

O/936/21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 3428338 IN THE NAME
OF GADGET CLINIC REPAIR LTD FOR THE SERIES OF TWO TRADE MARKS**

**Gadget Clinic
The Gadget Clinic**

IN CLASS 37

AND

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO UNDER
NUMBER 503247 BY TAL MARWOOD**

AND

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 3303979 IN THE NAME
OF TAL MARWOOD FOR THE TRADE MARK**



IN CLASS 37

AND

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO UNDER
NO. 503623 BY GADGET CLINIC REPAIR LTD**

Background and pleadings

- 1.This decision pertains to consolidated proceedings, as shown on the cover hereto, respectively brought by Mr Tal Marwood (“Party A”) and Gadget Clinic Repair Ltd (“Party B”).
- 2.On the 21 July 2020 Party A initiated invalidation proceedings under section 47(2)(a) of the Trade Marks Act 1994 (“the Act”), to have Party B’s registered trade mark No. 3428338 (“338”) declared invalid based on section 5(2)(b) of the Act.
- 3.Party B’s 338 registration is for a series of two word marks: Gadget Clinic and The Gadget Clinic, which was applied for on 13 September 2019 and was entered in the register on 6 December 2019; for the following Class 37 services:

Repair services, installation services, repair services in relation to electronic apparatus, refurbishment services in relation to electronic apparatus, none of the aforementioned services relating to online games, games for mobile phones, games for laptops, games for mobile digital devices, gaming and amusement machines; repair services in relation to phones; refurbishment services in relation to mobile phones; refurbishment of telecommunications equipment, apparatus and instruments; information and advisory services in relation to all the aforesaid services.

- 4.Party A relies upon its registered trade mark 3303979 (“979”) as an earlier right, claiming that there is a likelihood of confusion under section 5(2)(b) with the contested trade mark; because they are identical or similar and are both registered for identical or highly similar services in Class 37. Party A’s mark, as shown on the cover page, was applied for on 15 April 2018 and was registered on 13 July 2018, for these services in Class 37:

Mobile Phone and Tablet Repair Services; Computer repair services.

5. In its defence and counterstatement, Party B counterclaimed that it has an even earlier right, which predates the trade mark upon which Party A relies in the forerunning invalidation action.
6. Party B consequently filed invalidation proceedings against Party A's mark, under the provisions of section 47(2)(a) of the Act on the grounds of sections 5(2)(b), 5(3), and section 47(2)(b) in relation to a 5(4)(a) claim, on the basis that it (Party B) is the successor in title to registered trade mark, 3036132 ("132"), which is a similar mark, for identical services.
7. Trade mark 132 stands registered in the name of G@dgetClinic Ltd, an entity independent of Party B, from which it claims to have acquired the rights associated with this registration and from which the 338 mark appears to have been replicated; though the series of two marks is recorded in the reverse order: The Gadget Clinic and Gadget Clinic. This mark was applied for on 25 December 2013 and was entered in the register on 11 April 2014, for the selfsame services under the later 338 registration.
8. Party B further claims that its earlier right has acquired enhanced distinctiveness because of the use made of it since 2012.
9. Party A filed a defence and counterstatement denying each of the grounds of the objection; and "puts the Applicant for Invalidation to strict proof that it is the owner of UK trade mark registration no UK00003036132". Party A further asserts that: "It is my understanding that for the Sections 5(2)(b) and 5(3) grounds to succeed the applicant must be the owner of an earlier registered trade mark. The evidence filed by PARTY B does not show that PARTY B owns UK trade mark registration no. UK00003036132 on which the Sections 5(2)(b) and 5(3) grounds rely and I respectfully request that these grounds be dismissed".
10. In relation to the section 5(2)(b) objection, Party A also puts Party B to proof of use in respect of all of the services upon which it relies. Further, under the section 5(3) objection, Party B is put to "strict proof that at the date of application UK trade mark

registration no. UK00003303979, 15 April 2018, it had a reputation in the UK in relation to the services for which it is registered” and that “it has made use of [said] mark ... during the 5 year period prior to the application date for invalidation”.

11. In response to the passing off claim, Party A puts Party B “to strict proof that at the date of application UK trade mark registration no. UK00003303979, 15 April 2018, it had used the marks since at least August 16, 2012 throughout the United Kingdom and had built up valuable goodwill as a result of that use”.

12. In these proceedings Party A is a Litigant in Person and Party B is represented by Urquhart-Dykes & Lord LLP. Both parties filed evidence and submissions in lieu of a hearing. As a hearing was neither requested nor considered necessary, I give this decision after a careful review of all of the papers before me.

Evidence and submissions

13. Party A’s evidence consists of his (Tal Marwood’s) witness statements, which are dated: 7 December 2020 (with Exhibits TM1 - TM6); 14 July 2021 (including Exhibits TM1 and TM2); 12 October 2021 (with Exhibits TM1 – TM3); and submissions in lieu of a hearing dated 12 November 2021.

14. The evidence of Party B consists of two witness statements in the name of Marika Sarah Stanley, and Exhibits MSS1 to MSS27; and submissions in lieu of a hearing dated 12 November 2021. Ms Stanley is a Director of Gadget Clinic Repair Ltd, a position she has held since 5 December 2018.

15. Whilst I do not propose to summarise them here, I have taken all of the evidence and submissions into consideration in reaching my decision and will refer to them where necessary.

DECISION

16. Before considering the substantive grounds of the respective objections, it is important to clarify whether Party B has legal standing to bring its invalidation action against Party A under the 132 mark, particularly as the crux of the decision might turn on this issue. In any event, it makes sense to deal with Party B's invalidity application first; given that this is based on a claim to rights in a registration which is earlier in time to the mark relied upon by Party A in its invalidity action; and as such, determination of Party B's application could have consequences for Party A's application (though it was first in time in these proceedings).

17. Party A contends that the "evidence shows that Party B does not own UK trade mark registration no. UK00003036132 The Gadget Clinic/Gadget Clinic, nor did it own it at the date of application of UK trade mark application no. UK0000 3303979 [15 April 2018]. I submit therefore that all of the grounds in Cancellation Action No. CA00003623 which rely on ownership of registration no. UK00003036132 be dismissed".

18. In reply, Party B submits that "Sales of Business are sufficient to transfer the ownership of 3036132 from G@dgetClinic Ltd to Party B. The Sales of Business documents (exhibits MSS8 and MSS9) are valid contracts since they refer to consideration, which has duly been paid, and are signed by both parties. It is submitted that the terms 'the new purchasers will continue to use the existing name as a trading name' in both agreements is intended to include transfer of the trade mark registration".

19. By letter dated 10 February 2021, the Tribunal advised Party B as follows:

*Under the legislative changes that came into force on 1st October 2007, invalidations based on Section 5 of the Trade Marks Act 1994 can only be made by the proprietor of an earlier mark or other earlier right. As the invalidation has been filed by **GADGET CLINIC REPAIR LTD of Gadget Clinic, 276 St. Albans Road, Watford, WD24 6PE**, the applicant's details do not appear to correspond to those of the registered proprietor of UK00003036132 i.e.*

G@dgetClinic Ltd of 113 Durban Road, WATFORD, WD18 7DT (emphasis in original).

Before the invalidation can be admitted in respect of those grounds based on Section 5, the registry will require written confirmation that the applicant is the proprietor of the earlier mark or other earlier right. You may wish to provide a brief explanation as to why there is a discrepancy between the relevant details. A TM21A can be filed should the proprietor's details require updating for UK00003036132.

Please file an amended TM26(I) and statement of grounds on, or before, 3 March 2021 (emphasis in original).

If you choose not to amend the TM26(I) and statement of grounds the registry may decide to strike out any grounds which are not adequately explained.

20. Party B responded by email dated 17 February 2021 in the following terms:

We note the official letter dated 10 February 2021 and the query regarding the ownership of UK trade mark registration no. 3036132. The companies Gadget Clinic Repair Ltd and G@dgetClinic Ltd are two separate companies. The applicant for invalidity considers itself to be the successor in title to G@dgetClinic Ltd and therefore the proprietor of the earlier registration, however the change of proprietorship is complicated and has not been recorded on the UKIPO register. This is an issue which will be covered by the applicant's evidence and submissions in this case.

As the Tribunal Section is aware, the above-referenced cancellation action was filed in response to the deadline for the Registered Proprietor's submissions in cancellation action no. 503247 in respect of UK trade mark registration no. 3428338. This is one of the reasons that the proprietorship issue could not be resolved prior to the filing of the present invalidity application no. 503623.

We trust this explanation is sufficient to address the Tribunal Section's query and to explain why the TM26(l) does not need to be amended.

21. I note that Party B has chosen not to make further submissions to adequately explain, nor attempts to rectify, the identified discrepancy as to ownership of the 132 mark. It instead places reliance upon the sales agreements executed on 24 July 2017 and 1 November 2018 [Exhibits MSS8 and MSS9]. These sales agreements are found to be deficient (for present purposes) for a number of reasons, including: the fact that they do not expressly transfer ownership of the 132 mark to Party B; and even more critically, it (Gadget Clinic Repair Ltd) is not recorded as a party (as a promisor/beneficiary or in any form) to either of the contracts upon which it relies. To further compound the problem, at the time of writing this decision, the ownership status remained unchanged in the Trade Marks Register. Therefore, the fact that the mark in question remains vested in a third party (and not Party B), self-evidently undermines its claim to having an earlier right to challenge Party A's registration under sections 5(2)(b) and 5(3) of the Act.

22. The issue of transfer of ownership also bears relevance to Party B's claim under section 5(4)(a), which relates to protection of unregistered rights to the trade mark, for use that commenced prior to registration of the mark at issue. To bring this claim in the first instance, Party B must prove that relevant goodwill was assigned or transferred to it under the sales agreements adduced into evidence.

23. The first issue which vitiates Party B's section 5(4)(a) claim is that "the purchaser" recorded in the sales agreements is an individual (SM); no mention is made of Party B (Gadget Clinic Repair Ltd) as an entity entitled to benefit under either agreements. These proceedings are brought in the name of Party B and there is no explanation as to SM's relationship, if any, to Party B (SM is not party to these proceedings). In any event, as well established in law, Party B (a registered limited company) has a legal personality separate from those who have formed it, or those who own or manage it. Therefore, in view of the contractual instruments at issue, any established goodwill (if transferred) would have vested in SM and not in Party B.

24. Furthermore, without delving into apparent complexities, this highlights the additional issue as to whether the relevant goodwill was assigned or transferred under the sales agreements. However, I will not consider this further, given that Party B's passing off claim falls at the first hurdle; it is not the proprietor of any goodwill accrued under the mark and so, it does not have standing to bring this claim. In the circumstances, I have no alternative but to find that Party B's invalidation action against Party A fails in its entirety.

25. I will now proceed to consider Party A's invalidation application against Party B's mark.

Relevant Law

26. Section 5(2)(b) of the Act has application in invalidation proceedings by the agency of the provisions set out in section 47(2)(a) of the Act. By virtue of this section, a registered trade mark may be declared invalid if there is an earlier trade mark which satisfies the conditions under section 5(2) of the Act and the owner of the earlier mark has not consented to the registration. In circumstances in which the earlier mark completed its registration process more than five years before the date of the application for invalidity, the use conditions must be met.

Section 5(2)(b) provides that:

“A trade mark shall not be registered if because -

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

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

27. An earlier trade mark is defined under section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

28. The mark upon which Party A relies qualifies as an earlier right in accordance with the above provisions. Further, as this mark was entered in the register on 13 July 2018, it is not subject to the proof of use provisions contained in sections 47(2A) – (2E) of the Act.

Section 5(2)(b) case law

29. 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.¹

¹ 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.

The principles

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

30. The parties' respective services in class 37 are:

Party A's services	Party B's services
Mobile Phone and Tablet Repair Services; Computer repair services.	Repair services, installation services, repair services in relation to electronic apparatus, refurbishment services in relation to electronic apparatus, none of the aforementioned services relating to online games, games for mobile phones, games for laptops, games for mobile digital devices, gaming and amusement machines; repair services in relation to phones; refurbishment services in relation to mobile phones; refurbishment of telecommunications equipment, apparatus and instruments; information and advisory services in relation to all the aforesaid services.

31. 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): see *Gérard Meric v OHIM*, Case T-33/05, General Court ("GC"). I therefore find that the respective services (possibly with the exception of "installation" and "advisory services") are identical under this principle, having found that all of Party A's services, "Mobile Phone and Tablet Repair Services"; and "Computer repair services", are encompassed by Party B's services.
32. The contested "*installation services ... in relation to electronic apparatus*" and the earlier *repair services* have very similar natures and purposes; they are usually provided by the same traders, have the same distribution channels, target the same public and are complementary. Therefore, if they are not identical, they would at least be similar to a very high degree.
33. As far as the contested "*advisory services*" are concerned, it is not unreasonable to find an immediate and direct link with the related *repair services*, as companies who provide the latter services very often provide advisory services in connection to them; and from this perspective these services are complementary. They also have the same distribution channels, target the same public and may compete. Therefore, they can also be said to be highly similar.

The average consumer and the purchasing process

34. 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.
35. The parties' services are provided to the general public and may include provision to businesses. A damaged or defective device can significantly affect the average consumers' daily activities, owing to the central role electronic devices now play in the lives of individuals and businesses. This, coupled with the expense involved and the (contemplated) infrequent nature of the purchase, leads me to conclude that the


purchase of the services under consideration is likely to involve a reasonable amount of care and may be high in some circumstances. For example, the user of the services will also wish to make sure that there is the necessary expertise required to effect repairs to a complex, costly gadget. Purchasing will take place on a visual basis during (for example) consultation of websites, brochures and documentation, but, for both parties' services, there is also likely to be oral use of the marks when professional advice is being given to prospective customers.

Comparison of marks

36. 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.”

37. 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. The marks to be compared are:

Party A's Mark	Party B's Mark
	<p>The Gadget Clinic Gadget Clinic</p>

38. In comparing the marks there is no difference between the variation in the casing; because a word trade mark registration protects the word itself, not its written form. Therefore, it is of no consequence whether a word mark is represented in lower or upper case letters or a combination of both. Additionally, the doctrine of notional and fair use extends to use of Party B's mark in exactly the same colours as those in Party A's mark.

39. Party A's mark is a composite mark in three predominant colours, consisting of a figurative element and a series of words in different dimensions. The figurative element is made up of a white cross in a red circle, to the right of which are the words: "The", positioned in a smaller, blue font at the top of "Gadget Clinic", which is set in a proportionately larger font in the same shade of blue as the "The" element (both in title case); and the word sequence "FIRST AID FOR ALL YOUR TECH" below the "Gadget Clinic" element, in smaller sized, grey/black uppercase font. GADGET CLINIC are the dominant elements of the mark; as they stand out compared to the other elements, which attach no origin or trade mark significance to the mark.

40. Similarly, given that Party B's series of marks consist of only the words: THE/GADGET CLINIC, the overall impression lies in the unit formed by the combination of the word elements GADGET CLINIC.

41. However, I also consider that the "THE" element might contribute to the overall impression of the respective marks, where it is perceived (with emphasis on its pronunciation – "THEE") as indicating that the entity at issue (the GADGET CLINIC) is THE best known or THE most important of its kind.

42. Further, I also consider, in view of the services at issue, that GADGET will be seen as descriptive; CLINIC is not directly descriptive, although allusive of repairing or improving the health of a product; as shown by the parties' use of the word providing these services. Consequently, where this perspective is appreciated, the CLINIC element is the dominant and distinctive element in both marks. However, this does not much matter, given the identity of the dominant elements in the respective marks.
43. Visually, the marks coincide in the sequence of the words: THE GADGET CLINIC/GADGET CLINIC, which are the only elements in Party B's mark and which constitute the dominant elements of Party A's mark. Points of visual differences are found in Party A's mark, with the inclusion of a figurative device, the word sequence: "FIRST AID FOR ALL YOUR TECH" and the overall stylisation of the mark. In light of all of these considerations, I find that the respective marks share a medium degree of visual similarity.
44. Similarly, the marks overlap in the identical pronunciation of the words THE/GADGET CLINIC. The figurative element and the less dominant, descriptive elements ("FIRST AID FOR ALL YOUR TECH") in the earlier mark are unlikely to be articulated by the average consumer.² Where the respective marks are articulated as THE/GADGET CLINIC (with a proportion of the average consumer choosing not to articulate the descriptive and less dominant elements), the marks are aurally identical. In the less likely scenario where the additional word sequence in Party B's mark is articulated, the marks can be said to be aurally similar to a medium degree.
45. Conceptually, both trade marks comprise of ordinary dictionary words (in the same order), which will be readily understood by the average consumer. The additional elements in the earlier mark, particularly the word sequence "FIRST AID FOR ALL YOUR TECH", help to reinforce the overall conceptual message of GADGET CLINIC:

² With regard to the figurative element ..., where a trade mark is composed of verbal and figurative elements, the former should, in principle, be considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark. [The Board of Appeal] correctly takes the view that that general line of reasoning could reasonably be applied in the present case. According to the Board of Appeal, it is reasonable to assume that the average consumer will perceive the verbal element as the trade mark and the figurative element as a decorative element. Moreover, the figurative element is placed ... in a less visible position. (T-312/03, *Selenium-Ace*, § 37).

a specialist establishment for restoring or improving the health of a gadget. Therefore, I find that the marks are conceptually similar to a high degree, if not identical.

Distinctive character of the earlier mark

46. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion³. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

47. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

³ *Sabel BV v Puma AG*, Case C-251/95 [para. 24]

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

48. Trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it.

49. As indicated earlier, the mark is dominated by ordinary dictionary words: GADGET will be seen as entirely descriptive and CLINIC, though not directly descriptive, is allusive of repairing or improving the health of a gadget. Consequently, I find that the earlier mark has a low degree of inherent distinctive character for the services for which it is registered. Nevertheless, I must now go on to consider whether the mark has acquired enhanced distinctiveness, given that Party A has filed evidence of use.

50. In his evidence, Mr Marwood asserts that he has “been offering repair services [under the mark] since at least August 2012”; and that he “has made considerable efforts to promote the services [he] offers via social media including via paid for advertising on Facebook and Instagram. As a result of these activities and having a website presence since at least July 2017..., Party A enjoyed considerable goodwill in the marks”.

51. However, the evidence provided does not give me any clear opportunity to assess the acquisition of distinctive character through use. Although the evidence includes turnover figures in the witness statement dated 7 December 2020 and spreadsheets showing a sample of repairs conducted via a postal service (for example), I do not consider these sufficient to enable me to conclude that the mark was at the relevant date, well-known to the general public or to a substantial proportion of the relevant general public.

52. In his witness statement of 7 December 2020, Party A reports turnover figures as follows:

Year	Turnover
2012 -13	£15,173.00
2013 -14	£13,170.00
2014 -15	£68,092.00
2015 -16	£82,482.00
2016- 17	£93,949.00
2017 -18	£137,916.00
2018 -19	£78,009.00

53. Although these figures are not insignificant, in the absence of information on the size of the market or Party A's share of the market, they do not assist in taking me further along in this assessment. The sample of postal repairs (some of which are recorded as: pending, processing and refunded) shows one entry in 2016, a few entries in 2017, 2018 and 2019, a greater number in 2020 and four entries in 2021. Whilst there is some evidence of preparation of promotional materials and advertising in various forms, little information is provided in relation to advertising expenditure, exhibited at TM04, for example, which is not printed clearly; and the breakdown provided in the spreadsheets does not further assist my assessment of the geographical spread of the mark. The *Facebook* Account overview (at Exhibit TM04) shows that 338,885 people were reached; however, this does not relate to actual customers and there is no indication as to whether those reached were based solely in the UK. In the circumstances, I consider that the evidence filed is insufficient to show that Party A's mark has acquired an enhanced level of distinctiveness. Therefore, my earlier assessment on the inherent distinctive character of the mark remains unchanged.

Likelihood of confusion

54. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

55. In reaching a decision, I am also reminded that there are two types of possible confusion: direct, where the average consumer mistakes one mark for the other; and indirect, where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related.⁴

56. Earlier in this decision, I found that the parties' marks coincide in the inclusion of standard dictionary words, THE/GADGET CLINIC, which are the dominant and distinctive elements. I found that the competing marks share an above average degree of visual similarity; are aurally identical or similar to an average degree; and they are highly similar, or identical, conceptually, on grounds of the shared, dominant elements THE/GADGET CLINIC. Party A's earlier mark was found to have a low degree of inherent distinctive character.

57. I have identified the average consumer to be a member of the general public or a business user, who will select the services primarily by visual means (though I do not discount an aural component); and determined that the degree of attention paid will be reasonable to high, according to the respective groups of the average consumer and the spectrum of variables at play. I have found the parties' competing services to be identical and/or highly similar.

58. Although I have found the inherent distinctive character of the earlier mark to be of a low degree, I consider that this could not neutralise the cumulative effect of the compelling commonalities: visually, conceptually and even the potential identical articulation, between the marks. Moreover, with the principle of imperfect recollection in mind, I am satisfied that there will be a likelihood of direct confusion between the marks, that is, the average consumer will mistake one mark for another. This is the case even for those paying a high level of attention to the purchasing process because marks are rarely seen side by side. This conclusion accords with Party B's

⁴ *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10.

evidence of actual confusion (paragraph 12 of Ms Stanley's Witness Statement dated 14 July 2021 and Exhibit MSS22).

59. Further and/or in the alternative, given my findings on the similarities between the marks and the identity of the services, I consider that even if the average consumer recalls the differences between the marks, they are likely to perceive the later mark as a variant brand originating from Party A, leading to indirect confusion.

CONCLUSION

60. Given all of the above factors and findings, I conclude that there is a likelihood of confusion under section 5(2)(b) of the Act.

503247 Invalidation outcome

61. Party A's application for a declaration of invalidity succeeds against the entirety of Party B's registration number 3428338 (including all of its services); and under section 47(6) of the Act, the registration is deemed never to have been made.

503623 Invalidation outcome

62. As indicated earlier, Party B did not have legal standing to bring its invalidation against Party A's mark and that action has failed in its entirety.

Costs

63. Party A has been successful and is entitled to a contribution towards its costs. As a Litigant in Person, Party A completed a Cost Pro Forma of actual costs incurred in these proceedings, as follows:

Tribunal Cost Pro Forma	
Form types	Time spent in hours/minutes
Notice of Opposition	
Notice of Cancellation	2
Notice of Defence	2
Considering forms filed by the other party	2
TOTAL	
Official fees for the above forms	
TOTAL	£200.00
Preparing evidence/written submissions and considering and commenting on the other side's evidence/written submissions	
Description of activity	Time spent in hours/minutes
Preparing evidence of use, details of promotional activities; conducting research of the UKIPO Register; preparing Witness Statements and Exhibits; preparing submissions	5
Review of evidence filed by Gadget Clinic Repair Limited; review of 2 Witness Statements in the name of Marika Sarah Stanley and 27 Exhibits	5

64. The time spent by Party A appears reasonable; and Party B's evidence included substantial unnecessary material, which required consideration by Party A. Further, pursuant to section 1(1) of the Litigants in Person (Costs and Expenses) Act 1975 (as amended), a litigant in person is entitled to recover "... sums in respect of any work done, and any expenses and losses incurred, by the litigant in or in connection with the proceedings to which the order relates."

65. Taking an overall view, therefore, I consider that a total of 16 hours reasonably reflects the recoverable time spent on litigating the matter. The Civil Procedure Rules (CPR) provide that the amount which may be allowed to a litigant in person is set at the rate of £19 per hour (CPR, rule 46.5(4)(b) and Practice Direction 46, 3.4). This therefore amounts to £304, plus the official fee for filing the invalidation application (£200); thereby producing a total of **£504**.

66.I order Gadget Clinic Repair Ltd to pay Tal Marwood the sum of **£504**. This sum is to be paid within twenty-one (21) days of the expiry of the appeal period or within twenty-one (21) days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 23rd day of December 2021

**Denzil Johnson
For the Registrar,
the Comptroller-General**