O/0710/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3869006
IN THE NAME OF JINKO SOLAR CO., LTD.

TO REGISTER AS A TRADE MARK

SunTank

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 440049
BY WUXI SUNTECH POWER CO., LTD.

BACKGROUND AND PLEADINGS

1. On 18 January 2023, Jinko Solar Co., Ltd. ("the applicant") applied to register "**SunTank**" as a trade mark in the United Kingdom. The application was accepted and published for opposition purposes on 3 February 2023, in respect of goods in class 9, as shown at Annex A of this decision.

2. The application is opposed by Wuxi Suntech Power Co., Ltd. ("the opponent"). The opposition was filed on 3 April 2023 and is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application. The opponent relies upon six earlier marks, as shown in the table below. For the purposes of this opposition, I note that the opponent relies on certain goods and services in classes 9 and 42 only across the six marks relied upon.

Trade Mark No. and representation	**Details of registration/designation**
UK00906897862 (the '862 mark) SUNTECH	Filing date: 8 May 2008 Registered on: 28 January 2009 Registered in classes 9, 11, 42
UK00909121286 (the '286 mark) SUNTECH	Filing date: 20 May 2010 Registered on: 2 November 2011 Registered in classes 6, 9, 11, 16, 19, 37, 41, 42
UK00912643698 (the '698 mark) SUNTECH BE UNLIMITED	Filing date: 27 February 2014 Registered on: 17 July 2014 Expired on 27/02/2024[1] Registered in classes 9, 16

[1] I note that although the registration has since expired, it was still valid at the time the opposition was filed. The six month 'grace period' to renew the mark ends on 27 August 2024.

UK00002619064 (the '064 mark) **SUNTECH**	Filing date: 27 April 2012 Registered on: 3 August 2012 Registered in classes 9, 11, 19, 37, 42
WO0000000838829 (the '829 mark) 	Date of designation (UK): 19 July 2004 Date protection conferred: 30 October 2005 Registered in class 9
WO0000001216075 (the '075 mark) 	Date of designation (UK): 25 March 2014 Date protection conferred: 27 November 2014 Registered in classes 9, 16, 41

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's '862, '286 and '698 marks were each converted into a comparable UK trade mark. Comparable UK marks are now recorded in 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.[2]

4. Each of the trade marks upon which the opponent relies qualifies as an earlier trade mark under section 6(1) of the Act. All of the opponent's trade marks had completed the registration process or had been protected for more than five years before the application date of the contested mark, and, as a result, they are, in principle, subject to the provisions on use under Section 6A of the Act.

5. The opponent submits that having regard to the identity or high similarity of the respective marks, the inherent distinctiveness of the opponent's earlier marks, and the identity or high similarity of the respective goods and services, there exists a

[2] See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

likelihood of confusion on the part of the public. It submits that the application contravenes the provisions of section 5(2)(b) of the Act, including a likelihood of association. Accordingly, it requests that the application be refused.

6. The applicant filed a counterstatement denying the claims of a likelihood of confusion, although it admits to there being similarity between some, but not all of the contested goods. The applicant puts the opponent to proof of use of all its earlier marks for all the goods and services relied upon. It requests that the opposition under section 5(2)(b) be dismissed, and an award of costs be made in its favour.

7. During the evidence rounds, both parties filed evidence and the applicant filed written submissions. Neither party requested a hearing; only the applicant filed written submissions in lieu of a hearing, which will be referred to as and where appropriate during this decision. This decision is taken following careful consideration of the papers.

8. In these proceedings, the opponent is represented by Trademarkit LLP and the applicant is represented by Appleyard Lees IP LLP.

EVIDENCE AND SUBMISSIONS

The opponent's evidence

9. The opponent filed evidence by way of a witness statement dated 18 July 2023 in the name of Zhang Qi, alongside four exhibits, labelled **Exhibit ZQ1** to **Exhibit ZQ4,** accordingly. Zhang Qi is the legal supervisor of the opponent.

10. The main purpose of the evidence is to demonstrate that the earlier marks have been put to genuine use in the relevant territory during the relevant period.

The applicant's evidence and submissions

11. The applicant filed evidence by way of a witness statement dated 27 September 2023 in the name of Wang Ye, alongside three exhibits, labelled **Exhibit LS1** to

Exhibit LS3, accordingly.[3] Wang Ye is the IP Manager of the applicant, a position he has held since 1 June 2023.

12. The main purpose of the evidence appears to be to demonstrate the applicant's achievements and to show that it has created "a distinctive trade mark" which "bears no relation to the Opponent's Mark".[4]

13. The applicant also filed written submissions dated 27 September 2023 and written submissions in lieu of a hearing, dated 8 January 2024. The latter includes an Annex which comprises a printout of a decision made by the China National Intellectual Property Office in relation to a trade mark application by the applicant in that jurisdiction. I note that in the witness statement, Wang Ye states that the official examiner in China did not cite the opponent's "Suntech" mark during the substantive examination stage, meaning that the two marks were not considered similar to each other and could co-exist without causing confusion amongst relevant consumers (see also exhibit LS1). This is reiterated in the applicant's written submissions and its written submissions in lieu. I acknowledge the submissions made, however, I am not bound by findings of other jurisdictions, and I will draw my own conclusions on the similarity of the marks before me, as rationalised later in this decision.

14. I have read and considered all of the evidence and submissions, and I will refer to the relevant parts at the appropriate points in the decision to the extent that I consider necessary.

MY APPROACH

15. The evidence of use provided relates to all of the earlier marks relied upon. I note that all six marks contain the identical word "**SUNTECH**", while the applicant's mark is for the word "**SunTank**". The earlier '064 mark is a word mark which does not contain any other elements. Meanwhile, the remaining five marks are figurative

[3] I note that although some of the exhibits are in Chinese, a translation has been provided by Sean Chen. This is accompanied by a witness statement in which Mr Chen certifies the accuracy of the translation to the best of his abilities. The signed witness statement bears the seal of the Advance China IP Law Office.
[4] See point 6 of the witness statement of Wang Ze.

marks comprising an almost identical device element, with the '698 mark and the '075 mark both containing the additional words "BE **UNLIMITED**", none of which plays any part in the applicant's mark. In my view, the '064 mark represents the opponent's strongest case in terms of having both the widest specification of goods and services relied on, as listed at Annex A of this decision, as well as being the closest 'match' overall of all the earlier marks when compared against the applicant's mark.

16. I will focus my assessment under section 5(2)(b) on the opponent's '064 mark only, which going forward, I will refer to as "the opponent's mark". In the event that I find there to be a likelihood of confusion between the opponent's '064 mark and the applicant's mark, I do not consider that assessing the remaining marks would improve the opponent's position. If, however, I find no likelihood of confusion between the marks, it follows that the same finding will apply to the remaining earlier marks on the basis that they share a lesser degree of similarity with the applicant's mark.

17. For reasons that will become apparent throughout the course of my decision, I propose to proceed on the basis that the opponent has put the mark to genuine use during the relevant period for all of the goods and services relied upon.

18. I also note that in relation to the goods at issue, some of the goods are self-evidently identical, for example, the applicant's "*Solar modules; solar panels for generating electricity"* with the opponent's "*solar modules; solar panels for electricity generation."* Given that at least some of the goods are identical, and the applicant's admission of similarity for the majority of its goods,[5] I do not intend to undertake a full comparison of the respective goods and services. If there is a finding of no likelihood of confusion for the mark on identical goods, then it follows that there will be no confusion between the marks for goods which are only considered similar (to any degree).

[5] In its counterstatement, and again in its written submissions in lieu, the applicant admits that, with the exception of "*computer software applications, downloadable*", the opposed goods are similar because they circulate in the same trade channels and share the same purpose as the opponent's goods, which is to collect solar energy, although it has not said to what degree it considers them to be similar.

19. I will now move to consider the 5(2)(b) ground of the opposition. If required, I will address the above points further when considering any final remarks at the conclusion of this decision.

DECISION

20. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Section 5(2)(b)

21. Section 5(2)(b) is relied upon, which reads as follows:

> "5(2) A trade mark shall not be registered if because -
>
> (a) …
>
> (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".

22. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 greater 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing act

23. The average consumer is a legal construct, who is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

24. In my view, the average consumer for the competing goods in common, being a variety of solar related products, will most likely be business consumers with a specialist knowledge of the goods, such as the building trade and installers of solar systems, although I do not discount the general public as consumers. The goods are sold through a range of channels, including from physical premises as well as via the internet, and may be sourced through specialist providers or from more general builder’s merchants and home improvement stores. To my mind, the selection process would be predominantly visual, although aural considerations will play a part, for example, where the consumer receives verbal advice and recommendations from sales representatives.

25. Cost considerations will play a part and the goods will range in price, being less expensive for goods such as single solar panels to relatively expensive for full solar powered storage systems. When selecting the goods prior to purchase, the consumer will want to ensure that the goods are appropriate to their own specific needs, taking into account technical reviews, quality, ease of use, suitability of the product and the reputation of the provider. Overall, I would expect consumers within the building and installation trade, as well as the general public, to pay a medium to high degree of attention to the purchasing process, dependent on the exact nature of the goods purchased.

Comparison of marks

26. 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 in *Bimbo SA v OHIM* Case C-591/12P, that:

> "34. ... 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."

27. 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.

28. The marks to be compared are **SUNTECH** v **SunTank**.

29. The opponent's mark consists of a single word "**SUNTECH**", presented in capital letters in a standard black typeface. In my view, there is a natural break between the third letter, N, and the fourth letter, T, which would lead the average consumer to perceive it as two separate, dictionary defined words, "SUN" and "TECH". In *Usinor SA v OHIM*, Case T-189/05, the General Court ("GC") found that:

> "62. … it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd Schuhfabrik Meyer, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT) [2004] ECR II-3445, paragraph 51, and Case T-256/04 Mundipharma v OHIM – Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57)."

I do not consider that either word dominates, and as the opponent's mark contains no other elements, the overall impression therefore rests in the combined (conjoined) words.

30. The applicant's mark consists of the conjoined words "**SunTank**", presented as a single word in a standard black typeface. The use of capital letters at the start of "Sun" and "Tank" immediately leads the consumer to read the mark as two individual words, even though there is no space between those words. Again, neither word dominates, therefore the overall impression conveyed by the mark rests in the combination of the two (conjoined) words.

31. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, however, I accept that this is not always the case.

32. Visually, the competing marks are both words of seven letters in length. They have in common the first four letters S U N T (S u n t), placed in the same position within each word. However, the endings of the respective words differ, with the opponent's mark being completed with the letters "E C H" and the applicant's mark

being completed with the letters “a n k”. I do not consider the difference in capitalisation/title case is relevant to the visual impact, as the registration of a word mark gives protection irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. The words are relatively short, and while the variance between the marks is subsumed in the body of the words, it nonetheless creates a notable visual difference between the marks as a whole. Considering the position of the identical letters “S U N T”, I consider the marks to be visually similar to a medium degree.

33. Both marks would be articulated as two syllables, SUN-TEC and SUN-TANK respectively, meaning aural commonality between the first syllable only of the competing marks. Overall, I consider the marks to be aurally similar to a medium degree.

34. With regard to the conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, the GC held:

> “8. … In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the ‘concepts’ that the signs at issue convey. The term ‘concept’ means, according to the definition given, for example, by the Larousse dictionary, a ‘general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it.”

35. To my mind, both marks would be perceived as two separate, every day, dictionary defined words. I consider that a significant proportion of the average consumer would understand the opponent’s mark as combining “SUN” and “TECH”, the latter being a recognised abbreviation of the word “technology”. Therefore, in direct reference to the goods at issue, the mark is likely to be seen as referring to those goods which utilise solar technology i.e. goods that generate energy from the sun. Meanwhile, the combined words “SunTank” in the applicant’s mark would be seen by a significant proportion of the average consumer as pertaining to solar storage, with the word “tank” referring to such storage in the form of the goods at hand, such as batteries.

36. As the word “SUN”, which is common to both marks, refers to the solar properties of the goods at hand, the marks share a degree of conceptual similarity. However, when viewed as a whole, the marks send out different overall messages: the opponent’s mark conveying a more general message of solar (sun) technology, while the applicant’s mark is more specific to the concept of solar storage. Consequently, I consider the marks to be conceptually similar to a low degree.

Distinctive character of the earlier mark

37. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

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

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

39. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness although evidence of use has been filed.

40. I will begin by considering the inherent distinctive character of the mark. Earlier in my decision, I found that the "SUN" element of the opponent's mark would be recognised as referring to the solar properties of the goods at hand, while the "TECH" element would be seen as an abbreviation of "TECHNOLOGY". Therefore, in combination, the mark "SUNTECH" is likely to be seen as a direct reference to the goods at issue, being goods which utilise solar technology. As such I consider the mark to be low in inherent distinctive character.

41. I turn to the question of enhanced distinctive character through use, within the relevant period in the United Kingdom, being the territory relevant to this assessment. Considering the low level of inherent distinctiveness, I consider that the evidence needs to show significant use of the mark to demonstrate any such enhancement.

42. I note that in his witness statement, Zhang Qi has provided annual turnover figures (based on retail value) for the goods sold in the UK under the SUNTECH mark as follows:

Year	**Turnover (USD)**
2023	USD 2,996,229
2022	USD 27,616,432
2021	USD 8,268,955
2020	USD 560,263

2019	USD 18,030,258

On the face of it, the figures overall seem impressive, although I note that they are given in USD rather than pounds sterling (GBP/£). However, the figures have not been broken down to show which of the six earlier marks, nor which of the goods or services for which use has been claimed, that these figures relate to. I acknowledge that exhibit ZQ3 includes a variety of invoices for solar modules, which are dated within the relevant period and are headed as SUNTECH and are addressed to UK consumers:

SUNTECH

Wuxi Suntech Power Co., Ltd.

Tel: +86 510 8531 8888
Fax: +86 510 8531 7372

To: [redacted]
Iver, SL0 9AQ
United Kingdom

Date : 2021/7/12
Invoice No : GSED2101-3
Incoterms : DAP UK

Packing List

Marks	Description	Package (Pallets)	N.W (KG)	G.W (KG)	Measurement (CBM)
N/M	Solar Modules STP 535 -C72/Pmh+	200	203360	212000	662.4

43. Zhang Qi also states that in 2021 and 2022, advertising and marketing costs in the UK for the goods bearing the SUNTECH mark were GBP 14,000 each year. Exhibit ZQ4 shows attendance at the Solar & Storage Live exhibitions, held in Birmingham in 2021 and 2022.

44. As far as the assessment of enhanced distinctiveness of the mark through use is concerned, I consider the evidence to be somewhat lacking. It does not tell me anything of the market share held by the mark for the goods for which use is claimed. As pointed out by the applicant, the screenshots of third party websites which mention the SUNTECH brand in exhibit ZQ1 are undated, save for the date the pages were accessed for the purposes of filing evidence, being 31 March 2023. Considered overall, I do not consider the evidence to be sufficient to show that the distinctive

character of the earlier mark has been enhanced through use in the UK during the relevant period.

Likelihood of confusion

45. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

46. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> "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, 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)."

47. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

48. As explained earlier in this decision, I have proceeded on the basis that at least some of the competing goods are identical. I found the level of attention of the average consumer during the selection of the goods to range between a medium to high degree during the purchasing process, being the same for the business consumer as the most likely consumer of the goods, as well as the general public. I considered that the goods would be selected by predominantly visual means, although aural considerations would play a part.

49. I found the competing marks to be visually and aurally similar to a medium degree, and to be conceptually similar overall to a low degree. I found the earlier mark to be inherently distinctive to a low degree, with insufficient evidence to suggest that this has been enhanced through use in the UK.

50. In its written submissions, the applicant submits that an earlier decision of the UKIPO, being case number O-290-17 for the marks SUNLINE v SUNRAIN, is analogous with the present case, whereby the beginning of both marks at issue start with the word SUN, with the ending of both marks, both also containing four letters, being different. The hearing officer in that decision found no likelihood of confusion despite the goods at issue being considered identical or highly similar. Again, I am not bound by the previous findings of this Tribunal. However, I consider the applicant's submissions on the analogous nature of the earlier case compared with the case before me to be not without some merit.

51. I have weighed up each of the competing factors in my decision, not least the differences as well as the similarities between the competing marks, as identified above. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake the applicant's mark for the earlier mark, or vice versa. I bear in mind that in relation to the assessment of the likelihood of confusion, it is the section of the public with the lowest level of attention which must be taken into consideration.[6] In my view, the average consumer paying a medium degree of attention will notice and recall the visual, aural and conceptual differences between the marks, particularly taking into account the highly allusive elements of the earlier mark. I find this even though the differences between the opposing marks are found at the end of the respective words. To my mind, given the length of the words, and the differences in overall concept, those differences stand out and will not be overlooked. Even if I am wrong in my assessment of a low conceptual difference between the marks, I do not consider that this would affect the overall perception of the average consumer who would still recognise that the later mark is different from the earlier mark. Overall, I do not consider there to be any likelihood of direct confusion. I find this even where there is identity between the goods at issue.

52. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr

[6] Case T-247/12, *Argo Group International Holdings Ltd. v OHIM*.

James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

53. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, Lord Justice Arnold referred to the comments of James Mellor QC (as he then was) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said (at [16]) that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Lord Justice Arnold added that there must be “a proper basis” for concluding that there is a likelihood of indirect confusion when there is no likelihood of direct confusion.

54. I acknowledge that the categories listed by Mr Iain Purvis Q.C. (as he then was) are not exhaustive. I have made a multi-factorial assessment of the various considerations in play. Given the nature of the overlapping goods, the common element “SUN” at the beginning of the respective marks is not so strikingly distinctive that the consumer would assume that only the opponent would be using it as part of its trade mark. While sight of one mark may bring to mind the other mark, and consumers may consider that the marks coincidentally begin with the same letters, in my view, there would be no logical reason for consumers (either those in the trade or members of the public) to believe that there is an economic connection between the undertakings. I therefore find no likelihood of indirect confusion.

55. The opposition fails under section 5(2)(b) of the Act.

FINAL REMARKS

56. Earlier in this decision, I explained that I would proceed on the basis that the opponent had put the marks to genuine use during the relevant period for the goods and services relied upon. In light of my findings of no likelihood of confusion, it is unnecessary for me to return to undertake a full assessment of genuine use as this would not improve the opponent's position. For the same reason, neither do I deem it

necessary to undertake a full comparison of the respective goods and services. I have based my decision on the earlier '064 mark. I do not consider that the final outcome in relation to a likelihood of confusion against the applicant's mark would have been any different in relation to any of the remaining five earlier marks relied upon as none of these marks would have represented a stronger case for the opponent.

CONCLUSION

57. The applicant has been successful. Subject to any successful appeal, the application by Jinko Solar Co., Ltd. may proceed to registration.

COSTS

58. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. I do not consider that the evidence submitted by the applicant in support of its defence had any positive bearing on my decision; I further note the duplication of information across the counterstatement and two sets of written submissions. Therefore, I have made a reduction to the award of costs to reflect this. Applying the guidance in the TPN, I consider the following to be fair:

Considering the notice of opposition and filing a counterstatement:	£300
Considering the opponent's evidence:	£500
Preparing and filing written submissions:	£400
Total:	**£1,200**

59. I therefore order Wuxi Suntech Power Co., Ltd. to pay Jinko Solar Co., Ltd. the sum of £1,200. 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 26th day of July 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General

Annex A

The applicant's contested goods:

Class 9:

Solar batteries; Solar modules; solar panels for generating electricity; Energy storage systems consisting of electricity storage batteries; energy storage systems composed of batteries, inverters, control systems, electronic devices and recorded software for the operation and performance of energy storage systems; Accumulators, electric; Battery boxes; Batteries, electric; energy storage apparatus; Energy storage equipment; battery modules for energy storage systems for private households; Wirelessly connected electric battery apparatus with embedded remotely updateable software and firmware for storage and discharge of stored electricity for usage in entire dwellings and buildings; apparatus and instruments for accumulating and storing electricity, namely, accumulators, battery packs, and integrated energy storage systems comprising batteries and battery packs; solar energy storage system sold as a unit comprised of solar panels, batteries, solar inverters, and control panels; Solar energy storage devices; solar energy equipment for use in converting solar energy into electricity; computer software applications, downloadable.

The opponent's goods and services as relied upon under the '064 mark

Class 9:

Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; solar modules; solar modules for solar power stations; photovoltaic solar cells; photovoltaic solar modules; photovoltaic solar modules for integration into roofing and glazing and walls and other structures of buildings; power inverters for solar power systems; sun tracking apparatus for photovoltaic solar modules; solar powered batteries; electricity storage apparatus; junction boxes; transformers; solar panels for electricity generation.

Class 42:

Technology planning and consulting in the field of solar energy; technology planning and consulting in the field of solar energy specializing in substrates primarily of

ceramic, silicon and non-metals for electrical or thermal insulation of solar cells, photovoltaic cells, and solar collectors; technical planning of solar thermal installations; technical planning of photovoltaic/solar thermal hybrid installations.