

O/0830/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003351185

BY V7 LTD

FOR THE FOLLOWING TRADE MARK:

V7

IN CLASS 9

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 506212

BY INGRAM MICRO INC.

BACKGROUND AND PLEADINGS

1. V7 Ltd (“the proprietor”) is the registered proprietor of the UK trade mark shown on the cover page of this decision (“the contested mark”). The contested mark was filed on 06 November 2018 and was granted registration on 29 March 2019. It stands registered for the following goods:

Class 9: *Software; Software applications; Software applications for mobile devices; Software applications for use with mobile devices; Artificial intelligence software; Laboratory instruments [other than for medical use]; Laboratory robots; Character recognition apparatus; Character recognition software; Facial recognition apparatus; Gesture recognition software; Image recognition software; Optical character recognition apparatus [OCR]; Speech recognition software.*

2. On 26 June 2023, the contested mark was subject to an invalidation application by Ingram Micro Inc. (“the applicant”). The application is based upon Section 47 and Sections 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). For the purpose of its Sections 5(2)(a) and 5(3) grounds, the applicant relies upon the following trade mark registration:

UK00914376438¹

V7

Filing date: 17 July 2015

Date of entry in register: 13 April 2016

The mark is registered for various goods in classes 2, 9, 11, 16 and 20 but the applicant relies upon the following good only:

¹ This is a comparable mark based on earlier 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 existing EUTM and IRs designating the EU. This comparable mark enjoys the same filing and registration date as its European counterpart.

Class 9: *Computers, in particular notebooks, servers and personal computers, and parts therefor; Data input, data output, data duplication, data transfer and data storage devices, in particular keyboards, screens, projectors, printers, plotters, scanners, joysticks, mouse input devices, storage drives and storage, and media therefor, CD-ROM disk drives, network cards, graphics and sound cards, modems, modem cards and ISDN plug-in cards and housings for loudspeakers for computers and power supplies therefor; digital cameras; Computer motherboards; Machine readable data carriers; Machine-readable data carriers containing computer programs; All the aforesaid goods included in this class; Projection screens for large-screen data projectors; Navigation apparatus, including GPS navigation apparatus and portable navigation apparatus; Televisions, including televisions using DVBT technology; Reproduction apparatus for sound and image recordings, including DVD players and Mp3-player; Recording apparatus for sound and image recordings, including video recorders and hard disk recorders; Batteries; Cables; In particular computer connection cables and connection cables for notebooks, servers and personal computers, screens, loudspeakers, scanners, printers, keyboards, projectors, plotters, joysticks, mouse input devices, televisions and navigation apparatus; AC adapters for notebooks; PC loudspeakers and multimedia loudspeakers; Electronic safety locking devices, electronic security locks and electronic filters for personal data; Networking accessories, In particular electric switches, USB HUBs; Presentation devices, in particular wireless presentation devices, remote control apparatus; Remote controls for presentations, remote control apparatus for presentations; Laser pointers, headsets, headphones, web cameras, USB flash and data storage products, in particular electronic storage media, including memory cards, flash memories, USB flash drives, SD memory cards, flash memory cards; POS (cash register) scanners; Barcode scanners, Continuity units; Chargers for PCs and notebooks; Carrying bags for notebooks.*

Class 16: *Paper products, namely handbooks (manuals) and operating instructions for data processing apparatus, computers and computer programs; Copying paper.*

3. Under Section 5(2)(a), the applicant claims that the marks are identical and the goods are similar, leading to a likelihood of confusion.

4. Under Section 5(3), the applicant claims that it has developed a reputation in its mark through its extensive use in the UK in relation to the registered goods in class 9. The applicant also submits that the marks are identical and that the goods are similar referring to the likelihood of confusion; in particular, the applicant states that due to the identity of the marks and the similarity of the goods, the relevant public will believe that the trade marks concerned are used by the same undertakings or are economically connected. The applicant further claims that the contested mark will take unfair advantage of, or be detrimental to, the distinctive character of the applicant's mark.

5. Lastly, under Section 5(4)(a) the applicant relies upon the sign V7 which it claims it has used throughout the UK since 2007 in relation to *teaching solutions including software, interactive displays and boards, remote control apparatus, parts and accessories thereof; retail services in relation to software, including teaching software; providing access to web-based software and cloud software; providing software licences; teaching equipment, including equipment for school technology and computer laboratories; computer apparatus, peripherals and accessories*. The applicant claims that use of the proprietor's mark would be contrary to the law of passing off.

6. The proprietor filed a counterstatement denying the claims made and putting the applicant to proof of use for the goods claimed.

7. The proprietor is represented by Cooley (UK) LLP; whilst the applicant is represented by WP Thompson.

8. Only the applicant filed evidence in these proceedings. No hearing was requested and only the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

Relevance of EU Law

9. 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.

EVIDENCE

10. The applicant's evidence came in the form of a witness statement from Amit Khajanchi with exhibits IM1 – IM11. Mr Khajanchi is the Head of Operations and Compliance at the applicant's company, and his witness statement is dated 27 June 2024.

11. I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

12. Sections 5(2)(a), 5(3) and 5(4)(a) have application in invalidation proceedings pursuant to Section 47 of the Act. Section 47 reads as follows:

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

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

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

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

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

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

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

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

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

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

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

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

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive

to support a finding of likelihood of confusion within the meaning of section 5(2);

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

(3) [...]

(4) [...]

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

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

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

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

14. As the earlier mark is a comparable mark, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9.— (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 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 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union”.

Section 5(2)(a)

15. Section 5(2)(a) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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”.

16. The trade mark upon which the applicant relies clearly qualifies as an earlier trade mark pursuant to Section 6 of the Act. For the purpose of the present invalidation, as the mark relied upon had been registered for more than five years prior to the application for invalidity, it is subject to the proof of use provisions set out in Section 47(2A)-(2H) of the Act.

Proof of Use

17. I have already set out the proof of use provisions as they relate to invalidation applications. Pursuant to Section 47 of the Act, there are two relevant periods: the five-year period ending with the date of the application for the declaration of invalidity (27 June 2018 to 26 June 2023) and the five-year period ending with the filing date of the application for the contested mark (07 November 2013 to 06 November 2018).

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(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]; *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. Proven use of a mark which fails to establish *that “the commercial exploitation of the mark 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.

20. I take the following from the applicant’ evidence:

21. Mr Khajanchi says that the applicant has been using its earlier mark V7 in relation to the sale of the relevant products in the UK since 2007. He explains that as part of the package related to the sale of products requiring software, the applicant provides

software, software licences and user manuals. Mr Khajanchi says that the earlier mark appears on the goods manufactured and sold by the applicant, their packaging and instruction manuals, as well as on all paper documents which accompany their sale. It also appears in advertisements and sponsored events, as well as on the applicant's websites.

22. In support of this evidence, Mr Khajanchi provides the following:

A. *Selected pages of catalogues and brochures*²

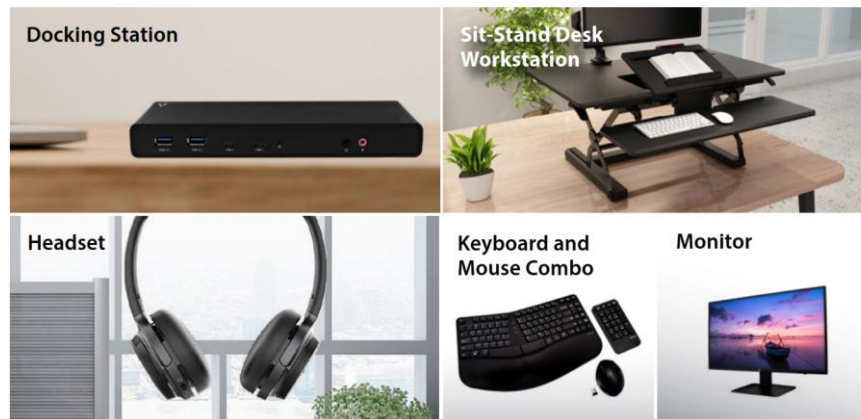
Along with selected pages of undated catalogues and brochures for goods sold under the earlier trade mark, Mr Khajanchi provides a very helpful summary of the goods advertised for sales as shown below:

Page	Catalogue	Specific year	Relevant goods advertised for sale
1	Business Solutions	2021	Docking stations, headsets, keyboards, mice, monitors, Interactive Flat Panel computers (IFPs) and related software, pointer and input devices, cables, mounts, bags, sleeves, audio headsets, webcams, privacy filters
8	Cables and adapters	2023	Data, audio, video, ethernet cables and adapters
16	Laptop bags	2021	Bags and sleeves for laptops and accessories
20	Education solutions	2023	Docking stations, headsets, keyboards, mice, monitors, Interactive Flat Panel computers (IFPs) and related software, pointer and input devices, cables, mounts, bags, sleeves, audio headsets, webcams, privacy filters, charge carts
25	Laptop bags	2021	Bags and sleeves for laptops and accessories
27	Monitor mounts	2023	Monitor mounts and stands
32	Monitors	2022	Desk and portable monitors
36	Racks	2022	Racks for electronic equipment
40	Education solutions	2022	Docking stations, headsets, keyboards, mice, monitors, Interactive Flat Panel computers (IFPs) and related software, pointer and input devices, cables, mounts, bags, sleeves, audio headsets, webcams, privacy filters, charge carts
49	Wall mounts & TV carts	2023	Monitor and TV mounts
52	Chromebook computer accessories	2023	Headsets, mice and electronic pens

² IM4

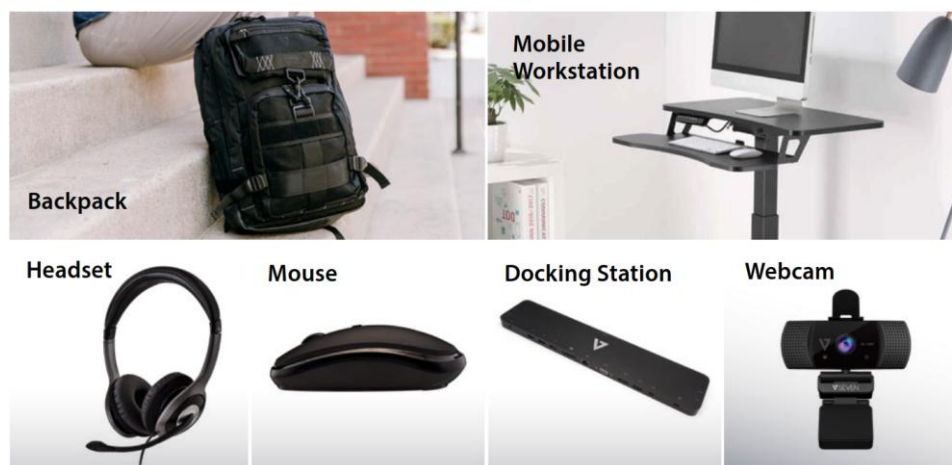
The goods are advertised as “*well-designed equipment for office rooms, workspaces, conference rooms and other environments, as well as remote work, business travel, and standing or seated workplaces*”. Examples of these types of goods as they appear on the catalogues and brochures are shown below:

All the Ingredients for Maximum Productivity



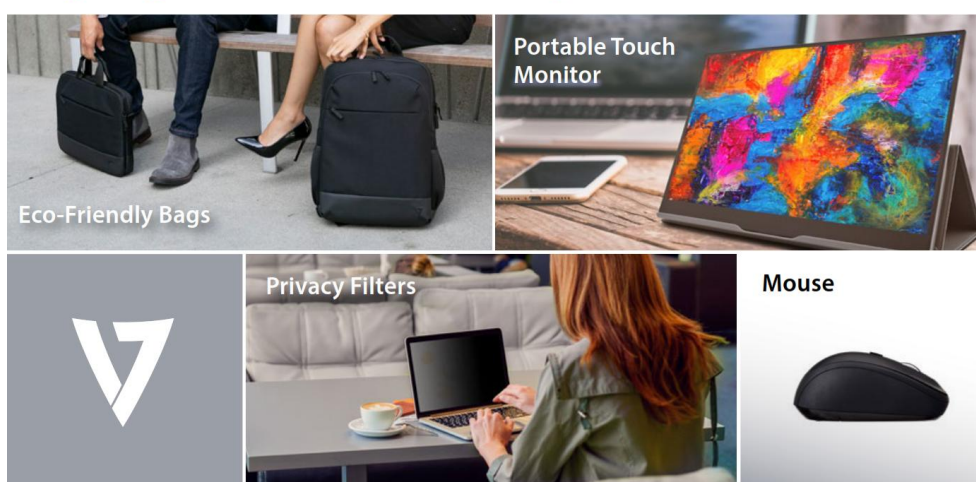
Other goods are advertised as follows: “*V7 provides solutions that help improve connectivity to remote colleagues as well as access to data and resources, plus tools to make any workplace healthier and more ergonomically efficient*”. Examples of these types of goods as they appear on the catalogues and brochures are shown below:

Tools to Get Up and Running in any Remote Setting



Other goods are advertised as follows: “V7 delivers everything it takes to stay on the go, without interruption. We offer a wide range of professional digital solutions that encourage greater interactivity along with accessories that provide the flexibility, reliability, and portability that travellers depend on, at down-to-earth prices”. Examples of these types of goods as they appear on the catalogues and brochures are shown below:

Everything Travelers Need to Boot Up and Go



Other goods are advertised as follows: “Classroom solution”, Remote Learning solution” and “Tech Lab Solution” . Examples of these types of goods as they appear on the catalogues and brochures are shown below:

Big Upgrade Ideas to Fit Any Classroom



Modern Remote Learning Tools for Any Budget



Headsets



Bags and
Carrying Case



Keyboards
and Mice



Works With
Chromebook

Upgrade and Modernize Your Tech lab



Keyboards and
Mice



Headsets



Privacy Filters



Cables/Adapters

Other goods include: (a) USB cables and adapters; (b) laptop bags; (c) Desk mounts and desk stands; (d) monitors; (e) wall mounts and TV Carts.

B. Website printouts from the applicant's website as well as from the websites of retailers who sold the applicant's goods.³

This evidence shows that (a) the applicant's website incorporates the mark V7 in the URL and (b) most of the applicant's retailers sell the applicant's goods through Amazon UK (c) between 1 March 2016 and 1 October 2023 the applicant's website had 73,000 UK sessions – which I understand is the total number of visits from the UK.

C. Samples of advertising in the UK in the relevant period.

³ IM5-6

The applicant also provides marketing figures for the years 2019-2023 amounting to thousands of US dollars, however, it is not clear whether these are global figures or UK figures.

D. *Samples of consumer reviews for the applicant's V7 products.*⁴

E. *Product lists from 2008 and 2012.*⁵

The product lists include the following categories of goods: bags, GPS, LCD monitors, wall mounts, cables, batteries, toner, surge/UPS, keyboards, mice, speakers, external HD, headset, USB Hubs, memory storing devices, webcam, network and internet related goods, digital picture frames, projectors, LCD TV, connected devices, personal media player, digital video camera, portable DVD player, and digital camera.

23. Mr Khajanchi further states that at the filing date of the contested mark, 06 November 2018, there was a well-established and widespread client base for the applicant's V7 products in the UK, with over 1,000 UK resellers.

24. Mr Khajanchi says that the applicant sold the relevant goods in the UK through more than 1,300 authorised retailers, including Amazon UK, Insight UK and CDW UK. As of January 2023, UK authorised resellers were 1,365.

25. Mr Khajanchi provides the following sales figures which, he says, relate to the goods claimed and were sold in the UK in the period 2018-2023 and 2015-2018:

2018-2023:

⁴ IM9

⁵ IM11

Sum of Sales (currency: USD)	Year						
	2018	2019	2020	2021	2022	2023	Grand Total
Access Points	\$2,061.83						\$2,061.83
Bags [carrier bags and carrier cases for notebooks]	\$129,982.02	\$217,704.73	\$471,408.00	\$719,079.13	\$389,436.53	\$217,384.41	\$2,144,994.81
Cables	\$149,224.08	\$195,695.36	\$304,695.31	\$352,240.20	\$486,305.65	\$365,421.59	\$1,853,582.18
Charge Carts [chargers for PCs and notebooks]	\$2,298.37	\$19,833.34	\$84,438.05	\$50,120.54	\$204,043.98	\$230,060.77	\$590,795.05
Display Filters	\$230,463.05	\$387,602.17	\$122,650.20	\$153,152.80	\$120,887.14	\$84,863.27	\$1,099,618.62
Docking	\$141,396.43	\$201,960.29	\$213,647.87	\$474,587.83	\$276,597.57	\$164,928.77	\$1,473,118.76
DRAM (Dynamic Random Access Memory modules for computers)	\$613,639.83	\$170,977.30	\$96,024.20	\$136,091.37	\$51,711.46	\$42,277.15	\$1,110,721.30
Headsets	\$381,905.03	\$372,976.25	\$603,055.88	\$586,584.76	\$470,791.72	\$430,657.65	\$2,845,971.29
IFP [Interactive Flat Panels – computers]				\$7,460.88	\$26,018.21	\$150,081.90	\$183,561.00
Keyboards	\$254,721.81	\$336,538.50	\$819,107.44	\$1,102,354.90	\$838,376.86	\$502,528.28	\$3,853,627.78
Mice	\$136,953.84	\$125,283.14	\$245,553.11	\$392,671.20	\$258,734.29	\$230,626.29	\$1,389,821.88
Monitors	\$426,324.73	\$505,532.01	\$511,712.04	\$229,364.61	\$927,385.47	\$473,081.30	\$3,073,400.16

Mounts [for computers, monitors and their accessories]	\$73,485.69	\$141,175.17	\$101,993.17	\$175,198.32	\$323,267.96	\$173,449.73	\$988,570.05
Networking [cards and accessories]	\$6,512.99	\$10.59					\$6,523.58
Notebook Batteries	\$10,373.10	\$16,436.44	\$10,862.19	\$17,170.42	\$43,453.96	\$53,235.42	\$151,531.52
Power Chargers	\$98,983.00	\$21,141.25	\$3,657.10		\$792.04	\$1,036.14	\$125,609.53
Projector Lamps	\$80,180.83	\$49,590.34	\$1,997.34				\$131,768.51
Racks [for computers, monitors and their accessories]	\$12,493.54	\$11,907.54	\$14,553.74	\$10,664.00	\$27,563.48	\$8,849.30	\$86,031.61
Security Locks	\$36,783.54	\$14,610.40	\$9,388.39	\$8,777.06			\$69,559.39
Speakers	\$6,998.50	\$12,744.86	\$29,251.05	\$14,153.20	\$15,833.95	\$10,639.51	\$89,621.07
Storage [data storage devices]	\$287,701.60	\$118,234.17	\$97,382.44	\$69,339.51	\$32,038.64	\$18,000.68	\$622,697.03
Stylus [pens for digital notepads]					\$145.15	\$108.15	\$253.30
Surge [power surge protectors]	\$2,301.55	\$3,407.34	\$4,408.03	\$11,557.67	\$4,277.10	\$3,669.81	\$29,621.50
UPS [Uninterruptible Power Supply devices]	\$64,295.44	\$93,766.57	\$69,211.57	\$68,743.20	\$92,435.34	\$93,273.03	\$481,725.17
UPS Batteries			\$47.10	\$24,872.75	\$28,178.72	\$21,073.72	\$74,172.28
Warranty	\$75.25						\$75.25
Webcam	\$250.93				\$5,325.53	\$12,146.43	\$17,722.90
Grand Total	\$3,149,406.97	\$3,017,127.76	\$3,815,044.24	\$4,604,184.32	\$4,623,600.75	\$3,287,393.30	\$22,496,757.34

2015-2018:

Sum of Sales		Year		
Category	2015 (GBP)	2016 (GBP)	2017 (GBP)	2018 (USD)
Access Points			GBP 1793.61	USD2,061.83
Bags [carrier bags and carrier cases for notebooks]	GBP 152,414.97	GBP 80,279.74	GBP 42,537.41	USD 129,982.02
Cables	GBP 183,375.07	GBP 135,278.60	GBP 126,120.04	USD 149,224.08
Charge Carts [chargers for PCs and notebooks]				USD 2,298.37
Display Filters	GBP 52,037.22	GBP 50,162.97	GBP 80,110.25	USD 230,463.05
Docking	GBP 17,425.64	GBP 7,524.97	GBP 36,875.35	USD 141,396.43
DRAM (Dynamic Random Access Memory modules for computers)	GBP 32,598.89	GBP 15,994.65	GBP 317,790.88	USD 613,639.83
Headsets	GBP 134,449.32	GBP 105,811.89	GBP 168,072.86	USD 381,905.03
Keyboards	GBP 151,667.09	GBP 103,656.93	GBP 155,388.98	USD 254,721.81
Mice	GBP 120,329.70	GBP 83,791.43	GBP 90,134.97	USD 136,953.84
Monitors	GBP 324,687.13	GBP 274,926.74	GBP 482,218.12	USD 426,324.73
Mounts [for computers, monitors and their accessories]	GBP 6,662.89	GBP 19,102.09	GBP 47,043.80	USD 73,485.69
Networking [cards and accessories]		GBP 1,566.55	GBP 29,117.16	USD 6,512.99
Notebook Batteries	GBP 16,658.07	GBP 17,384.83	GBP 14,313.65	USD 10,373.10
Power Chargers	GBP 11,989.03	GBP 14,069.70	GBP 18,014.87	USD 98,983.00
Projector Lamps	GBP 9,718.20	GBP 11,500.13	GBP 40,891.68	USD 80,180.83
Racks [for computers, monitors and their accessories]		GBP 841.21	GBP 6,890.86	USD 12,493.54
Security Locks	GBP 45,216.39	GBP 31,216.40	GBP 15,144.59	USD 36,783.54
Speakers	GBP 8,608.18	GBP 7,064.81	GBP 3,549.16	USD 6,998.50
Storage [data storage devices]	GBP 51,016.38	GBP 46,608.96	GBP 182,867.07	USD 287,701.60
Stylus [pens for digital notepads]	GBP 1,898.64	GBP 260.39		
Surge [power surge protectors]	GBP 531.08	GBP 2,817.09	GBP 857.79	USD 2,301.55
UPS [Uninterruptible Power Supply devices]			GBP 18,013.51	USD 64,295.44
Warranty	GBP 9,470.89	GBP 1,016.52	GBP 1,155.66	USD 75.25
Webcam	GBP 12,341.48	GBP 4,385.73	GBP 3,067.00	USD 250.93
Yearly Total	GBP 1,343,096.24	GBP 1,015,058.44	GBP 1,882,016.69	\$3,149,406.97
Grand total (at current exchange rates)	GBP 6,731,131.82 / USD 8,510,401.46			

26. Between 2015 and 2018, the applicant's UK sales for relevant V7 products amounted to over GBP 6.7 million. Between 2018 and 2023, the applicant's UK sales for relevant V7 products amounted to over USD 22.4million.

27. Lastly, the applicant issued more than 35,000 invoices for the sale of relevant goods under the mark V7 in the UK in each of the relevant years. Sample invoices are provided.⁶

⁶ IM3

Assessment of genuine use

28. There are plenty of examples of use of the mark 'V7' in the evidence filed by the applicant. Although the mark 'V7' does not appear on the invoices, it is not fatal because the goods are identified by product codes. Further, whilst the evidence shows use of a logo mark incorporating the element V7, this does not take away from the fact that there is also sufficient use of V7 as a word mark. Hence, there are no issues as to the use of the mark as registered.

29. It is also clear that the applicant runs a successful business in the UK as a manufacturer and seller of IT related goods under the earlier mark. This is demonstrated by the healthy turnover figures which total over USD 30million in the period 2015-2023 – most of which falls within the two relevant periods of 7 November 2013 to 06 November 2018 and 27 June 2018 to 26 June 2023. This conclusion is further supported by the evidence about the customer reviews, as well as by the catalogues and brochures; although the latter are undated, it is not fatal because they show the same goods as those indicated in the product lists for 2008-2012 and in the turnover (which is helpfully broken down by product) indicating continuity of use in respect of the same goods from 2008 until 2023.

30. Taking the above evidence into account, it seems to me that there has plainly been genuine use of the earlier mark in relation to the provision of various goods in class 9.

31. Whilst the applicant's goods might be supplied with manuals and operating instructions, they are part and parcel of the providing of information technology goods serving the purpose of (i) providing clear and concise instructions on how to use the products effectively, (ii) empowering users to resolve issues independently and (iii) equipping users with the knowledge they need to maximize the functionality of the products. Accordingly, the applicant providing manuals and operating instructions for their own goods does not amount to trading in manuals and operating instructions with a view of maintaining or creating a share in the market for these goods. As such, I find that there has been no commercial exploitation of the mark in relation to the goods in class 16 and the applicant cannot rely on them.

32. Turning to the goods in class 9, I bear in mind that the goods upon which the applicant might rely must survive both proof of use periods.

Fair specification

33. Whilst the evidence suggests that the earlier mark has been used in relation to goods other than those listed in the turnover figures, in particular IFP computers and related software, (i) the evidence is not clear as to whether the UK is the only market in which the applicant trades, hence, unless the goods are those listed in the turnover figures, I am not prepared to assume that they were goods marketed and sold in the UK and (ii) genuine use must relate to the registered goods (which does not include software), consequently, in framing a fair specification, I am limited by the categories of goods for which the earlier mark is protected. Accordingly, I consider that based on the registered specification and the goods to which the turnover figures relate, and taking into account that 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,⁷ the evidence warrants the applicant relying on the following terms in its specification:

- *Computers, in particular notebooks, servers and personal computers, and parts therefor.* The applicant's term cover broadly computers and parts of computers, as the words 'in particular' indicates that the goods which follow are not an exhaustive list. Whilst the evidence indicates that the applicant has sold and advertised Flat Panel Computers and related software during the years 2021, 2022 and 2023 (which fall within the most recent relevant period), there is no indication of such goods being sold or advertised in the UK during the earliest relevant period (as the first sales took place in 2021). Hence, the applicant cannot rely on computers. However, in both periods the applicant has sold parts of computers, including monitors, chargers for computers, dynamic random-access memory for computers (this is the main memory used by computers), and networking cards (these goods allow computes to connect to a network

⁷ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) and *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834

and can be internal components of computers). Accordingly, the applicant can rely on the term “*parts of computers*”. In this connection, given the breadth of goods for which use has been shown, to narrow the specification down any further would be unfairly restrictive.

- *Data input, data output, data duplication, data transfer and data storage devices, in particular keyboards, screens, projectors, printers, plotters, scanners, joysticks, mouse input devices, storage drives and storage, and media therefor, CD-ROM disk drives, network cards, graphics and sound cards, modems, modem cards and ISDN plug-in cards and housings for loudspeakers for computers and power supplies therefor.* The applicant has sold many goods falling within these listed, including keyboards, mice, power chargers, network cards, and data storage devices during both relevant periods. Accordingly, the applicant can rely on this term.
- *Batteries; Cables; In particular computer connection cables and connection cables for notebooks, servers and personal computers, screens, loudspeakers, scanners, printers, keyboards, projectors, plotters, joysticks, mouse input devices, televisions and navigation apparatus.* The applicant has sold cables and batteries for computers and computers accessories during both relevant periods. Accordingly, the applicant can rely on this term, however, I think it is appropriate to restrict it to *Batteries; Cables for computers and computers accessories.*
- *PC loudspeakers and multimedia loudspeakers.* The applicant has sold speakers during both relevant periods. Accordingly, the applicant can rely on this term.
- *Electronic safety locking devices, electronic security locks and electronic filters for personal data.* The applicant has sold security locks during both relevant periods. Accordingly, the applicant can rely on this term.

- Networking accessories, In particular electric switches, USB HUBs. The applicant has sold networking accessories during both relevant periods. Accordingly, the applicant can rely on this term.
- Laser pointers, headsets, headphones, web cameras, USB flash and data storage products, in particular electronic storage media, including memory cards, flash memories, USB flash drives, SD memory cards, flash memory cards. The applicant has sold many goods falling within these listed, including data storage devices during both relevant periods. Accordingly, the applicant can rely on this term.
- Carrying bags for notebooks. The applicant has sold those goods during both relevant periods. Accordingly, the applicant can rely on this term.

34. There is no evidence of use in relation to any of the other terms relied upon by the applicant. With this in mind, a fair specification will include (at least) the following:

Class 9: *Parts of computers; Data input, data output, data duplication, data transfer and data storage devices, in particular keyboards, screens, projectors, printers, plotters, scanners, joysticks, mouse input devices, storage drives and storage, and media therefor, CD-ROM disk drives, network cards, graphics and sound cards, modems, modem cards and ISDN plug-in cards and housings for loudspeakers for computers and power supplies therefor; Batteries; Cables for computers and computers accessories; PC loudspeakers and multimedia loudspeakers; Electronic safety locking devices, electronic security locks and electronic filters for personal data; Networking accessories, In particular electric switches, USB HUBs; Laser pointers, headsets, headphones, web cameras, USB flash and data storage products, in particular electronic storage media, including memory cards, flash memories, USB flash drives, SD memory cards, flash memory cards; Carrying bags for notebooks.*

Section 5(2)(a) - case-law

35. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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; and

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

Comparison of goods

36. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

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

38. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“[...] 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.”

39. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that the responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC

noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

40. Whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

41. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

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

42. The competing goods and services are as follows:

The proprietor's goods	The applicant's goods
Class 9: Software; Software applications; Software applications for mobile devices; Software applications for use with mobile devices; Artificial intelligence software; Laboratory instruments [other than for medical use]; Laboratory robots; Character recognition apparatus; Character recognition software; Facial recognition apparatus;	Class 9: Parts of computers; Data input, data output, data duplication, data transfer and data storage devices, in particular keyboards, screens, projectors, printers, plotters, scanners, joysticks, mouse input devices, storage drives and storage, and media therefor, CD-ROM disk drives, network cards, graphics and sound cards, modems,

<i>Gesture recognition software; Image recognition software; Optical character recognition apparatus [OCR]; Speech recognition software.</i>	<i>modem cards and ISDN plug-in cards and housings for loudspeakers for computers and power supplies therefor; Batteries; Cables for computers and computers accessories; PC loudspeakers and multimedia loudspeakers; Electronic safety locking devices, electronic security locks and electronic filters for personal data; Networking accessories, In particular electric switches, USB HUBs; Laser pointers, headsets, headphones, web cameras, USB flash and data storage products, in particular electronic storage media, including memory cards, flash memories, USB flash drives, SD memory cards, flash memory cards; Carrying bags for notebooks.</i>
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43. The applicant argues that the earlier goods are normally used with software applications and, as such, are complementary with the contested software goods. In particular, the applicant argues that the contested software is required to operate and control the earlier devices or to enhance their features.

44. In addition, the applicant argues that:

- (i) The goods claimed in the earlier registration are often used along with software applications for mobile devices, which allow control of a device from a mobile, e.g. a smartphone.
- (ii) Artificial intelligence software can be used, and is often used, for the purpose of controlling or enhancing an electronic device or its components.

- (iii) The goods claimed in the later registration cover instruments and robots used in any laboratory, including tech labs. Laboratory instruments include electronic devices and their accessories and/or they are used in connection with electronic devices and their accessories, such as those claimed in the earlier registration in class 9.

45. In support of these arguments, the applicant relies on exhibit IM10. This exhibit shows that some of the goods sold by the applicant, including UPS (Uninterruptable power supply devices) and interactive flat panels are used along with software. Further, the applicant relies on exhibit IM4, which includes examples of use of the cancellation applicant's goods in tech labs as shown below:

Solutions for Modern Learning

It's time to bring your classroom, tech lab or remote learning space up to date. Turn to V7 solutions for fast deployment, reliable computer peripherals and accessories to complete your distance learning and virtual instruction programs without straining the budget.

46. The applicant argues that the goods have the same nature, users, use, trade channels and/or they are complementary. It also states that the proprietor's goods include apparatus and software for the recognition of characters, faces, gestures, images and speech which are often used in connection with electronic devices and equipment (such as the applicant's computers, digital cameras and computer peripherals) in business and educational contexts, e.g. to process files such as pdf files or images/videos obtained through digital cameras. Lastly, the applicant relies on exhibit IM4 insofar as it shows examples of use of the applicant's goods along with software and apparatus such as the proprietor's ones, for example software applications used with the cancellation applicant's IFP computers, and software used with the cancellation applicant's digital cameras. According to the applicant, the goods concerned are complementary and have the same users and trade channels, as they are often made, sold and/or licensed by the same company.

47. I agree with the applicant that many of the proprietor's goods which are items of hardware, hardware devices, computer parts and/or computer accessories, operate

with the help of software. For example, a network card allows the operating system and the software to send and receive data over a network, if you type something on the keyboard, software processes it and it appears on the monitor, data duplication is mainly done by a software application, etc. Although the goods have a different nature and purpose, they target the same users, are highly complementary and are distributed through the same trade channels. Accordingly, I find that the proprietor's Software; Software applications are similar to the applicant's goods to a medium degree.

48. The same conclusion applies to the proprietor's Software applications for mobile devices; Software applications for use with mobile devices. Although some of the applicant's goods are for computers as opposed to mobiles, others are not. For example, the proprietor's mobile phone's operating system/software control how the applicant's memory card (which is a term unrestricted and includes memory cards for mobile phones) is read and written. Similarly, the applicant's headphones do not normally need their own software just to produce sound, but Bluetooth headphones might use one of the proprietor's mobile apps to function. These goods are similar to a medium degree.

49. I also find that there is a low to medium degree of similarity between the applicant's goods and the other software goods in the proprietor's specification namely *Artificial intelligence software; Character recognition software; Gesture recognition software; Image recognition software; Speech recognition software*. This is because, although the proprietor's software goods are specific types of software, the applicant has retained parts of computers as well as other items of hardware and computer accessories, with which the proprietor's software might be used. For example, *Character recognition software; Gesture recognition software; Image recognition software* might be used with a web camera, so that the applicant's web camera provides the visual input, while the proprietor's software analyses/interpret that input. Likewise, the proprietor's *Speech recognition software* might rely on a microphone, and the applicant's *headsets, headphones* include goods incorporating a microphone for use with *Speech recognition software*. Although the goods have a different nature and purpose, they target the same users, are highly complementary and are distributed through the same trade channels.

50. Similarly, I find that the proprietor's *Character recognition apparatus; Facial recognition apparatus; Optical character recognition apparatus [OCR]* might use a web camera as an input device. Although the goods have a different nature and purpose, they target the same users, are highly complementary and are distributed through the same trade channels. These goods are similar to a low to medium degree.

51. Lastly, *Laboratory instruments [other than for medical use]; Laboratory robots*. The closest clash I can see here is with the applicant's laser pointers, because laser pointers can be used in a lab, for example, for teaching purposes. The goods would have a similar purpose, all being for use in labs, target the same users, and be distributed through the same trade channels. Alternatively, these goods are similar to the applicant's *Parts of computers* because laboratory instruments and robots might be computerised or used with computers as part of the same system, so the goods would target the same users, be complementary and distributed through the same trade channels. I consider that these goods are similar to a low degree.

Average consumer

52. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

53. In *Iconix Luxembourg Holdings* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

54. The average consumer of the competing goods is a member of the general public or a business user.

55. The goods will typically be selected visually in retail outlets, catalogues and online. While I do not discount the possibility of oral selection by requests to staff, consumers are still likely to have viewed the goods before purchase. The selection process will therefore be predominantly visual.

56. Given the technical nature of the goods, but considering that they are not overly expensive, the average consumer is likely to pay a medium degree of attention when selecting them.

Comparison of marks

The contested mark	The earlier mark
V7	V7

57. Both marks are word-only marks consisting of the capital letter ‘V’ followed by the number 7. The marks are self-evidently identical.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

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

59. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, 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.

60. Starting from the inherent position, the length of signs may influence their distinctiveness. In *Kunze Folien GmbH v Kartell UK Limited*,⁸ Mr Iain Purvis KC sitting as the Appointed Person, referred with approval to the decision of *Alfa-Beta Vassilopoulos AE v Agro de Bazan*,⁹ in which the Board of Appeal considered the letters ‘AB’ in a stylised form against ‘AB’ in a different stylised form, for the same goods. The Board of Appeal stated as follows:

“As to the distinctive character of the letter combination ‘AB’ in the earlier marks and of the contested mark, [...] it should be noted that letters or letter combinations of two or three letters are inherently weak, given the limited number of letters in the alphabet, the great number of meanings that acronyms and abbreviations may have and the fact that consumers frequently encounter abbreviations and letter combinations of all kinds in everyday life and business as generic abbreviations but not as marks.”

61. Accordingly, I find that the earlier mark is not particularly distinctive because it merely consists of the two-character alphanumeric sequence ‘V7’. Nevertheless, it is neither descriptive nor allusive for the goods at issue. Overall, I consider the distinctive character of the mark to be inherently low.

⁸ BL-O-085-14

⁹ Case R 82/2011-4 of the Board of Appeal of OHIM (now the EUIPO), paragraph 16

62. Turning to the evidence of use, whilst the evidence indicates a well-established business that has been operating in the UK for around 10 years prior to the relevant date of 06 November 2018 and has generated approximately £6.7million prior to the relevant date, the major increase in sales shown in the evidence occurred between 2018 and 2023 with the figures bumping up to over USD 22million. Hence, prior to the relevant date, the turnover generated under the earlier mark is not particularly remarkable. In addition, as I have noted above, it is not clear whether the marketing figures relate to the UK only, but in any event, they are given only for the years 2019-2023 which is after the relevant date. Accordingly, I consider that the evidence filed is not sufficient to establish that the distinctiveness of the earlier mark has been enhanced to any material extent in the UK.

Likelihood of confusion

63. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

64. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., 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, 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)."

65. In BL-O/382/16, *CALEDONIAN*, Professor Phillip Johnson, sitting as the Appointed Person, stated as follows:

"There are two sorts of confusion: direct confusion and indirect confusion. In relation to confusion stemming from a comparison of marks the distinction was explained by Ian Purvis QC, sitting as the Appointed Person, in *LA Sugar v By Back Beat* (O/375/10) at paragraph 14. However, the principles of direct and indirect confusion are not confined to the comparison of marks, but extend to the overall global comparison. Direct confusion is where the average consumer simply believes, with "no process of reasoning", that the goods sold under the

mark in front of them come from the same undertaking as the goods bearing a similar (or identical) earlier mark which they imperfectly recollect. Indirect confusion, on the other hand, is where the average consumer sees the marks on the particular goods and assumes that the common elements (be they in the mark or the similarity of the goods) mean that there is a connection – an economic link – between the undertaking selling the goods in front of them and the undertaking they imperfectly remember selling goods under the earlier mark. So for example, the consumer will say to themselves: “I know that I have never seen X selling lager before, but I know they sell cider, and so it makes sense that X has extended its brand to some new similar product like lager.

Direct confusion is unlikely to arise where the goods are not identical or close to being so.....”

66. Earlier in this decision I found that:

- The marks are identical.
- The parties’ goods are similar to a low, low to medium, or medium degree.
- The average consumer is a member of the general public who will select the goods mainly visually, with a medium degree of attention.
- The earlier mark is inherently distinctive to a low degree.

67. Bearing in mind the interdependency principle, and in particular, the identity of the marks and the similarity of the goods, I consider that the low degree of distinctive character of the earlier mark is not sufficient to avoid confusion. Indeed, as Professor Johnson commented in *CALEDONIAN*, the fact that the goods are sufficiently different for the consumers to become aware of both products only means that there cannot be direct confusion. However, I am of the view that the consumer having seen the identical mark ‘V7’ on the parties’ goods in class 9 they will perceive the goods as coming from

the same or economically linked undertakings, attributing the identity of the marks to economic connection, not to coincidence.

68. There is a likelihood of confusion.

Section 5(3)

69. I can deal with this ground very briefly. I have already commented on the applicant's evidence and said that it is not sufficient to establish enhanced distinctiveness, which refers to an increased recognition and capacity of a trade mark to identify the goods or services for which it is registered as coming from a particular undertaking as a result of extensive use. Whilst reputation and enhanced distinctiveness are different concepts, they are closely related and their assessment is based on the same factors. For the same reasons as those I have outlined above, I find that the applicant's evidence does not establish that the earlier mark benefits from reputation and the ground under Section 5(3) fails at the first hurdle.

Section 5(4)(a)

70. Likewise, I can deal with this ground very briefly. Theoretically, this ground provides a better case for the applicant because it relies on a range of software goods which would be closer to the proprietor's software goods compared to the hardware goods the applicant relies upon under Section 5(2)(a). However, the relevant date for the purpose of assessing this ground is 06 November 2018, and as I have noted above, the only sale of software by the applicant (as shown by the turnover figures) relates to the software connected with the sale of Flat Panel Computers during the years 2021, 2022 and 2023, which is after the relevant date. Insofar as the applicant's evidence establishes a protectable goodwill at the relevant date, it would more or less relate to the same goods for which I have found genuine use, which means that the outcome of the Section 5(4)(a) would be the same as that of the Section 5(2)(a).¹⁰

¹⁰ *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41

OUTCOME

71. The application for invalidity is successful, and the proprietor's mark will be cancelled ab initio.

COSTS

72. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the sum of £1,600 calculated as follows:

Preparing application and considering the counterstatement:	£300
Filing evidence:	£800
Submissions in lieu:	£300
Official fees:	£200
Total:	£1,600

73. I therefore order V7 Ltd to pay Ingram Micro Inc. the sum of £1,600. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of September 2026

TERESA PINTO
For the Registrar