

O/819/21

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION FOR TRADE MARK NO. 3519771
IN THE NAME OF SYNAPSE GLOBE LTD FOR THE TRADE MARK**



IN CLASS 24

AND

THE OPPOSITION THERETO UNDER NUMBER 422036

BY

LA PIACENTINA S.P.A.

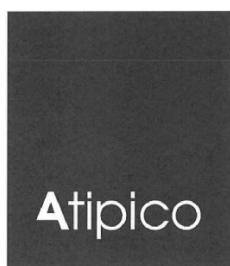
Background and pleadings

1. On 6 August 2020, Synapse Globe Ltd (“the applicant”) applied for the trade mark shown on the cover page of this decision (number 3519771) for goods in class 24:

Apparel fabrics; Artificial silk; Baby blankets; Baby buntings; Bar cloths; Bath linen; Bath linen, except clothing; Bath mitts; Bath sheets; Bath sheets (towels); Bath towels; Bath wrap towels; Bathroom towels; Beach towels; Bed blankets; Bed blankets made of cotton; Bed blankets made of man-made fibres; Bed canopies; Bed clothes; Bed clothes and blankets; Bed coverings; Bed covers; Bed linen; Bed linen and blankets; Bed linen and table linen; Bed linen made of non-woven textile material; Bed pads; Bed quilts; Bed sheets; Bed skirts; Bed spreads; Bed throws; Bed valances; Bed warmer covers; Bedroom textile fabrics; Bedsheets; Bedspreads; Blackout curtains; Blanket throws; Blankets (Bed -); Blankets for household pets; Blankets for outdoor use; Borders (textile wall hangings); Canvas.

2. The application was published for opposition purposes in the *Trade Marks Journal*, on 11 September 2020. On 12 November 2020, La Piacentina S.p.A. (“the opponent”) filed an opposition to the application under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The section 5(2)(b) and 5(3) grounds are based upon the following two earlier registered European trade marks:¹

(i) 8171217: filing date 23 March 2009; registered 16 March 2010



¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

Relying on all its goods in classes 3, 4, 5, 8, 18, 20, 21, 24 and 27.

(ii) 8171357: filing date 23 March 2009; registered 1 December 2009.

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Relying on all its goods in classes 3, 4, 5, 8, 18, 20, 21, 24 and 27.

3. The opponent claims that the parties' marks are visually and aurally similar, and conceptually identical, for identical and similar goods, leading to a likelihood of confusion under section 5(2)(b) of the Act. Under section 5(3), the opponent claims a reputation in its mark for the registered goods such that the relevant public will believe the parties' marks are used by the same undertaking or an economically linked undertaking. The opponent also claims that use of the applicant's mark will erode the distinctiveness of the earlier marks, damage its reputation, and give an unfair advantage to the applicant by virtue of the reputation of the earlier marks.

4. The applicant denies all of the grounds of opposition.

5. The earlier marks completed their registration processes more than five years before the date the contested application was filed. The opponent has made a statement that it has used the mark for the goods relied upon and the applicant indicated in its defence and counterstatement that it requires the opponent to prove that it has made genuine use of the earlier marks.²

6. Throughout the proceedings, the opponent has been professionally represented by Stobbs. The applicant has represented itself from the outset. Both parties filed evidence and the opponent filed submissions in lieu of a hearing (the applicant requested a decision from the papers). I make this decision after a careful reading of all the papers, referring to the evidence and submissions as necessary.

² See section 6A of the Act.

Evidence

7. The opponent's evidence-in-chief comes from Enrico Corbari, its Chairman.³ The opponent also filed a witness statement from a professional linguist, addressing the meanings of the words in the parties' marks.⁴ The applicant's evidence comes from Neel Shah, its Director⁵, in reply to which the opponent filed evidence from Clare Sugden, its trade mark attorney.⁶

8. In its pleadings and in its written submissions in lieu of a hearing, the opponent submits that the parties' class 24 goods are identical. It also submits that the opponent's goods in classes 20 and 21 are similar to the applicant's goods. In the opponent's letter of 21 April accompanying its evidence-in-chief, the opponent claims that the evidence shows a reputation and an enhanced level of distinctive character in the UK in relation to its goods in classes 8, 20, 21, 24 and 27. It does not mention the goods in classes 3, 4, 5 and 18 upon which it also relies in its initial pleadings. Likewise, the letter says that the evidence provides proof of use of the opponent's marks for goods in classes 8, 20, 21, 24 and 27. It is not apparent to me from the papers why the opponent did not expressly withdraw its reliance upon classes 3, 4, 5 and 18; or, if it did not withdraw its reliance, what similarity exists between its goods in classes 3, 4, 5 and 18 and the applicant's goods for the purpose of section 5(2)(b) of the Act.

Decision

9. I will begin by assessing whether the earlier marks have been put to genuine use. Section 6A of the Act states:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

³ Witness statement dated 19 April 2021

⁴ Witness statement dated 19 April 2021

⁵ Witness statement dated 20 June 2021

⁶ Witness statement dated 15 August 2021

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

10. The onus is on the opponent, as the proprietor of the earlier marks, to show genuine use because Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

11. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG*

[EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a

non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

12. The relevant period for proof of use of the earlier marks is 7 August 2015 to 6 August 2020. The relevant date for the assessment of the section 5(2)(b) and 5(3) grounds is the date on which the contested application was filed: 6 August 2020. As mentioned above, the opponent has not expressly withdrawn its reliance upon classes 3, 4, 5 and 18 and has been put to proof of genuine use in relation to the registered goods in these classes, as well as to those in classes 8, 20, 21, 24 and 27. Although for the purposes of the section 5(2)(b) goods comparison the opponent’s class 24 goods appear to be most relevant, it is necessary to assess genuine use for all of the opponent’s goods because section 5(3) of the Act is not dependent on goods or services being similar. The specifications of the two earlier marks are almost identical:

Class 3: Soaps; essential oils; preparations for perfuming linen; cleaning, polishing, scouring and abrasive preparations.

Class 4: Candles and wicks.

Class 5: Deodorants except for personal use (air fresheners).

Class 8: Kitchen utensils (hand-operated), not included in other classes; cutlery; forks and spoons.

Class 18: Bags; handbags; trunks; valises; umbrellas.

Class 20: Furniture and furniture fittings, not included in other classes; mirrors; picture frames; cushions.

Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); sponges; articles for cleaning purposes; glassware, porcelain and earthenware; drinking glasses and glassware for household purposes.

Class 24: *Textiles and textile goods; bed and table covers; sofa throws; table covers and table linen; covers for cushions.*

Class 27: *Carpets; rugs; mats.*

13. Mr Corbari provides a table of the total net sales of the opponent for ATIPICO branded products from 2012 to 2019.⁷ There are no UK-specific figures, although there are EU figures and separate figures for Italy, as well as figures for outside of the EU. Since the earlier marks are EUTMs, EU and Italian figures are relevant.⁸ The figures are displayed using commas and fullstops in the opposite way to how they are used in the UK. So, for example, the opponent's 2015 EU figure of €91.773,11 equates to €91,773.11.

Year	Total net sales	Italy	EU	Extra EU
2012	284.363,22	179.376,82	43.092,80	61.893,60
2013	374.292,12	218.285,96	53.614,64	102.391,52
2014	424.071,79	160.377,54	95.798,64	167.895,61
2015	423.071,21	134.505,37	91.773,11	196.792,73
2016	384.995,18	180.453,12	82.256,66	122.285,40
2017	262.180,29	125.031,76	68.795,01	68.353,52
2018	241.296,53	93.323,45	68.875,23	79.097,85
2019	221.600,03	112.678,49	75.464,26	33.457,28

14. Putting the Italian and EU figures together (since Italy is in the EU), the total EU net sales in 2015 to 2019 were €226,278.48 (2015); €262,709.78 (2016); €193,826.77 (2017); €162,198.68 (2018); and, €188,142.75 (2019). No breakdown of the sales is provided as between goods or classes.

⁷ Exhibit EC10

⁸ *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, Court of Justice of the European Union; *Intermar Simanto v Nike Innovate CV*, BL O/222/16, Mr Daniel Alexander QC, sitting as the Appointed Person

15. Exhibit EC10 also includes a schedule which Mr Corbari describes as listing a number of individual products sold by the opponent under the ATIPICO brand specifically for the UK, between 2016 and 2020. Total sales for these items are given as €12,836.30 in 2016; €2,770.55 in 2017; €31,421.55 in 2018; €13,965.30 in 2019; and, €2,256.98 in 2020. All the product listings are in Italian and no translation has been provided. Whilst I can guess that 'vaso' means vase; 'candeliere' means candle holder; and, 'caraffa' means jug or carafe, I do not know what the other terms mean. I have been able to work some of them out from other exhibits (e.g. price lists where 'cuscino' appears next to a picture of a cushion). Further, I note that the items have names and pictures of goods with some of those names appear in the opponent's Brand Book: 'Esag' (candle holders), 'Boccia' (jugs and glasses), 'Crudo' (bowls), 'Reton' (tables) and 'www' (jugs and glasses).⁹ Although the Brand Book is undated, Mr Corbari states that the Brand Book showcases the full range of the opponent's products offered for sale during 7 August 2015 to 6 August 2020 and that the Brand Book is a "typical example" of the way in which the opponent's goods have been advertised and offered for sale under the earlier marks since use of the mark commenced in the UK (which he states was in the 1990s). The Brand Book shows EUTM 8171357.

16. Price lists for the years 2015 to 2020 are shown in Exhibits EC2 to EC7. The price lists show EUTM 8171217 on each page. The following goods are shown in the price lists (with pictures and range names), although not all of these appear in all the price lists: tables, bowls, dishes, glasses, jugs, candle holders, vases, lamps, clocks, mirrors, umbrella stands, stools, chairs, ornaments, laundry bins, storage boxes, blankets/throws, cushions, rugs and shelving units.¹⁰ Exhibit EC8 includes copies from the UK retailing site, Wayfair, which gives UK prices. For example, a stool costs £469.99; a laundry bin £449.99; a table £929.99; vases £91.99 and £384.99; a jug £153.99; mirrors £1,479.99 and £3,039.99; and, a candle holder at £121.99. The Wayfair prints are undated. Also undated are the screenshots from the opponent's English version of its Italian website, although I note the copyright date of 2016.

⁹ Exhibit EC1

¹⁰ The opponent's evidence refers to blankets rather than throws, but these terms seem interchangeable.

17. Mr Corbari states that the sample of invoices from the opponent to direct UK customers is representative, not the total sales achieved.¹¹ I note that the invoices show the product descriptions in English, together with the range names. The goods listed on the invoices comprise vases, tableware, glassware, ornaments, candle holders, laundry bins and tables. They have mostly been ordered in single numbers; rarely more than ten of each item. The value of the orders range from £91.18 (for twelve drinking glasses) to £2639.00 (sixteen vases, six bookends, eight glasses, two coffee tables, two ornaments and two candle holders).

18. There are no class 24 goods listed in the invoices and none are shown in the Brand Book. The only goods in the evidence which are in class 24 are blankets/throws which are listed in the price lists and shown on the prints from the opponent's website, but without any prices. They do not appear in the Wayfair evidence. The names for the blanket/throw ranges are Iride, Queen, Edera, Photo, Nodomaglia, Knot and Longitudini. I note that none of these names appear on the UK invoices or in the list of UK-specific products sold in Exhibit EC10. There is no way of telling how many blankets/throws were sold in the EU. The opponent could have provided invoices showing blankets sold to customers in Italy and other parts of the EU, but has chosen not to. The opponent has provided net sales figures which are outside of the EU, so it could be the case that blankets/throws were sold outside the EU. The omission is all the more glaring seeing that invoices have been provided for several other products. The inference is that there were no sales of blankets/throws during the relevant period to customers within the EU.

19. The only other products shown in the evidence which are textile-based are the opponent's cushions, in class 20; and rugs, in class 27. Although, none of these appear in the Brand Book, there are cushions (Intrecci, Spinatino, Spinato, Longitudini, Dune and Blues) in the 2015 price list; in the 2016 price list (Intrecci, Spinatino, Spinato and Longitudini); and, in the 2017 to 2019 price lists (Intrecci, Spinato and Longitudini). Some of these names are listed in the UK-specific schedule in Exhibit EC10: Intrecci, Spinato and Longitudini with sales in 2016 and 2018 amounting to €1729. Cushions

¹¹ Exhibit EC11

also appear on the opponent's (undated) website, although none of these names, and no cushions, are listed in the invoices.

20. The evidence in respect of rugs is limited to the 2015 price list, which shows the ranges Knottie, Burma, Tundra, Nordic, Fez, St Barth and Saint Martin; to the (undated) Wayfair screenshots showing Burma and Nordic rugs; and to the UK-specific schedule of goods, with sales of Nordic rugs amounting to €41 in 2016 and no other UK sales of rugs listed. There are no rugs shown on the opponent's website and none appear in the invoices.

21. Social media evidence is from the opponent's Instagram and Facebook pages. I note that the Instagram screenshots have a copyright date of 2021, so must date from the year after the end of the relevant period (the date on which they were printed was 16 April 2021). There were, at this date, 203 posts and 2,562 followers (without details as to the locations of the followers). The Facebook pages only show vases and some information about the opponent in Italian and in English. There were 2,950 people following the Facebook page on 16 April 2021.

22. There is no use in relation to the registered goods in classes 3, 4, 5 and 18. There is also no use in relation to any class 8 goods.

23. The evidence contains considerable gaps. The exhibits have not been cross-referenced. I acknowledge that flaws in the evidence are not necessarily fatal to the opponent's case because an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹² That said, there comes a point when there are too many gaps to bridge and the tribunal becomes sceptical as to the reason why there are important gaps.¹³ I have already mentioned the lack of evidence in relation to what must be the high point of the opponent's case, blankets/throws (class 24): there is no evidence that the blanket/throw ranges were aimed at the UK; no UK evidence of sales, whilst such evidence has been provided for other products; no

¹² Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, GC.

¹³ *Awareness Limited v Plymouth City Council*, O/236/13 Mr Daniel Alexander QC, sitting as the Appointed Person.

breakdown of EU sales figures for blankets/throws; and, no invoices from non-UK member-states in the EU showing blankets/throws.

24. The opponent has not provided a product breakdown of the net sales figures, whether by item or grouped by goods type. If the evidence is thin elsewhere, as it is, in relation to the high point of its case (blankets/throws), the opponent ought to have bolstered the evidence by providing sales figures for blankets/throws somewhere in the EU. It has not done so. The onus is on the opponent to prove its use and it must do that by filing cogent evidence.¹⁴ Where it relies upon homogenous net sales figures across a range of different goods in different classes, the rest of the evidence should be particularised; or, the net sales should be particularised and backed up by examples of invoices, brochures and screenshots which are dated. Further, the evidence shows lamps which are not relied upon and not covered by the earlier marks' specifications, yet are presumably covered by the unparticularised net sales figures. I am unable to find that the earlier marks have been put to genuine use in the relevant period in relation to any of the opponent's class 24 goods: *Textiles and textile goods; bed and table covers; sofa throws; table covers and table linen; covers for cushions*.

25. The registered specification for class 20 is *furniture and furniture fittings, not included in other classes; mirrors; picture frames; cushions*. There is no use in relation to picture frames. The UK-specific schedule shows that there were sales of the '24.12' mirror in 2016 (€684) and in 2019 (€1280). Mirrors appear in the 2015 price list; on the opponent's website and in the undated Wayfair prints, but not in the invoices. The Wayfair prints show that the 21.12 mirror retails at a starting price of £1,479.99, depending on size. Therefore, the UK-specific schedule seems to amount to only about two mirrors sold in the UK (at less than the Wayfair starting price). These figures are the only sales figures relating to mirrors because the net sales figures have not been particularised. I am not prepared to find genuine use in relation to mirrors.

26. There is also not enough evidence which can be pulled together to find genuine use in relation to cushions; similarly, only €1729-worth were sold in the UK according

¹⁴ *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person

to the UK-specific schedule. According to the 2020 price list print, one cushion retails at €78. That is about 22 cushions. The UK-specific schedule has sales in 2016 amounting to €39. Even at that price, assuming that is a single cushion, that is 44 cushions. There is no particularisation of the net sales figures, and no appearance in the invoices to bridge the evidential gaps. In what is a huge market, this evidence is not enough to find that the opponent has created or maintained a market share for cushions in the EU.

27. *Furniture and furniture fittings, not included in other classes* is a wide term which the evidence does not support.¹⁵ The evidence shows tables in various forms, with sales figures appearing in the UK-specific schedule in 2016, 2017, 2018, 2019 and 2020. The sales across these years amount to €31,727.70. For the table range names which appear in the schedule (Reton and Tamburo), I see from the 2015 price list and from the two invoices in which a Tamburo table appears that the average retail price is about £300-£400. Sales in the UK therefore amounted to about one hundred tables. I am prepared to find genuine use in relation to tables.

28. The class 27 specification is *carpets; rugs; mats*. There is no use in relation to carpets or mats. The only price list which shows rugs is from 2015, at the start of the relevant period. The undated Wayfair prints show rugs, but there are none on the opponent's website and none in the invoices. The sum total of sales in the UK-specific schedule is €41 in 2016. There are no other sales details to make up for the evidential gaps. I decline to make a finding of genuine use in relation to rugs (or carpets or mats).

29. The class 21 specification is *household or kitchen utensils and containers (not of precious metal or coated therewith); sponges; articles for cleaning purposes; glassware, porcelain and earthenware; drinking glasses and glassware for household purposes*. There is no genuine use in relation to sponges and articles for cleaning purposes. I find that there has been genuine use in relation to the other goods in the specification; indeed, these types of goods seem to form by far the majority of the

¹⁵ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

opponent's sales in the UK, from what is shown in the invoices and in the UK-specific schedule from 2016 to 2020. They are also in evidence in the 2015 price list, the Brand Book, Wayfair and the opponent's website.

30. I find that the opponent may rely upon the following goods in this opposition:

Class 20: *Tables.*

Class 21: *Household or kitchen utensils and containers (not of precious metal or coated therewith); glassware, porcelain and earthenware; drinking glasses and glassware for household purposes.*

Section 5(2)(b)

31. Section 5(2)(b) of the Act states:

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

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

32. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-

120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.¹⁶

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

¹⁶ 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

33. In the event that I am wrong regarding my findings as to genuine use, it makes no difference to the outcome of these proceedings, as can be demonstrated by making a global assessment based on the parties' goods being identical. The law requires that goods/services be considered identical where one party's description of its goods/services encompasses the specific goods/services covered by the other party's description (and vice versa).¹⁷ The opponent has cover for *textiles and textile goods* which is a wide term encompassing all of the applicant's goods, which are therefore identical.

¹⁷ *Gérard Meric v OHIM*, Case T-33/05, General Court

34. With the exception of the applicant's bar cloths and table linen, based upon the caselaw which follows below there does not appear to be any similarity between the opponent's goods, in relation to which I have found genuine use, and the remainder of the applicant's goods. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

35. In *Kurt Hesse v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

"82 ... there is a close connection between [the goods], in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...".

36. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

37. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU

in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

Table linen and bar cloths

38. The opponent's tables (class 20) do not share the same nature, purpose or method of use as table linen. They are not likely to be sold in the vicinity of one another and are not in competition. Although table linen requires a table for its *raison d'être*, these goods are not complementary in the sense described in the caselaw; indeed, the relationship is analogous to the wine/wine glass example given by Mr Daniel Alexander QC, sitting as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

And:

".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

39. Whilst there is no similarity between the opponent's *tables* and the applicant's *table linen*, there is a degree of similarity, albeit very low, between the opponent's *household or kitchen utensils and containers (not of precious metal or coated therewith); glassware, porcelain and earthenware; drinking glasses and glassware for*

household purposes and the applicant's *table linen* and *bar cloths*. Both of these goods are sold nearby to tableware such as the opponent's plates, bowls, cups, carafes and glasses. However, they are not complementary, not in competition, do not share nature or purpose, and do not share the same or a similar method of use.

The average consumer and the purchasing process

40. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. The parties' goods are aimed at the general public. Some will be relatively inexpensive such as sheets and everyday drinking glasses. Whilst the goods are not likely to be purchased very frequently, they are common and everyday household consumer goods to which a normal degree of attention will be paid during the purchasing process. That process will be overwhelmingly visual because the look of the products will be important to consumers. They may also be an aural aspect to the purchase if the goods are referred to orally by shoppers and retailers.

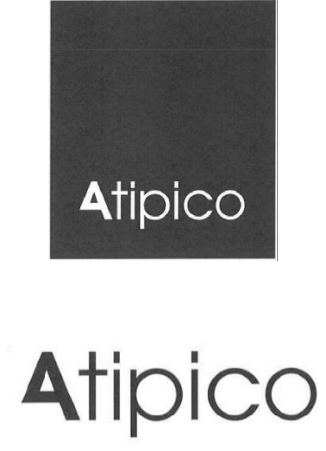

Comparison of marks

41. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

42. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

43. The marks to be compared are:

Opponent's marks	Applicant's mark
	

44. The two earlier marks differ in marginal details: they are the same word, with the same thicker stylised capital letter A, but one is black on white and, in the other mark, the word is presented in white upon a black rectangle. There is also a faint black line beneath the black word version. The line and the black rectangle make a very minor contribution to the overall impression of the earlier marks which are, in both cases, dominated by the Atipico word element.

45. The applicant's mark is comprised of three main elements: the lightbulb device, the letter A, in red, and the word 'typical'. None of these overtly dominate more than the others; the overall impression resides in the combination. This is because the A will be perceived as belonging to 'typical' to make the word Atypical, which is wide enough in terms of proportions to stand out equally with the device of the lightbulb, which is at the front of the mark and extends above the word.

46. Apart from the faint horizontal line and the black rectangle, the applicant's lightbulb, absent from the earlier marks, is a prominent visual difference between the parties' marks. The initial letter A in the parties' words looks different, with the opponent's version being partly missing. The opponent's word is seven letters long, whilst the applicant's word is eight letters long. Of the letters in the parties' respective words, the first, second, fourth, fifth and sixth letters are the same. However, the initial letter A in the applicant's mark is separated from the rest of the word because it is encased within the lightbulb and this makes a marked visual difference. The final letter of the opponent's mark, O, looks very different to the final letter of the applicant's mark, I. Balancing the similarities and the differences, there is a low degree of visual similarity between the parties' marks.

47. Since the stylistic elements of the parties' marks will not be articulated, only the word elements Atipico and Atypical will be spoken. It is the opponent's case that Atipico means Atypical in Italian, Spanish and Portuguese, as to which, see below. In *Zipcar, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* the GC observed:¹⁸,

“41 As regards the phonetic aspect, it must be noted that it is difficult to establish with any certainty how the average consumer will pronounce a word of foreign origin in his native language. First, there is no certainty that the word will be recognised as being foreign. Secondly, even if the foreign origin of the word in question is recognised, it may not be pronounced in the same manner as in the original language. A correct pronunciation according to the original language presupposes not only knowledge of that pronunciation, but also the ability to pronounce the word in question with the correct accent (see, to that effect, HOOLIGAN, paragraph 58).”

48. There are four syllables in each word. Although the third letter in each mark, the i and the y, differ visually, they are likely to be pronounced identically within the parties' words - a short 'i' sound. All of the y/i letters in both marks are likely to be said as short 'i' sounds, making the second and third syllables identical. The initial A in the

¹⁸ Case T-36/07

applicant's mark, which is a common English word with settled pronunciation, will be said as a long A. The initial A in the earlier marks could be pronounced in the same way, or as a short A (as in apple), depending on whether the average consumer knows of the Italian, Spanish or Portuguese pronunciation. The final 'o' syllable in the earlier marks sounds completely different to the final 'al' syllable in the applicant's mark. Overall, there is, depending upon the pronunciation of the initial A sound, either a medium/high or a medium degree of aural similarity between the parties' marks.

49. The opponent filed a short witness statement from a professional linguist, Mr Stephen Hunter, addressing the meanings of the words in the parties' marks. Mr Hunter states as follows:

"1. I am a Professional Linguist. My native tongue is English and I am fluent in the languages German and Spanish.

2. In the course of my work I translate, analyse, research and interpret language.

3. I have been asked by Stobbs, a professional firm of Chartered trade mark attorneys, to comment on the meaning of the words for ATYPICAL and ATIPICO bearing in mind the goods applied for, which relate to textiles, fabrics and fabric covers for household use, household linen and curtains all for use in the bedroom, bathroom, for the beach or for pets.

4. I can confirm that, as far as I can see, the words atypical, atypisch, atypique, atipico and atípico are more or less entirely synonymous. That is, I do not think there is any way in which the respective variants of the word are 'false friends' in any of the languages, though minor differences in usage may exist. Examples of such false friends could include the difference between English 'ambulance', which has come to mean a vehicle for taking people to and from hospital, particularly in emergencies, whereas German *Ambulanz* has taken a slightly different historical route and come to mean 'outpatient department'. An English-Spanish example could be the English 'constipated' versus Spanish *constipado*, which means 'having a cold'. In both cases the notion of blockage

underlies the different usages, of course. As far as I am aware no such potential confusion exists in relation to the various versions of the word 'atypical' in different European languages.

5. Accordingly, Stobbs assertion that "the marks are identical conceptually" appears to be a reasonable one."

50. There appear to be two groups of average consumers whose reactions may differ as far as discerning any meaning to the words in the parties' marks. The first is the monoglot average UK consumer. This group of average consumer knows that the English word 'atypical' means something that is not typical, or "different from all others of the same type".¹⁹ They are not likely to know what atipico means, and will not evoke the word atypical because of the swapped i for a y, and the entirely different endings. This group will see Atipico in the earlier marks as an invented word. They will also recognise the device to be a lightbulb. For this group of average consumer, the words, and the marks as wholes, are conceptually different.

51. The second group of average consumer comprises those who know what 'atipico' means. They could be Italian or Spanish speakers, whether by family heritage or by having learned the language at school or during further education. They may not speak the other languages all the time but have an understanding of words in those languages. For this group, given the statement of Mr Hunter, they will understand the words in the parties' marks to mean 'atypical'. The meaning will be the same. However, there is still the lightbulb to factor into the analysis, which is absent from the earlier marks and bears no relationship to the words in the marks. This is a conceptual difference between the marks. Overall, for this group, there is a medium degree of conceptual similarity between the parties' marks.

¹⁹ Cambridge English Dictionary

Distinctive character of the earlier mark

52. There is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it.²⁰ I will begin by considering the inherent distinctive character of the earlier mark *per se*, taking into account the guidance of the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*.²¹

53. Distinctive character is a measure of how strongly the mark identifies the goods of the opponent; determined, according to *Lloyd Schuhfabrik Meyer & Co.*, by assessing the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking. As said earlier, the evidence is not well-marshalled and only supports a finding of genuine use in relation to a limited number of terms in the class 20 and 21 specifications. Although the earlier marks are EUTMs, and therefore use in the EU counts in relation to genuine use, the distinctiveness of the earlier marks must be assessed from the perspective of the UK average consumer. Any enhancement to distinctive character which is not apparent to UK consumers will not assist the opponent because a likelihood of confusion must occur to UK average consumers. The UK sales figures are those in the UK-specific schedule: €12,836.30 in 2016; €2,770.55 in 2017; €31,421.55 in 2018; €13,965.30 in 2019; and, €2,256.98 in 2020. These are very small numbers in the context of the market for the opponent's goods – whether those in relation to which I have found genuine use, or for all the goods relied upon. The opponent is not entitled to claim that the distinctive character of its marks has been enhanced.

Likelihood of confusion

54. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision.

²⁰ *Sabel BV v Puma AG*, Case C-251/95

²¹ Case C-342/97

55. There are two types of confusion: direct and indirect. Direct confusion occurs where marks are mistaken for one another, flowing from the principle that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them which has been retained in the mind.²² The likelihood that marks will be mistaken for one another may be reduced in circumstances where one of the marks has a meaning which is immediately apparent to the average consumer, whereas the other mark has no such conceptual hook and no other aspect leading to confusion. This was explained by the CJEU in *The Picasso Estate v OHIM*.²³

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

56. Such counteraction does not always avoid a likelihood of confusion, however, as the GC stated in *Nokia Oyj v OHIM*.²⁴

57. In the present case, the first group of average consumers will not perceive Atipico to have a meaning, but they will grasp the meaning of Atypical immediately. This meaning will be retained in their mind, along with the visual representations of the marks, the purchase being primarily visual. The clear and specific meaning of Atypical will counteract the visual similarity, which in any case is low, and the aural similarity, even at its highest level. Added to this, the further concept of the lightbulb will also stick in their mind. Even if identical goods (in class 24) were to be involved, and no more than a normal degree of attention paid to the purchase, the effects of imperfect recollection, which typically leads to direct confusion, are unlikely to occur because, as in *Picasso*, the meaning of Atypical will be so immediate and different to the common element in the earlier marks that the marks will not be mistakenly recalled.

²² *Lloyd Schuhfabrik Meyer*, at [26].

²³ Case C-361/04 P

²⁴ Case T-460/07

58. I also consider that the second group of average consumers in the UK, those with an understanding of Atipico in Italian or Spanish (or Portuguese) will not mistake the parties' marks for one another (again, even for identical goods). Such average consumers will be particularly alive to the fact that one version of the word is e.g. Italian or Spanish, and the other is English. I do not think it would be right to proceed on the assumption that they do not know the English version of a common word in the UK because these proceedings are concerned with UK average consumers and, moreover, the goods are not aimed at a particular ethnic group.²⁵ They will not mistake the foreign version of the word for the English version of the word in a trade mark, particularly where there are other visual differences.

59. I find that neither group of average consumers is likely to be indirectly confused, which involves the average consumer recognising that the marks are different but nevertheless, because of common element(s) concluding that the marks emanate from the same or economically linked undertakings.²⁶ The monoglot group will know the meaning of Atypical and will not conclude what they see as an invented word, Atipico, as being a natural brand extension or sub-brand (or vice versa). Neither will the second group; there is no reason why the word would appear in different languages and look quite different, along with a lightbulb, which bears no conceptual relationship to the word. Even if, on the hypothetical basis that identical goods were involved and that there was a fleeting bringing to mind (which I doubt), this is not enough. In *Duebros Limited v Heirler Cenovis GmbH*, Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element.²⁷

60. There is no likelihood of confusion. For this reason, it is unnecessary to look at the applicant's evidence, which principally consists of statements about the state of the register and whether the opponent's marks appear on search results in various online platforms; nor to examine the opponent's reply to this evidence which goes to how search engines work, and third parties' marks.

²⁵ See, for example, *Industria de Diseno Textil S.A. (Inditex, S.A.) v Hilary-Anne Christie*, BL O/040/20, Mr Daniel Alexander QC, sitting as the Appointed Person

²⁶ See *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10

²⁷ BL O/547/17

Section 5(2)(b) outcome

61. The section 5(2)(b) ground of opposition fails.

Section 5(3) of the Act

62. Section 5(3) states:

“(3) A trade mark which-

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

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

63. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10, Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55, Case C-323/09, *Marks and Spencer v Interflora* and Case C-838/12 P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

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

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

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

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

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

64. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks are similar to the application. Secondly, it must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

65. The first condition of some level of similarity between the marks is satisfied, as found earlier in this decision.

66. The next condition is reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public. In *General Motors*, the CJEU held that:

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

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

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

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

67. In *Spirit Energy Limited v Spirit Solar Limited*, BL O/034/20, Professor Phillip Johnson, sitting as the Appointed Person, held that the opponent had not established a qualifying reputation for s.5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the five years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of s.5(3).

68. Even if I were, to give the opponent its best chance, to proceed on the basis that it has met the genuine use requirements for all of the goods covered by the earlier marks, it has not met the reputation requirement. Bearing in mind that the earlier marks are EUTMs, the figures for EU net sales from 2015 to 2019 were €226,278.48 (2015); €262,709.78 (2016); €193,826.77 (2017); €162,198.68 (2018); and, €188,142.75 (2019). As said earlier, there are goods in the evidence which are not even relied upon. There is nothing to show me what proportion of the sales relate to which goods. Putting that to one side, these sales figures are not substantial enough to find a qualifying reputation in a huge market.

69. Again, giving the opponent its best chance, even if I were to find that the above figures did qualify, without a reputation in the UK it is difficult to see how a link would arise in the minds of the UK relevant public. The UK sales figures are those in the UK-specific schedule: €12,836.30 in 2016; €2,770.55 in 2017; €31,421.55 in 2018; €13,965.30 in 2019; and, €2,256.98 in 2020. These figures are nowhere near high enough to result in a link being made in the minds of the UK relevant public and, if one was made, it would be so fleeting that no damage would arise.

Section 5(3) outcome

70. The ground of opposition under section 5(3) of the Act fails.

Overall outcome

71. The opposition fails.

Costs

72. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its actual costs, including providing

accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs, other than official fees arising from the action and paid by the successful party...will be awarded”.

73. Since the applicant did not respond to that invitation within the timescale allowed (nor has any response been received from the applicant prior to the date of the issuing of this decision), and as the applicant has not incurred any official fees in defending its application, I make no order as to costs.

Dated this 5th day of November 2021

**Judi Pike
For the Registrar,
the Comptroller-General**