

OPPOSITION No B 3 160 576

TikTok Information Technologies UK Limited, Kaleidoscope 4 Lindsey Street, EC1A 9HP London, United Kingdom (opponent), represented by **Taylor Wessing N.V.**, Parnassusweg 821B, 1082 LZ Amsterdam, Netherlands (professional representative)

a g a i n s t

Tee Turtle, LLC, 6200 Pershall Rd, 63042 Hazelwood, United States (applicant), represented by **Kilburn & Strode LLP**, Laapersveld 75, 1213 VB Hilversum, Netherlands (professional representative).

On 02/03/2023, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 160 576 is upheld for all the contested goods.
2. European Union trade mark application No 18 544 331 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 17/12/2021, the opponent filed an opposition against all the goods of European Union trade mark application No 18 544 331 for the word mark 'TIC TAC K.O.'. The opposition is based on EUTM registrations No 18 184 895 for the word mark 'TikTok' (earlier mark 1) and No 17 913 208 for the word mark 'TIK TOK' (earlier mark 2). The opponent invoked Article 8(1)(b) EUTMR in relation to earlier mark 1, and invoked Article 8(5) EUTMR in relation to earlier mark 2.

The opposition is based on more than one earlier trade mark. The Opposition Division finds it appropriate to first examine the opposition in relation to the opponent's EUTM registration No 18 184 895 (earlier mark 1).

LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) EUTMR

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

a) The goods

The goods on which the opposition is based are, inter alia, the following:

Class 28: *Games; toys.*

The contested goods are the following:

Class 28: *Board games; card games; dice games; party games; tabletop games; stuffed and plush toys; toy figures.*

The contested *board games; card games; dice games; party games; tabletop games* are included in the broad category of the opponent's *games*. Therefore, they are identical.

The contested *stuffed and plush toys; toy figures* are included in the broad category of the opponent's *toys*. Therefore, they are identical.

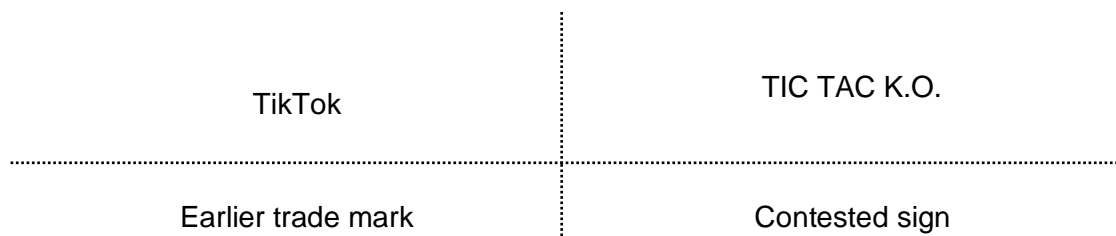
b) Relevant public – degree of attention

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods in question.

In the present case, the goods found to be identical target the public at large.

The degree of attention is considered to be average.

c) The signs



The relevant territory is the European Union.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The unitary character of the European Union trade mark means that an earlier European Union trade mark can be relied on in opposition proceedings against any application for registration of a European Union trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, Armafoam, EU:C:2008:511, § 57). Therefore, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

The applicant argued that 'the mark TikTok conveys immediately the concept of a ticking clock. In contrast, the meaning of the Applicant's mark is instantly recognised by

consumers as a play on the name Tic-Tac-Toe. Tic Tac Toe is a game known the world over under this name and less so as “noughts and crosses”. While the Opposition Division concurs with the applicant that the contested sign’s verbal element ‘TIC TAC’ will be associated with the game ‘tic-tac-toe’ by part of the public – especially the English native speakers – this does not hold true for all consumers in the European Union. For example, the French word used to designate the aforesaid game is ‘morpion’ (information extracted from *Le Robert* on 22/02/2023 at <https://dictionnaire.lerobert.com/definition/morpion>), which is completely different from its English equivalent. Therefore, when the French-speaking consumers encounter the contested sign in an ordinary purchase situation, they are likely to perceive the verbal component ‘TIC TAC’ of the contested sign as an onomatopoeia, whose exact meaning and the degree of distinctiveness is discussed in detail below. This is because the term ‘tic-tac’ is reproduced in numerous French dictionaries (information extracted from *Le Robert* and *Larousse* on 22/02/2023 at <https://dictionnaire.lerobert.com/definition/tic-tac> and <https://www.larousse.fr/dictionnaires/francais/tic-tac/78014>), and it is a widespread and frequently used figure of speech in the French-speaking Members States, for example in France.

Taking the above considerations into account, the Opposition Division finds it appropriate to focus the comparison of the signs on part of the French-speaking public, such as the French public, as this will have an impact on the conceptual similarity between the signs. This affects the perception of the signs by that public and influences the assessment of likelihood of confusion.

In light of the aural identity with the French onomatopoeia ‘tic-toc’ (interchangeably used with the variant ‘tic-tac’), the earlier mark ‘TikTok’ will be perceived by at least part of the relevant public under examination as a misspelling of the aforementioned imitative, used to denote a repeated ticking sound. Since this verbal element is not descriptive, allusive or otherwise weak in relation to the goods at issue, it has an average degree of distinctiveness.

The contested sign’s verbal elements ‘TIC’ and ‘TAC’ will be perceived by at least a substantial part of the public under examination as a variant of the known word combination ‘tic-toc’/‘tic-tac’, with the meaning and the degree of distinctiveness as described above.

The contested sign’s verbal element ‘K.O.’ will be perceived by the French consumers as an abbreviation of the word ‘knock-out’, meaning a disqualification of the boxer who remains on the ground after an opposing blow for more than 10 seconds (information extracted from *Le Robert* on 22/02/2023 at <https://dictionnaire.lerobert.com/definition/ko>). Since this verbal element is not descriptive, allusive or otherwise weak in relation to the goods at issue, it has an average degree of distinctiveness.

Both signs are word marks. In principle, the protection offered by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic or stylistic characteristics that the mark might possess (22/05/2008, T-254/06, RadioCom, EU:T:2008:165, § 43). In addition, word marks do not have elements that could be considered clearly more dominant than others.

Visually, the signs coincide in the first two letters ‘TI’ and the fourth letter ‘T’. The signs differ in the earlier mark’s letters ‘K’, ‘O’ and ‘K’ versus the letters ‘C’, ‘A’, ‘C’ of the contested sign, and in the additional verbal element ‘K.O.’ in the contested sign.

Aurally, insofar as the letters 'K' in the earlier mark versus 'C' in the contested sign will be pronounced identically, as a /K/, the signs' pronunciation coincides in the sequence of letters 'TIKT*K' in the earlier mark versus 'TICT*C' in the contested sign. They differ in the sounds of their fifth letters ('O' versus 'A') and in the pronunciation of the additional verbal element 'K.O.' of the contested sign, which has no counterpart in the earlier mark.

Consumers generally tend to focus on the beginning of a sign when they encounter a trade mark. This is because the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader.

Therefore, the signs are visually similar to a low degree. As the signs differ aurally in the sounds of the vowels 'O' in the earlier mark versus 'A' in the contested sign, placed in the same positions within relatively long strings of letters, and in the additional element 'K.O.' of the contested sign, they are aurally similar to a higher-than-average degree.

Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. The signs will all be associated by the public under examination with essentially the same semantic content conveyed by the expressions 'tic-tac' and 'tic-toc', used interchangeably to denote a repeated ticking sound. The contested sign's verbal element 'K.O.' will be associated with the word 'knock-out'. Therefore, the signs are conceptually similar to an average degree.

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

d) Distinctiveness of the earlier mark

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the opponent, the earlier mark has been extensively used and enjoys an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed in the present case (see below in 'Global assessment').

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. In the present case, the earlier trade mark as a whole has no meaning for any of the goods in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) Global assessment, other arguments and conclusion

Likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case. This appreciation depends on numerous elements and, in particular, on the degree of recognition of the trade marks on the market, the association that the public might make between the marks, and the degree of similarity between the signs and the goods (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).

The goods are identical. According to case-law, when the goods covered by the signs at issue are identical, the degree of difference between the signs must be high to exclude a likelihood of confusion (13/11/2012, T-555/11, tesa TACK, EU:T:2012:594, § 53).

The goods target the public at large. The level of attentiveness of the relevant public is average. The inherent distinctiveness of the earlier mark is normal.

The signs are visually similar to a low degree, aurally similar to a higher-than-average degree and conceptually similar to an average degree. Considering the similarities and differences between the signs, as described in section c), the overall impression of the signs for the relevant public will be that they are similar. This is because the differences between the marks will not be sufficient to counteract the commonalities. Therefore, the relevant public, who must rely on their imperfect recollection of the signs, could easily confuse them or believe that the identical goods originate from the same or economically linked undertakings.

Account is taken of the fact that average consumers rarely have the chance to make a direct comparison between different marks but must trust in their imperfect recollection of them (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). In the present case, the identity between the goods compensates for and outweighs the fact that the signs are visually similar to a low degree.

In its observations, the applicant argues that its trade mark coexists with the opponent's earlier marks.

According to case-law, the possibility cannot be ruled out that the coexistence of two marks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those marks on the part of the relevant public (03/09/2009, C-498/07 P, LA ESPAÑOLA (fig.) / ACEITE DE OLIVA CARBONELL (fig.), EU:C:2009:503, § 82). In certain cases, the coexistence of earlier marks in the market could reduce the likelihood of confusion that the Office finds between two conflicting marks (11/05/2005, T-31/03, GRUPO SADA (fig.) / Sadia (fig.), EU:T:2005:169, § 86). However, that possibility can be taken into consideration only if, at the very least, during the proceedings before the EUIPO concerning relative grounds for refusal, the applicant for the European Union trade mark duly demonstrated that such coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks upon which it relies and the intervener's earlier mark on which the opposition is based, and provided that the earlier marks concerned and the marks at issue are identical (11/05/2005, T-31/03, GRUPO SADA (fig.) / Sadia (fig.), EU:T:2005:169, § 86).

In this regard, it should be noted that formal coexistence in national or European Union registries of certain marks is not per se particularly relevant. It should also be proved that they coexist in the market, which could actually indicate that consumers are used to seeing the marks without confusing them. Last but not least, it is important to note that the Office is in principle restricted in its examination to the trade marks in conflict.

Only under special circumstances may the Opposition Division consider evidence of the coexistence of other marks in the market (and possibly in the register) at national/European Union level as an indication of 'dilution' of the distinctive character of the opponent's mark that might be contrary to an assumption of likelihood of confusion.

This has to be assessed on a case-by-case basis, and such an indicative value should be treated with caution as there may be different reasons as to why similar signs coexist, e.g. different legal or factual situations in the past, or prior rights agreements between the parties involved.

Therefore, in the absence of convincing arguments and evidence thereof, this argument of the applicant must be rejected as unfounded.

Furthermore, the applicant argues that

the Applicant's mark was applied for in the United States of America on 3 March 2021. That mark was granted registration by the USPTO on 9 August 2022. It further added that not only do the marks coexist in the marketplace, but also on the US Trade Marks Register, with no apparent confusion. Furthermore, the USPTO did not consider the marks to be similar when examining the Applicant's US application. It did not cite the Opponent's mark against the application as a conflicting earlier mark.

However, this is irrelevant in the present case. In this regard, the lawfulness of the Office's decisions must be assessed solely on the basis of EU regulations, as interpreted by the European Union judicature. Accordingly, the Office is not bound either by its previous decision-making practice or by a decision given in a Member State, or indeed **a third country**, that the sign in question is registrable as a national mark (23/01/2014, T-513/12, Norwegian getaway, EU:T:2014:24, § 63). This is true even if the decision was adopted in a country belonging to the linguistic area in which the word sign in question originated (16/05/2013, T-356/11, Equipment, EU:T:2013:253, § 7).

Moreover, the applicant contends that, essentially, the Office's search report did not cite the earlier marks, which, according to the applicant, means that the Office does not consider the earlier marks in conflict with the later-filed application. However, the Office's search report is designed to identify similar earlier marks filed for the same classes, or for classes that are considered to contain similar goods and/or services by the Office, and that its sole purpose is to inform the applicant, in a non-exhaustive manner, whether there can be any conflicts with regard to relative grounds for refusal. It does not preclude trade marks that have not been discovered and not listed from being invoked in opposition proceedings (11/12/2014, R 1160/2014-1, VALUA (fig.) / VALEA *et al.*, § 37). Therefore, the applicant's claim has to be dismissed.

Considering all the above, there is a likelihood of confusion on the part of the French-speaking part of the public specified in detail in section c) of this decision. In this regard, as stated above, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

Therefore, the opposition is well founded on the basis of the opponent's EUTM registration No 18 184 895. It follows that the contested trade mark must be rejected for all the contested goods.

Since the opposition is successful on the basis of the inherent distinctiveness of the earlier mark, there is no need to assess the enhanced degree of distinctiveness of the opposing mark due to its extensive use and/or reputation as claimed by the opponent. The result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

As the earlier EUTM registration No 18 184 895 leads to the success of the opposition and to the rejection of the contested trade mark for all the goods against which the opposition was directed, there is no need to examine the other earlier right invoked by the opponent (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268).

Since the opposition is fully successful on the basis of the ground of Article 8(1)(b) EUTMR, there is no need to further examine the other ground of the opposition, namely Article 8(5) EUTMR.

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the applicant is the losing party, it must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMIR, the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Justyna GBYL

Anna PEKAŁA

Alexandra KAYHAN

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.