

O/672/22

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 3298961
IN THE NAME OF SHENZHENSHI JIUMAO TECHNOLOGY CO., LTD.
IN RESPECT OF THE TRADE MARK**

YOSCO

IN CLASS 16

AND

**THE APPLICATION FOR INVALIDATION THEREOF UNDER NO. 504176
BY OSCO EUROPE LIMITED**

Background and pleadings

1. ShenZhenShi Jiumao Technology Co.,Ltd. (“the proprietor”) owns the registered trade mark number 3298961 for the mark YOSCO in the UK (“the contested mark”). The registration holds a filing date of 23 March 2018 and a registration date of 22 June 2018. It is registered in respect of the following goods:

Class 16: Pads [stationery]; Pamphlets; Writing or drawing books; Note books; Folders for papers; Envelopes [stationery]; Bookmarkers; Greeting cards; Files [office requisites]; Covers [stationery]; Pencil holders; Pen cases; School supplies [stationery]; Stands for pens and pencils; Writing cases [stationery].

2. OSCO Europe Limited (“the cancellation applicant”) filed an application to invalidate the above registration on the basis of the above registration under sections 47(2)(a) and 47(2)(b) whilst relying on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) on 27 September 2021.

3. The application for invalidation under 5(2)(b)

OSCO

Class 16: Office requisites (other than furniture); magazine storage files, trays for stationery use on desks to contain stationery, filing trays, pen pots, desk organisers, desk tidies, desk racks, desk trays, desk mats, phone holders, bookends, memo holders, mouse mats, paper sorters, index boxes, letter racks, filing boxes, portable filing cases and containers, storage boxes and containers (being office requisites).

Class 20: Magazine racks, magazine storage files, footrests, stools, steps, storage boxes and containers, hat stands and coat stands.

Class 21: Waste paper bins; storage boxes and containers.

4. By virtue of its earlier filing date of 10 October 2008, this mark constitutes an earlier mark under section 6 of the Act.

5. In respect of section 5(2)(b) of the Act, the cancellation applicant argues that the marks are highly similar and the respective goods are identical or similar, and that as such there exists a likelihood of confusion.

6. In respect of section 5(3) of the Act, the cancellation applicant submits that it holds a reputation under its mark in respect of all of the goods relied upon, and that the high similarity of the marks is likely to lead consumers into believing that there is an economic connection between the same. The cancellation applicant argues that the public would make a link between the marks and would be misled into believing the contested mark is a variation of the cancellation applicant's mark. In addition, the cancellation applicant argues the contested mark would call the earlier mark to mind, which in turn would incite interest in the proprietor's goods. The cancellation applicant argues the proprietor would gain an unfair advantage on this basis. Further, the cancellation applicant submits that as they would have no control over the use of the contested mark, there is the potential for the proprietor to offer goods of an inferior quality and for consumer dissatisfaction, both of which may be detrimental to the repute of the cancellation applicant's mark. In addition, the cancellation applicant submits the use contested mark will erode the distinctiveness of the earlier mark.

7. The opposition based on section 5(4)(a) of the Act is based on the sign OSCO, which the cancellation applicant claims has been used throughout the UK since 1 January 1998 in respect of the following goods:

Office requisites (other than furniture); magazine storage files, trays for stationery use on desks to contain stationery, filing trays, pen pots, desk organisers, desk tidies, desk racks, desk trays, desk mats, phone holders, bookends, memo holders, mouse mats, paper sorters, index boxes, letter racks, filing boxes, portable filing cases and containers, storage boxes and containers (being office requisites).

Magazine racks, magazine storage files, footrests, stools, steps, storage boxes and containers.

8. The cancellation applicant submits that it holds substantial goodwill in its business carried out under the sign OSCO, and that due to the similarity of this sign with the contested mark and bearing in mind the similarity and identity between the goods applied for and those for which the cancellation applicant holds goodwill, the contested mark is liable to misrepresent to consumers that the goods derive from the cancellation applicant. The cancellation applicant submits that such a misrepresentation would inevitably result in damage.

9. The proprietor filed a counterstatement denying the similarity between the marks and denying there exists a likelihood of confusion under section 5(2)(b). The proprietor submits that the cancellation applicant's claims under section 5(3) or 5(4)(a) of the Act are denied on the basis of the low similarity and the long-term coexistence of the two marks. The proprietor did not request that the cancellation applicant provide proof of use of the mark relied upon.

10. Only the cancellation applicant filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.

11. Both parties are represented in these proceedings. The proprietor is represented by Tony Chen. The cancellation applicant is represented by Haseltine Lake Kempner LLP. A hearing took place before me via video conference on 18 July 2022. Only the cancellation applicant opted to attend the hearing, and they were represented by Mr Martin Krause of Haseltine Lake Kempner LLP.

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

13. The cancellation applicant's evidence comprises a witness statement dated 28 February 2022. The witness statement is in the name of John Paul Massey, managing

director of the cancellation applicant since its incorporation in 1998. The statement introduces a total of 10 exhibits, namely JPM1 – JPM10.

14. In his witness statement, Mr Massey confirms the cancellation applicant developed a range of wooden stationery products in 2002, which were marketed under OSCO.¹ They were originally supplied to John Lewis' UK stores.² The product range developed over the next few years and included items made from bamboo, acrylic, faux leather, wiremesh, metal, cardboard, MDF and PVC.³ The mark OSCO has always featured on the products.⁴

15. Mr Massey states the 2017 range was very similar to the cancellation applicant's present range, but just differed in colour and material.⁵ Exhibit JMP2 provides a catalogue extract for its grey faux leather range dated 2021. This shows the mark in use in relation to a range of desk organisation products, such as desk trays, holders and organisers, baskets, files holders and boxes, in addition to desk and mouse mats and waste bins. Examples of packaging of the goods showing the mark is provided at Exhibit JMP3, and photos of the goods available in retail stores identified as John Lewis and Staples are provided at Exhibit JMP4. Mr Massey states the photos are from 2019 but that these are "...typical of how the products would have been displayed in the time leading up to 2018."⁶

16. Within his witness statement, Mr Massey explains:

¹ See paragraph 9 of the witness statement of Mr John Paul Massey

² As above

³ See paragraph 10 of the witness statement of Mr John Paul Massey

⁴ As above

⁵ See paragraph 11 of the witness statement of Mr John Paul Massey

⁶ See paragraph 16 of the witness statement of Mr John Paul Massey

18. If we look at 2017, which is just before ShenZhenShi Jiumao Technology Co.,Ltd. filed its UK application for YOSCO, the largest proportion of our sales was to our UK retailer base, principal of which were:

- Rymans
- CDS (Superstores International) Ltd T/A The Range
- SUK Retail Ltd T/A Office Outlet
- John Lewis Plc
- TJX UK T/A TK Maxx
- W H Smith

17. Mr Massey explains that sales to UK retailers accounted for just over 43% of the companies total turnover in 2017,⁷ and that 38.8% of its sales in the same year, which accounted for 95% of their online sales.⁸ The remaining sales were to large stationery wholesalers.⁹ Annual turnover for the last 7 years, which from the date of the statement in February 2022 I take to include 2015 to 2021 was between 2.5 and 3 million GBP per year.¹⁰ Mr Massey confirms that in 2017 turnover was £2.76 million.¹¹

18. Undated pages from UK websites shown to stock the goods are provided at Exhibit JPM5. These show goods including desk organisation products, waste paper bins and a mouse-mat available at online stores of retailers including John Lewis and Ryman (amongst others). Mr Massey states this is "...typical of the way in which the products have been displayed over the past 7 years".¹²

19. UK press articles all of which post-date the date the contested mark was filed are provided at Exhibit JPM7.

20. Exhibit JPM8 to JPM10 are filed for the purpose of showing that the goods offered by the cancellation applicant are classed as 'stationery' or 'stationery collections' by third party retailers, including John Lewis and WHSmith, or as examples of the products listed within the specifications offered by other parties.

⁷ See paragraph 19 of the witness statement of Mr John Paul Massey

⁸ See paragraph 20 of the witness statement of Mr John Paul Massey

⁹ See paragraph 21 of the witness statement of Mr John Paul Massey

¹⁰ See paragraph 22 of the witness statement of Mr John Paul Massey

¹¹ See paragraph 24 of the witness statement of Mr John Paul Massey

¹² See paragraph 28 of the witness statement of Mr John Paul Massey

21. Whilst I have not outlined all of the evidence provided in detail, this has all been carefully considered for the purpose of this decision.

Preliminary issues

22. Within its counterstatement, the proprietor submits the parties have been coexisting on the market in the United Kingdom since 2017. At the hearing, Mr Krause for the cancellation applicant submitted that these arguments should be disregarded on the basis that there is no evidence that that the coexistence has taken place. I agree with Mr Krause on this point and will not consider the proprietor's argument regarding coexistence on the market any further within this decision.

Proof of use

23. Whilst the earlier mark relied upon was over five years old both at the date the contested registration was filed and at the date of the application for invalidity, as I have outlined previously, the proprietor has not requested that the cancellation applicant provide proof of use of the mark relied upon, and as such the cancellation applicant may rely on all of the goods as set out in its pleadings.

Decision

Section 47

24. Section 47(2)(a) and 47(2)(b) read as follows:

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

25. Subsections 2A and 2G read as follows:

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

...

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

26. Subsection 2H provides:

(2H) The reasons referred to in subsection (2G) are—

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

27. Section 47(5) of the Act is as follows:

“47. — (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only”.

Section 5(2)(b)

28. Section 5(2)(b) of the Act has application in invalidation proceedings because of the provisions set out in section 47 above. Section 5(2)(b) of the Act is as follows:

“5(2) 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”.

The principles

29. The following principles are gleaned from the decisions of the EU courts 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:

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 goods

30. The cancellation applicant has set out in its pleadings that the goods are identical or similar. The proprietor has stated as follows:

5. Relating to the goods listed, on the premise of significantly different appearance and pronunciation of the marks, a certain number of similar goods make no major impact on the possibility of confusion.

31. There is no denial of similarity in respect of any of the goods registered by the proprietor, and instead its position focuses on the low level of similarity between the marks. I therefore accept, as Mr Krause for the cancellation applicant put forward at the hearing, that the applicant has in essence, conceded all of the contested goods are similar. However, as the cancellation applicant has not been specific about the level of similarity between the goods within its pleadings, it is open to me to determine the level of similarity I find between the same, with consideration to the principles set out in the relevant case law for assessing the similarity of goods, as below.

32. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

33. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

34. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that goods may be considered “complementary” where:

“...there is a close connection between them, 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”.

33. It is obvious that where two specifications contain identical terms, or different terms both with identical meanings, the goods should be considered identical. In addition, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

35. With these factors in mind, the goods for comparison are as follows:

Goods relied upon	Contested goods
Class 16: Office requisites (other than furniture); magazine storage files, trays for stationery use on desks to contain stationery, filing trays, pen pots, desk organisers, desk tidies, desk racks, desk trays, desk mats, phone holders, bookends, memo holders, mouse mats, paper sorters, index boxes, letter racks, filing boxes, portable filing cases and containers, storage boxes and containers (being office requisites).	Class 16: Pads [stationery]; Pamphlets; Writing or drawing books; Note books; Folders for papers; Envelopes [stationery]; Bookmarkers; Greeting cards; Files [office requisites]; Covers [stationery]; Pencil holders; Pen cases; School supplies [stationery]; Stands for pens and pencils; Writing cases [stationery].
Class 20: Magazine racks, magazine storage files, footrests, stools, steps, storage boxes and containers, hat stands and coat stands.	

Class 21: Waste paper bins; storage boxes and containers.	
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36. It is my view that the term *Office requisites (other than furniture)* covered by the cancellation applicant's mark will include all items that are essential or important for the general functioning of an office, other than the furniture. This will, in my view, encompass all of the proprietor's goods other than those outlined below. I therefore find all goods other than the following to be identical in line with the principles set out in *Meric*:

Pamphlets; Bookmarkers; Greeting cards; School supplies [stationery];

37. However, if I am wrong about the breadth of the term *Office requisites (other than furniture)*, it is my view the earlier goods including *pen pots* and *desk tidies* are clearly identical to the contested goods *Pencil holders* and *Stands for pens and pencils* within the earlier specification, either self-evidently or in line with the principles set out in *Meric*. In addition, it is my view that the contested *Pen Cases* and *Writing cases* are highly similar to the earlier *pen pots*. They are all receptacles for holding pens and will share an intended purpose in this respect. In addition, they will also share trade channels and users generally, are likely to be produced by the same entities, and will all be sold in general stationery stores or in the same sections of more general stores.

38. In addition, I find the earlier *filing boxes* and *portable filing cases* to be identical to the contested *Files [office requisites]* and to be similar to a high degree to *Folders for papers*. They will share the intended purpose of neatly storing papers, and be of a similar nature, both often being rectangular goods made from plastic or cardboard. The goods are also likely all to be sold in the same sections of stores, share users and share trade channels and producers.

39. I find the cancellation applicant's earlier goods *trays for stationery use on desks to contain stationery* will be complementary to the applicant's *Pads [stationery]; Writing or drawing books; Note books; Envelopes [stationery]; Covers [stationery] and School supplies [stationery]* on the basis these goods will all be important to the earlier goods,

and it is likely the consumer will believe the same provider will supply the same. I find they are all likely to be sold in the same stationery stores or the same sections of more general stores, and they are likely to share trade channels. The intended purpose and nature of the goods will differ, and they will not be in competition. Overall, I find these goods to be similar to a medium degree.

40. I consider that *Bookmarkers*; as covered by the contested mark will be for use with books, in addition to the bookends covered by the earlier specification. They may well therefore be sold in the same book related stores, although the purpose, one being for keeping books upright when being stored and one being for marking a position a reader has reached in a book are quite different. The goods will not be in competition or competitive, but they are likely to share users, those being primarily book readers. Considering all of the factors, I consider there will be only a very low degree of similarity between these goods.

41. It is my view that the contested *Pamphlets* and *Greeting cards* share little in common with the earlier goods. On the basis that I have accepted some similarity between all of the goods due to the proprietor's pleadings, I find these goods to be similar to the cancellation applicant's goods to a very low degree.

Comparison of marks


42. 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 proceed to 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 Court of Justice of the European Union 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.”

43. It would be wrong, therefore, to dissect the trade marks artificially, although 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.

44. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
	YOSCO

45. The earlier mark is the four-letter word OCSO. The overall impression of the mark is dominated by this. The mark is registered in simple block red which adds only marginally to its overall impression. The slight stylisation and shading used on the letters is minimal and it is likely to go unnoticed by the consumer. It is my view this is negligible in the overall impression of the earlier mark.

46. The contested mark is a plain word mark YOSCO. The overall impression resides in the mark as a whole.

Visual comparison

47. Visually, the marks coincide through the use of the letters ‘OSCO’. The contested mark is a word mark meaning it may be used in a range of standard colours and fonts, including a similar font and colour red to the contested mark, meaning little visual difference is created by this. The only significant point of visual difference is the additional letter ‘Y’ that features as the first letter of the contested mark. I note this letter is at the beginning of the mark where the consumer tends to pay more attention.¹³ Overall, I find the marks to be visually similar to between a medium and high degree.

¹³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Aural comparison

48. Aurally, it is my view that the earlier mark will ordinarily be pronounced in two syllables, broken down as 'OZ-COH'. I also consider the contested mark will be pronounced in two syllables as 'YOZ-COH'. Overall, I consider the use of the letter 'Y' at the beginning of the initial syllable of the contested mark makes only a small phonetic difference overall, and I find the marks to be aurally similar to a high degree.

Conceptual comparison

49. It is my view that neither mark will convey a conceptual meaning to the majority of UK consumers. I note that 'Osco-Umbrian' refers to a group of extinct languages in Italy,¹⁴ but I do not consider that this will be brought to the mind for more than a very small minority of UK consumers, and it is my view this minority will not form a significant portion of consumers. I therefore consider the conceptual comparison to be neutral.

Average consumer and the purchasing act

50. 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.

51. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that

¹⁴ <https://www.collinsdictionary.com/dictionary/english/osco-umbrian>

constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

52. The contested goods are primarily stationery items. The goods are generally all fairly low cost and may be purchased fairly frequently, both by the general public and by businesses.

53. It is my view the general public is unlikely to pay more than a low degree of attention to many of the items, such as pads, notebooks, envelopes, pamphlets and covers. These items are generally unlikely to receive a great deal of consideration other than perhaps to the size of the goods, and they are likely to be disposable or frequently replaced. Items such as folders and files are more likely to be reused and will receive more attention on the basis that the suitability for storing particular documents will be assessed. However, the category as a whole will still comprise relatively low cost and fairly frequently purchased items and on that basis will likely receive only a low to medium degree of attention from the general public. I consider that a medium degree may be paid to some of the more substantial items such as writing cases and pen cases which will be replaced less often and will receive additional consideration regarding the suitability for the consumer’s needs and the materials used, in addition to aesthetic considerations.

54. I find the business consumer is likely to pay between a below medium and slightly above medium degree of attention across the range of goods, with disposable and single use items such as envelopes receiving the lower level of attention, and the more substantial items such as writing cases receiving the higher level.

55. Goods such as greetings cards and bookmarkers will primarily be purchased by the general public and are likely be assessed for aesthetics and in the case of greetings cards, suitability for the occasion, but I note these are generally low cost, and in the case of greetings cards fairly disposable items, and I don’t consider the level of attention paid towards the categories as a whole to be any higher than below medium.

56. I consider that these goods will generally be purchased in retail or wholesale stores or the online equivalents, and the purchasing process will therefore be primarily visual.

However, I also note that aural assistance may be sought from retail staff, and in the case of business consumers, orders may be placed verbally over the telephone, and as such I cannot completely discount the aural considerations.

Distinctive character of the earlier trade mark

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

58. It is my view that the majority of consumers will consider the earlier mark to be an entirely made-up word. I consider the inherent distinctiveness of the mark is fairly high.

59. The cancellation applicant has filed evidence of its use of the earlier mark. I therefore consider if the distinctiveness of the earlier mark had been enhanced above its inherent level at the relevant date, that being the filing date of the contested mark on 23 March 2018. The highpoint of its evidence is the sales figures provided, which have been between 2.5 and 3 million GBP per year from 2015 onwards. I consider that the items are not particularly high cost and as such there will need to have been a higher volume of goods sold to reach these figures than if they were higher cost items. I also consider that the cancellation applicant's goods are said to have been sold in major retailers during this time. However, there is little information provided relating to the cancellation applicant's promotional activity and spend, although I note the reference at paragraph 31 of Mr Massey's statement to several thousand GBP being spent exhibiting at trade shows each year. In addition, whilst the turnover figures date back seven years, only three of these fall prior to the date the contested registration was filed. Considering the evidence as a whole, it is my view from the sum of the evidence that the use of the mark had not, at the relevant date, raised the distinctive character of the mark above its inherent level, which is already fairly high.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

60. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 29 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion, and that the likelihood of confusion may be increased where the distinctive character held by the earlier mark is high and may be less likely where it is low. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be increased through use, and that the distinctiveness of the common elements is

key.¹⁵ I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are selected will have a bearing on how likely the average consumer is to be confused.

61. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.¹⁶

62. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

63. I found the marks to be visually similar to between a medium and high degree, to be aurally similar to a high degree, and to be conceptually neutral. I found the applied for goods to include those to which the general public, who will form a portion of the relevant consumer, will pay only a low degree of attention, although I note the level of attention paid by the general public for some of the goods will be higher, sitting at a medium level. I consider that the inherent distinctiveness of the earlier mark sits at a high level by virtue of the word element OSCO. I found the goods to range from identical to similar to a very low degree. With consideration to all of the factors, and keeping in mind the consumers imperfect recollection, it is my view that there is a likelihood of direct confusion between the marks in respect of all goods for which there is at least a medium degree of similarity with the earlier goods. However, where the

¹⁵ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

¹⁶ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

degree of similarity between the goods is very low, such as in the case of *Pamphlets*, *Greeting cards* and *Bookmarkers* it is my view that there will be no likelihood of direct confusion.

64. In respect of indirect confusion, it is my view that where the differences between the marks are noticed, whilst the later mark may bring the earlier mark to mind, there is no reason for the consumer to believe they derive from the same economic undertaking. In this instance, I see no logical reason for the addition of a 'Y' before 'OSCO' to indicate a sub brand or brand extension. I therefore find no likelihood of indirect confusion between the marks.

65. The opposition based on section 5(2)(b) of the Act therefore succeeds in respect of all of the goods other than:

Pamphlets; Greeting cards; Bookmarkers

Section 5(3)

66. Section 5(3) of the Act 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”.

67. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *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 of 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*).

68. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements, the cumulation of which must satisfy all elements of the claim. To be successful on this ground, the cancellation applicant must prove it held a reputation under the earlier mark relied upon amongst a significant portion of the public at the relevant date. If it is shown that the earlier mark held a qualifying reputation at that date it must then be shown that the reputation, combined with the similarity between the marks will result in the relevant public establishing a link between the same. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all of these elements have been established, it

must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage.

69. In this instance, the cancellation applicant has pleaded that use of the contested mark will result in the proprietor gaining an unfair advantage, and that it will also result in detriment to the cancellation applicant's reputation under the mark, and an erosion of its distinctive character.

Relevant date

70. The relevant date at which the cancellation applicant must establish if it held a reputation is the date on which the contested registration was originally filed, that being 23 March 2018.

Reputation

71. In *General Motors*, Case C-375/97, 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."

72. Before I consider the reputation is held by the cancellation applicant, I consider firstly the cancellation applicant's pleadings and the comments made in response by the proprietor within its counterstatement.

73. The cancellation applicant has pleaded that its mark holds a reputation in respect of all of its goods relied upon. The proprietor has responded within its counterstatement as follows:

"8. Maybe it is a fact that the Earlier Trade Mark has acquired a reputation and goodwill in respect of its business since long-term use. As a 20-year-old enterprise, the cancellation application shall maintain the stability of the economic society and fair competition in this industry while managing their own industry well, but not monopolize and prevent other lawful and reasonable enterprises and brands from growth and development.

....

13. Due to the low degree of similarity and long-term coexistence of the two marks, the Applicant denies the Earlier Trade Mark's claims under Section 5(3) and 5(4)(a)."

73. At the hearing, the cancellation applicant stated that its claim to hold a reputation has not been denied by the proprietor, and that in the circumstances it should be accepted. I acknowledge that the proprietor has not offered a clear denial of the cancellation applicant's reputation, although it is also not an outright concession. I consider that the proprietor's comments are provided in the second version of its counterstatement. Following the first version received, the Tribunal wrote to the proprietor requesting amendments and providing the advice as follows:

The purpose of the counter statement is to admit (agree) or deny (disagree) with the opponents claims made in the Form TM7. In this case the opponent has made claims under section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994.

It is noted that you have addressed the opponents claims regarding the similarity of the marks and goods and services. However, you have not stated whether you agree or deny the opponents claims under s5(3) and s5(4)(a). Please review this and state if you admit or deny the opponents claims.

74. Considering the circumstances in which the statement was made by the proprietor within its counterstatement, it is my view that it can be taken from this statement that they do not deny that the cancellation applicant holds a reputation in the mark for the goods relied upon. I therefore accept there is a reputation held under the earlier mark for the goods relied upon, however, the strength of this reputation remains to be determined.

75. At the hearing, I noted to Mr Krause of Haseltine Lake Kempner LLP who was representing the cancellation applicant that if I were to accept the proprietor's statement as a concession, it would still be for me to determine the level at which the reputation is held. Mr Krause made submissions on what he viewed as the strong points of the evidence. During his submissions, Mr Krause highlighted Mr Massey's statement that "... the OSCO trade mark is now recognised as the leading brand in the UK for desktop storage solutions." Mr Krause submitted that this statement had not been challenged, and that it was part of a carefully prepared and measured witness statement, and as such it should be accepted. I noted within the hearing that whilst this statement had not been challenged, it was for me to determine how much weight to place on this statement made. Mr Krause submitted that the witness statement has been made by Mr Massey who is the managing director of the cancellation applicant and has been for many years, and that as such he is an expert in his market. He submitted that there was not reason to believe that it was not a true statement, and he reiterated that in the absence of a challenge and in the context of the witness statement, the statement should be accepted. Mr Krause stated that he believed it was Lord Justice Arnold that stated unless clearly wrong, a statement that has not been challenged should stand.

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

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

76. Whilst these comments are made in the context of proving use of the mark, I also find they apply here. It is plainly the case that in order to prove use or show a reputation

for a mark, the tribunal will rarely be satisfied purely on the basis of broad statements as to a brand's success, even when unchallenged and placed in a witness statement. Whilst I therefore do not doubt that Mr Massey's statement is honest, I am not satisfied that his statement that the OSCO trade mark is the leading UK brand for desktop storage solutions is sufficient on its own to warrant a finding that the level of reputation held by the cancellation applicant is very strong, nor do I consider to be a highpoint of the cancellation applicant's evidence. In any case, even if this statement is taken on face value, what qualifies a brand as 'leading' may vary dramatically depending on how this is measured, and the evidence does not show me how or why this is the case.

77. I will therefore consider what the evidence does show. In my view, the highpoints of the evidence as highlighted earlier in this decision include the referenced turnover figures of between 2.5-3 million GBP for approximately three years leading up to the relevant date. I also note Mr Massey's statement that goods under the mark were developed in 2002 and supplied to John Lewis to be sold via its UK stores. I consider the estimated sales figures of 10 million items sold to the UK market sold between 2004 – 2022 under the brand, although I consider a large portion of these sales will have been sold following the relevant date, with the cancellation applicant confirming 800,000 items were sold in 2020 alone. Only limited details of promotional spend have been provided, and the press provided relating to goods for sale under the mark post dates the relevant date. I have not been provided with details on the size of the market, but I consider this will be fairly large. It is my view that with consideration to the sum of the evidence and keeping in mind of the lack of denial of the reputation from the proprietor, the cancellation applicant holds a modest reputation for its goods relied upon.

Link

78. In order to establish whether the public will make the required mental 'link' between the marks, I must consider the position globally, taking into account all of the factors set out in *Intel*,¹⁷ including the similarity between the marks and the services, the degree of overlap of the relevant consumers and the distinctiveness of the earlier

¹⁷ *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU)

mark, and the strength of the reputation established by the cancellation applicant. I will also consider whether there is a likelihood of confusion between the marks.

The similarity of the marks

79. Earlier in this decision I found the marks to be visually similar to between a medium and high degree, aurally similar to a high degree and conceptually neutral.

The similarity of the services and the relevant public

80. I found the similarity of the goods to range from very low to identical. The relevant public will either be members of the general public, or in some instances, business users, and there will be a degree of overlap between the consumers on this basis.

The strength of the reputation

81. As identified above, I find the cancellation applicant to hold a modest reputation for its goods.

The degree of distinctive character held in the earlier mark

82. I found the level of inherent distinctive character held in the earlier mark to be fairly high. I did not find the inherent distinctive position to have been enhanced through use.

The likelihood of confusion between the marks

83. As set out earlier in my decision, I found a likelihood of confusion in respect of all goods other than in respect of *Pamphlets, Greeting cards and Bookmarkers*.

84. Having considered all of the factors above, it is my view that where there is a likelihood of confusion, the consumer will also make a link between the marks in respect of those goods.

85. Where there is no likelihood of confusion, with consideration to all of the factors, it is my view that considering the differences between the marks, the modest level of the cancellation applicant's reputation and the distance between its goods, the consumer is unlikely to make a link between the marks in respect of *Pamphlets,*

Greeting cards and *Bookmarkers*. However, if a link is made, it is my view it will be too fleeting for it to result in one of the pleaded types of damages to occur.

Damage

86. On the basis of the link made between the marks, it is clear the cancellation applicant's case based on section 5(3) of the Act will not take them further than the case based on section 5(2)(b). However, for completeness, I briefly assess whether the cancellation applicant's 5(3) claim would succeed in respect of the goods for which a link would be made. In respect of unfair advantage, the cancellation applicant has pleaded that the consumer would believe there would be an economic connection between the marks, and also that the calling to mind of the cancellation applicant's mark would result in an unfair advantage being gained by the proprietor as the mark will incite the consumers interest and gain undeserved exposure.

87. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

88. There is nothing in this case to indicate that the proprietor intended to unfairly benefit from the cancellation applicant's reputation. However, to the extent that the

cancellation applicant's mark holds a reputation, and there would be direct confusion between the marks, the proprietor will gain an unfair advantage through the additional misdirected familiarity and sales resulting from that reputation without paying financial compensation. This advantage would not exist if it were not for the reputation of the earlier mark. The opposition on section 5(3) of the Act therefore succeeds in respect of all goods other than *Pamphlets, Greeting cards and bookmarkers*.

Section 5(4)

89. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

90. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

91. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

The relevant date

92. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

93. In this case, there is no evidence that the contested mark is in use in the UK, and as such the relevant date for consideration for the establishment of goodwill is the date the registration was filed, that being 23 March 2018.

94. At the hearing, the cancellation applicant opted not to make substantial submissions on its 5(4)(a) ground, stating that providing its claim under section 5(2)(b) and 5(3) were successful, this would not take them any further. However, when questioned, Mr Krause stated that should the 5(2)(b) and 5(3) ground fail, this ground should still be addressed within my decision. I consider therefore this ground to the extent that the earlier grounds have failed, that is in respect of the goods *Pamphlets, Greeting cards* and *Bookmarkers* under the contested registration.

95. It is my view that the sum of the evidence, including the UK sales estimates for the years directly preceding the relevant date, in addition to the images of the goods in stores and catalogues combined with Mr Massey's statement that these images are "typical of how the products would have been displayed in the time leading up to 2018"¹⁸ shows it is highly likely the cancellation applicant held goodwill in its business respect of at least *trays for stationery use on desks to contain stationery, filing trays, pen pots, desk organisers, desk tidies, desk racks, desk trays, and filing boxes* at the relevant date. Images showing the sign relied upon indicate this sign would have been distinctive of the cancellation applicant's goodwill at this time. In addition, I note for the same reasons set out under section 5(3), the proprietor appears to have conceded to the cancellation applicant holding goodwill in respect of all of the goods relied upon.

96. I found under section 5(2)(b) of the Act based on the full list of the cancellation applicant's goods relied upon that there will be a likelihood of confusion in respect of all goods with the exception of *Pamphlets, Greeting cards* and *Bookmarkers*. Whilst the sign relied upon by the cancellation applicant under this ground is a word mark, this does little to alter the distinctive character of the mark relied upon under 5(2)(b), within which the dominant and distinctive element was OSCO. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ

¹⁸ See paragraph 16 of the witness statement of Mr Massey

considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

97. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

98. With consideration to the above, and whilst keeping in mind the slight differences in the sign relied upon under this ground, it is my view that the test for misrepresentation under section 5(4)(a) will not produce a different outcome to that found based upon its section 5(2)(b) ground. As this ground will not advance the cancellation applicant’s case any further, I dismiss it at this stage.

Final Remarks

99. The cancellation applicant has been mostly successful, and subject to any successful appeal the registration will be deemed to have never been registered in respect of the following goods:

Class 16: Pads [stationery]; Writing or drawing books; Note books; Folders for papers; Envelopes [stationery]; Files [office requisites]; Covers [stationery];

Pencil holders; Pen cases; School supplies [stationery]; Stands for pens and pencils; Writing cases [stationery].

100. Subject to any successful appeal the registration will remain registered in respect of the following goods:

Class 16: Pamphlets; Greeting cards; Bookmarkers.

COSTS

101. Whilst both parties have achieved a measure of success, the cancellation applicant's has been proportionately more successful than the proprietor, and is entitled to a contribution towards its costs. In the circumstances I award the cancellation applicant the sum of £1,485 as a contribution towards the cost of the proceedings, which incorporates a 10% reduction to account for the proprietor's partial success. The sum is calculated as follows:

Official fees	£200
Preparing a statement and considering the other side's statement	£250
Preparing evidence	£500
Preparing for and attending a hearing	£700
10% reduction for the proprietor's partial success	-£165
Total	£1,485

102. I therefore order ShenZhenShi Jiumao Technology Co.,Ltd. to pay OSCO Europe Limited the sum of £1,485. The above sum should be paid within twenty-one days of

the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 10th day of August 2022

Rosie Le Breton

For the Registrar