

O/1060/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003940396
IN THE NAME OF CROSS-BORDER CLOUD (SHENZHEN) TECHNOLOGY CO.,
LTD

FOR THE FOLLOWING TRADE MARK:

CustomSolo

IN CLASSES 11 AND 20

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 445324 BY
ONE-LUX LIMITED

BACKGROUND AND PLEADINGS

1. On 1 August 2023, Cross-Border Cloud (Shenzhen) Technology Co., Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 20 October 2023, and registration is sought for the following goods:

Class 11 Stage lighting apparatus; Light bulbs; Electric light bulbs; Electric lamps; Lamps; Incandescent lamps; Discharge tubes, electric, for lighting; Sockets for electric lights; Filaments for electric lamps; Flares; Chinese lanterns; Fairy lights for festive decoration; Luminous tubes for lighting; Magnesium filaments for lighting; Electric lights for Christmas trees; Luminous house numbers; Light-emitting diodes [LED] lighting apparatus; Fluorescent lamp tubes.

Class 20 Furniture of metal; Boxes of wood or plastic; Keyboards for hanging keys; Mouldings for picture frames; Moldings [mouldings] for picture frames; Picture frames; Bamboo baskets for industrial purposes; Cold cast resin figurines; Mobiles [decoration]; Wind chimes [decoration]; Display boards; Placards of wood or plastics; House numbers, not of metal, non-luminous; Signboards of wood or plastics; Funerary urns; Non-metal clothes hooks; Picture and photograph frames; Statues of wood, wax, plaster or plastic; Figurines [statuettes] of wood, wax, plaster or plastic; Works of art of cork; Figurines of resin.

2. On 16 January 2024, the application was partially opposed by One-Lux Limited (“the opponent”) based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at the class 11 goods in the application only. Under section 5(2)(b) of the Act, the opponent relies upon the following trade mark:¹

¹ The opponent also originally relied upon UKTM no. 3684303, but this application was withdrawn on 10 January 2025.

ONE-LED SOLO/ One-Led Solo (series of 2)

UKTM no. 3684300

Class 11 Lighting and emergency lighting components; luminaries for emergency use; emergency lighting; emergency lighting apparatus and installations; parts and fittings for emergency lighting.

3. The earlier mark was filed on 20 August 2021 and is not yet registered. The opponent relies upon all goods in the earlier mark's specification.

4. The opponent claims that the marks are similar, and the goods are identical or similar, with the result that there is a likelihood of confusion.

5. Under section 5(4)(a) of the Act, the opponent relies upon the signs ONE-LED SOLO, One-Led Solo and SOLO which it claims to have used throughout the UK since 2014 in relation to "emergency lighting components; luminaries for emergency use; emergency lighting; emergency lighting apparatus and installations; parts and fittings for emergency lighting." The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

6. The applicant filed a counterstatement denying the grounds of opposition.

7. Neither party requested a hearing, and neither filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

REPRESENTATION

8. The applicant is represented by Axis Professionals Ltd.

9. The opponent is represented by Swindell & Pearson Limited.

EVIDENCE AND SUBMISSIONS

10. The opponent filed evidence in chief in the form of the witness statement of Glynnis Murray dated 17 June 2024, which is accompanied by 26 exhibits (Exhibits GM1 to GM26). Ms Murray is the Managing Director of the opponent, a position she has held since 1 October 2008.

11. The opponent's evidence was accompanied by written submissions dated 17 June 2024.

12. The applicant filed evidence in the form of the witness statement of Yingbo Xu dated 21 August 2024, which is accompanied by 3 exhibits (Exhibits 1 to 3). Mr Xu is the Director of the applicant, a position he has held since 2013.

13. The opponent filed submissions in reply dated 10 October 2024.

RELEVANCE OF EU LAW

14. 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.

DECISION

Section 5(2)(b)

15. Section 5(2)(b) of the Act 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.”

16. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

17. Given its filing date, the mark relied upon by the opponent qualifies as an earlier mark pursuant to section 6 of the Act. However, as it has not yet completed its registration process, it is not subject to the use provisions of section 6A of the Act. The opponent can, therefore, rely upon all of the goods identified.

18. The following principles 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 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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

Comparison of goods

19. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><u>Class 11</u> Lighting and emergency lighting components; luminaries for emergency use; emergency lighting; emergency lighting apparatus and installations; parts and fittings for emergency lighting.</p>	<p><u>Class 11</u> Stage lighting apparatus; Light bulbs; Electric light bulbs; Electric lamps; Lamps; Incandescent lamps; Discharge tubes, electric, for lighting; Sockets for electric lights; Filaments for electric lamps; Flares; Chinese lanterns; Fairy lights for festive decoration; Luminous tubes for lighting; Magnesium filaments for lighting; Electric lights for Christmas trees; Luminous house numbers; Light-emitting diodes [LED] lighting apparatus; Fluorescent lamp tubes.</p>

20. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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.”

21. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

Light bulbs; Electric light bulbs; Discharge tubes, electric, for lighting; Sockets for electric lights; Filaments for electric lamps; Luminous tubes for lighting; Magnesium filaments for lighting; Fluorescent lamp tubes.

22. The earlier mark's specification includes the term "lighting and emergency lighting components". This will, in my view, include components for both emergency lighting and other types of lighting. Consequently, I consider that all of the above terms, being components of lights, will fall within the wider term in the opponent's specification. As such, they are identical on the principle outlined in *Meric*.

Electric lamps; Lamps; Incandescent lamps; Fairy lights for festive decoration; Electric lights for Christmas trees; Luminous house numbers.

23. These are all types of lights, or products that contain lights. They would require the “lighting ... components” in the specification of the earlier mark in order to function. The same businesses that sell the lights, or products containing lights, would also sell the components for them (such as replacement parts, or bulbs). There is, therefore, an overlap in trade channels. Plainly, there would be an overlap in user as the same customers would buy both the finished article and replacement parts/bulbs for those products. In my view, the goods are complementary as one is important or indispensable for the other, and the average consumer would consider the same undertaking to be responsible for both.² I consider the goods to be similar to a medium degree.

Stage lighting apparatus; Light-emitting diodes [LED] lighting apparatus.

24. My primary finding is that some goods that would be considered “apparatus” within the above terms, such as holders or structures that support the light itself, would also be considered components of lighting, as covered by the specification of the earlier mark. Consequently, I find the goods to be identical on the principle outlined in *Meric*. If I am wrong in that finding, then the same overlap in trade channels and user would apply as discussed above, and the goods would be complementary for the same reasons. In my view, they are similar to a medium degree.

Chinese lanterns.

25. My understanding is that this term refers to a decoration which is made from thin (usually colourful) paper, with a light inside. Traditionally, Chinese lanterns would have contained a candle, but I consider it likely that such goods could also be purchased with an electric light inside. Consequently, I find that the same undertakings would supply Chinese lanterns and the lighting components within the specification of the earlier mark for use within those lanterns, to the same users. There would also be complementarity. I find these goods to be similar to “lighting components” to a medium degree.

² *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

Flares.

26. My understanding is that a flare is a small device which produces a bright flame, used to signal for help. This would fall within the term “luminaries for emergency use” in the specification of the earlier mark. Consequently, the goods are identical on the principle outlined in *Meric*.

Average consumer and the nature of the purchasing act

27. 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.

28. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

29. The average consumer for the goods would include both members of the general public and professional users. The goods are likely to vary in price and frequency of purchase. However, the average consumer will consider factors such as compatibility (for component parts/apparatus), aesthetics or functionality (for the finished lighting products) and reliability and ease of use (for flares). Consequently, I consider that at least a medium degree of attention will be paid. However, where goods such as flares

are being purchased, which are likely to be used in emergency situations, the level of attention paid may be higher.

30. The goods are likely to be purchased by self-selection from retail outlets or following perusal of signage on websites, catalogues or advertisements. Consequently, the purchasing process will be dominated by visual considerations. However, I do not discount an aural component given that advice may be sought from retail assistants/specialists.

Comparison of trade marks

31. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

32. 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.

33. The respective trade marks are shown below:

The opponent's trade mark	The applicant's trade mark
ONE-LED SOLO/ One-Led Solo (series of 2)	CustomSolo

Overall Impression

34. The applicant's mark consists of the conjoined words CustomSolo. Neither word dominates the overall impression of the mark. However, the word CUSTOM is clearly descriptive/non-distinctive for the goods, which could be custom made or customizable. Indeed, in its counterstatement the applicant appears to accept this by saying "Custom' means the products the applicant sells can be designed according to the expectations of clients". The word SOLO is, therefore, the more distinctive part of the mark.

35. The opponent's mark consists of a series of two marks. However, given that protection of a word only mark covers use of the words, not a particular form of those words, nothing will turn on the different marks within the series. Consequently, the same findings will apply to each. None of the words dominate the overall impression of the mark. However, the words "ONE-LED" are clearly descriptive/non-distinctive for goods which may contain one LED or be compatible with a product that contains one LED. Consequently, the word SOLO is the more distinctive element of the mark.

Visual Comparison

36. The marks coincide in the presence of the word SOLO. The word CUSTOM in the applicant's mark and the words ONE-LED in the opponent's mark act as points of visual difference. As explained above, the words that are points of difference are non-distinctive. I also bear in mind that the words in the applicant's mark are conjoined, whereas they are not in the opponent's mark. Taking this into account, I find there to be a medium degree of visual similarity between the marks.

Aural Comparison

37. The word SOLO will be pronounced identically in the applicant's mark and the opponent's mark. However, the words CUSTOM and ONE-LED will act as points of aural difference. In my view, the marks are aurally similar to a medium degree.

Conceptual Comparison

38. The word SOLO will have the same meaning in both the earlier mark and the applicant's mark; it is typically used to refer to someone who does something alone, rather than with other people. The words CUSTOM and ONE-LED will act as points of conceptual difference, albeit not distinctive ones. I find the marks to be conceptually similar to at least a medium degree.

Distinctive character of the earlier mark

39. 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-2779, 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).”

40. Registered trade marks possess varying degree of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

41. The earlier mark consists of a series of two marks, both containing the words ONE-LED SOLO. The words ONE-LED are descriptive/non-distinctive for the goods. They cannot, therefore, contribute to the distinctiveness of the mark. The word SOLO is not descriptive or non-distinctive for the goods. However, I recognise that it may have some mild allusion based on the fact that the goods may be used on their own. Consequently, I find the earlier mark to be inherently distinctive to between a low and medium degree.

42. The opponent has filed evidence of use of the earlier mark. Ms Murray explains that the earlier mark has been in use since 2014. I recognise that the opponent is a member of the Lighting Industry Association and Industry Committee for Emergency Lighting, which Ms Murray says is an internationally recognised authority on emergency lighting. I also recognise that the opponent is authorised to use a collective mark (Made in Britain) which is reflective of a certain quality standard. However, the quality of the opponent’s goods is not relevant to the question of whether the marks relied upon have become more distinctive to average consumers.

43. Ms Murray states that the earlier marks have been used in relation to “a light emitting diode (LED) lamp and driver kit, used primarily for emergency lighting”. There are examples of the earlier mark in use on product packaging and in brochures.³ She has provided a sample of invoices from 2014 and 2015 which total sales of over

³ See, for example, exhibits GM4 and GM8

£34,000.⁴ They show the words SOLO and ONE-LED SOLO in the product descriptions and the goods include emergency lighting and LED lamps. Ms Murray has also provided a sample of invoices from 2021 which amount to over £69,000.⁵ Whilst they do not all refer to the mark relied upon, they do refer to “OLS”, which Ms Murray states is an abbreviation for “ONE LED SOLO”. Between 2014 and 2022, the opponent sold over 27,000 units under the SOLO and ONE-LED SOLO signs. This amounts to sales of over £680,000 during that period. The opponent’s advertising spend for its SOLO and ONE-LED SOLO products during the period 2014 to 2023 has been over £19,000. I note that Ms Murray has provided the following table, which she states “are the annual sales figures between 2012 to 2023 for the entire LED emergency lighting market in the United Kingdom”:

Year	Total Luminaire Sales	LED Luminaire Sales	% LED Luminaire Sales	Emergency Luminaire Sales	% Emergency Sales	One-LED SOLO Net Sales Value	Quantity	% Emergency market
2012	£ 220,811,358	£ 26,464,017	12%	£30,479,387	14%			
2013	£ 219,018,541	£ 46,014,836	21%	£29,577,542	14%			
2014	£242,900,786	£ 86,824,315	36%	£24,543,615	10%			
2015	£287,287,199	£ 144,433,245	50%	£24,556,777	9%			
2016	£ 479,869,498	£ 365,211,147	76%	£35,322,030	7%			
2017	£508,806,475	£ 396,688,799	78%	£39,749,238	8%			
2018	£498,070,341	£ 418,085,411	84%	£42,113,816	8%			
2019						£81,472	4059	
2020						£70,904	2875	
2021	£ 470,571,641	£ 444,695,910	95%	£59,474,830	13%	£79,549	3011	0.134%
2022	£ 458,013,717	£ 431,426,718	94%	£60,584,435	13%	£45,541	1661	0.075%
2023	£432,608,118	£ 395,538,740	91%	£48,614,074	11%	£69,111	2567	0.142%

44. This table includes percentage figures in three columns. It may be that these relate to the opponent’s market share. However, the witness does not clarify this, and I am not convinced that I can simply assume this without further explanation.

45. I accept that use has been fairly long-standing. However, use has not been particularly intensive, there is no clear evidence regarding market share and the promotional activities undertaken seem to be on a fairly small scale. I bear in mind that the opponent’s market is likely to be smaller than others (such as typical consumer products). However, in my view, the evidence falls short of establishing that the distinctiveness of the earlier marks has been enhanced through use to a meaningful degree.

⁴ Exhibit GM11

⁵ Exhibit GM12

Likelihood of confusion

46. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods down to the responsible undertakings being the same or related. 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. The first is the interdependency principle i.e. a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

47. I have found as follows:

- a. The goods vary from being similar to a medium degree, to identical.
- b. The average consumer for the goods will include members of the general public and professional users who will pay at least a medium degree of attention when purchasing the goods, although the level of attention may be higher where the goods are intended for use in an emergency.
- c. The purchasing process will be predominantly visual, although I do not discount an aural component.
- d. The earlier mark and the applicant's mark are visually and aurally similar to a medium degree. The word SOLO will be conceptually identical in both marks,

and whilst the words CUSTOM and/or ONE-LED will act as points of conceptual difference, they are not distinctive ones.

e. The earlier mark is inherently distinctive to between a low and medium degree.

48. Given that the only distinctive element of both marks is the word SOLO, and taking into account the principle of imperfect recollection, I consider that there is a likelihood that average consumers will only recall this element. In these circumstances, the marks are likely to be mistakenly recalled or misremembered as each other, when used on goods that are similar to a medium degree or identical. Consequently, I find there to be a likelihood of direct confusion.

49. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case 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)".

50. If the elements CUSTOM and/or ONE-LED are recalled, they will be recognised as consistent with a brand extension or sub-brand. This is because they are descriptive of goods which are either custom-made or contain one-LED (or are compatible with the same). The average consumer will perceive the word SOLO as the distinctive element of all three marks; in this regard, whilst I have found this common element to be distinctive to only between a low and medium degree, it remains the most distinctive element of the marks. Consequently, there is a likelihood of indirect confusion.

51. The opposition based upon section 5(2)(b) of the Act succeeds in its entirety.

Section 5(4)(a)

52. Section 5(4)(a) of the Act states as follows:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

53. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

54. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

55. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

56. The prima facie date is the filing date of the application i.e. 1 August 2023. I note that Mr Xu gives evidence that his company has been using the applied-for mark since March 2013. In principle, this may have resulted in the need to consider an earlier relevant date. However, he does not state where the mark has been used. In this regard, I note that the exhibits provided are all listed in dollars and Exhibit 3 refers to France. It does not, therefore, appear that the use has been in the UK. Consequently, I do not find that there is an earlier relevant date to consider.

Goodwill

57. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

58. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

59. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered or passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

60. I summarised the opponent's evidence of use above. Whilst I was not satisfied that the evidence was sufficient to establish that the distinctiveness of the earlier mark had been enhanced through use, the business has clearly been trading (albeit on a relatively small scale) for a number of years. The signs relied upon have been used throughout the evidence. Taking all of this into account, I am satisfied that the opponent had a small (but protectable) goodwill at the relevant date in relation to emergency lighting and that the signs relied upon were distinctive of that goodwill.

Misrepresentation and damage

61. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] *R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in *Halsbury's Laws of England 4th Edition Vol.48 para 148* . The necessity for a substantial number is brought out also in *Saville*

Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

62. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

63. The goodwill relied upon is small, but protectable. The parties operate within the same or related fields of activity: the opponent’s goods are emergency lighting, whereas the applicant’s are either emergency related goods (such as flares) or are other types of lighting and associated goods. Given the similarities between the marks/signs and the parties’ fields of activity, I find it likely that a substantial number of members of the relevant public would be misled into purchasing the applicant’s goods in the mistaken belief that they are the goods of the opponent. Consequently, there is misrepresentation. Damage through diversion of sales is easily foreseeable.

64. The opposition based upon section 5(4)(a) of the Act is successful in its entirety.

CONCLUSION

65. The opposition is successful and, subject to any appeal, the application is refused for the following goods against which the opposition was directed:

Class 11 Stage lighting apparatus; Light bulbs; Electric light bulbs; Electric lamps; Lamps; Incandescent lamps; Discharge tubes, electric, for lighting; Sockets for electric lights; Filaments for electric lamps; Flares; Chinese lanterns; Fairy lights for festive decoration; Luminous tubes for lighting; Magnesium filaments for lighting; Electric lights for Christmas trees; Luminous house numbers; Light-emitting diodes [LED] lighting apparatus; Fluorescent lamp tubes.

66. The application may proceed to registration for the following goods which were not subject to the opposition:

Class 20 Furniture of metal; Boxes of wood or plastic; Keyboards for hanging keys; Mouldings for picture frames; Moldings [mouldings] for picture frames; Picture frames; Bamboo baskets for industrial purposes; Cold cast resin figurines; Mobiles [decoration]; Wind chimes [decoration]; Display boards; Placards of wood or plastics; House numbers, not of metal, non-luminous; Signboards of wood or plastics; Funerary urns; Non-metal clothes hooks; Picture and photograph frames; Statues of wood, wax, plaster or plastic; Figurines [statuettes] of wood, wax, plaster or plastic; Works of art of cork; Figurines of resin.

COSTS

67. The opponent 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 opponent the sum of **£1,650**, calculated as follows:

Preparing a Notice of opposition and considering the applicant's counterstatement	£400
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Preparing evidence and considering the applicant's evidence	£700
Written submissions	£350
Official fee	£200
Total	£1,650

68. I therefore order Cross-Border Cloud (Shenzhen) Technology Co., Ltd to pay One-Lux Limited the sum of **£1,650**. 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 14th day of November 2025

S WILSON
For the Registrar