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Editorial

This month's newsletter features case law updates from the UKIPO, EUIPO and General Court. We focus on issues of genuine use, navigating earlier rights in EUTM oppositions, and the nuances of visual similarity and likelihood of confusion. We also have an important update on the new gTLD program for which applications are now open.

Close to home, the energy in London is palpable as we prepare for the INTA conference! It's an exciting opportunity to reconnect and debate the latest industry and legal trends. Our team look forward to welcoming many of you there for what promises to be a truly inspiring week. Don't forget your umbrella!

Anna Reid
Partner, Solicitor

Events

INTA 2026
02-06 May 2026, London UK
We are excited to welcome INTA visitors to London in May! A leading centre for trade marks and IP, it is home to iconic brands, creative industries, and a sophisticated IP ecosystem. We hope those visiting London for this year's conference find your time her sparks fresh thinking and meaningful connections.

UK Trade Marks: Recent Decisions & Developments in One Hour
01 October 2026, Webinar
Charlotte Duly and Peter Byrd will present this MBL-hosted webinar.

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Evidence / oppositions

Wikipedia won't save you
Why professionally drafted evidence is key

OpenAI, the developer behind the AI chatbot ChatGPT, has recently succeeded in its opposition to the application for the word mark "CallGPT", filed by XEROTECH LTD, offering a stark reminder of the importance of high-quality evidence in UK opposition proceedings.

The opposition, filed in October 2023 under Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994, relied on a suite of earlier marks including CHATGPT, GPT, GPT-3, GPT-4 and GPT-5.

Comparison of the marks

The hearing officer came to the conclusion that CHATGPT had the best chance of a finding of similarity with CallGPT; consequently, despite all of the relied-upon marks being compared, the judgment largely focused on the CHATGPT mark.

Visually, the CallGPT and CHATGPT marks were held to share a medium to high degree of similarity, driven by the shared initial "C" and the identical "GPT" suffix. Aurally, similarity was assessed as medium due to the identical pronunciation of GPT.

Conceptually, the marks were found to have a medium degree of similarity, as "CALL" and "CHAT" both evoke forms of communication. Notably, however, the hearing officer concluded that "GPT" would not convey any clear meaning to the average UK consumer, despite the applicant's assertions that GPT is a widely used descriptor for "generative pre-trained transformers".

Distinctiveness

CHATGPT was found to possess a low to medium degree of inherent distinctiveness, reflecting the allusive nature of "CHAT" in the context of natural language processing services.

Yet more significantly, the hearing officer maintained their position that "GPT" lacked a clear meaning for the average consumer. This conclusion was reached despite the applicant providing evidence in the form of weblinks and printouts of webpages which refer to "generative pre-trained transformers", including a webpage that specifically explains what the acronym stands for.

However, these materials were not considered sufficient by the hearing officer, criticising the reliance on sources such as Wikipedia, which is "inherently unreliable", and the lack of evidence indicating how widely known this meaning would be amongst average UK customers.

Despite the hearing officer's conclusion, it is unlikely that this establishes "GPT" as inherently non-descriptive in all contexts. Rather, it may underscore the evidential shortcomings in the material provided by the applicant, serving as a reminder of the need to provide robust evidence from various sources, even when a point may feel obvious from an insider perspective.

On the evidence, the hearing officer also found that CHATGPT had acquired enhanced distinctiveness, to a medium to high degree, in relation to specific class 9 and 42 goods/services concerning natural language processing. This conclusion was exclusively driven by substantial evidence of direct UK user engagement, including millions of website visits and app downloads, which highlights the persuasive value of clear quantitative, market-facing data in establishing acquired distinctiveness.

Comparison of goods and services

The applied for goods and services, all relating to software, were found to range from a low to high degree of similarity with those covered by CHATGPT. Notably, goods/services connected to artificial intelligence were considered to share a higher degree of similarity.

Likelihood of confusion

Taking into account the similarity of the marks, the overlap in goods and services, and the enhanced distinctiveness of CHATGPT, the hearing officer found a likelihood of both direct and indirect confusion.

A key observation was that "the average consumer tends to see what they expect to see." In this context, the strong

Case details at a glance
Jurisdiction: England & Wales
Decision level: UKIPO
Parties: XEROTECH LTD and Noman Ahmed Shah v OpenAI OPCO LLC
Date: 16 March 2026
Citation: O/0219/26
Decision: dycip.com/ukipo-openai-xerotech

The hearing officer criticised evidence materials reliant on sources such as Wikipedia

recognition of CHATGPT increased the likelihood that similar signs used for similar services would be mistaken for it.

Importantly, the hearing officer also identified a likelihood of indirect confusion. The substitution of "CHAT" with "CALL" was considered a logical variation that was consistent with brand extension. Consumers could reasonably assume that CALLGPT represents a variant or sub-brand of CHATGPT.

On the face of it, this may suggest that "GPT" operates as a core brand identifier of OpenAI, yet the outcome may equally reflect the applicant's failure to convincingly provide evidence that "GPT" is a widely understood descriptive term, highlighting the ripple effect poor evidence can have.

In light of these findings, the opposition under s5(2)(b) succeeded.

Reputation

Having already established similarity between the marks, the hearing officer turned the s5(3) ground and whether CHATGPT enjoyed a reputation among the relevant public. Applying the same factors used to assess enhanced distinctiveness, they readily concluded that it did.

This finding was again grounded in the strong evidence of UK user engagement, including substantial website traffic and app downloads. The reputation of the mark was further supported by coverage in major UK media outlets such as The Guardian and The Times, reinforcing its prominence beyond its immediate user base.

Link

The hearing officer had little difficulty in finding that the relevant public would establish a link between CALLGPT and CHATGPT. This was driven by the combination of the strong reputation of CHATGPT and the similarity between the signs, making it likely that customers would mentally associate the two marks.

Damage (unfair advantage)

The hearing officer concluded that use of CallGPT would confer an unfair advantage on the applicant, due to the benefit they would gain from CHATGPT's strong reputation.

The hearing officer particularly highlighted articles, provided by the opponent, which showed the CHATGPT mark in the context of advancements of AI. Consequently, they considered the mark to have a reputation for being at the forefront of technology, which would transfer to the applicant, allowing them to unfairly benefit.

Accordingly, all elements required to establish a successful opposition under s5(3) were satisfied.

Conclusions

The central takeaway from this decision is that outcomes in trade mark oppositions are often determined as much by the quality of evidence and representation as by the marks themselves.

On the applicant's side, a decisive weakness lay in the failure to substantiate the claim that "GPT" had a commonly understood meaning among average consumers. This evidential gap therefore prevented the applicant from demonstrating any reduction in the inherent distinctiveness of the opponent's mark, conceptual dissimilarity and ultimately reinforced the hearing officer's finding of indirect confusion. As a result, the lack of varied and reliable evidence destroyed any hope the applicant had of successfully defending the opposition.

Consequently, this case serves as a cautionary example for parties engaging in opposition proceedings without professional representation, as even potentially arguable points will likely fail if not properly evidenced.

By contrast, through professional representation and comprehensive materials, including national press coverage and user base figures, the opponent was able to demonstrate that CHATGPT had acquired an enhanced level of distinctiveness and enjoyed a strong reputation. This foundation enabled the hearing officer to accept the opposition on both grounds with relative ease.

Author:
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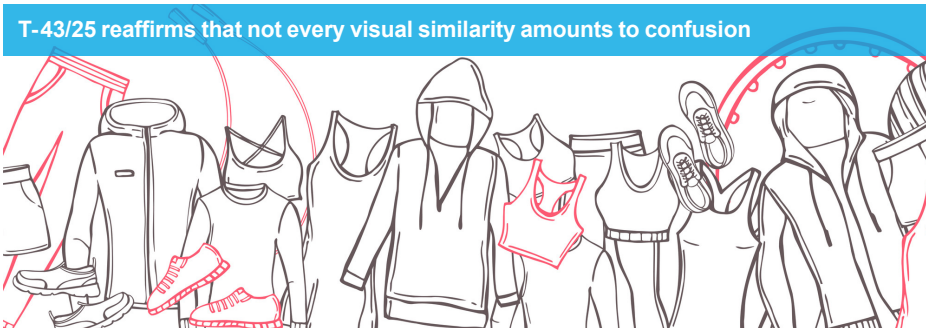
No confusion in the curves
Lessons from Puma v EUIPO Ningbo Gongfang Commercial Management

Case details at a glance
Jurisdiction: European Union
Decision level: General Court
Parties: Puma SE v EUIPO and Ningbo Gongfang Commercial Management Co Ltd
Date: 21 January 2026
Citation: T-43/25
Decision: dycip.com/euipo-t4325

This judgment centres around visual similarity and confirms how the EU courts assess likelihood of confusion in cases involving purely figurative trade marks, particularly within the fashion and sportswear sector. The General Court of the EU upheld the decision of the Board of Appeal of the EUIPO, confirming that no likelihood of confusion existed between the marks at issue despite the identity of the goods.

T-43/25 reaffirms that not every visual similarity amounts to confusion



Background
The dispute arose when Puma SE opposed an application filed by Chinese company Ningbo Gongfang Commercial Management Co Ltd for a figurative EU trade mark consisting of a curved stripe and an irregular triangle within a black rectangle:

Image source T-43/25: *dycip.com/euipo-t4325*

Puma relied on three earlier EU figurative marks featuring one or more curved stripes ascending to the right, commonly associated with its branding:

Image source T-43/25: *dycip.com/euipo-t4325*

The opposition was based on Article 8(1)(b) of Regulation (EU) 2017/1001, which prohibits registration where there is a likelihood of confusion due to similarity between marks and identity or similarity of goods. It was undisputed that the goods (clothing and footwear in class 25) were identical and targeted at the general public with an average level of attention. The central issue, therefore, was whether the signs themselves were similar enough to create confusion.

Visual comparison of the signs
The General Court's analysis focused heavily on the visual differences between the marks.

Puma referred to the O2 Holdings (C 533/06, EU:C:2008:339) ruling, in which the Court of Justice of the European Union (CJEU) stated it was necessary to assess all circumstances in which the mark might be used. However, the General Court clarified that this principle applies to infringement cases, which look at how a mark is actually used in the marketplace, and does not apply to opposition proceedings, which focus only on the mark "as registered" or applied for, specifically pointing to the Chanel v EUIPO Huawei Technologies (T-44/20) ruling.

Therefore, Puma's argument that the black background might "disappear" on dark clothing, or be perceived differently if rotated "upside down", was rejected. The General Court reaffirmed established case law that hypothetical or alternative uses of a mark are irrelevant in assessing similarity. This strict approach reinforces legal certainty by limiting the analysis to the sign as registered.

No phonetic or conceptual similarity
Given that all the marks were purely figurative, the General Court agreed that a phonetic comparison was not possible.

On conceptual similarity, the General Court held that abstract geometric shapes, such as stripes, generally lack inherent conceptual meaning. As a result, conceptual comparison was not possible.

Global assessment of likelihood of confusion
The General Court reiterated that likelihood of confusion must be assessed globally, taking into account the interdependence between the similarity of the marks and the similarity of the goods. While identical goods can lower the threshold for finding confusion, the marks themselves must be at least similar.

In this case, the General Court found that the signs were visually dissimilar overall, with no phonetic or conceptual overlap. Consequently, one of the cumulative conditions under Article 8(1)(b) was not satisfied, and the opposition had to fail.

Puma also argued that its earlier marks had enhanced distinctiveness due to extensive use and that they formed a "family of marks" based on stripe motifs. However, the General Court rejected these arguments due to insufficient substantiation.

Conclusion
This judgment underscores several key principles in EU trade mark law.

First, it highlights the importance of the overall visual impression in cases involving figurative marks, especially where no verbal elements are present. Even if marks share certain design features, differences in structure, composition, and background can outweigh similarities.

Second, the ruling reinforces the principle that marks must be compared in their registered form, excluding speculative variations in use.

Finally, the decision reaffirms that not every visual similarity amounts to confusion and serves as a warning to businesses in the fashion and sportswear sector that sometimes even identical goods and potentially strong brand recognition cannot establish a likelihood of confusion.

Author:
Ella Lane

Sky's the limit?
UKIPO finds "Sky" does not retain an independent distinctive role in "SkyDuck"

Case details at a glance
Jurisdiction: UK
Decision level: UKIPO
Parties: Shi Liang (applicant) and Sky Limited (opponent)
Date: 03 March 2026
Citation: O/0179/26
Decision: dycip.com/ukipo-skyduck

Sky Limited (Sky) was unsuccessful in its opposition against a UK trade mark application for the word mark "SkyDuck" in the name of Shi Liang (the application), despite a finding of identity between some of the goods.

The hearing officer found that "Sky" did not retain an independent distinctive role in the application and consequently that there would be no confusion. The case demonstrates a somewhat strict approach and highlights that just because a mark is replicated at the start of an application, there is no guarantee that confusion will be found.

Background

Sky opposed a trade mark application for "SkyDuck" for various goods in class 9 such as "Power wires" and "Cell phone cases". Sky relied on two of its earlier marks, a word mark for "SKY" and a logo mark: (Series of 2), both covering class 9 goods (the earlier marks): The opposition was grounded on a likelihood of confusion only, and neither mark was subject to proof of use.

(Series of two marks) UK000003859806, image source O/0179/26: *dycip.com/ukipo-skyduck*

Decision

In summary, the hearing officer found:

- the relevant goods to be identical or similar to varying degrees;
- the average consumer to be the general public, paying a medium degree of attention;
- the marks to be visually, aurally and conceptually similar to a medium degree (at least to the earlier "Sky" word mark);
- despite submissions to the contrary, that "Duck" was not descriptive of the goods at issue;
- the earlier marks to have a medium degree of inherent distinctiveness; and
- the earlier marks to not have enhanced distinctive character via use (Sky's evidence was held to be of no assistance since it demonstrated that the goods were sold under the trade marks of other companies).

Considering these points, the hearing officer proceeded to assess whether there would be either direct or indirect confusion. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity down to the undertakings being the same or related.

In finding against a likelihood of direct confusion, the hearing officer found "I cannot identify any reason why the average consumer would mistake SkyDuck to SKY".

In considering indirect confusion, the hearing officer took account of Sky's submissions that "Sky" maintained an independent distinctive character within the application. In considering this principle, they noted three points established by case law:

1. There are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two signs one of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
2. The principle does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components
3. Even where an element of the composite mark which is identical to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. A global assessment still needs to be carried out.

Taking these considerations into account, the hearing officer found that "Sky" and "Duck" did not form a unitary meaning and agreed that "the word SKY has an independent distinctive character" in the application. Despite this, they found that there was no confusion stating, "I do not consider that SKY is so distinctive that average consumers would assume that no one, other than the opponent, would use this word in their trade mark".

The hearing officer seemed to take significance from the fact that the DUCK element was not descriptive and "will not be overlooked by the average consumer" so that SkyDuck would not be viewed "as a sub-brand or brand-extension of SKY".

Finally, the hearing officer acknowledged that the opponent had provided evidence of sub-brands, for example, SKY SPORTS and SKY NEWS. However, it noted that Sky had not relied on these marks either individually or as a family. In any event, they noted that the structure of the application was different to these marks and its second element was not descriptive/allusive.

Considering the above, the hearing officer refused the opposition.

Key takeaways

Even where an earlier mark is replicated at the start of an application and found to retain an independent distinctive role, it is not a guarantee that a likelihood of confusion will be found.

Relying on marks with a reputation can bolster a case even where there is identity between the relevant goods and services: it would have been interesting to see the result had Sky relied on its famous marks and potential damage such as dilution.

If arguments relating to a family of trade marks are to be raised, the relevant marks and argument need to be pleaded from the outset.

Author:
Sophie Rann

Going nowhere with a bathing ape
Earlier rights in EUTM oppositions

Case details at a glance
Jurisdiction: EU
Decision level: CJEU
Parties: EUIPO v Nowhere Co Ltd
Date: 05 February 2026
Citation: C-337/22 P
Decision: dycip.com/c-337-22p

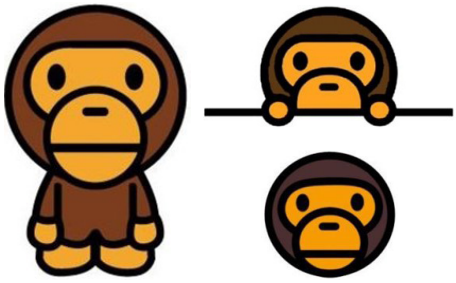
A Bathing Ape (BAPE) is a famous, luxury, Japanese fashion brand. The eponymous BAPE is sometimes stern and sometimes very cute. The cute BAPE is Baby Milo, who is often seen popping up on BAPE apparel and merchandise.

Baby Milo has become unwittingly embroiled in a procedural debate at the European Union Intellectual Property Office (EUIPO) with important practical consequences for EU trade mark oppositions: at what point in such proceedings must "earlier rights" exist?

Background

A European Union trade mark (EUTM) application for "APE TEES" was opposed by Nowhere Co Ltd (the entity responsible for BAPE) based on its UK unregistered rights, including passing off, in Baby Milo.

APE TEES



Baby Milo
Image source C-337/22 P: *dycip.com/c-337-22p*

At the time the opposition was filed, those UK rights were valid as a basis to oppose an EUTM. But by the time the EUIPO came to issue its decision, Brexit had taken effect and those rights no longer had effect within the EU legal framework.

The issue

The CJEU's decision in EUIPO v Nowhere (C-337/22 P) clarifies a key point about EU trade mark oppositions. If you want to rely on an earlier right in EU opposition proceedings, it is not enough for that earlier right to exist at the filing date of the contested EU trade mark application. It must also remain in force and be enforceable at the time the EUIPO issues its final decision. If the right relied upon falls away during the proceedings, the opposition fails with it.

> This decision clarifies a point that had become surprisingly uncertain given the differing decisions of the EUIPO and the EU appellate courts. It restores the EUIPO's established approach that the relevant period to assess the rights relied on in an opposition stretches across the entire life of the proceedings.

Practical takeaways

The fact that earlier rights are no longer a "set and forget" asset in EUTM oppositions impacts prosecution practice in a number of ways.

The big picture point is that the risk to the opponent increases and extends throughout the opposition lifetime, which can last several years with appeals. This means that any earlier right is potentially vulnerable. Registrations can expire if not renewed. They can be revoked for non-use. They can be invalidated. Where any of those events occur before the decision, it can be fatal to an opposition. This, in turn, feeds through to the type of rights parties choose to rely on. For example, rights with shorter lifespans now carry greater risk in EU proceedings, simply because they may be less likely to survive to the end of a long-running case. Where possible, more stable registered rights may offer a safer foundation for EU opposition proceedings.

For rights holders, this puts a spotlight on portfolio management during opposition proceedings.

> It is no longer enough to file an opposition and focus purely on the trade mark arguments. The underlying right needs to be maintained and defended throughout.

Renewal deadlines, use requirements and potential validity challenges all become part of managing an opposition.

For trade mark applicants, the decision opens up possibilities to fight oppositions on more strategic grounds rather than being based predominantly on a comparison between the rights asserted and applied for mark. For example, can the earlier right relied on be challenged based on its durability? Is it close to expiry? Has it been genuinely used? Is it open to challenge? In some cases, there may be value in applying pressure to that right or simply allowing time to do the work.

Further EU-UK divergence

The BAPE ruling also creates further divergence between EU and UK trade mark practice. In the UK, the focus remains largely on the position at the filing date of the contested application. In the EU, the position at the date of decision is now critical. That means parallel disputes could produce different outcomes, and strategies may need to be adapted accordingly.

For any existing EUTM oppositions still ongoing that are based on UK-only rights (especially unregistered rights) that existed at the start of the opposition proceedings, these will no longer support the EU opposition following Brexit and the opposition can be expected to fail.

Author:
Phil Leonard

Small town, big bite
Local restaurant shows genuine use doesn't need a big footprint

Case details at a glance
Jurisdiction: EU
Decision level: General Court
Parties: Heinz Thomas Alfendorger v EUIPO
Date: 07 July 2025
Citation: T-297/25
Decision: dycip.com/t297-25

GC confirms "local" use in one member state can still amount to genuine use in the EU

A single steakhouse, social media buzz and cross-border visibility: the General Court clarifies how "local" use in one member state can still amount to genuine use in the European Union.

In T-297/25, the General Court (GC) confirmed that even a single restaurant in a relatively small German town can establish genuine use of an EU trade mark. The decision highlights that "local" does not necessarily mean "insufficient", provided the overall commercial context shows real market presence beyond the immediate location.

From Braunschweig to Luxembourg

At first glance, the facts seem unremarkable: a steakhouse in Braunschweig operating under the name "OX". But the legal question was far from simple. Can such a local business maintain EU-wide trade mark protection? The EUIPO had initially revoked the trade mark for non-use, but the Board of Appeal reversed that finding in part, accepting genuine use for hospitality services. The General Court has now confirmed that assessment.

What makes the judgment interesting is not simply the outcome, but the way the court got there. In confirming genuine use for services for providing food and drink, it focused on three familiar factors:

1. the nature of the use;
2. the place of the use; and
3. the extent of the use.

Together, they paint a picture of a business that may have been local in location but was not local in any narrow commercial sense.

Nature of use: more than a name on the door

On the nature of use, the court accepted that "OX" did more than identify the business behind the restaurant. That matters because a company name does not automatically function as a trade mark.

Here, however, the sign was used consistently in ways that connected it directly with the restaurant services: on business papers, cutlery, staff clothing, the website and in advertising. In the court's view, that was enough to show that "OX" was being used not merely as the name of a company, but also as a trade mark for the services themselves.

Place of use: beyond Braunschweig

Regarding the place of use, the court reiterated that there is no abstract minimum geographical area in which an EU trade mark must be used. Genuine use does not require activity across a large part of the EU; use in a single member state can be sufficient. Just as importantly, the court distinguished between the place where the services are actually provided and the place where the trade mark is used. For service businesses, that is a significant distinction. A restaurant may operate from one city only, but its trade mark may be used more broadly through advertising and online presence beyond its immediate location.

That was precisely the case here. The restaurant itself was in Braunschweig, but the court found that the place of use extended at least to Germany and Austria. It relied on German-language online advertising, more than 2,000 Facebook followers, TripAdvisor reviews in multiple languages, inclusion in a German-language guide to leading hotels and restaurants in Germany, and evidence that some guests came from other EU countries. In other words, the business may have had one front door, but the trade mark reached much further.

Extent of use: the numbers tell the story

As for the extent of the use, the evidence showed seven-figure annual turnover since 2015, supported by sample invoices and booking system extracts. The court also treated social media presence as a relevant part of the overall picture, because it demonstrated efforts to reach consumers.

In short

This case is a useful reminder that a single business in one member state can be enough to establish genuine use of an EU trade mark, provided the evidence shows that the sign is being used as a trade mark, reaches beyond its immediate surroundings and is backed by real commercial activity.

Read alongside earlier case law, the judgment suggests that the key issue is not the size of the town or the fame of the venue, but whether the trade mark has been used and promoted beyond its immediate location. Reviews, guidebook mentions and social media metrics may support that assessment, but they may also say more about success than use. The clearest evidence is likely to remain advertising and other material showing that a trade mark was actively directed at a broader public.

Author:
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And finally...

Domain names / gTLDs

New gTLD program
2026 round brand protection opportunities & challenges

In the Internet Corporation for Assigned Names and Numbers' (ICANN's) latest initiative to expand the Domain Name System (DNS), eligible legal entities will be able to apply for new generic top level domains (gTLDs), including ".brand" extensions.

In 2012 there was a program run by ICANN where more than 1,200 new gTLDs were created, including geographic TLDs (such as ".london"), community TLDs (such as ".scot"), brand extensions (such as ".google") and generic TLDs not linked with a specific brand, geographical location or community.

The 2026 application window (open between 30 April 2026 and 12 August 2026) is an opportunity for organisations to apply for new custom domain name extensions across a range of languages and scripts. The application process is relatively expensive and complex, and ICANN intends for the list of applied for gTLDs to be published later in 2026.

For rightsholders, a notable category of gTLDs remains ".brand" extensions, where organisations can apply for new domain name suffixes which match their brand name and then operate controlled namespaces. For organisations intending to apply for a ".brand" gTLD in this year's round, it is important to engage with the Trademark Clearinghouse (the TMCH) to validate the associated trade mark.

If multiple rightsholders apply for the same ".brand" extension, there will be an opportunity to change the applied-for gTLD string and/or ICANN will facilitate a resolution. It will also be possible for groups with standing to submit feedback about specific applications. In particular, brand owners may wish to object to new gTLD applications, for example, on the grounds that the applied for string is confusingly similar to their trade mark or an existing TLD.

Therefore, even for rightsholders not intending to apply for a new gTLD, it will be prudent to monitor the published gTLD list and/or ensure that brand protection and monitoring strategies are in place. Rightsholders can also proactively register their key trade marks with the TMCH to be notified of domain names which match their recorded trade mark.

Useful link

New gTLD program, 2026 round:
dycip.com/gtld-program-2026

Related articles

Generic top level domains (gTLDs), new challenges, 01 November 2011:
dycip.com/gtld-2011-challenges

Generic top-level-domain rollout, 14 March 2014:
dycip.com/gtld-2014-rollout

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