

**O-716-22**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3549396  
BY STITCH EDITING LTD  
TO REGISTER**

**STITCH**

**AS A TRADE MARK  
IN CLASS 41  
AND OPPOSITION THERETO (UNDER NO. 424438)  
BY  
TIKTOK INFORMATION TECHNOLOGIES UK LIMITED**

## Background & pleadings

1. Stitch Editing Ltd (“the applicant”) applied to register the trade mark **STITCH** on 28 October 2020. The mark was accepted and published in the Trade Marks Journal on 12 February 2021 for the following services in class 41:

*Editing of music, television programs, films, commercials, internet videos, and video programs; music, film and video production; providing advice and information for music, video and film concept and script development; multimedia entertainment services in the nature of development, production and post-production services in the fields of video and films; post-production editing services in the field of music, videos and film; production of visual effects for videos, commercials, dvds, pre-recorded optical discs featuring music, television programs, films, commercials, internet videos, and video programs; television production for internet web sites; video editing; videography services.*

2. Tiktok Information Technologies UK Limited (“the opponent”) opposed the application on 12 May 2021 under sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (“the Act”). The opponent’s grounds under sections 3(1)(b), (c) and (d) are set out as follows:

- That under 3(1)(b) – “the word ‘stitch’ lacks the capacity to distinguish the services of the Applicant from those of other entities”.
- That under 3(1)(c) – “the word ‘stitch’ has a descriptive meaning/connotation in relation to the services for which the Applicant is seeking protection”.
- That under 3(1)(d) – “the word ‘stitch’ is commonly used within the relevant trading sector in relation to the services for which the application is seeking protection”.

3. The applicant filed a counterstatement<sup>1</sup> in which the grounds were denied.

4. The parties have been represented throughout these proceedings. The applicant is represented by Haseltine Lake Kempner LLP and the opponent by Taylor Wessing LLP.

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<sup>1</sup> See my comments in paragraphs 13 and 14

5. Both parties filed evidence and a hearing was requested. The hearing took place before me on 13 July 2022, via video conference. Both parties were represented by Counsel. The applicant was represented by Jonathan Moss, instructed by Haseltine Lake Kempner, and the opponent by Guy Hollingworth, instructed by Taylor Wessing.

6. 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.

### **Preliminary issues**

7. On 12 July 2022, in advance of the hearing, the applicant contacted the tribunal in response to the opponent's skeleton argument. In particular the applicant was concerned with the comments at paragraph 14, viz

“It is entirely unclear why this evidence has been filed or what purpose it is intended to serve. There is no claim to acquired distinctiveness (unsurprisingly since, on the basis of the evidence put forward, the Applicant would not even begin to satisfy the criteria set out in the Windsurfing Chiemsee case). The fact that the Applicant may have managed to operate a business under a non-distinctive name is in no way probative of the absolute grounds of opposition in sections 3(1)(b), (c) or (d), particularly having regard to the public policies underlying those grounds.”

8. In its email, the applicant stated that:

“With reference to the Opponent's skeleton argument filed yesterday, and particularly the surprising comments at paragraph 14 that “There is no claim to acquired distinctiveness” and “It is unclear why this [the applicant's] evidence has been filed or what purpose it is intended to serve”, it is noted that the Opponent has long been on notice that the applicant intended to rely

on acquired distinctiveness, in the alternative to its primary position that the STITCH mark is inherently distinctive.

We draw attention particularly to the comments in the request for a stay filed on the applicant's behalf on 29 November 2021 (a copy of which is attached): "to answer the objections, the applicant will need to file evidence to show that the word SITCH is inherently capable of distinguishing its services from those of others and may also demonstrate that, notwithstanding the inherent distinctiveness of the word for those services, it signifies the applicant's services by virtue of the use made of it by the applicant"

This statement was further crystallised in the skeleton argument for the CMC hearing that followed that stay request, dated 26 January 2022 (at para 11, also attached): "**evidence will be filed in addition to support an alternative claim that the mark has acquired distinctiveness**".

9. The applicant also sought leave to amend the TM8 from the originally filed point 1 at section 8 of that form, namely

"1. The Opponent's assertion that the word STITCH lacks the capacity to distinguish the Applicant's services from those of other entities is denied."

To the following rewording:

"1. The Opponent's assertion that the word STITCH lacks the capacity to distinguish the Applicant's services from those of other entities is denied (due to either inherent or acquired distinctiveness)."

10. At the hearing I took submissions from both parties on the leave to submit an amended TM8 and the issues regarding acquired distinctiveness.

11. Mr Moss, for the applicant, took me through the points made in his 12 July email in more detail culminating in the view that "this case has been about inherent and acquired distinctiveness all the way along" and that the applicant believes that the

wording in its pleading at point 1 of section 8 on the TM8 is a sufficiently broad denial covering both inherent and acquired distinctiveness but out of caution the revised wording has been submitted.

12. Mr Hollingworth, in his response, submitted that the purpose of pleadings, as set out in the Manual of Trade Mark Practice, is to identify the issues between the parties, i.e. to know the grounds on which a mark is attacked and the grounds on which a mark is defended from that attack. Mr Hollingworth further submitted that for acquired distinctiveness the burden of proof must be on the applicant then he took me to the applicant's counterstatement on the original TM8, viz

1. The Opponent's assertion that the word STITCH lacks the capacity to distinguish the Applicant's services from those of other entities is denied.
2. It is denied that the word STITCH has a descriptive meaning / connotation in relation to the services for which the Applicant is seeking protection.
3. It is denied that the word STITCH is commonly used within the relevant trading sector in relation to the services for which the Applicant is seeking protection.
4. The Opponent is put to strict proof of all of its claims.
5. The Applicant asks that the Opposition be rejected in its entirety.
6. The Applicant also asks that an award of costs be made in its favour.

for which he submitted that points 1-3 are a flat denial of the opposition grounds under section 3(1)(b), (c) and (d), point 4 puts the opponent to proof, point 5 states the opposition should be rejected and point 6 relates to costs. It was further submitted that "not only is there no mention of acquired distinctive character, but the way they have pleaded it positively precludes it because they are not taking any burden of proof of their own".

13. Having considered the matter and taken on board the oral submissions at the hearing, I find that opponent had been aware that the applicant intended to file evidence of acquired distinctiveness from the previous correspondence filed during these proceedings and had not raised this issue before now. Furthermore the opponent has seen and thoroughly examined all of the applicant's evidence for the purpose of submitting its best case at the hearing and from that examination has raised what it believes are deficiencies going against the establishment of acquired distinctiveness.

14. I gave this finding at the hearing and directed that I would admit the amended TM8.

15. A point was then raised by Mr Hollingworth about not having a separate appeal period relating to this specific finding which he felt would be messy for all and that the appeal period should run alongside the appeal period for this substantive decision. Mr Moss agreed with this suggestion so I confirmed that I would take this course of action relating to the appeal period issue.

### **Opponent's evidence**

16. The opponent filed a witness statement dated 21 September 2021 in the name of Mark Owen, a partner at Taylor Wessing LLP who are the opponent's legal representatives. Mr Owen appended 17 exhibits.

17. In relation to the meaning of the word STITCH, Mr Owen states that

“5. The word "stitch" is defined in the Cambridge English Dictionary in its traditional sense by reference to sewing (e.g. to sew two things together) and as a noun (e.g. a stitch is a sharp pain in the side of your stomach) (see Exhibit MWO1).

6. As supported by the evidence in this statement, the word "stitch" is also used by English speakers to refer to the joining together of things i.e. in the sense of "stitching" something together. This is particularly the case in relation to media e.g. videos, where different videos/scenes can be stitched together to create one video.”

18. The evidence and exhibits can roughly be categorised in to five separate sections namely mainstream media, online and trade press use, user community use, technical use, patent application extract use and historical use. I do not intend to summarise all of the evidence but will highlight what I find to be the most pertinent parts below.

19. In exhibit MWO2 the opponent gives examples of what it describes as descriptive use from online and mainstream media. It summarises the use as follows

- (a) In a 2 November 2004 article in The Daily Telegraph, reader Chris Catton asks for assistance, stating that he has "tried various video-editing packages that allow you to **stitch** together video clips, add titles and so on" (see Page 7 of Exhibit MWO2).
- (b) In a 15 March 2005 article in The Guardian, the process of animation is described and is stated to require that "students take a series of still pictures, and then **stitch** them together to produce an animated gif file". Readers are pointed to PaintShop Pro and also to "over 40 other pieces of software" (see Pages 8 to 9 of Exhibit MWO2)
- (c) In a 2 May 2005 article in The Western Mail, a project run by BBC Wales is described. The project sees "Participants bring along their ideas and develop their scripts in a group with the help of advisers provided by BBC Wales". The participants are then said to use "Adobe Premier, a powerful film editing software" to "**stitch** together the threads of their story, pictures, music and other sound, and any narrative, into a format that can be broadcast on television or made available on the BBC Wales website" (see Pages 10 to 11 of Exhibit MWO2).
- (d) In a 7 June 2019 article in Mail Online, the newspaper discusses the rising problem of 'deepfakes' and how AI can be used to create videos. One step of the process is stated to be that "users then make revisions to the video transcript, the algorithm identifies segments from elsewhere in the film that contain the right facial movements to **stitch** together new footage to match the revised text" (see Pages 12 to 16 of Exhibit MWO2).
- (e) In a 7 May 2020 article on dawkes.co.uk, tips are offered to musicians wishing to showcase their talent by making home recordings. One such tip is that "You could film yourself playing separate parts, and then **stitch** it all together in a separate app or on your computer. Alternatively, there are smartphone apps that can even do this bit for you – like 'Acapella'" (see Page 17 of Exhibit MWO2).
- (f) Bedfordshire Drone Services offers a "Drone Mapping" service which "collects data by taking GPS tagged photos of land" and then the company's software is able to "**stitch** these together to create highly detailed 2D or 3D maps of the surveyed area" (see Pages 18 to 19 of Exhibit MWO2).

(g) In a 28 October 2018 article on [www.estateagentnetworking.co.uk](http://www.estateagentnetworking.co.uk) describes how "Many smartphone[s] will allow you to edit videos and **stitch** them together so to have a complete and edited property video tour that you can then directly upload to the likes of Youtube" (see Pages 20 to 22 of Exhibit MWO2).

(h) In a 22 September 2018 post on [videoforums.co.uk](http://videoforums.co.uk), a user states "Hi! I have this project where I'm the director and I have editors, and for context, I have zero knowledge on video editing, I just have this idea and I'm relying on my editors to have that idea reflected in the editing process. Now, what we've been trying to do is a transition effect (forgive me, I don't know all terminologies) that kind of **stitches** one shot to another" and further that "while my editor could do the '**stitching** together' of the two videos, the difference in the blocker from each shot is too obvious not to fix" (see Page 23 of Exhibit MWO2).

(i) A Sunday Times (UK) article published in 2011 states that the then new Google+ service was "designed to **stitch** together instant messaging, audio and pictures" (see Pages 24 to 26 of Exhibit MWO2)

20. In exhibit MWO3 the opponent gives examples of what it describes as descriptive use from Apple and Adobe users online communities and forums. It summarises the use as follows,

"(a) Pages 28 to 29 of Exhibit MWO3 shows questions related to Apple's Keynote software. A user asks, in 2009, why Keynote audio loops sound bad at the loop point. Another user responds stating "I just found the same [...] why can't it **stitch** them together properly".

(b) Pages 30 to 36 of Exhibit MWO3 shows a question, from 2006, related to Apple's iWork and iLife software and states "I still cannot find a tool to let me **stitch** [...] two photos together".

(c) Pages 37 to 40 of Exhibit MWO3 shows a question, from 2010, related to Apple's Garageband music creation and editing software. The user states that they have "just started learning to use Garageband to '**stitch**' some songs together".



(d) Pages 41 to 42 of Exhibit MWO3 shows a question, from 2007, in relation to Apple's movie and film editing software iMovie. The user seeks help "with a relatively simple task" and has "4 small MPEG movies on [their] hard drive that [they] want to **stitch** together".

(e) Pages 43 to 46 of Exhibit MWO3 shows a question, from 2009, related to Apple's Logic software. The user requires assistance in "Stitching Songs Together in Logic" and asks if "anybody know[s] if there is an efficient way to **stitch** separate logic songs together".

(f) Pages 47 to 50 of Exhibit MWO3 shows a question, from 2010, relating to segments of movies in Apple's QuickTime software. The user asks if there is "any free app that will let me **stitch** these together to be one .MOV file?"

(g) Pages 51 to 52 of Exhibit MWO3 shows a question, from 2013, related to Apple's iTunes music streaming and media playing software. The user asks, "Can I **'stitch'** two songs together" and if "it is possible (using iTunes) to **'stitch'** or join two songs into one on a CD?".

(h) Pages 53 to 58 of Exhibit MWO3 shows questions raised in relation to Adobe's Captivate software. The response to a question asked in 2009, states "moving the waveforms to say the 0.5 sec marker on the TimeLine prevents Captivate from **stitching** all the audio files together". Another user has, in 2012, an issue with lag, and states that "because of this lag I have to manually **re-stitch** together the audio segments".

(i) Pages 59 to 63 of Exhibit MWO3 shows a question related to Adobe's Animate software. The user states, in 2008, that they "have so far been successful getting my array of dynamically loaded videos to **stitch** together".

(j) Pages 64 to 73 of Exhibit MWO3 shows a selection of user comments on the Apple Community thread discussing the process of **stitching** items of media together.

(k) Pages 74 to 77 of Exhibit MWO3 shows a selection of user comments on the Adobe Support Community thread discussing the process of **stitching** items of media together.

21. In exhibit MWO10 the opponent gives examples of extracts from GB patent applications in which it says the contested mark is used to describe a feature of the patent or patent process being applied for, viz

“(a) GB2410639A – "Viewfinder Alteration for Panoramic Imaging", published in August 2005 (see extracts at Pages 195 to 197 of Exhibit MWO10). In the description, methods are described which "stitch" together a plurality of captured images".

(b) GB2489791A – "Identifying qualifying image frames for a panoramic image", published in November 2012 states at [0013] "the embodiments may stitch the qualifying frames into a composite panoramic image for output and storage" (see extracts at Pages 198 to 203 of Exhibit MWO10).

(c) GB2416947A – "Seamless Stitching of Multiple Images in a Wide Format Laser Printer", published 8 February 2006 (see extracts at Pages 204 to 205 of Exhibit MWO10). (d) GB2517730A - "A Method and System for Producing a Video Production" published in March 2015 which describes "a stitch module operable to stitch the temporarily corresponding image frames of each video signal together" (see extracts at Pages 206 to 209 of Exhibit MWO10).

### **Section 3(1)**

22. Section 3(1) of the Act states:

“3.— Absolute grounds for refusal of registration

(1) The following shall not be registered—

(a) signs which do not satisfy the requirements of section 1(1).

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

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

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

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

23. It must be borne in mind that these grounds are independent and have differing general interests. It is possible that if a mark does not fall foul of section 3(1)(c), it may still be objectionable under sections 3(1)(b) or (d). In *SAT.1 SatellitenFernsehen GmbH v OHIM*<sup>2</sup>, the Court of Justice of the European Union stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

24. The date that the contested mark must be assessed is the filing date of the application, i.e. 28 October 2020. I will first make an assessment on the basis of the contested mark’s inherent characteristics and if I find that the mark is open to objection on that basis, I will then determine whether the mark has acquired a distinctive character as a result of the use made of it prior to its filing date.

### **3(1)(c)**

25. I begin by considering the contested mark under section 3(1)(c). The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

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<sup>2</sup> Case C-329/02 P

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

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

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

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

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

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

And

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

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

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

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

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to

believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

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

27. In *Matratzen Concord AG v Hukla Germany SA*<sup>3</sup>, the Court of Justice held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

28. In *Exalation v OHIM*<sup>4</sup>, the General Court (“GC”) confirmed that, at least where technical terms are concerned, it is appropriate to take account of meanings known to those in the trade. However, if a specialised public to whom a particular meaning would be known forms only a negligible part of the relevant public, this is unlikely to be sufficient to sustain an objection under ss. 3(1)(b) and (c)<sup>5</sup>.

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<sup>3</sup> Case C-421/04

<sup>4</sup> Case T-85/08, EU:T:2010:303

<sup>5</sup> *MCM Products AG v EUIPO* Case T-285/20, EU:T:2021:397

29. All of the relevant facts and circumstances must be taken into account when examining the distinctive character of a trade mark. In the absence of other indications, this means taking into account the types of use which, in the light of the customs in the sector concerned, can be “practically significant”<sup>6</sup>. This means that the reaction of average consumers to uses of the mark which are possible in theory but unlikely in practice do not need to be factored into the assessment.

30. The relevant public for the services at issue in these proceedings are specialised businesses, specifically those in the creative industries.

31. In the first instance I note there is no dictionary definition which defines the use of STITCH in a technology related capacity. The dictionary definitions given in evidence are more traditional in nature, i.e. relating to the joining of things (e.g. fabric or skin) together by means of sewing. At its most basic level then I find that STITCH is a way of joining things together.

32. At the hearing the applicant accepted that the word STITCH was descriptive in relation to photography, meaning to join still photographs together to form a panorama shot and in its skeleton, it accepted that the word has been used in a video editing context “to some degree”. The former was evidenced by the opponent in exhibit MWO5 in relation to technology used by the camera manufacturer Canon. This indicates to me that the word STITCH then has moved into the technology field with the same basic level definition of joining things together. This use of STITCH in technology is further solidified in the GB and European patent application extracts dated between 1988 and 2014 evidenced by the opponent in its exhibits MWO9, 10 and 11. Essentially the language used in a patent application must clearly and precisely describe the invention or the process the patent seeks to protect. The word STITCH in the patent related evidence variously uses it to describe the joining of images in a variety of technologies such as laser printing, digital imaging, audio and video production. STITCH therefore appears to be the apt word to use in this descriptive sense of joining images.

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<sup>6</sup> *AS v Deutsches Patent – und Markenamt* Case C-541/18, EU:C:2019:725



33. This usage describing the stitching together of images, film and music also appears to be prevalent in the informal comments and postings made in the user forums of Apple and Adobe evidenced by the opponent in exhibit MWO3. Examples like “a tool to let me stitch” and “getting my array of dynamically loaded videos to stitch together” confirm this. The use of the word STITCH in forums like those evidenced suggest a shared understanding of what the word means in creative editing or post production context.

34. Taking all of the above into consideration I find that the word STITCH is descriptive of the kind and intended purpose of the applied for services and therefore objectionable under section 3(1)(c) of the Act.

### **3(1)(b)**

35. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union (“CJEU”) in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

36. Trade marks which are excluded from registration because they describe a particular characteristic of the services also lack the distinctive character required to avoid objection under section 3(1)(b) as they do not serve to identify the services applied for as originating from a particular undertaking, and cannot distinguish that product from those of other undertakings. Therefore I find that applied for mark is also objectionable under section 3(1)(b).

### **3(1)(d)**

37. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*<sup>7</sup>, the General Court summarised the case law of the CJEU under the equivalent of s.3(1)(d) of the Act, as follows:

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<sup>7</sup> Case T-322/03

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

38. For a section 3(1)(d) objection to apply, the following tests must then be satisfied. That is whether STITCH has become customary in the current language or in the bona fide and established practices of the trade to designate the services in respect of which registration of the mark is sought. The opponent's evidence has sought to demonstrate the word STITCH is used in the language of patent applications and in various technical applications relating to photography, audio and video editing techniques as a bona fide term to describe a way of stitching or joining digital files together. The opponent has also sought to demonstrate that the relevant public, i.e. users of video editing technologies, regard the mark as descriptive of a type of service that of joining together digital images. To my mind this evidence has satisfied the section 3(1)(d) test that STITCH is customary language in the editing and production environment. Therefore I find that applied for mark is also objectionable under section 3(1)(d).

#### **Acquired distinctive character**

39. Having found that the applied for mark is objectionable *prima facie* in respect of the class 41 services, I now go on to consider the applicant's evidence of use as the proviso to section 3(1) states that marks shall not be refused registration if before the date of the application they have, in fact, acquired distinctive character as a result of the use of them.

40. The CJEU provided guidance in *Windsurfing Chiemsee*<sup>8</sup> about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a

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<sup>8</sup> Joined cases C-108 & C-109/97

particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

### **Applicant’s evidence**

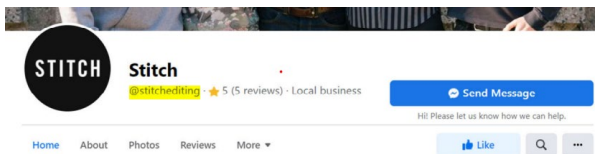
41. The applicant filed a witness statement in the name of Leo Zola King dated 24 March 2022. Mr King is a director and co-founder of the applicant. Pertinent points to note from Mr King’s witness statement are that STITCH was first used in 2010 in the following form



42. The applicant rebranded in 2015 to this form which is still in use.



43. The applicant gives several undated examples of this mark being used on its stationery, garments, letterheads and its Facebook page, viz



44. Other pertinent points to note from the applicant's evidence are set out below.

45. In exhibit LZK7, Mr King presents a list of the dozens of creative awards won by the applicant between 2012 and 2021 for their class 41 services. The exhibit also includes an explanation of who the award bodies are, such as the British Television Advertising Awards to take a single example.

46. In exhibit LZK8 the applicant presents some examples of the contested mark in use in the trade press, viz

46. From Shoot: dated 18 February 2020

Editor Sam Sneade And His Speade Roster Join  
Stitch

TUESDAY, FEB. 18, 2020

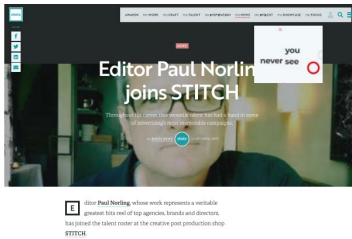


Pictured (l-r) are Tim Hardy, Angela Hart, Sam Sneade, Kirsty Oltveld and Lee King.

**LONDON** – Stitch London has brought aboard its roster the ensemble of editors from the venerable edit house Speade. Joining Stitch are Speade founder Sam Sneade and fellow editors Gareth McEwen, Sacha Szwarz, Carlos Font Clos, Rich Woolway and Sam Allen, along with executive producer Kirsty Oltveld.

A respected, award-winning U.K. edit shop, Speade has been cutting high-profile work for the past 25 years spanning feature films, television, commercials, shorts and music videos.

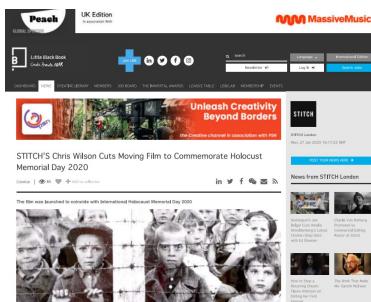
47. From Shots: dated 4 April 2019



48. From Little Black Book: dated 15 November 2018



49. From Little Black Book: dated 27 January 2020



50. Exhibit LZK8 also contains emails dated between 2013-2018 from some of the applicant's clients regarding various work projects.

51. In exhibits LZK9 and 10, the applicant lists a number of widely viewed YouTube videos for which the applicant has been credited as the editor or the edit house. These include videos by well known music stars. Screen shots have been taken from four of those videos, namely Naughty Boy (dated September 2015), Stormzy (dated November 2019), Dua Lipa (dated August 2020) and Royal Blood (dated February 2015). The credits usually take the following form

Director – Nathan James Tettey  
Production Company – Untold Studios  
Head of Music & Social – Annie Ayres  
Executive Producer – Tessa Wood  
Producer – Natalie Steiner  
1st AD – Daniel Smith  
2nd AD – Gabriel O'Donohoe

Director of Photography – Aaron Reid  
Steadicam Operator – Grant Sandy-Phi  
Focus Puller – Brendan Harvey  
B Cam Focus Puller – Kate Eccarius  
Clapper Loader – Jomar O'Meally  
Gaffer – Danny Hayward  
Production Designer – Benny Casey  
Casting Director – Rae Elliman  
Choreographer – Ricky Labib  
Costume Stylist – Holly MacDonald  
Make-up Artist – Paul Rodgers  
Hair Stylist – Dion Thomaz  
Editor – Chris Wilson  
Edit House – Stitch  
Colourist – Simon Bourne  
Colour House – Framestore  
VFX – Untold Studios

52. In exhibit LZK11, the applicant presents a list of the work undertaken between 2010 and 2022 for various brands in addition to the list of the production companies commissioning the jobs.

53. At exhibit LZK11, the applicant lists over 3400 jobs that it has been involved with and points to the breadth of the brand names, such as Tesco, Ford, Adidas, Burger King for example, as evidence that the use of STITCH has acquired distinctiveness for the services.

54. In its witness statement the applicant mentions the sub- brand HOMESPUN which has been used since 2014 for short films and music videos and sits within the applicant's business but is said to have a separate branch identity for establishing "artistic and technical creativity outside of commercials work". It is claimed to have a clear link to the STITCH identity through shared personnel and through the STITCH website, email addresses and social media accounts. It is unclear what the relevance of HOMESPUN is, in relation to the applicant's evidence. The applicant does not state that HOMESPUN is the brand under which awards have been won, but simply that work undertaken under the HOMESPUN brand is done by STITCH personnel and credited as STITCH. As this appears to be irrelevant to the issue at hand so I do not propose to consider it any further.



55. In my consideration of the applicant's evidence, I return to the criteria set out in *Windsurfing*. Firstly I note that the applicant has used the mark since 2010 which favours the applicant in terms of long standing use. However it has not produced any turnover figures or any figures for advertising expenditure. The applicant states it has a website and social media accounts but does not present any figures around web traffic or numbers of users/followers of its accounts. At the hearing the applicant pointed to the list of awards it had won for its work as evidence of its market share. Whilst I do not doubt the credibility of the award bodies nor deny that industry awards are given for excellence in the particular endeavour, it is not apparent to me from the evidence how widespread the nominee field is, or what the criteria is for nominees so I cannot judge this activity as being indicative of a market share.

56. In terms of geographical spread, mentioned as one of the *Windsurfing* factors, the applicant states its base is in London and it has some business interests in California, USA. It has not stated where its clients, i.e. the commissioning companies, are based. At the hearing the applicant pointed to the number of times, 416 million, just one of the YouTube videos had been viewed. I accept that this number of views is extremely high but believe it is a very tenuous link to suggest that these views equate to a geographically widespread use of the contested mark or even indicative of the number of viewers actually exposed to the mark, for example if they did not read the credits.

57. I note the applicant's jobs list at exhibit LZK11 and that in its witness statement it claims that the brand owners were its clients. At the hearing the opponent rebuffed this claim, saying that the applicant's clients were not the brand owners themselves but were in fact the production companies commissioning the work. I do not find anything turns on this particular issue. Customers for the kind of specialist services provided by the applicant are likely to come from the creative industry rather than brand owners themselves. I note that many of the commissioning companies are repeat customers which goes some way to establishing that a proportion of the relevant class of persons who, because of the mark, identify the services as

originating from a particular undertaking. However this appears to be the high point of the applicant's evidence.

58. Taking all these factors into account and regarding the evidence as a whole, I find it is insufficiently solid, according to the *Windsurfing* criteria. Therefore I find that the applicant has not sufficiently demonstrated that the mark STITCH has acquired distinctive character.

### **Conclusion**

59. The opposition has succeeded. Subject to any appeal against this decision, the contested mark will be refused.

### **Costs**

60. As the opponent has been successful, it is entitled to a contribution to its costs. Awards of costs are ordinarily governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Neither side identified any issues which would deviate from the published scale. Bearing in mind the guidance given in TPN 2/2016, I award costs to the opponent as follows:

£200 Official fees

£400 Preparing Notice of Opposition and considering counterstatement

£700 Preparing evidence and consideration of applicant's evidence

£800 Preparation for and attending the hearing

**£2100 Total**

61. I order Stitch Editing Ltd to pay TikTok Information Technologies UK Limited the sum of £2100. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24<sup>th</sup> day of August 2022**

**June Ralph**

**For the Registrar**

**The Comptroller-General**