**BL O/0304/24**

**IN THE MATTER OF**
**THE TRADE MARKS ACT 1994 (THE "ACT")**

**AND IN THE MATTER OF UK TRADE MARK REGISTRATION**
**NO. 915250707 FOR SOLO (DEVICE)**
**IN THE NAME OF KEVIN LEE**

**-AND-**

**AND IN THE MATTER OF CANCELLATION APPLICATION**
**NO. 504105 THERETO BY ONE-LUX LIMITED**

**AND IN THE MATTER OF AN APPEAL FROM THE DECISION**
**OF MS TERESA PERKS DATED 31 MARCH 2023**

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**DECISION**

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1. This is an appeal from the decision of Teresa Perks (the "Hearing Officer"), BL O/0323/23, dated 31 March 2023, in which she rejected an application to invalidate trade mark No. 915250707 in the name of Kevin Lee ("the Proprietor"). The applicant for the declaration of invalidity was One-Lux Ltd ("the Applicant") which now appeals.

**Background**

2. The contested trade mark ("the Mark") was filed on 21 March 2016. It consists of the following logo:

3. The Mark was a comparable mark deriving from an EUTM and it was registered in the UK on 2 August 2018 for goods in Class 11:

> LED light bulbs; LED lighting installations; Light-emitting diodes [LED] lighting apparatus; Lighting; Lighting lamps; Lighting units; Electric lighting; Lighting fittings; Lighting installations; Lighting fixtures; Electrical lighting fixtures; Bulbs for lighting; LED lighting installations; Electrical lamps for indoor lighting; Lighting fixtures for household use.

4. On 2 September 2021 the Applicant applied for a declaration of invalidity of the Mark on the basis of s 47 and s 5(4)(a) of the 1994 Act, relying on its earlier unregistered rights in two signs: SOLO and ONE-LED SOLO. It claimed in the TM26(I) to have used both signs since 2014 in relation to "Light-emitting diode (LED) lamps and driver kits."

5. Only the Applicant filed evidence, in which its Managing Director, Ms Glynnis Murray, described the goods in relation to which the earlier signs had been used as "a light emitting diode (LED) lamp and driver kit, used primarily for emergency lighting."

6. Both parties filed written submissions. No hearing was requested.

7. The Hearing Officer found that the Applicant lacked goodwill in the SOLO sign at the relevant date, but had a small but not trivial goodwill in ONE-LED SOLO, sufficient to sustain a claim for passing off at the relevant date. Nevertheless, she found that use of the Mark would not give rise to a misrepresentation and there would have been no passing off at the relevant date. The application therefore failed.

8. The Applicant appealed against the Hearing Officer's Decision on the basis set out in a Notice and Grounds of Appeal filed under s.76 of the 1994 Act on 2 May 2023.

9. The Proprietor then filed a document which it called a Respondent's Notice, which included an application for security for the costs of the appeal. The Notice did not raise any different or additional reasons to maintain the Decision, and so was not a Respondent's Notice within the meaning of the Rules. I need not consider it further.

**Security for costs**

10. The application for security for costs was based on what the Proprietor said was a previous example of the Applicant failing to pay a costs award. That was an award of costs made by the EUIPO Board of Appeal in previous proceedings between the parties. The failure to make that payment was raised before the UKIPO whereupon the Applicant paid the outstanding costs. The same point was raised at the CMC below, when security for costs was sought, and refused on the basis that the payment had been made and the Applicant had explained the reason for late payment.

11. I was supplied with a copy of the decision following the CMC on 16 December 2021, in which the Hearing Officer said inter alia

> "In regard to the request for security for costs, to my mind, Mr Povid has provided mitigating circumstances for the late payment of the EU award of costs which appears to have been due to a failure on the part of the representatives and not the Applicant."

12. The Hearing Officer in the decision under appeal also explained the position:

> "6. In tandem with his defence, the proprietor made an application for summary judgement and security for costs, on the basis that the applicant had already failed twice (in first instance and on appeal) in parallel proceedings instigated against the EUTM registration from which the contested mark is cloned, based on the same evidence and substantially the same cause of action (alleged common law rights under the equivalent provisions of the European Union Trade Mark Regulation) and failed to pay the cost order arising from those proceedings… In a preliminary view issued on 8 November 2021, the Tribunal refused the proprietor's request for summary judgement, which was subsequently re-examined, together with the request for security for costs, at a Case Management Conference ("CMC") by a Hearing Officer who, on 16 December 2021, dismissed both requests, noting, *inter alia*, that the pending EU cost award had been paid a week before the CMC took place."

13. I indicated to the parties that I would refuse the application for security for costs and would give my reasons for doing so in this judgment.

14. The circumstances in which security for costs may be awarded in Registry proceedings and on appeal to the Appointed Person were considered quite recently by Mr Geoffrey Hobbs KC in *MATCHU MEETCHU trade mark* BL O/0266/23. He said:

> "5. The Registrar acting at first instance "*may require any person who is a party in any proceedings under the Act or these Rules to give security for costs in relation to those* proceedings*; and may also require security for the costs of any appeal from the registrar's decision*": r.68(1) of the 2008 Rules. In r.73(4) it is specified that r.68 "*shall apply to the person appointed and to proceedings before the person appointed as it applies to the registrar and to proceedings before the registrar*". The Appointed Person may accordingly require security for costs to be provided by "*any person who is a party in any proceedings*" pending on appeal before him or her under s.76 of the Act.
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> 6. In the exercise of the discretionary power conferred by rr. 68(1) and 73(4), a trade mark applicant can be required to provide security for the costs of an opposition to his application for registration : *JINI Trade Mark* BL O/585/01 (28 December 2001) at paras [8] to [12]; *Puma SE v Lagoniassa Ltd* BL O/084/20 (11 February 2020) paras [24] to [28]. Security can be required for costs already incurred in connection with the proceedings at first instance as well as for those to be incurred in connection with the proceedings on appeal: *DOUGLAS OF DRUMLANRIG Trade Mark* BL O/380/20 (20 July 2020) at para. [20] (referring to *Great Future International Ltd v Sealand Housing Corp* [2003] EWCA Civ 682; see also *Golubovich v Golubovich* [2011] EWCA Civ 528 at paras [6] to [8] per Wilson LJ)."

15. The Proprietor relied upon paragraph 5.7 of the Manual, which provides

> "In proceedings before the Tribunal [security for costs] is usually requested where a party does not carry on business in the United Kingdom or does not appear to have any, or sufficient, assets in the United Kingdom to cover any award of costs made against them, or has not paid previous costs ordered by the Tribunal, EUIPO or a Court. … A failure to pay previous costs awards will usually be accepted as good evidence of a difficulty in recovering costs."

16. The current application was made on what appear to be identical grounds to those raised at the CMC before the UKIPO in this case. There was no suggestion that the Applicant

would not be able to pay any costs awarded against it, but the Proprietor said that the explanation offered for the previous late payment "strains all credulity."

17. Following my directions, the Applicant filed submissions in response saying:

> "5) The Appellant's representative accepts that the costs awarded by the EUIPO and Appeal Board of the EUIPO were not paid in time. The Attorney dealing with these UKIPO cancellation proceedings was not aware of the background to those EUIPO proceedings and so cannot comment on them. The Attorney does however acknowledge that once non-payment had come to his knowledge, he informed the Applicant/Appellant of this fact who paid the costs awarded by the EUIPO and Appeal Board.
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> (6) The Appellant's representative re-asserts that the Proprietor/Respondent's request for payment had been overlooked at the time and once the Proprietor/Respondent's request had been reported to the Applicant/Appellant by their representative, they paid the amount in full. This was accepted by the Tribunal's decision issued on 16 December 2021 following the Case Management Conference on 12 December 2021."

The Proprietor did not make any further substantive response.

18. As a general rule, an Order for security for costs may be appropriate where, for a variety of reasons, it can be said that there is a reasonable apprehension that an order for costs will not be satisfied. Non-payment of an earlier costs award is but one way of demonstrating that there may be such a risk. In my judgment, this was not a case in which it would have been appropriate to order security for the costs of the appeal on the basis of non-payment of an earlier costs award. The costs previously awarded by EUIPO had been paid, and an adequate explanation had been offered for the fact that payment was late. There was no continuing basis for concern that any costs of the appeal would not be paid, and no more reason to order security for the appeal than there was at first instance. I declined to do so on the same basis as the Hearing Officer did at the CMC.

**The Grounds of Appeal**

19. The Grounds of Appeal were lengthy. The Applicant's counsel's skeleton argument for the appeal said that the document disclosed 3 core grounds of appeal:

**Ground 1:** the Hearing Officer erred in failing to find that the Appellant had a small but non-trivial goodwill arising through use of SOLO;

**Ground 2:** had the Hearing Officer not so erred she would have found that use of the Mark would amount to passing off in respect of that goodwill; and

**Ground 3:** despite finding that the Appellant owned goodwill for ONE-LED SOLO she erred by finding that use of the Mark would not give rise to passing off.

**Standard of appeal**

20. It was common ground that this appeal is by way of review, it is not a rehearing. The relevant principles were not in dispute. An appeal against a decision taken by the Registrar is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for the appellate tribunal to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. See *Reef Trade Mark* [2003] RPC 5; and *Actavis Group PTC v. ICOS Corporation* [2019] UKSC [2019] UKSC 15, [2019] RPC 9 at [78] to [81].

21. The principles have been summarised in numerous cases. For instance, the Respondent referred me to the Court of Appeal's decision in *Volpi v Volpi* [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2]. The principles have also been stated in a number of recent trade mark appeals, such as by Sir Anthony Mann in *Stitch Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch), [2023] ECC 17 at [6] to [8]:

> "6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in *Instagram LLC v Meta 404 Ltd* [2023] EWHC 436 (Ch). In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in *Volpi v Volpi* [2022] EWCA Civ 464.
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> "i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.
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> ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial

judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.

iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.

iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.

v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract."

7. So far as the decision below is evaluative, an appellate court should also approach the appeal with caution:

"76. So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, "such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion". (*Re Sprintroom Ltd* [2019] EWCA Civ 932)

8. And last, as Richards J observed in *Instagram*, proper respect should be paid to the decision of an expert tribunal in the field in question:

"26. Finally, it is relevant to observe that this is an appeal from a tribunal with particular expertise. As Lady Hale observed in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49 at paragraph 30, the court should

approach the appeal on the basis that it is probable that an expert tribunal, charged with applying the law in their specialist field, has probably got it right.""

22. I have kept these principles in mind when considering the present appeal.

**Merits of the appeal**

***Ground 1:*** *the Hearing Officer should have found goodwill arising through use of SOLO*

23. The Applicant raised several points which, it said, led the Hearing Officer into error in dismissing its claim to goodwill in the sign SOLO alone.

24. First of all, it criticised the Hearing Officer for suggesting that SOLO lacked distinctive character. At paragraph 67 of the Decision, when considering whether a misrepresentation would arise by virtue of use of the Proprietor's mark, the Hearing Officer, said:

> "67. Given the nature of the applicant's goods, which are self-contained emergency lighting systems that include their own batteries and operate independently, the word 'SOLO' is descriptive or at least allusive of the goods sold by the applicant insofar as it describes (or alludes to) a characteristic of the goods, namely that of being powered by their own batteries (in the event of mains failure) and operating independently."

At paragraph 69 she added:

> "69. In taking into account the above factors, I also bear in mind my findings about (a) the fact that the applicant uses the main brand 'ONE-LUX' as well as sub-brands incorporating the element 'ONE' and/or 'ONE-LED' which, as I explained above, are highly distinctive of the applicant's business and will be perceived as the main indicator of origin, and (b) the descriptive/allusiveness of the word 'SOLO' in the context of the applicant's goods and (c) the fact that the name 'ONE-LED SOLO' has a unitary character and is used as a product name."

25. The Applicant submitted that the question of whether the mark SOLO was descriptive or allusive of the goods was not one which was before the Hearing Officer, as it had not been raised by the Proprietor. However, at the hearing of the appeal counsel accepted

that a Hearing Officer needs to consider the meaning of the sign relied upon when considering goodwill, pointing instead to what it said was the illogicality of accepting that the slightly stylised version of the word SOLO in the Proprietor's mark was sufficiently distinctive for registration, whilst not accepting that the unregistered word was sufficiently distinctive to garner goodwill. Counsel submitted that the same objection could have been taken against each of the elements of its ONE-LED SOLO sign, so that SOLO simpliciter was no less distinctive than ONE-LED.

26. In my view, the Hearing Officer did not plainly fall into error in her view of the word SOLO. Once the Applicant is constrained to accept that it was right for the Hearing Officer to consider whether that word was purely descriptive, it seems to me that much of the force of its argument falls away. However, had the Hearing Officer said that SOLO was directly descriptive of the goods there would, in my view, have been some force in a criticism of her analysis. That was not all that she said, though, as she added that the Mark was at least allusive of the nature of the goods. I admit to having some difficulty in following why that is so, but it does not seem to me that it is a finding which is so clearly wrong that I can, or should, set aside the Hearing Officer's decision on that basis.

27. A further criticism made of her analysis of the distinctiveness of SOLO by itself was that the Hearing Officer found ONE-LED SOLO to be sufficiently distinctive to have acquired goodwill, yet the ONE and LED elements of that sign are no more distinctive than SOLO, and LED rather less so. I do not consider that this point helps the Applicant. In my view, she found that goodwill attached to the sign ONE-LED SOLO because of the amount of use made of it, and it is plain that a major reason she rejected the claim to goodwill for SOLO alone was that she found that the evidence showed only one or two instances of its use alone.

28. Next, the Applicant complained that the Hearing Officer had erred in the views she expressed as to the size of the relevant market for the goods. This was addressed in the evidence of Ms Murray. She said that she had worked in the field since 2008, and her evidence was that the size of the UK market for all emergency lighting products is in the region of £80-£100 million per annum and for the subcategory of SOLO style

products, only £1.2-2.5 million per annum. The Hearing Officer considered this evidence at paragraphs 38-39 of her Decision and commented:

> "39. … Ms Murray's statement about the size of the UK market for emergency lighting products and/or for the 'SOLO' style product is wholly unsupported by any evidence and Ms Murray does not explain where she got his [*sic*] estimates from."

Ms Murray provided a list of some of the Applicant's customers in her second witness statement, giving their annual turnover, totalling some £90m. This may have explained where she got her figures from, but it does not seem to me that she explained how this showed the total size of the UK market for such goods.

29. The Hearing Officer took the point about the size of the market into account at paragraph 50, saying:

> "50. Although I accept that there is some evidence of sale, that is, in my view, very tiny, amounting to less than 6,000 units sold before the relevant date. The applicant attempted to argue that the sales achieved must be contextualized insofar as the market for the products sold under the sign 'SOLO' is a niche market which is significantly smaller than the UK market for all emergency lighting products. I reject the submission. Although Ms Murray gave some estimates about market share, there is no explanation as to how the figures supplied were generated and one cannot simply pluck a figure out of thin air as it seems Ms Murray has done in this case. There is no independent evidence to indicate (1) what is the size of the UK market for light emitting diode (LED) lamp and driver kits, (2) what is the size of the UK market for lighting equipment/products and (3) that the market for light emitting diode (LED) lamp and driver kits used for emergency lighting is a niche market within the overall UK lighting industry. In any event, as the proprietor states, even if Ms Murray's estimation of the UK lighting market being worth £100 million was correct (bearing in mind that the relevant date is in 2016), the sales achieved by the applicant at the relevant date would amount to a tiny percentage (according to my calculation of 0.13%)."

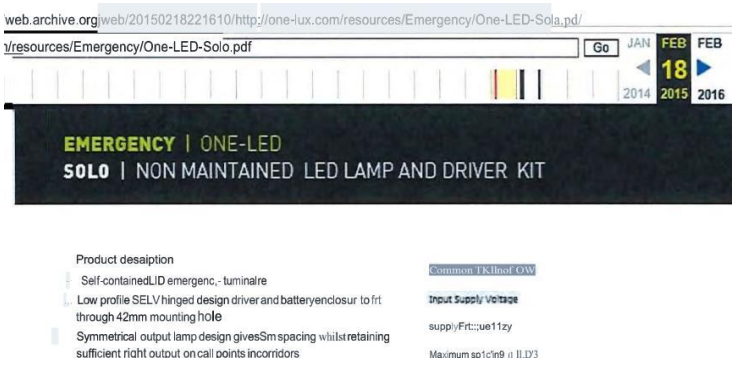
The reference to the "UK lighting market" in the last sentence of that paragraph must have been intended to be a reference to the UK emergency lighting market, as that was the market which Ms Murray had said was worth £80-100m.

30. Then, in paragraph 58 of the Decision, the Hearing Officer said that it was her view that the market in which the Applicant was operating was "the lighting market at large." She did not explain why she took that view, but it may well be because of the third point she had made at paragraph 50 of her decision, that is, that she had not been provided with any evidence that the market for LED lamp and driver kits used for emergency lighting is a niche market within the overall UK lighting industry. It is right that the Proprietor had not challenged the veracity of Ms Murray's evidence about the size of the market, but it had submitted that there was no relevant niche market. Alternatively, given the way she had described the market at paragraph 50, it seems to me that at paragraph 58 the Hearing Officer again meant to refer to the whole emergency lighting market.

31. In my judgment, reading these paragraphs together, it seems that the Hearing Officer had the emergency lighting market at large in contemplation. In the absence of better evidence from Ms Murray to justify her view that there is a narrower, specialist market which was the appropriate one to consider, in my judgment it is not possible to say that the Hearing Officer was plainly wrong in her assessment of the appropriate market.

32. Next, the Applicant criticised the Hearing Officer's analysis of the evidence of its use of the sign SOLO on its own. Whilst counsel realistically accepted that the evidence was not strong, or as extensive as it might have been, the Applicant said that the Hearing Officer had not looked at the evidence in the round, but had simply picked out a few examples to criticise. Moreover, it submitted that the evidence upon which the Hearing Officer found there to be goodwill in ONE-LED SOLO should also have been found to support goodwill in SOLO alone. I was taken to a number of the examples of use in the evidence, which the Hearing Officer described at paragraphs 26-37 of the Decision. Taking the example under paragraph 26, from a ONE LUX brochure from 2014, the Applicant said that the differentiation by colour showed SOLO being used as a separate sign to ONE-LED SOLO:

32. In other examples, such as in packaging, and product labels, and in entries on the Applicant's website, the Hearing Officer noted that references were made to ONE-LED SOLO, set over a description, or as follows:




33. The Hearing Officer summarised her view of this evidence as well as the evidence of marketing at paragraphs 51-2:

> "51. In terms of marketing and promotion, the advertising figures for 2014-2015 amounts to just over £5,000 which may go to explain the scarcity of the evidence of advertising. Ms Murray says that since 2014, the sign 'SOLO' has featured in a variety of media, including (a) the applicant's website in the 'Emergency' section and 'Product Guide,' (b) the promotional brochure printed in 2014, 2016 and 2018, (c) a company presentation on the applicant's website, (d) the MiB website and (e) other promotional material such as the specific email marketing campaigns exhibited in evidence. However, this evidence is not particularly strong as it does not show much outward use of the sign or is undated/dated after the relevant date. In this connection, I note that:
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> • with regard to points (a) and (b), the sign 'SOLO' featured only on one page (page 7) in the catalogue from 2014 and 2/3 of the copies which were printed were distributed at the 2014 Light + Building Show in Frankfurt. Although Ms Murray says that in the guide that was reprinted in 2016 and distributed at the 2016 Light + Building Show in Frankfurt between 13 and 17 of March 2016, the sign 'SOLO' featured on 2 pages rather than one, she did not provide a copy of the 2016 reprint, nor did she say that the 2016 guide was also distributed in the UK. In any event, as the proprietor correctly states, the evidence about the applicant's participation to the Light + Building Show in Frankfurt is unlikely to assist, because it only shows that the applicant attended two exhibitions in Germany prior to the relevant date (with the 2016 exhibition being only a few days before the relevant date) and there

are no details which would allow me to draw any conclusion as to whether any outward use of the signs at the exhibitions gauged any interest and committal response from UK customers;

• with regard to points (c) although Ms Murray refers to the mark 'SOLO' featuring in a company presentation on the applicant's website since 2014, there is no evidence of that presentation and there are no details as what the presentation was about, when was it published, whom was it aimed at, and to what extent and in which form the signs 'SOLO'/'ONE-LED SOLO' were used;

• with regard to point (d), although Ms Murray states that the sign 'ONE-LED SOLO' was used on the MiB website, the webpage exhibited is undated, and the sign appears in very small writing along with other brands, so I doubt it would even be noticed, but in any event, it does not appear to be used in relation to any product;

• with regard to point (e), again the page exhibited is not an email and it is undated but, in any event, if this the best evidence of marketing that the applicant can provide, it is less than persuasive.

52. Overall, whilst the evidence establishes that the sign 'ONE-LED SOLO' was used on the applicant's website and on a product catalogue since 2014, neither the website nor the catalogue draws much attention to the name 'SOLO' or 'ONE-LED SOLO'. This is consistent with the rest of the evidence which indicates that 'ONE-LED SOLO' is the name of a specific product sold by the applicant under the unifying umbrella of the company name 'ONE-LUX' from which the applicant derived a number of sub-brands (or products names) incorporating the word 'ONE' plus a descriptive word, … Further, the sign 'ONE-LED SOLO' is always used in conjunction with the main brand 'ONE-LUX' and with the abbreviation 'OLS' which stands for 'ONE-LED SOLO' and is referred to as model number or a product code; this is shown on the invoices, on the product labels, on the product guide, on the product itself and on the website. Finally, the one image of packaging that has been exhibited only shows the abbreviation 'OLS' without the sign 'ONE-LED SOLO'."

34. This led her to her conclusions on goodwill at paragraphs 58-60:

"58. In this case the applicant's sales … are still very low (but more than trivial) by reference to the market in which the applicant is operating, which I consider to be the lighting market at large. Further, the length of use is far from being long-

standing, sales having commenced approximately two years before the relevant date, the marketing spend is very small and there is little information about the applicant's advertising reach in the UK but given the minimal advertising efforts shown in the evidence I doubt that it was significant. Overall, my conclusion is that the evidence demonstrates a small but probably more than trivial goodwill at the relevant date. This is sufficient to satisfy the first required element of passing off.

*Are the signs being relied upon distinctive of the applicant's goodwill?*

59. The applicant relies on two signs, namely 'SOLO' and 'ONE-LED SOLO'. The first conclusion I draw on the basis of the evidence filed is that the applicant did not have any goodwill in the sign 'SOLO' alone at the relevant date. This is because the name used by the applicant is 'ONE-LED SOLO', which is used as a product name and is abbreviated in 'OLS' as the product code – the fact that an acronym is created from the name also confirming the unitary character of the name itself. Although there are one of two instances of the sign 'SOLO' being highlighted or presented separately on the invoices and on the product guide, such use is inconspicuous to say the least.

60. The fact that the sign 'ONE-LED SOLO', is used as a product name is an important fact because it serves the purpose of indicating what the goods are rather than denoting their trade source. However, to the extent that the sign 'ONE-LED SOLO' is part of a family of marks which incorporates the applicant's brand 'ONE' and the descriptive element 'LED' – and recreated a distinctive pattern used by the applicant's marks - it is likely to be also appreciated as an indication of origin.

35. It seems to me that none of the criticisms made of the Hearing Officer's analysis of the evidence about use of SOLO as a separate sign show that she went wrong in assessing the claim to goodwill attaching to that name. The Applicant acknowledged that its evidence was not compelling, and there was very limited use of SOLO by itself, and much more evidence of use of the acronym OLS and the sign ONE-LED SOLO. In my judgment, the conclusions she drew were all open to her on the evidence before her, and the Applicant did not identify any material errors in terms of missing evidential points or reaching plainly unsustainable conclusions about the impact of the evidence. The Applicant was really doing no more than inviting me to reach different conclusions about the SOLO sign to those reached by the Hearing Officer. In my judgment, the Hearing Officer's finding on this point was one which was undoubtedly open to her.

36. In all the circumstances, I reject Ground 1 of the Appeal. Ground 2 therefore falls away.

***Ground 3:*** *despite finding that the Appellant owned goodwill for ONE-LED SOLO the Hearing Officer erred by finding that use of the Mark would not give rise to passing off.*

37. Ground 3 challenged the Hearing Officer's conclusion that there would be no misrepresentation through use of the Mark. She had found that the goods in question were identical or similar. In paragraphs 66-8 she held that the marks are visually similar to a low degree and aurally similar to a low to medium degree, and had a medium degree of conceptual similarity. She concluded:

> "69. In taking into account the above factors, I also bear in mind my findings about (a) the fact that the applicant uses the main brand 'ONE-LUX' as well as sub-brands incorporating the element 'ONE' and/or 'ONE-LED' which, as I explained above, are highly distinctive of the applicant's business and will be perceived as the main indicator of origin, and (b) the descriptive/allusiveness of the word 'SOLO' in the context of the applicant's goods and (c) the fact that the name 'ONE-LED SOLO' has a unitary character and is used as a product name.
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> 70. In my view, when all of the above factors are weighted together, use of the proprietor's mark will not be passing-off. The main factor which, in my view, is effective to distinguish the applicant's goods is that they are always sold under the applicant's own brand name, namely as a sub-brand of 'ONE LUX' called 'ONE-LED'. It is my view, therefore, that the applicant's actual or potential customers are unlikely to be misled into purchasing the proprietor's goods in the belief that they are the applicant's goods because they will consider that the absence of the distinctive brand 'ONE-LED' in the proprietor's marks means that the goods do not come from the applicant. The applicant does not have an exclusive reputation in relation to the sign 'SOLO' and whilst there is some goodwill associated with the sign 'ONE-LED SOLO', it is small, and the sign in itself has been effectively used as the name of a product within which the element that is more likely to be appreciated as an indication of origin is the element 'ONE-LED'. Further, the element 'SOLO' denotes a characteristic of the goods concerned, namely that they

operate independently and is more likely to be appreciated for its own sake (rather than as an indication of origin).

71. For all of the above reasons, my conclusion is therefore that there is no misrepresentation."

38. The Applicant criticised the Hearing Officer's approach, saying that as she had found goodwill in the sign ONE-LED SOLO it was wrong to take into account the fact that it might have been used in conjunction with ONE LUX. I think that would have been a good point, had that been the Hearing Officer's main reason to reject a likelihood of misrepresentation.

39. However, in my judgment she did not use ONE LUX and ONE-LED "interchangeably" as the Applicant submitted. The reference to the use of ONE LUX together with ONE-LED SOLO was not the crux of the Hearing Officer's reasoning. As I read it, in paragraph 70 she refers to ONE-LED as a sub-brand of ONE LUX, and it is the absence of the element ONE-LED in the registered Mark which led her to find that the average consumer would not believe that goods bearing the Mark are connected in the course of trade with the Applicant. She believed that this was the more significant element of the whole sign ONE-LED SOLO. It seems to me that this was a conclusion which it was open to her to reach, weighing up the various factors which she had considered in her decision, as she was required to do. In the circumstances, I reject this Ground of Appeal too.

40. As a result, the appeal fails.

41. The Proprietor is entitled to a contribution towards its costs of the appeal. It submitted that the appeal had been so unmeritorious that this should be reflected in the costs award. I do not agree, it does not seem to me that the appeal was in any way out of the ordinary. I will order the Applicant to pay the Proprietor £1500 in respect of its costs of the appeal to be paid within 21 days, together with the costs awarded by the Hearing Officer.

Amanda Michaels
The Appointed Person
4 April 2024

**Mr JAMIE MUIR WOOD** (instructed by **Swindell & Pearson Ltd**) appeared for the Appellant

**MR BENJAMIN LONGSTAFF** (instructed by **Harrison IP Ltd**) appeared for the Respondent