

**O/0309/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 03704485 BY  
DAVID DANIEL  
TO REGISTER THE TRADE MARK:**

**SUNNY G**

**IN CLASS 9**

**AND**

**OPPOSITION THERETO  
UNDER NO. 432043  
BY  
SMA SOLAR TECHNOLOGY AG**

## BACKGROUND & PLEADINGS

1. David Daniel (“**the applicant**”), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 30 September 2021. It was accepted and published in the Trade Marks Journal on 24 December 2021 for the following goods and services:

**Class 9:** Extension leads; Extension leads [electric]; Electrical extension leads; Phone extension leads; Electric extension leads; Adaptors (Electric -); Plug adaptors; Electrical adaptors; Coaxial adaptors; Power adaptors; Electric adaptors; Audio adaptors; Extension cords; Extension cables; Alternating current adaptors; Electric current adaptors; Electrical power adaptors; Jump leads; Electrical travel adaptors; SCART leads; Test leads; Phone extension jacks; Electric extension cables; Sounding leads; Ignition leads; Battery leads; Electric leads; Multimeter leads; Electrical power extension cords; Cable jump leads; Test leads [Electrical]; Travel adaptors for electric plugs; Earth test leads [Electrical].

2. SMA Solar Technology AG (“**the opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opponent is the proprietor of the following mark:

<b>Trade Mark no.</b>	UK00908243222 ('222)
<b>Trade Mark</b>	SUNNY
<b>Goods &amp; Services Relied Upon</b>	Classes 6, 9, 35, 38 & 42
<b>Relevant Dates</b>	Filing date: 17 September 2019
	Date of entry in register: 26 January 2010

<b>Trade Mark no.</b>	UK00801371270 ('270)
<b>Trade Mark</b>	Sunny Highpower
<b>Goods</b>	Class 9
<b>Relevant Dates</b>	Filing date: 17 August 2017

	Date of entry in register: 21 March 2018
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<b>Trade Mark no.</b>	UK00801337314 ('314)
<b>Trade Mark</b>	Sunny Tripower Core
<b>Goods</b>	Class 9
<b>Relevant Dates</b>	Filing date: 18 January 2017
	Date of entry in register: 8 September 2017

3. The trade marks relied upon by the opponent are UK 'comparable' trade marks. The earlier marks '270 and '340 are based on the opponent's earlier International Registration which have designated the EU ("IR(EU)"), and the earlier mark '222 is based on an existing registered EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM and IR. As a result, the opponent's earlier marks were automatically converted into comparable UK trade marks. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.
4. For the purpose of this opposition, the opponent relies on its Class 9 goods of the earlier marks.
5. The opponent argues that there is a "likelihood of confusion between the two marks given their visual and phonetic similarities and the overlap in goods." Therefore, registration of the contested mark should be refused under Section 5(2)(b) of the Act.
6. The applicant filed a notice of defence and counterstatement denying the claims made in the following terms:

"Although the two brands, SUNNY and SUNNY G, are close in terms of sound, I appreciate that since I operate in the UK and want to use

this brand as a UK owner, and my opponent owns an internationally registered brand, our clientele is not the same, being different geographical areas.

Also, our products are not the same.

The opponent sells under this brand mainly accessories and components for solar panel systems (batteries, etc.), products that differ substantially from those sold by the undersigned, which sell small household electronics (chargers, extension cords, etc.).

Therefore, I do not believe that I am harming the owner of the SUNNY G brand in any way.”

The applicant requested that the opponent provides proof of use of its earlier mark relied upon.

7. Only the opponent filed evidence in these proceedings, which will not be summarised but will be referred to as and where appropriate during this decision.
8. Only the applicant filed written submissions in lieu of a hearing. No hearing was requested and so this decision is taken following a careful perusal of the papers.
9. In these proceedings, the opponent is represented by Nash Matthews LLP and the applicant is a litigant in person.
10. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## Relevant Date/Period

11. An “earlier trade mark” is defined in Section 6(1) of the Act:

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

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

[...]

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

12. As the earlier mark ‘222 relied upon had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies, which states:

“(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), (aa) 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.”

13. 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”.

14. In accordance with Section 6(1) of the Act, the opponent’s trade mark clearly qualifies as an earlier mark. The relevant period for proof of use of the opponent’s mark is **29 September 2016 to 30 September 2021**. In the present proceedings, the opponent relies on a UK comparable mark, and, thus, it is possible for the opponent to rely on evidence of use in the EU as

set out in Tribunal Practice Notice 2/2020.<sup>1</sup> In accordance with paragraph 7(3) of Part 1 of Schedule 2A of the Act, the assessment of use shall take into account any use of the corresponding EUTM prior to IP Completion Day, being 31 December 2020. Therefore, for the portion of the relevant five year period between **29 September 2016 and 31 December 2020**, evidence of use of the mark in the EU may be taken into account. For completeness, for the remaining period (1 January 2021 to 30 September 2021), it's only the UK use that counts.

15. The relevant date for the assessment of likelihood of confusion as per Section 5(2)(b) is the date on which the contested application was filed, namely **30 September 2021**.

## **EVIDENCE**

### **Opponent's Witness Statement**

16. Only the opponent filed evidence in these proceedings. It consists of a witness statement, dated 3 August 2022, of Steven Schöller the Head of Global Marketing of SMA Solar Technology AG, who has held this position since 2019, introducing 11 Exhibits. The main purpose of the evidence is to demonstrate that the earlier mark '222 has been genuinely used in for the relevant period.
17. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

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<sup>1</sup> See 'Tribunal Practice Notice (2/2020) End of Transition Period – impact on tribunal proceedings'.



## DECISION

### Proof of Use

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

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

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

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d)

the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

19. As the earlier mark is a comparable mark, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant. The court noted that:

“36.It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use. [...]

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark. [...]

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

20. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance

with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

21. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since *Leno* and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute

genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted Leno as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]- [40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of Leno persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multifactorial one which includes the geographical extent of the use."

22. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even

where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

23. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required 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/services and the market(s) for them
- v. The geographical extent of the use shown

24. The onus is on the proprietor of the earlier mark to show use. This is in accordance with Section 100 of the Act, which states:

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

25. Proven use of a mark which fails to establish that “the commercial exploitation of the marks is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

## Form of the Mark

26. In Case C-12/12 *Colloseum Holdings AG v Levi Strauss & Co.*, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.”

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the



purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)."

(Emphasis added)

27. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

28. Although the earlier mark “SUNNY” is registered as a single-word mark, predominantly the evidence shows that “SUNNY” is directly followed by another word, for example, SUNNY TRIPOWER, SUNNY BOY, SUNNY HIGHPOWER etc. In my view, the mark as registered, while fully incorporated in the composite word marks, retains its independent use as an indicator of origin, pertaining to the *Colloseum* principles. Consequently, I find that the form of use set out above may also be taken into account. If I am wrong, I do not consider that the use in these forms alters the distinctiveness of the registered mark, and these are variants upon which the opponent can rely, as per *Lactalis*.

## Genuine Use

29. As indicated in the case law cited above, use does not need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.
30. The witness statement of Steven Schöller provides a short description of the history of the opponent’s mark. Particularly, Mr Schöller mentions that:

“2. SMA was first established in Germany in 1981 to produce products for the energy sector with particular emphasis on the development of renewable energies. Since 1981 SMA has expanded to have sales and service subsidiaries in 20 countries, with a UK subsidiary incorporated in 2010. SMA designs, installs, services and manufactures products for the renewable energy sector, in addition providing software which allows users to design the configuration of their photovoltaic installations and to monitor energy production by their installations, see in particular the website of SMA's UK subsidiary [www.sma-uk.com](http://www.sma-uk.com). SMA is the world leading provider of products and services in the renewable energy sector. [...]

4. MA has a range of products available under a variety of marks based on the element 'SUNNY', for example the marks SUNNY, SUNNY CENTRAL, SUNNY TRIPOWER, SUNNY TRIPOWER CORE, SUNNY HIGHPOWER, SUNNY PORTAL. Use of the element SUNNY was first adopted in 1995 and since then SMA has adopted various SUNNY prefixed marks. This opposition against the mark SUNNY G as applied for by Mr Daniel has been filed on the basis of SMA's registered UK rights in the marks SUNNY, SUNNY HIGHPOWER, SUNNY TRIPOWER CORE.”

31. Mr Schöller also provides the opponent’s turnover under SUNNY prefixed marks in the UK:

	2017 (EUR)	2018 (EUR)	2019 (EUR)	2020 (EUR)	2021 (EUR)
UK turnover for all products incorporating the mark SUNNY	26092853	9474153	9935931	19488438	5158795
SUNNY CENTRAL	1397533	3133880	8877731	540506	2424350
SUNNY TRIPOWER	442314	778244	875902	1299683	1559073
SUNNY HIGHPOWER	0	122962	1220598	4035320	479369

Mr Schöller specifies that *“for 2018 SMA's UK turnover for all products incorporating the mark SUNNY was 9,474,153 EUR with this including sales of 3,133,880 EUR for products sold under SUNNY CENTRAL, 778,244 EUR for products sold under SUNNY TRIPOWER and 122,962 EUR for products sold under SUNNY HIGHPOWER.”*

32. In addition to the above figures, a selection of UK invoices between 2017 and 2021 illustrates sales of goods under the earlier mark in the UK.<sup>2</sup> Although I have considered all the invoices filed, I note that only some of them contain goods under the earlier mark. In particular, the following number of invoices per year include entries of products under the mark SUNNY: 4 from 2017, 4 from 2018, 3 from 2019, 3 from 2020, and 2 from 2021. The invoices were headed as being issued by the opponent and contained the description, quantity, and number of purchased items. All the invoices are UK sales and are addressed to various customers in the UK, including Kings Langley, Burton on Trent, Newquay, Bath, Somerset, Hereford and Worcester, Hampshire, Bolton, Newcastle-upon-Tyne, London, and Southampton. In addition, undated screenshots from distributors’ websites of the opponent are provided demonstrating goods under the registered mark and its forms.<sup>3</sup>

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<sup>2</sup> Exhibit SS1.

<sup>3</sup> Exhibits SS3-6.

33. Further to the above sales figures and invoices, the opponent exhibited evidence of advertising and marketing materials, including a product leaflet from November 2020<sup>4</sup>; a summary of a marketing report from 2020, which says that the advertising costs exceeded the amount of 6,000 EUR<sup>5</sup>; social media posts from the opponent and its distributors targeting the UK consumers<sup>6</sup>; and email newsletters<sup>7</sup>. I note that the evidence exhibited shows use of the mark with the forms that I have already identified in the previous section. Mr Schöller also states that “*SMA exhibit products at UK and International trade fairs and sponsor awards so as to raise the profile of SMA products, for example sponsoring the Solar & Storage Live 2021 awards.*” However, there is no indication of the level of awareness of the UK consumers of the said awards.
34. Although the evidence could have been better and more comprehensive in parts, an assessment of genuine use is a global assessment, which requires looking at the evidential picture as a whole and not whether each individual piece of evidence shows use by itself.<sup>8</sup> Even though the opponent did not provide any evidence as to the market share it possesses, I am satisfied that this evidence supports that the opponent has operated in a way aimed at real commercial exploitation and has done so for a number of years. Bearing in mind the evidential picture as a whole, I am satisfied that the evidence supports genuine use of the mark in the UK during the relevant period. As such, the opponent can rely upon the registered mark for the purposes of these proceedings.

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<sup>4</sup> Exhibit SS2.

<sup>5</sup> Exhibit SS9.

<sup>6</sup> Exhibit SS10.

<sup>7</sup> Exhibit SS11.

<sup>8</sup> See *New Yorker SHK Jeans GmbH & Co KG v OHIM, T-415/09*.

## Fair specification

35. I must now consider what a fair specification would be for the use shown.

36. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. 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.”

37. 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:

“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."

38. The goods at issue are in Class 9 for which the opponent made a statement of use. The applicant, in its counterstatement, asserts that "*the opponent sells under this brand mainly accessories and components for solar panel systems (batteries, etc.)*." However, the opponent has submitted that the earlier mark has been used in relation to all the goods relied upon in this opposition.
39. One of the areas in which the opponent's evidence could have been more helpful is to illustrate the link between what they have used the mark on and how that relates to the specification they have registered. This is

particularly so given the technical nature of the use in the case at hand.

The specification in Class 9 reads:

**Class 9:** Apparatus for conducting, switching, transforming, accumulating, regulating and/or controlling electricity; power supply and power transforming apparatus, comprising transformers, inverters, direct current converters, battery storage units and measuring and regulating devices therefor; computer software, namely software exclusively for analysis for solar current inverters; regulating, control and measuring apparatus and systems; optical display devices, in particular displays for inverters and photovoltaic installations; software for communication with inverters, in particular for reading and inputting data into an inverter; apparatus for the collating and transmission of data from energy technology apparatus, including photovoltaic installations and railway engineering installations; software, in particular for designing photovoltaic installations.

40. Some of the terms in Class 9 are far too broad to properly reflect the use shown and would not represent a fair description. From my perspective, the evidence only really shows use of the mark on goods that directly concern the operation of photovoltaic power goods. This is also evident from the witness statement where it is stated that the opponent “designs, installs, services and manufactures products for the renewable energy sector, in addition providing software which allows users to design the configuration of their photovoltaic installations and to monitor energy production by their installations [...]”. Consequently, I consider a fair specification to be:



**Class 9:** photovoltaic storage power inverters; photovoltaic management systems; photovoltaic generators, chargers, and batteries; computer software, namely software exclusively for analysis for solar current inverters; optical display devices, in particular displays for inverters and photovoltaic installations; software for communication with **photovoltaic** inverters, in particular for reading and inputting data into an inverter; software **for designing photovoltaic installations**.

### Section 5(2)(b)

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

“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”.

42. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of Goods**

43. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the CJEU stated that:

“23. 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 complementary.”

44. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

45. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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 für 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”.

46. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks)* (*IP TRANSLATOR*) [2012] ETMR

42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

47. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

48. Taking into account the fair specification as set out earlier in this decision, the competing goods to be compared are shown in the following table:

<b>Opponent’s Goods</b>	<b>Applicant’s Goods</b>
<p><b><u>Earlier Mark ‘222</u></b>  <b>Class 9:</b> photovoltaic storage power inverters; photovoltaic management systems; photovoltaic generators, chargers, and batteries; computer software, namely software exclusively for analysis for solar current inverters; optical display devices, in particular displays for inverters and photovoltaic installations; software for communication with photovoltaic inverters, in particular for reading and inputting data into an inverter; software for designing photovoltaic installations.</p>	<p><b>Class 9:</b> Extension leads; Extension leads [electric]; Electrical extension leads; Phone extension leads; Electric extension leads; Adaptors (Electric -); Plug adaptors; Electrical adaptors; Coaxial adaptors; Power adaptors; Electric adaptors; Audio adaptors; Extension cords; Extension cables; Alternating current adaptors; Electric current adaptors; Electrical power adaptors; Jump leads; Electrical</p>

<p><b>Earlier Marks '270 &amp; '314</b>  <b>Class 9:</b> Apparatus for conducting, switching, transforming, storing, regulating and controlling electricity; devices and instruments for measuring and analysing electricity; software; electric display panels; data processing apparatus.</p>	<p>travel adaptors; SCART leads; Test leads; Phone extension jacks; Electric extension cables; Sounding leads; Ignition leads; Battery leads; Electric leads; Multimeter leads; Electrical power extension cords; Cable jump leads; Test leads [Electrical]; Travel adaptors for electric plugs; Earth test leads [Electrical].</p>
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49. In its statement of grounds, the opponent put forward the same claim for all three earlier marks in the following terms:

“The goods covered by the Applicant in Class 9 relate to various types of electrical apparatus, including alternating current adaptors, power adaptors, electric leads, battery leads and extension cables. The goods covered by the Applicant are encompassed by the goods in class 9 of the Opponent's prior registration and so the Applicant covers identical goods to those covered by the Opponent in Class 9.

Current adaptors, power lead, electric leads, extension cables and the like all form part of or are used with the goods covered by the Opponent. A consumer seeing the mark SUNNY G on electrical apparatus as covered by the Applicant would assume there was a connection with the goods under the [earlier] mark[s] [...] as covered by the Opponent in class 9 such as electrical apparatus, inverters, battery storage units.”

50. In his notice of defence, the applicant claimed that the competing goods are not the same.

51. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are

sufficiently comparable to be assessed in essentially the same way for the same reasons.<sup>9</sup>

### **Preferred Approach**

52. I will start my assessment by considering first the contested specification against the earlier marks '270 and '314 specifications. This is because the earlier specification of '222 has been subject to a fair specification narrowing the scope of the earlier goods.

### **Earlier Specifications '270 and '314**

Extension leads; Extension leads [electric]; Electrical extension leads; Phone extension leads; Electric extension leads; Extension cords; Extension cables; Electric extension cables; Electrical power extension cords; Electric leads; Multimeter leads

53. The contested goods are electrical power cables that are used for extending electrical power typically providing a set of socket outlets. The closest comparable term from the opponent's specifications is "*Apparatus for conducting, switching, transforming, storing, regulating and controlling electricity*". I consider the earlier term to be broad thereby encompassing the contested goods. Thus, I find the competing goods to be identical as per *Meric*.

Ignition leads; Battery leads; Cable jump leads; Jump leads

54. It is my view that the contested goods are intended to be used to start a vehicle with a flat battery. Again, in this case I consider that the opponent's term "*Apparatus for conducting, switching, transforming, storing, regulating and controlling electricity*" will cover the contested goods. I find that they are *Meric* identical.

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<sup>9</sup> *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Adaptors (Electric -); Plug adaptors; Electrical adaptors; Coaxial adaptors; Power adaptors; Electric adaptors; Alternating current adaptors; Electric current adaptors; Electrical power adaptors; Electrical travel adaptors; Travel adaptors for electric plugs

55. I consider that the applicant's above goods would fall within the broader category of "Apparatus for conducting, switching, transforming, storing, regulating and controlling electricity" in the opponent's specification. I consider them identical on the principle outlined in *Meric*.

Test leads [Electrical]; Earth test leads [Electrical]; Test leads

56. The contested goods are used for electrical testing procedures. The closest comparable term from the earlier specifications is "Apparatus for conducting, switching, transforming, storing, regulating and controlling electricity". The goods may overlap in nature but not in purpose, as the contested goods are intended for testing. However, I consider that the competing goods may share the same channels of trade sold in the same shops, potentially in close proximity to each other. To that extent, they may overlap in users. I do not consider that the goods will be in competition or complementary. I find them to be similar to a low to medium degree.

Sounding leads; SCART leads; Phone extension jacks; Audio adaptors

57. In relation to the remaining contested goods and the opponent's, they are different in method of use and purpose, although they target the public at large. However, the respective goods may potentially overlap in nature and trade channels as the contested goods may be sold in the same stores as the opponent's. Consequently, I find that the services at issue are similar to no more than a low degree.



## **Earlier Specification '222**

58. Following the fair specification, the earlier specification '222 contains largely photovoltaic inverters, software, and devices designed for photovoltaic systems. In this respect, it is my view that there is no obvious similarity between the competing specifications. Their nature, purpose, users and method of use are different. They may neither coincide with their producer/provider nor share the same distribution channels. Further, these goods are not complementary or in competition. Thus, I find them to be dissimilar.
59. The likelihood of confusion does not arise in relation to the application's goods which are dissimilar to the goods of the earlier mark '222. Thus, likelihood of confusion does not arise in such a case.<sup>10</sup> **The opposition cannot succeed against dissimilar goods and, therefore, is dismissed in relation to the earlier mark '222.**

## **Average Consumer and the Purchasing Act**

60. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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

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<sup>10</sup> See Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

test is to be applied objectively by the court from the point of view of that constructed person. The word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

61. The average consumer of the goods at issue will be a member of the general public without excluding professionals/businesses. Such goods can be selected from stores, including specialist ones, brochures and catalogues, and online. In retail premises, the goods will be displayed on shelves, where they will be viewed and self-selected by consumers. Although I consider this purchasing act to be primarily visual, aural considerations will not be ignored in the assessment. The cost of the goods may vary from low to medium value, and the average consumer is likely to consider compatibility and other factors, for example, the material of the product, examining the products to ensure that they are fit for purpose. As a result, the degree of attention will range from relatively medium to above medium, with professionals and businesses potentially paying slightly a higher degree of attention.

### **Comparison of Trade Marks**

62. 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

to the circumstances of the case, to assess the likelihood of confusion.”

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

64. The marks to be compared are:

<b>Earlier Marks</b>	<b>Contested Mark</b>
<u>Earlier Mark '270</u> Sunny Highpower  <u>Earlier Mark '314</u> Sunny Tripower Core	SUNNY G

Overall Impression

65. The earlier word marks '270 and '314 consist of the words “Sunny Highpower” and “Sunny Tripower Core”, respectively, presented in a standard font and typeface. Registration of a word mark protects the word itself. I note the conjunction of the word elements “Highpower” and “Tripower”, consisting of ordinary words that the consumers will readily understand. I also note that the word “Sunny” in the earlier marks will be more dominant, as the rest of the word elements will be considered to be highly allusive to the registered goods, as shown below in this decision. That said, the overall impression of the marks lies in the words themselves.

66. The contested mark is the word mark “SUNNY G” in upper case and standard type face. Registration of a word mark protects the word itself.<sup>11</sup> The overall impression of the mark lies in the words themselves.

### Visual Comparison

#### *Earlier word mark ‘270 and contested mark*

67. Visually, the earlier mark consists of two words, namely “Sunny Highpower”, whereas the contested mark consists of “SUNNY” and the letter “G”. I bear in mind that the beginnings of words tend to have more impact than the ends.<sup>12</sup> In particular, I note that both marks share the same first word element “SUNNY”. However, the marks differ in the second word element. In particular, the word “Highpower” is nine letters long as opposed to the single letter “G” in the opponent’s mark. Thus, weighing the various points of similarity and difference, I consider that the marks are visually similar to a medium degree.

#### *Earlier word mark ‘314 and contested mark*

68. The earlier mark is three words as opposed to the earlier mark, which is two. Again, the marks in this instance share the common word element “SUNNY” appearing at the beginning. Nevertheless, they differ in the rest of the word elements, where the words “Tripower Core” in the earlier mark are twelve letters long against the single letter “G” in the contested mark. Considering all the factors, including the overall impression, I find that the degree of visual similarity falls somewhere between low and medium.

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<sup>11</sup> See *LA Superquímica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

<sup>12</sup> See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

## Aural Comparison

### *Earlier word mark '270 and contested mark*

69. The earlier mark will be verbalised as “SUN-NY HIGH-POW-ER” and the applicant’s as “SUN-NY-G”. The earlier mark is five syllables long, and the contested mark is three, from which they share the first two syllables. However, there is no phonetic counterpart for the word element “HIGH-POW-ER” in the applicant’s mark. I find that the degree of aural similarity falls somewhere between low and medium.

### *Earlier word mark '314 and contested mark*

70. In this instance, the competing marks will aurally share the same first word element, “SUN-NY”. However, the marks will differ in articulating the rest of the word elements “TRI-POW-ER CORE” and “G”. I find that the degree of aural similarity falls between low and medium.

## Conceptual Comparison

71. The competing marks share the common word “SUNNY”, which will be immediately grasped by the UK average consumer and be understood to mean bright sunshine. However, there are points of conceptual difference in the marks. More specifically, in terms of the earlier marks '270 and '314, the words “Highpower” and “Tripower Core”, respectively, will be seen as allusive to the performance or characteristics of the Class 9 goods; for example, goods that provide powerful performance or maximum power. Despite the allusiveness of these elements in the earlier marks, they still contribute towards the overall impression of the marks and cannot be disregarded completely. I also note that there are no such conceptual counterparts in the applicant’s mark. In addition, the letter “G” in the contested mark will be understood as such with no further concept attributed to it. When the competing marks are viewed as a whole, I do not consider that the combination of the words will give rise to a unified meaning that will hang together. Taking all the above factors into account

and the overall impression of the marks, I find that the marks are conceptually similar to between a low and medium degree.

### **Distinctive Character of the Earlier Trade Marks**

72. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

73. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

74. As outlined in the previous section, the opponent's word marks "Sunny Highpower" and "Sunny Tripower Core" will contain the common and dictionary word "Sunny", which is not allusive or descriptive of the goods. In contrast, the rest of the word elements are allusive to the performance or characteristics of the goods. Thus, in my view, the distinctive character of the mark lies predominantly in the word element "Sunny", which is the only common element with the contested mark,<sup>13</sup> being distinctive to a medium degree. I find that the earlier marks as a whole have, at best, a medium degree of inherent distinctive character.

#### Enhanced Distinctiveness

75. I should stress here that, whilst the marks '270 and '314 are comparable marks, it is the position in the UK that must be considered because the question is whether the average consumer in the UK will be confused. I find the evidence insufficient to demonstrate that the marks have acquired an enhanced degree of distinctive character through use in the UK for the given goods that the opponent has genuinely used the marks. The sales, which have been evidenced, do not strike me as particularly significant in what must be a niche market in the UK. Although turnover figures and invoices are provided, they are not broken down or explained as relating to any particular goods, and there is no indication of the market share held by the marks. Also, despite the opponent's promotional activities, including the social media posts and email newsletters as exhibited in the evidence, no evidence of promotional material indicates any extensive media coverage nor intensive advertising or promotional activities in the UK. I do not consider that the use shown establishes enhanced distinctiveness for the average consumer as a whole or even for a significant enough subset of average consumers. Overall, the evidence is insufficient to demonstrate enhanced distinctiveness.

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<sup>13</sup> *Kurt Geiger v A-List Corporate Limited*, BL O/075/13.

## Likelihood of Confusion

76. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.<sup>14</sup> It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.<sup>15</sup>
77. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
78. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis K.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark,

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<sup>14</sup> See *Canon Kabushiki Kaisha*, paragraph 17.

<sup>15</sup> See *Lloyd Schuhfabrik Meyer*, paragraph 27.



which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example).”

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>16</sup>

79. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, on the court’s earlier judgment in *Medion v Thomson*. He stated:

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<sup>16</sup> See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

80. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis K.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. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

81. Earlier in this decision I have concluded that:

- the competing goods at issue range from identical to similar to a low degree;
- the average consumer of the Class 9 goods will be a member of the general public without excluding professionals/businesses. The selection process is predominantly visual without discounting aural considerations. Depending on the cost of the item, the degree of attention will range from relatively medium to above medium, with professionals and businesses potentially paying slightly a higher degree of attention;
- the earlier mark ‘270 and the contested are visually similar to a medium degree, and aurally and conceptually similar to between a low and medium degree;
- the earlier mark ‘314 and the contested are visually, aurally and conceptually similar to between a low and medium degree;

- the earlier marks have at best a medium degree of inherent distinctive character, but the use is not sufficient to establish enhanced distinctiveness of the marks.

82. Taking into account the above factors and considering the identical goods in play, there is no likelihood of direct confusion. Notwithstanding the principle of imperfect recollection, I find that when the marks are considered as a whole, the average consumer would recall the presence/absence of the words “Highpower”, “Tripower Core”, and “G” in the competing marks. Given that direct confusion involves no process of reasoning, and the additional word elements in the marks are not negligible so as to go unnoticed, the average consumer will not mistake the applicant’s mark for the opponent’s.

83. Turning to indirect confusion, the average consumer will identify the differences in the marks emanating from the words “Highpower”, “Tripower Core”, and “G”, but they will assume that the respective marks originate from the same or economically linked undertakings. This is because the average consumer will likely attribute trade mark significance to the commonly shared word element “SUNNY”, playing an independent distinctive role within the marks, and treat it as the ‘house’ brand. As delineated above, it is my view that the word elements in the earlier marks do not hang together. Thus, when encountering the earlier marks, the average consumer will consider that the word elements “Highpower” and “Tripower Core” will be allusive to the performance of the goods rendering them as sub-brands or logical brand extensions. In this case, the common word element “SUNNY”, particularly considering its position at the beginning of the marks, creates the conceptual hook between the competing marks that will lead the consumers to perceive the single letter “G” in the contested mark as a brand extension or variation of the earlier mark, or vice versa. Consequently, I find there to be a likelihood of indirect confusion between the marks where the average consumer would assume a commercial association between the parties. This finding extends to the goods for which I found any degree of similarity.

## **OUTCOME**

84. The opposition under Section 5(2)(b) of the Act is **successful in its entirety**. Therefore, subject to appeal, the application will be refused.

## **COSTS**

85. The opponent has been successful and is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs as follows:

Official opposition fee	<b>£100</b>
Preparing a statement and considering the counterstatement	<b>£250</b>
Preparing and filing evidence	<b>£600</b>
Total	<b>£950</b>

86. I, therefore, order, David Daniel to pay SMA Solar Technology AG the sum of £950. 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 27<sup>th</sup> day of March 2023**

**Dr Stylianos Alexandridis  
For the Registrar,  
The Comptroller General**