

O/990/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3646823

BY CASTLE INTERNATIONAL LTD

TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS:

CASTLE[®]
INTERNATIONAL

CASTLE[®]
INTERNATIONAL

CASTLE[®]
INTERNATIONAL

IN CLASSES 9, 35 AND 42

AND

AN OPPOSITION THERETO UNDER NUMBER 428519

BY CASTLES TECHNOLOGY CO. LTD.

BACKGROUND AND PLEADINGS

1. On 25 May 2021, Castle International Ltd (“the applicant”) applied to register as a series the trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 10 September 2021 and registration is sought for goods and services in classes 9, 35 and 42.¹

2. On 26 November 2021, Castles Technology Co. Ltd. (“the opponent”) opposed the application in respect of classes 9 and 35, based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UK trade mark (“UKTM”) number 910523223 (“the earlier mark”)² which has a filing date of 23 December 2011, a registration date of 6 July 2012 and is registered for goods in class 9 and services in class 35, all of which are relied upon for this opposition.³ A representation of the earlier mark is as follows:



3. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion on the basis that the marks are highly similar and the goods and services are identical or highly similar. In accordance with section 6A of the Act, the earlier mark is subject to proof of use; the opponent made a statement of use in relation to all the goods and services relied upon.

4. The applicant filed a defence and counterstatement denying the grounds of opposition and requesting that the opponent provide proof of use of all goods and services relied upon.

¹ The opposed classes are listed in the goods and services comparison; the remainder of the specification is listed in the Annex to this decision.

² On 1 January 2021 the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable trade marks for all right holders with an existing EU trade mark (“EUTM”). As a result of the opponent’s EUTM number 10523223 being registered before the end of the transition period, a comparable UKTM (the earlier mark) was created. Comparable trade marks are recorded on the UK trade marks register and retain their EU filing date. They are enforceable rights in the UK, consisting of the same sign, for the same goods or services.

³ The full specification is listed in the proof of use assessment.

5. The opponent is represented by Adamson Jones; the applicant is unrepresented. During the evidence rounds, the opponent filed evidence and the applicant filed written submissions under a witness statement. Neither party requested a hearing nor did they file submissions in lieu. The evidence and submissions will be summarised to the extent that it is considered necessary. This decision is taken following a careful perusal of the papers.

PRELIMINARY ISSUE

6. In its witness statement, the applicant refers to the trade marks register and the number of trade marks containing the word CASTLE. I bear in mind the comments of the General Court (“GC”) in *Zero Industry Srl v OHIM*, Case T-400/06:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

7. Accordingly, the state of the register is not evidence of how many of such trade marks are in fact used in the market, nor does it clarify whether consumers have or have not been confused by the presence of such marks.

EVIDENCE

8. The opponent filed evidence in the form of the witness statement of Justin Chen dated 9 May 2022 and its corresponding six exhibits. Mr Chen is Director of the opponent company, a position he has held since November 2017. I have considered the evidence and will refer to it, where necessary, during this decision.

DECISION

Relevance of EU law

9. 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. This is why this decision continues to make reference to the trade mark case law of EU courts.

Proof of use

10. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“6A (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

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

11. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7. (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union.”

12. Accordingly, for the purposes of assessing proof of use, the earlier mark will be treated as an EUTM for the part of the relevant period before IP completion day and, as such, use in the EU may be sufficient.

13. Section 100 of the Act is also relevant, which reads:

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

Relevant case law

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

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the

goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide;

and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

15. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander QC (as he then was) as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use. [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having

regard to the interests of the proprietor, the opponent and, it should be said, the public.”

And further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

16. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs QC (as he then was) 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."

17. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

18. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date of the application in issue, i.e. 26 May 2016 to 25 May 2021.

19. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the earlier mark, in the course of trade, sufficient to create or maintain a market for the goods and services at issue in the UK (or the EU, prior to IP completion day) during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown;
- ii) The nature of the use shown;
- iii) The goods and services for which use has been shown;
- iv) The nature of those goods and services and the market(s) for them; and
- v) The geographical extent of the use shown.

20. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole rather than whether each individual piece of evidence shows use by itself.⁴

21. The opponent claims to have used its earlier mark in relation to the following goods and services:

Class 9 Computers; Computer terminals; Computer software; Computer software and hardware; Computer software for facilitating and processing electronic payment transactions; Computer software for facilitating and processing electronic purchase and commercial transactions via a global computer information network; Radio transmitters and receivers payment card acceptance software; Credit card readers; Data processing equipment; Payment card terminals; Apparatus for reading credit, debit, smart and private label cards with modular communication facilities and a thermal or impact printer.

Class 35 Import-export agencies; Quoting agencies for variety of products of domestic and foreign businesses; Tender agencies for variety of products of domestic and foreign businesses in the field of computer hardware and software; Sales agencies for variety of products of domestic and foreign businesses in the field of computer hardware and software; Purchasing goods and services for other businesses; Outsourcing assistance for businesses.

22. Mr Chen gives evidence that the opponent was founded in 1993 in Taiwan and opened offices in Spain, Italy, Greece, France and the UK between 2014 and 2020.

23. Exhibit JC0000 contains two undated screenshots from what is said to be the opponent's website – www.castlestechemea.com. Part of the earlier mark is visible in the top, left-hand corner of each page, though a small part of it appears to have been cropped from the screenshot (see Figure 1, below). Under the tab 'Merchant Services' several services are listed and explained (see Figures 2-5).

⁴ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.



Figure 1



Help Desk

Castles Technology's in-house, multi lingual technical help desk is available 24/7, 365 days a year. Tailored contracts to meet the needs of your business. We will provide a first-class service to your merchants and to your operational and sales teams by ensuring that we understand your business and work in partnership with you to deliver service excellence at all times.

Figure 2



Logistics

Castles Technology's terminal storage, configuration, and despatch facility are securely controlled to meet PCI regulations. Each product is individually customised prior to shipping to merchant premises and is tracked through to receipt.

Figure 3



Repair and Refurbish

Our repair centre is located beside our UK head office in Salisbury and is managed and staffed by Castles employees. Our maintenance packages are designed to provide you with product replacement on a next day service, ensuring your merchant has the minimum interruption to business and there is no additional cost for swap out. Standard warranty repairs are also provided.

Figure 4



Project Management and Technical Support

The Castles technical support team will ensure any projects, new software rollouts or upgrade programmes are delivered in a professional manner and to agreed timescales and deliverables.

Figure 5

24. Twenty pages of brochures are shown in exhibit JC001 which, according to Mr Chen, show the product code of every product the opponent sells. Listed in the exhibit are 10 payment devices, named: Castles MP200/MP200L; Saturn 1000; Saturn 1000-E; Saturn 1000-E UPT; Saturn 1000F2; Saturn 1000KC; Saturn 1000-L; UPT1000F; UPT2000; and VEGA3000. There is no date visible on any page of the brochures and Mr Chen's witness statement does not explain when they were created or distributed. The earlier is mark visible in the top, left-hand corner of most pages of the brochures, though in a slightly different form to the mark as registered (see Figure 6).



Figure 6

25. A selection of invoices has been provided to demonstrate sales in the UK and the EU between 2018 and 2020.⁵ A large proportion of the invoices contain product descriptions that are not identifiable, including, for example, “V3C-I1-PCI...”,⁶ “V3 PORTATIL PCI 3.5...”,⁷ “10 LECTORES OP3000...”,⁸ and “V3M2-G1-PCI...”.⁹ As there has not been any attempt to explain what these products are or to translate the descriptions into English, I cannot presume that they are any one of the goods or services listed in the earlier mark’s registration. An even larger proportion of the invoices contain prices which have been entirely redacted and so, with no corroborating sales or turnover figures in the witness statement, it is difficult to be satisfied that such invoices provide sufficient evidence of use.

26. There are, however, some invoices which assist the opponent on the basis that (i) the product descriptions align with those shown in the brochure evidence and (ii) the prices are visible. I bear in mind that the brochure evidence, by itself, would not be sufficient to show use but that it does corroborate the invoice evidence and assists in my assessment of genuine use. By examining these invoices I am satisfied that there have been sales to Italy, Romania and Spain between 2018 and 2019 for products listed in the brochure evidence, all of which are payment card terminals. The invoices also show sales of power cords, power cables and adapters to the same countries in the relevant period. The earlier mark, in the form shown at Figure 6, above, is visible on almost all of the invoices and so I am satisfied that the sales of these goods were made under that mark.

⁵ Exhibits JC002, JC003, JC005 and JC006.

⁶ Page 1 of Exhibit JC002.

⁷ Page 16 of Exhibit JC002.

⁸ Page 23 of Exhibit JC002.

⁹ Page 8 of Exhibit JC006.

27. In relation to exhibit JC004, whilst the images contained therein are undated, Mr Chen's narrative evidence is that these were taken at a trade show in Milan, Italy on 8 November 2019 and I have no reason to dispute this. Again, this evidence, by itself, would not be sufficient to show use but it does support the other evidence in that payment card terminals bearing (a form of) the earlier mark were on the market during the relevant period.

28. I turn now to whether use of the mark shown at Figure 6 qualifies as use of the earlier mark as registered. In accordance with section 6A(4)(a) of the Act, use of the mark in a form differing in elements which do not alter the distinctive character of the registered mark will qualify as illustrating use of the mark. The differences between the earlier mark and the mark shown at Figure 6 are (i) the change of colour of the circular device in the figurative element from grey to red and (ii) the addition of the trade mark symbol (™). I bear in mind that where a mark contains words and figurative elements, the word element will usually be more distinctive and that changes in figurative elements are less likely to change the distinctive character of the mark.¹⁰ The trade mark symbol will simply be seen as an indication of such and has no bearing on the mark's distinctive character. Accordingly, I am satisfied that the mark shown at Figure 6 qualifies as use of the earlier mark.

29. Overall, there are clear deficiencies within the evidence; there are no sales or turnover figures, there are undated exhibits and a large proportion of the invoices either have the prices redacted or list unidentifiable goods. However, given that there are some helpful invoices, and taking the evidential picture as a whole, I am satisfied that the opponent has demonstrated use of the earlier mark in the EU during the relevant period. I remind myself that as the earlier mark is a comparable mark, use in the EU prior to IP completion day is sufficient.

30. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods and services relied upon. In *Euro Gida Sanayi*

¹⁰ *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22.

Ve Ticaret Limited v Gima (UK) Limited, BL O/345/10, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

31. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably

be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

The opponent's class 9 goods

32. From the evidence I have been provided with, the opponent has shown use of its trade mark in relation to the sale of *payment card terminals* which could reasonably include *credit card readers*. The opponent may rely on these terms from its specification for the purpose of these proceedings.

33. In relation to *computer hardware*, there is evidence of use in relation to power cords, power cables and electrical adapters. However, *computer hardware* is a very broad term and would include a wide range of other goods. As such, the opponent may rely on the terms *electric cables* and *electrical adapters* for the purpose of this opposition.

34. In my view, the opponent has not adequately demonstrated that it has used the earlier mark in relation to any of the remaining terms in class 9 of its specification and I will explain why. *Computers*; *computer terminals* and *data processing equipment* are broad terms that could encompass a vast range of other goods. By showing use only in relation to payment card terminals, I consider these terms too broad to accurately describe what the opponent has demonstrated use for.

35. *Computer software; computer software for facilitating and processing electronic payment transactions; computer software for facilitating and processing electronic purchase and commercial transactions via a global computer information network and radio transmitters and receivers payment card acceptance software* are all types of software. The opponent has not shown that it has used the earlier mark in relation to computer software. Whilst the specifications for the payment card terminals, shown in the brochure evidence, show that the products are pre-programmed with software, that is not sufficient, by itself, to demonstrate that the opponent has used the earlier mark to create or maintain a market for software; the software is simply built into the payment card terminals, as would be expected by the purchaser.

36. The payment card terminals provided by the opponent could reasonably be considered *apparatus for reading credit, debit, smart and private label cards with modular communication facilities and a thermal or impact printer* if the evidence supported this, but it does not. I understand this term in the opponent's specification to refer to card readers which have a printing function and can communicate with other devices. It is not clear from the evidence that the opponent's payment card terminals have these functions, particularly the in-built printer, and the opponent has not indicated to this information anywhere in its witness statement or exhibits.

The opponent's class 35 services

37. The only evidence going to services is exhibit JC000 – shown at Figures 2-5, above – and paragraph 9 of Mr Chen's witness statement, which reads:

"9. My company uses the mark of both UK trade mark registration No. UK00910523223 and EU trade mark registration No. 010523223 in connection with portable and fixed payment terminals, downloadable software for portable and fixed payment terminals, credit card readers and in connection with advertising, marketing and promotional services within the financial sector, software creation and maintenance of software for portable and fixed payment terminals and credit card readers. In addition, my company offers 24 hour a day 'help desk' support for customer, repair and refurbishment services,

customisation and project management services. Attached hereto and shown at Exhibit JC000 are screen grabs from my company's website which show the broad range of services offered."

38. The evidence in this regard is simply not sufficient for me to be satisfied that the earlier mark has been used in relation to the class 35 terms in the opponent's specification. Firstly, these pieces of evidence list services which are not actually included within the registered specification. Secondly, exhibit JC000 is undated and not explained as coming from a particular date within the witness statement and so I have no way of ascertaining if and when the opponent's website looked as it does in the evidence. And thirdly, I would expect there to be some corroborating evidence to support the narrative evidence and webpage evidence, which are wholly inconclusive. There is nothing in the evidence to suggest any customers have ever accessed these services or whether they are complimentary services or require payment. As the case law above indicates, the burden lies on the owner of the trade mark to prove use and the evidence provided must be sufficiently solid and specific. The evidence provided by the opponent to demonstrate use of its earlier mark in relation to the class 35 services in its specification is neither solid nor specific and I am not satisfied that it has demonstrated such use.

39. Taking all of this into account, I am satisfied that a fair specification for the earlier mark is:

Class 9 *Payment card terminals; credit card readers; electric cables; electrical adapters.*

Section 5(2)(b)

40. Section 5(2)(b) of the Act states 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.”

Relevant law

41. The following principles 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.

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 and services

42. In light of my findings above, the competing goods and services are shown below:

The opponent's specification (following proof of use)

Class 9 *Payment card terminals; credit card readers; electric cables; electrical adapters.*

The applicant's specification (as opposed)

Class 9: *Search marketing software; Software for designing online advertising on websites; Computer software for use in creating and designing websites; Website development software; Computer software for creating dynamic websites; Social software; Downloadable media; Recorded media; Media content; Media software; Photographic media [films, exposed].*

Class 35: *Marketing; Promotional marketing; Market research; Product marketing; Marketing information; Marketing research; Marketing advice; Marketing consultancy; Event marketing; Market research and marketing studies; Market research and market analysis; Market campaigns; Financial marketing; Direct marketing; Market surveys; Surveys (Market -); Online marketing; Marketing consulting; Database marketing; Market prospecting; Digital marketing; Marketing assistance; Marketing services; Referral marketing; Affiliate marketing; Internet marketing; Marketing studies; Advertising and marketing; Business marketing services; Marketing by telephone; Direct market advertising; Market research studies; Market research consultancy; Market study and analysis of market studies; Market information services relating to market statistics; Marketing management advice; Market survey analysis; Direct marketing services; Market analysis studies; Marketing consultation services; Marketing plan development; Conducting marketing studies; Market analysis reports; Market segmentation consultation; Marketing analysis services; Analysis of markets; Direct marketing consulting; Market assessment consultancy; Marketing agency services; Market reporting consultancy; Computerised market research; Conducting market surveys; Marketing research services; Market research services; Marketing advisory services; Market intelligence services; Business marketing consultancy; Advertising and marketing consultancy; Provision of marketing information; Investigations of marketing strategy; Search engine marketing services; Market research and analysis; Advertising and marketing services; Conducting of marketing studies; Estimations for marketing purposes; Marketing research or analysis; Preparation of marketing surveys; Computerized market research services; Market research data analysis; Analysis relating to marketing; Market analysis and research; Conducting of market research; Marketing research and analysis; Providing market intelligence services; Analysis of marketing trends; Business marketing consultation services; Providing market research statistics; Development of marketing concepts; Provision of marketing reports; Preparation of marketing plans; Consumer market information services; Business analysis of markets; Planning of marketing strategies;*

Market reports and studies; Business and market research; Market research for advertising; Providing business marketing information; Consultancy relating to marketing; Design of marketing surveys; Business marketing consulting services; Market research data collection services; Creative marketing plan development services; Personnel management of marketing personnel; Advertising, marketing and promotion services; Advertising, promotional and marketing services; Analysis of market research data; Collection of market research information; Advisory services relating to marketing; Marketing (Business advice relating to -); Preparation of reports for marketing; Provision of market research information; Planning services for marketing studies; Interviewing for qualitative market research; Analysis of market research statistics; Marketing, advertising and promotion services; Market analysis and research services; Providing marketing information via websites; Interviewing for market research purposes; Advice relating to marketing management; Interpretation of market research data; Advertising, marketing and promotional services; Website traffic optimization; Website traffic optimisation; Promoting the designs of others by means of providing online portfolios via a website; Providing business information via a website; Providing business information in the field of social media; Providing marketing consulting in the field of social media; Advertising and marketing services provided by means of social media; Media relations services; Media buying services; Arranging subscriptions to information media; Arranging subscriptions to media packages; Sales promotion using audiovisual media; Advertising services to promote public awareness of social issues; Subscription to an information media package; Promotional marketing services using audiovisual media; Organisation of promotions using audiovisual media; Rental of advertising time on communication media; Provision of advertising space on electronic media; Organisation of promotions using audio-visual media; Market research services relating to broadcast media; Provision of advertising space, time and media; Advertising via electronic media and specifically the internet.

43. The opponent made no submissions in relation to the comparison between the competing goods and services beyond its suggestion in its statement of grounds that they are identical or highly similar. I see no obvious similarity between the above-listed specifications.

44. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49. [...] I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be

considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

45. Since I have found no similarity between the competing goods and services, there can be no likelihood of confusion under section 5(2)(b).

CONCLUSION

46. The opposition has failed and the application may proceed to registration in full.

COSTS

47. The applicant has been successful and would ordinarily be entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited the applicant to indicate whether it wished to make a request for an award of costs and, if so, to complete a pro-forma including a breakdown of its actual costs. The applicant failed to return the pro-forma. As it incurred no official fees in the defence of its application, I make no award of costs in this matter.

Dated this 11th day of November 2022

E FISHER (née VENABLES)

For the Registrar

Annex

Class 42: *Website design; Website design services; Website design consultancy; Computer website design; Design of websites; Website design and development; Designing websites for advertising purposes; Design of homepages and websites; Hosting websites; Design and construction of homepages and websites; Design and development of homepages and websites; Creating websites; Design and development of software for website development; Design, creation, hosting and maintenance of websites for others; Website development services; Consultancy relating to the creation and design of websites; Maintenance of websites; Hosting of websites; Website hosting services; Hosting computer sites [websites]; Providing information in the field of architectural design via a website; Planning, design, development and maintenance of online websites for third parties; Website usability testing services; Website load testing services; Building and maintaining websites; Providing information in the field of interior design via a website; Website development for others; Updating websites for others; Creating and maintaining websites; Hosting of mobile websites; Designing; Creation and maintenance of websites; Consultancy relating to the creation and design of websites for e-commerce; Designing feasibility studies on designs; Visual design; Packaging design; Computer design; Design consultancy; Graphic designing; Hosting the websites of others; Provision of websites for others; Hosting memory space for websites; Hosting websites on the Internet; Rental of software for website development; Creating and designing website-based indexes of information for others [information technology services]; Packaging designs; Design planning; Technical design; Hosting an online website for creating and hosting micro websites for businesses; Design consultation; Brochure design; Database design; Product design; Design services; Software design; Graphic design; Creating and maintaining websites for others; Programming of software for website development; Rental of memory space for websites; Illustration services (design); Design services (Packaging -); Design of packaging; Computer design research; Designing computer codes; Design feasibility studies; Computer systems design; Software design (Computer -); Web site design; Design of artwork; Web portal design; Commercial art design; Design of signs; Research in the field of social media; Electronic storage of entertainment media content.*