylisation of the earlier mark to fall outside of what I would consider to be normal and fair use of the contested mark, and I consider the stylisation to alter the distinctive character of the mark. The stylisation of the earlier mark therefore creates a further point of visual difference. I also note the contested mark begins with the additional word 'Santa's'. Overall, I find the marks to be visually similar to a below medium degree.

Aural comparison

36. The marks coincide aurally by way of the second two syllables in the contested mark which form the entirety of the earlier mark, namely LAP-LAND. The contested mark also contains the initial two syllable word SAN-TAS which is not present in the earlier mark. Based on the two shared syllables, and single shared word, I find the marks aurally similar to a medium degree.

¹¹ The meaning conveyed to the consumer is discussed in more detail in the conceptual comparison to follow.

Conceptual comparison

37. Within its written submissions, the opponent argues as follows:

“19. The Applicant briefly states in its counterstatement that ‘LAPLAND’ is a region in Finland. However, that region has nothing to do with the services in question. The Applicant also argues that ‘LAPLAND’ is associated with Christmas and is used by multiple companies for Christmas-related services. However, the opponent submits that the Hearing Officer should dismiss the Applicant’s arguments. The connection between ‘Santa’ and Christmas and its use in respect of ‘Santa’s Grottoes’ is so well-known in the UK that the Hearing Officer is invited to take judicial notice of that fact. However, even if consumers associate the word ‘LAPLAND’ with a geographical region in Finland, that region does not have i) anything to do with the relevant services in itself, or ii) the same obvious connection with Christmas as ‘Santa’, and the Applicant has not submitted any evidence to suggest otherwise. In other words, whilst ‘Santa’ is inextricably connected with Christmas and grottoes, ‘LAPLAND’ is first and foremost a geographical region, that has nothing to do with the relevant services, and there is no evidence in these proceedings to the contrary. It should also be noted that Earlier Mark 2 contains the letters UK, which would be seen as a reference to the country, so consumers will not consider the word LAPLAND is a reference to the region in Finland as that makes no sense alongside a clear geographical reference to the UK.”

38. I accept, as the opponent has highlighted, that the applicant has not filed evidence showing the use of LAPLAND by multiple companies in the UK, nor has it filed evidence relating to the consumer’s understanding of the word. However, while I am cautious not to believe that my own understanding and knowledge is more wide spread than it is, contrary to the opponent’s submission, I do not consider it to be a point of serious dispute to find that ‘LAPLAND’ will be understood by the UK consumer as a reference to the fictional home of Santa Claus, and that it will therefore be inextricably linked to Christmas. I am therefore able to make this finding without the need for

evidence in respect of the same.¹² I accept that for some, the fact that Lapland is also a region in Finland will be obvious, but that some UK consumers may have a harder time placing the exact geographical location of LAPLAND, possibly even believing that it is a fictional location only. However, I believe it will be widely understood by the vast majority of consumers as being at least a Nordic region of some kind, in addition to the fictional home of Santa.

39. Conceptually, I therefore find the earlier mark will convey to the consumer the concept of the Nordic region Lapland, which is simultaneously the fictional Christmas land which houses elves, reindeer, Santa Claus, and his workshop, or else for the minority, the concept of the fictional Christmas land only. This concept is reinforced by the heavy stylisation of the mark, the sum of which is indicative of elves, Christmas decorations and reindeer. It is my view that 'Santa's Lapland' will also convey this concept to consumers, and I find the marks conceptually highly similar.

The word mark

40. The opponent's word mark comprises two elements, those being LAPLAND UK. Both of these are references to different locations. As I have mentioned above, I do not find LAPLAND to be particularly inherently distinctive for many of the services, and I will discuss this in more detail later on in this decision. However, I also note that the use of UK at the end of a trade mark tends to simply indicate to consumers that the services under the mark are UK based. It is my view that the word LAPLAND plays the most dominant role in the overall impression of the mark, however, on the basis of the low level of distinctiveness of both elements, in addition to the juxtaposition of the two contrasting locations within the one mark, it is my view that the use of UK will not be negligible in this instance, and the overall impression of the mark as a whole resides in the combination of the two elements.

41. The overall impression of the contested mark is as outlined above.

¹² *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

Visual comparison

42. Visually, again the marks coincide through the use of the word LAPLAND. They differ by way of the word 'Santa's' in the contested mark, and the use of 'UK' in the earlier mark. Overall, I find the marks to be visually similar to a medium degree.

Aural comparison

43. Again, the two syllables of the word LAP-LAND will be pronounced identically in each mark, although they are in different positions in each. The two syllable word SAN-TAS in the contested mark is not present in the earlier mark. It is my view that due to the low level of distinctiveness in LAPLAND alone, in addition to its location outside of the UK (whether understood as real or mythical by consumers), that the mark LAPLAND UK will be pronounced in full. Whilst short for United Kingdom, 'UK' will likely simply be pronounced as the two letters 'U-K'. Considering the aural similarities and differences between the marks, I find them to be aurally similar to a medium degree.

Conceptual comparison

44. The contested mark will be conceptualised as outlined above. It is my view the LAPLAND element of the earlier mark will also convey a reference to Lapland as the Nordic region that is the home of Santa Claus. In the context of the services, it is my view the earlier mark as a whole will convey to the consumer the concept of a version or recreation of Lapland located within the UK. It is my view it is conceptually highly similar to the contested mark.

Average consumer and the purchasing act

45. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

46. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

47. The average consumer of the services will primarily be members of the general public. However, I accept that particularly in respect of the services such as photography services, there may also be a number of corporate and professional consumers. The services offered such as entertainment will be considered by the general public, and factors such as suitability, preferences and reviews may play a part in the decision making, although I do not find the category as a whole will warrant more than a medium degree of attention. For the services such as photography, artistic preferences and reviews may play a part in the decision making process for these services, and the general public will pay at least a medium degree of attention when choosing the same. I find the professional public will pay a slightly higher degree of attention when choosing the services, and this will be at least at an above medium level.

48. The purchasing process for the services will be primarily visual, with these being offered via websites, social media and with visual material such as pamphlets and visual advertisements used to promote the same. However, I accept there may also be word of mouth recommendations in respect of these types of services, and as such the aural considerations cannot be ignored.

Distinctive character of the earlier trade mark

49. 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).”

50. As mentioned under the conceptual comparison for this mark, the stylised mark conveys to the consumers the concept of the Nordic location that is also the fictional home of Santa, or for some, the latter only. With consideration to the types of services that are covered by this mark, including those such as *entertainment and amusement park and theme park services, production of entertainment shows featuring actors, dancers and singers*, and even those falling within the meaning of *photography services*, the mark is at least highly

allusive that these services will be themed around the fictional Lapland, Santa Claus and Christmas. I find the word Lapland alone to be inherently distinctive at best to a very low degree in respect of the services covered. Whilst I note the stylisation of the mark serves to reinforce this concept, it is fairly heavy and relatively creative, and as such I find the inherent distinctiveness of the mark as a whole will fall at just above a low level when taking this into account.

51. In respect of the word mark, again the word LAPLAND is, as a minimum, highly allusive of the types of services offered under the mark. The inclusion of 'UK' indicates to the consumer that the services are offered within the UK, and the mark as a whole indicates to the consumer the services will be themed around Christmas and Lapland set in the UK. Overall, I find the inherent distinctiveness of the mark to be very low.

52. I therefore consider if the inherent distinctiveness of the marks has been enhanced through the use made of the same. I consider firstly, the marks that are shown within the evidence. I note there is consistent reference to the word mark LAPLAND UK, and I consider that the use of this in various standard fonts and in upper-case and lower-case text, will all constitute fair and normal use of this mark. This mark is also sometimes shown in the evidence as LAPLANDUK, and I also consider that use without a space between the words to be use of the mark as registered, as the removal of the space between the words makes such a minor difference to the overall impression of the mark it will likely go unnoticed.

53. I also note there is more limited use shown of the stylised mark as registered, in addition to its use in conjunction with UK as below:



54. It is my view that where the mark is used as above, the stylised mark maintains its role as an independent indication of origin within the same. I therefore find the use in the form above to be use of an acceptable variant of the stylised mark.¹³ The application was filed on 1 February 2021, making this the relevant date for assessing if the distinctive character of the marks has been enhanced by virtue of the use made of the same amongst UK consumers.

55. I note the stylised mark first makes an appearance via the opponent's Instagram in June 2017, and so the evidence identified as being from prior to this date, including the turnover figures from before this time, cannot be taken to reference sales under the stylised mark. However, I note the total number of tickets sold in the years 2018, 2019 and 2020 as set out within the evidence summary is 273,000, which I consider to be healthy particularly in relation to seasonal services, which Mr Battle has confirmed are available just two months of the year. I note that at least some of the 2017 sales will likely have fallen after the introduction of the stylised mark, and that at least a portion of the 2021 figures will have fallen before the relevant date. I note the ticket sales during this time contributes to a turn over figure of several million GBP each year. I note the reach and the use of both of the marks on the opponent's social media, with one video of 30 September 2020, a screenshot for which is provided within the evidence summary, showing the stylised mark having had 329,445 views. Although it is not confirmed that all of these views will be from a UK audience (or that they were all from prior to the relevant date), it is clear the services are based in the UK, and so it is reasonable to assume these posts are at least primarily targeted at the UK consumer. Further, I note the mark is shown on the opponent's website and in its branding guidelines from 2018.

56. However, I note the stylised mark is scarcely shown within the celebrity posts or press articles referring to the park. Whilst I accept that the press references to the word mark will likely have resulted in some additional exposure for the stylised mark via traffic to the opponent's website, it is my view the exposure to

¹³ See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

this mark will not have been near that of the word mark itself, which is referenced within the same.

57. In respect of the word mark, I note Mr Battle's statement that the opponent has operated as Lapland UK since 2007 and has had over a million visitors since that date.¹⁴ The turnover figures provided are also set out in full within the evidence summary, and I note these date back to 2015 and begin at over 3 million GBP at the outset and increase from that point onwards, and there are references to the word mark both in press and on social media during that time. I note the awards and competitions run as provided in the evidence also make reference to the word mark Lapland UK.

58. I also note the significant national press attention received, in addition to the social media attention from various celebrities. Instagram posts from comedian David Walliams (December 2020) and actress Liv Tyler (December 2019) are provided, with the former receiving over 20,000 likes and the latter over 210,000 views. Footballer Harry Kane also posted his visit on Instagram in 2020 and received over 160,000 likes, and posts by other celebrities including singers Cheryl and Stacey Solomon and TV presenter Holly Willoughby received hundreds of thousands of likes or views. The posts either tag the Instagram handle '@laplandUK' or refer to the word mark in text. Online press articles referring to the Beckham's visit with their family to 'Lapland UK', include an article in the Daily Mail online from 2019, and from Hello magazine online from 2016, and the Daily Mail online also reported on both reality TV star Billie Faier and TV presenter Emma Willis visiting Lapland UK in 2019, with OK magazine also reporting on the former and Hello magazine also reporting on the latter. A further Daily Mail online article from 20 December 2017 shows Elton John visiting, and states "Elton visits every year" in an article about Mr Battle and his wife setting up Lapland UK. It also states "Lapland UK sells out every year and attracts royal family and A-list celebrities". Further press articles are provided at Exhibit MB-15 including some from the Daily Mail online dating back to 2013.

¹⁴ See paragraph 13 of the witness statement of Mike Battle

59. The opponent's services are summarised by Mr Battle in his witness statement as a "...unique, immersive Christmas experience..." and states:

"Visitors to Lapland UK explore a magical world and are treated to scripted theatrical performances by its residents, as well as activities, workshops and more."

60. The park is described in the press as below:

"While the site this year had multiple attractions including reindeer, a toy factory, a magical forest and shops, Father Christmas has always been at the heart of Lapland UK." (i Business online article dated 23 December 2020)

"Victoria and David Beckham have been making the most of the festive period as they treated their children to a trip to Lapland UK, a Christmas-themed attraction located in Winkfield Row, this weekend." (Hello Magazine online dated 19 December 2016)

"David Beckham, 44, treated his children to a day out at Christmas-themed park Lapland UK on Sunday" (Daily Mail online dated 23 December 2019)

"Billie Faiers gave her daughter Nelly, 5, and son Arthur, two, the ultimate festive treat on Sunday as they enjoyed a festive family outing at Lapland UK.

The Mummy Diaries star, 29, documented the outing with her husband Greg Shepherd, 33, on Instagram as their children paid a visit to Santa Claus, had a go at making toys and decorated some gingerbread men." (Daily Mail Online dated 23 December 2019)"

“LaplandUK has become a must-visit destination in the lead up to Christmas for celebrity parents and their children. Matt and Emma visited just days after his former McBusted bandmate Tom Fletcher and his wife Giovanna took their three sons, while Holly Willoughby treated her children to a day out there at the weekend, and said it was a "magical day out".

Located within Whitmoor Forest close to Ascot, the attraction sells out months in advance, with parents already able to sign up for alerts to nab tickets in 2020. It promises a four-hour immersive experience with an original adaptation of the Father Christmas story, featuring interactive activities for children and adults alike to enjoy. No wonder Matt and Emma loved it so much!” (Hello Magazine online dated 20 December 2019)

61. Whilst I acknowledge there may be live performances, as well as various workshops offered within the opponent’s park, it is my view that the services offered are primarily theme park/amusement park services.

62. With consideration to the sum of the evidence provided, whilst I note its use since 2017 for *amusement park and theme park services* it is my view that the evidence provided does not support a finding that the distinctiveness of the opponent’s stylised mark has been significantly enhanced through use. However, I accept that the use of the stylised mark prior to the relevant period and the inevitable additional exposure following the significant press attention received by the parks will have resulted in a marginal enhancement to slightly below a medium level in respect of the stylised mark as a whole in relation to these services.

63. In respect of the word mark, based on the longstanding use, the success of the ticket sales, and particularly the press reporting of the many high profile celebrity visits referencing the mark, it is my view the distinctive character of the word mark LAPLAND UK has been enhanced from its inherently very low level

to slightly above a medium degree in respect of the mark as a whole, in relation to *amusement parks*.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

64. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 26 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier marks will have an impact on the likelihood of confusion, and that the likelihood of confusion may be increased where the distinctive character held by the earlier marks are high and may be less likely where they are low. I must remember that the distinctive character of the earlier marks may be inherent, but that they may also be increased through use, and that the distinctiveness of the common elements is key.¹⁵ I must keep in mind that a lesser degree of similarity between the services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the services are selected will have a bearing on how likely the average consumer is to be confused.

¹⁵ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

65. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.¹⁶

66. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

67. I found the marks to be aurally similar to a medium degree, and that the contested mark is visually similar to the earlier word mark to a medium degree, and to the stylised mark to a below medium degree. I found both earlier marks and the contested mark to be conceptually similar to a high degree. I found the services covered by the marks to be identical, and that the distinctive character of the earlier word mark has been enhanced through the use of the same in the UK to slightly above a medium degree in respect of some of the services, whilst the distinctiveness of the stylised mark was enhanced above its inherent level to a slightly below medium degree in respect of some of the services. I found the level of attention that will be paid to the services will be medium or above, depending on the consumer and the category of services.

68. Considering all of the factors, including the degrees of visual and aural differences between the marks, it is my view that the consumers will notice and recall the differences between these. Whilst I note the points in favour of a likelihood of direct confusion, including the high conceptual similarity, and that the word LAPLAND is the dominant element of all of the marks, it is my view

¹⁶ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

that due to the low level of distinctiveness of this element alone, the additional elements are more likely to be noticed and retained by the consumer in this instance. Whilst I acknowledge the opponent's argument that 'SANTA'S' is so widely associated with Christmas that it should be considered descriptive, it is my view that this hangs together with LAPLAND in the applicant's mark and that this will not go unnoticed or be forgotten by the consumer. It is my view that in this instance, the shared use of LAPLAND in respect of the services provided will not cause the consumer to mistake either earlier mark for the contested mark. I therefore consider there to be no direct confusion between the marks.

69. I therefore consider if I believe there will be a likelihood of indirect confusion between the marks. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person set out three examples of instances in which indirect confusion may occur, as follows:

"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)".

70. In this instance, the opponent has argued within its written submissions that this falls within category (c) above, and that it would be entirely logical to add the descriptive element SANTA'S to the earlier mark to indicate a brand extension.

71. I note at this point that the categories set out above were not intended to be exhaustive. However, considering all of the relevant factors, I disagree with the opponent that this situation falls within category (c) above. The opponent has not provided further reasoning or any examples of a scenario in which it would be logical for the opponent to offer some services under LAPLAND UK or its stylised mark, and extended services under SANTA'S LAPLAND, and it is my view the consumer would not consider the marks in this way. In this instance, I do not find that the marks fall within one of the categories set out above.

72. I therefore consider if there is another reason for me to find indirect confusion between the marks. Whilst I find the distinctiveness of the mark LAPLAND UK has been increased to slightly above a medium level in respect of some of the services, I consider this is in respect of the mark as a whole, and not simply in respect of the word LAPLAND alone, which I find holds at best a very low level of distinctiveness. I also remind myself that whilst the element LAPLAND is the focus of the mark SANTA'S LAPLAND, the contested mark nonetheless hangs together as a unit, and it is my view that consumers will not construe the common element LAPLAND independently as an indication of the economic origin of the services provided within this mark, meaning the consumer is not likely to be confused on the basis that they believe the contested mark consists of two or more independent marks.¹⁷ Considering these factors, it is my view that if the consumer were to notice this element being shared by the two marks, they would put this down to coincidence, and consider that it points to the shared subject matter of the services offered, and not to a link between the origin of the marks. I also find this to be the case in relation to the stylised mark, which I note holds a slightly below medium level of distinctive character in respect of some of the services based on the combination of the stylisation and the word LAPLAND in this instance. I therefore find no likelihood of indirect confusion between the marks.

¹⁷ See paragraphs 18 – 21 of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 in which Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*.

73. The opposition, so far as it is based on section 5(2)(b) of the Act therefore fails.

Section 5(3)

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

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

75. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L’Oreal v Bellure* and *Case C-323/09, Marks and Spencer v Interflora* and *Case C383/12P, Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

76. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements, the cumulation of which must satisfy all elements of the claim. To be successful on this ground, the opponent must prove it holds a reputation for the earlier marks relied upon amongst a significant portion of the public. If it is found both that the earlier mark holds a qualifying reputation it must then be shown that this reputation, combined with the similarity between the marks will result in the relevant public establishing a link between the same. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all of these elements have been established, it must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage.

77. In this case, the opponent has pleaded that the similarity of the signs will result in both confusion between the earlier marks, and the later mark calling the earlier marks to mind. The opponent submits that on this basis, the applicant would unfairly benefit from the power of attraction, prestige and reputation that the opponent's mark enjoys, without the applicant having made the associated investment themselves. The opponent also pleads there may be detriment to the opponent's reputation based on the link and confusion between the marks, and the possibility that the applicant will offer inferior services or attract bad publicity. Finally, the opponent pleads that the use of the contested mark would

dilute its marks' distinctive character and weaken its capacity to distinguish the services of the opponent from those of third parties.

Relevant date

78. The relevant date for considering if the opponent held a reputation in its earlier marks is the date the contested application was filed, namely 1 February 2021.

Reputation

79. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

80. The opponent claims to hold a reputation in its marks in respect of all of the services set out at the outset of this decision. Having considered the sum of the evidence, and as detailed within my findings regarding enhanced distinctive character, it is my view that if the opponent has gained a reputation for its services under its two marks, this will be in respect of *amusement park and theme park services* as relied upon under its stylised mark, and *amusement parks* as relied upon under its word mark.

81. I consider the sum of the evidence showing the use of the marks prior to the relevant date. In respect of the stylised mark, I note again that this has been shown as in use since 2017 on the opponent's social media, and that Mr Battle states it has been used "...since at least 2018..." at paragraph 14 of his witness statement. I note it has been used on the opponent's website and within the park. I note the number of views received by social media clips showing the stylised mark, some reaching hundreds of thousands, and I consider again the turnover provided of several million each year, and the ticket sales made since the stylised mark was introduced, which rise from over 65,000 ticket sales in 2017 to 155,000 ticket sales in 2021, part of which is likely to fall within the period leading up to the relevant date. As I have mentioned previously, I consider the number of ticket sales to be healthy, particularly noting that the opponent offers its services for two months of the year on a seasonal basis only, and I accept that the majority of ticket holders from after the stylised mark was introduced are likely to have come into contact with the stylised mark. I consider that only a limited number of ticket sales will be possible for services such as those offered. There is nothing to quantify or put into context Mr Battle's statement that the opponent is the "...most successful company in the Christmas performance space" and I note the use of the stylised mark is not particularly longstanding, and I have not been provided with much in the way of marketing or advertising materials under this mark, outside of the social media posts. I note Exhibit MB-12 referencing the number of website visits between November 2020 – November 2021 as 1.2 million, but the majority of this period falls after the relevant date.



83. In respect of the word mark, I note again that Mr Battle has confirmed the mark LAPLAND UK has been in use since 2007 and there have been over a million visitors since that date. I note consistent reference to this mark in text, on social media and in national press. I note reference to Lapland UK in respect of the awards won and the competitions run, as well as in the examples of the promotional material shown on the opponent's website. I note the turnover figures dating back to 2015 beginning at over 3 million GBP and rising to over 8 million GBP in 2020, in respect of which it is reasonable to assume the consumer will have been exposed to this mark. I also note the comments in the press in 2019 that the tickets to "Lapland UK" sell out months in advance of the event itself, and the comments in the press from 2017 that tickets sell out yearly.

84. I also note particularly the considerable celebrity and press attention received by the park, referred to consistently under the mark "Lapland UK", with reporting of visits from Elton John and David and Victoria Beckham, amongst other high-profile celebrities, in online articles, including in online national newspapers

such as the Daily Mail, prior to the relevant date. A summary of the celebrity visits reported on in the press, in addition to Instagram posts are set out under my analysis of the evidence relating to the enhanced distinctive character of this mark. It is my view these reports will have undoubtedly raised the profile of the opponent's word mark for the services, and I note that there is also additional press reporting on the park and its success separate to the celebrity references. It is my view that from the sum of the evidence, the opponent has shown it holds a reasonably strong reputation amongst a significant proportion of the UK consumer in respect *amusement parks* as relied upon under its word mark.

Link

85. In order to establish whether the public will make the required mental 'link' between the marks, I must consider the position globally, taking into account all of the factors set out in *Intel*,¹⁸ including the similarity between the marks and the services, the degree of overlap of the relevant consumers and the distinctiveness of the earlier mark, and the strength of the reputation established by the opponent. I will also consider whether there is a likelihood of confusion between the marks. In case I am wrong in my initial finding of there being no qualifying reputation held under the opponent's earlier stylised mark, I will consider this in respect of both earlier marks relied upon at this stage.

The similarity of the marks

86. Earlier in this decision, I found the earlier word mark to be aurally and visually similar to the contested mark a medium degree, and to be conceptually similar to a high degree. I found the stylised mark to be aurally similar to a medium degree, visually similar to a below medium degree and conceptually similar to a high degree.

The similarity of the services and the relevant public

¹⁸ *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU)

87. Under section 5(2)(b) of this decision, I found the services relied upon to be identical to the services contested. However, I have only found the opponent to hold a reputation for *amusement parks* or *amusement park and theme park services* under this ground, and as such I will conduct a comparison of the services based on the same. In the judgment of the CJEU in *Canon*, Case C-39/97, 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”.

88. 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.

89. Whilst I note that *amusement parks* and *theme parks* may employ entertainers, I do not find *Entertainer services* to be encompassed within the meaning of these services. However, I do find there to be a level of complementarity between these services and the opponent's services, as the applicant's services will be important for the same, and the consumer is likely to believe that these types of services may be offered by the same entities.¹⁹ They will also share the broad intended purpose of providing entertainment. I do not find there to be any realistic competition between the services, and the nature will differ. The users will be shared to the extent the services are offered to the general public. Overall, I find there to be a medium degree of similarity between these services.

90. In respect of *Photography services*, I also find it highly likely these will also be offered within *amusement parks* and *theme parks*, and that they will be important to the same, and that in that context, there may be a level of complementarity with the consumer assuming they are offered by the same entity. However, the nature, method of use, and intended purpose will all differ. Again, the users will be shared to the extent the services are offered to the general public. I find these services to share only a low degree of similarity with the opponent's services for which they have a reputation.

91. I do not find the ordinary and natural meaning of the term *amusement parks* or *amusement park and theme park services* to encompass *theatre services* or vice versa, and as such I find no identity between them. Further, I do not find *theatre services* to be important for the running of amusement parks, although I do find there will be occasions where these services will be offered within the same. I do find all the services to be in the field of entertainment, and to share users as all of the services will be aimed at the general public. I find the nature of the services to be shared to a degree, with both likely providing or requiring sets and costumes, and with both possibly offering performances for the

¹⁹ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

entertainment of the consumer. I do not find these services likely to be in competition. Overall I find the services similar to between a low and medium degree.

The strength of the reputation

92. It is my view that the reputation held by the opponent in its word mark in respect of *amusement parks* has not been evidenced to be at the very highest level, but it will nonetheless be reasonably strong. I found that if I am wrong about the stylised mark not holding a qualifying reputation for its services, then its reputation will sit at a modest level.

The degree of distinctive character held in the earlier mark

93. Previously in this decision I found the earlier word mark to be inherently distinctive to a very low degree. However, in respect of the services for which the marks hold a reputation, I found the distinctiveness of the word mark as a whole to have been enhanced to slightly above a medium degree. I found the inherent distinctiveness of the earlier stylised mark to be just above a low level, and to have been marginally enhanced to slightly below a medium level through the use of the same.

The likelihood of confusion between the marks

94. As set out in my decision under section 5(2)(b), I found there to be no likelihood of confusion between the marks.

95. Having carefully considered all of the factors above, it is my conclusion that the consumer will not make a link between the marks in this instance. I note the similarity between the marks and the services, and I keep in mind it is enough for the contested mark to simply bring the earlier marks to mind. However, I note that the similarities between the marks reside in an element that inherently holds a very low level of distinctiveness in respect of the services offered, and the marks begin differently, with the word mark also ending differently. Whilst I note that the distinctiveness of the earlier marks overall is higher, it is my view this higher level of distinctiveness is held in respect of the combination of the

elements together, that including the use of 'UK' in the word mark and the stylisation of the stylised mark. I do not find that the opponent has gained a reputation for the word LAPLAND alone or that it has enhanced its distinctiveness in such a way that the use of this element in the contested mark and in the context of the services will result in the consumer bringing to mind the opponent's earlier mark. Rather, it is my view this would instead immediately bring to mind the concept of the home of Santa and inform the consumer that the services offered under the mark are likely to relate to this. If a link is made between the earlier marks and the contested mark, it will be too fleeting for the image of the earlier mark to transfer to the later mark and give rise to unfair advantage or detriment in this instance.

96. As I have not found that the consumer will make a link between the marks, there can be no unfair advantage or damage. I therefore find the opposition based on section 5(3) of the Act fails.

Section 5(4)(a)

97. Section 5(4)(a) states:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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

98. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

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

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

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

The relevant date

100. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

101. In this case, there is no evidence that the contested mark is in use in the UK, and as such the relevant date for consideration for the establishment of goodwill is the date the application was filed, that being 1 February 2021.

Goodwill

102. The opponent has claimed to hold goodwill in respect of its business in the UK as distinguished by the word LAPLAND. In his witness statement, Mr Battle states he has regularly used the mark LAPLAND without the UK add on.²⁰ However, there is little else evidencing use of the simple word LAPLAND alone by the opponent. I acknowledge that there is some use of the considerably stylised mark as relied upon under section 5(2)(b) and 5(3) of this opposition, however, I do not consider this use will lead the consumer to associate the word mark LAPLAND alone with the business of the opponent.

103. Whilst I accept the opponent will have accrued goodwill in its business in the UK in respect of at least the *amusement park and theme park services* relied upon, I do not find the goodwill held in its business will be distinguished by the sign relied upon, namely the word LAPLAND only.

²⁰ See paragraph 13 of the witness statement of Mike Battle

104. As I find the goodwill held by the opponent in its business will not be distinguished by the mark relied upon under this ground, the opposition under section 5(4)(a) must fail.

Final Remarks

105. The opposition has failed in its entirety, and subject to a successful appeal, the application will proceed to registration in respect of all of the services.

COSTS

106. The applicant has been successful and ordinarily would be entitled to a contribution towards its costs. On 24 March 2022, the Tribunal wrote to the applicant attaching a costs pro-forma and stating as follows:

What to do if you intend to request costs

If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to tribunalhearings@ipo.gov.uk.

If there is to be a “decision from the papers” this should be provided by **7 April 2022**.

If a hearing is taking place you will be advised of the deadline to do so when the Hearing is appointed.

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.

107. The applicant did not return the costs pro-forma provided, and in the circumstances, I make no award of costs.

Dated this 5th day of July 2022

Rosie Le Breton

For the Registrar