O/1172/24

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 3806067
IN THE NAME OF SHENZHEN XUYONG ELECTRONIC TECHNOLOGY CO., LTD.
IN RESPECT OF THE TRADE MARK

JOYTUTUS

IN CLASS 12

AND

THE APPLICATION FOR INVALIDATION THEREOF UNDER NO. 506024
BY GUANGZHOU ISSYZONE TECHNOLOGY CO., LIMITED

AND

IN THE MATTER OF APPLICATION NO. 3896399

IN THE NAME OF GUANGZHOU ISSYZONE TECHNOLOGY CO.,LIMITED

IN RESPECT OF THE TRADE MARK

JOYTUTUS

IN CLASS 12

AND

THE CONSOLIDATED OPPOSITION THERETO UNDER NO. 441498
BY SHENZHEN XUYONG ELECTRONIC TECHNOLOGY CO., LTD.

Background and pleadings

1. Shenzhen Xuyong Electronic Technology Co., Ltd. ("SX") applied to register trade mark no. 3806067 for the mark JOYTUTUS in the UK on 5 July 2022. It was accepted and published in the Trade Marks Journal on 22 July 2022 and registered on 7 October 2022. It stands registered in respect of the following goods:

> Class 12: *Automobile windshield sunshades; Fenders for land vehicles; Interior trim parts of automobiles; Steering wheel covers for automobiles; Ashtrays for automobiles; Tire snow chains [land vehicle parts]; Vehicle seat covers; Drinks holders adapted for use in land vehicles; Cigarette lighters for cars; Fitted vehicle covers.*

2. On 21 April 2023, GUANGZHOU ISSYZONE TECHNOLOGY CO., LIMITED ("GI") applied to invalidate the above trade mark on the basis of sections 47(2)(a) and 5(2)(a), and 47(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. The application for invalidation based on section 47(2)(a) and 5(2)(a) of the Act relies on the three trade mark registrations below, which, by virtue of their earlier filing dates, all constitute earlier marks in accordance with section 6 of the Act:

> 1. JOYTUTUS
>
> UK comparable mark[1] no. 917884990
>
> Filing date: 9 April 2018
>
> Registration date: 24 August 2018
>
> Relying on all goods, namely:

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent's EUTM being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

Class 21: *Kitchen utensils; Cooking utensils, non-electric; Cleaning instruments, hand-operated; Tea services [tableware]; Coffee services [tableware]; Liqueur sets; Drinking glasses; Works of art of porcelain, ceramic, earthenware or glass; Combs; Brush goods; Hair for brushes; Material for brush-making; Toothpicks; Toothpick holders; Cosmetic utensils; Toilet cases; Oven gloves; Oven heat resistant pads; Dishwashing brushes; Glass, unworked or semi-worked, except building glass.*

Class 28: *Playing balls; Baseball balls; Racketball balls; Tennis balls; Rugby balls; Beach balls; Golf balls; Shuttlecocks; Basketballs; Table-tennis balls; Nets for ball games; Body-building apparatus; Exercisers [expanders]; Machines for physical exercises; Dumb-bells; Archery implements; Belts for weightlifting; Appliances for gymnastics; Play swimming pools; Ice skates; Athletic protective sportswear; Rods for fishing; Fish hooks; Lines for fishing; Fishing tackle; Playthings; Ornaments for Christmas trees, except illumination articles and confectionery.*

2. Joytutus

UK comparable trade mark no. 917947108

Filing date: 24 August 2018

Registration date: 9 January 2019

Relying on all goods, namely:

Class 22: *Tents; Tents for mountaineering; Tents for camping; Awnings; Hammocks; Awnings of textile; Awnings of fabric; Awnings of plastic; Eiderdown; Eiderdown feathers; Feathers for stuffing upholstery; Feathers for bedding; Tarpaulins; Glass fibers for textile use; Flock [stuffing].*

Class 24: *Sleeping bags; Travelling rugs [lap robes]; Cotton blankets; Sleeping bags [sheeting]; Fabric; Frieze; Towels of textiles; woolen cloth; jersey [fabric].*

3. Joytutus

UK trade mark no. 3556082

Filing date: 16 November 2020

Registration date: 26 March 2021

Relying on all goods, namely:

Class 25: *Clothing for cycling; Cycling shorts; Cycling shoes; Caps; Sports caps and hats; Cycling caps; Headbands against sweating; Headbands; Sport stockings; Gloves [clothing]; Driving gloves; Riding Gloves; Sports bibs; Motorcycle jackets; Cycling tops.*

4. GI argues that the respective goods are similar and that the marks are identical, and that as such there is a likelihood of confusion, including a likelihood of association between the marks. GI therefore submits the contested mark should be declared invalid in accordance with sections 47(2)(a) and 5(2)(a) of the Act.

5. GI also submits that by virtue of its use in the UK since 5 December 2019, it has goodwill in its business in relation to the goods set out below, as distinguished by the sign JOYTUTUS:

Car covers; floor mats compatible with automobiles; steering wheel eating tray; vehicle carpet; car cup holder.

6. GI argues that use of the contested mark for the goods registered by SX would result in a misrepresentation that those goods derive from GI or a related entity. GI argues that it has, or that it is likely to suffer damage as a result of this misrepresentation. It therefore argues that the contested registration should be declared invalid in accordance with sections 47(2)(b) and 5(4)(a) of the Act.

7. SX filed a counterstatement accepting that the marks are identical but denying that there is any similarity between the goods, or that the registration should be declared invalid in accordance with section 47(2)(a) and 5(2)(a) of the Act. SX also denies in its counterstatement that the GI holds goodwill in respect of the goods claimed, and denies the claims made under section 47(2)(b) and 5(4)(a) of the Act.

8. On 3 April 2023, GI applied to register the trade mark no. 3896399 for the mark JOYTUTUS in the UK. It was accepted and published in the Trade Marks Journal on 21 April 2023 in respect of the following goods:

> Class 12: *Tops [folding roofs] for vehicles; Rearview mirrors; Anti-skid chains; Bumpers for automobiles; Sun-blinds adapted for automobiles; Spare wheel covers; Ashtrays for automobiles; Bicycle kickstands; Mudguards; Bicycle handlebars; Bicycle pedals; Bicycle saddles; Saddlebags adapted for bicycles; Air pumps [vehicle accessories]; Trolleys; Portholes; Rowlocks; Air cushion vehicles; Luggage carriers for vehicles; Windshield wipers; Luggage nets for vehicles; Seat covers for vehicles; Windscreens; Covers for vehicle steering wheels; Cup holders for vehicles.*

9. On 21 June 2023, SX filed an opposition against the application based on section 5(2)(a) of the Act. The opposition is based on its earlier UK trade mark no. 3806067,[2] which is the subject of the cancellation proceedings outlined above. SX argues that the marks are identical, and that the goods are similar, and as such there exists a likelihood of confusion between the marks.

10. GI filed a counterstatement in the opposition proceedings. The statement did not deny any of the claims made by the SX against the application, instead stating "[t]he Applicant cannot deny that the trademarks in dispute are identical covering goods in class 12". GI instead highlighted the application for invalidation filed against the earlier mark, and requested that the opposition proceedings be suspended pending the outcome of the cancellation action.

11. On 19 September 2023, the Tribunal wrote to the parties, informing them that the request to suspend proceedings had been refused, and instead directing that, in accordance with Rule 62(1)(g) of the Trade Mark Rules 2008, the two matters be consolidated.

[2] By virtue of its earlier filing date, and subject to the success of the invalidation proceedings filed by SX, this mark will constitute an earlier mark in accordance with section 6 of the Act.

12. Only GI filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Neither side filed written submissions, and no hearing was requested. This decision is taken following a careful perusal of the papers.

13. Both parties are represented in these proceedings. SX is represented by Pawel Wowra. GI is represented by IBE Avocat - Isabelle Bertaux.

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.

Evidence

15. GI filed its evidence in the form of a witness statement in the name of the Isabelle Bertaux of IBE Avocats, GI's representative in these proceedings. The statement is dated 20 November 2023 and introduces one exhibit, namely Exhibit IBE01. This goes to the use of GI's mark.

Proof of use

16. The earlier mark relied upon by SX in the opposition proceedings had not been registered for a period of five years or more at the time that GI's opposed mark was filed. Further, the earlier registrations relied upon by GI in the application for invalidation filed had not been registered for a period of five years or more on the date the application to invalidate the earlier mark was made. Therefore, in accordance with sections 47(2A) and sections 6A of the Act, neither party is required to prove use of any of the earlier registrations relied upon in these proceedings.

Approach

17. If the application for the invalidation of registration no. 3806067 succeeds, the opposition based on that earlier mark will fall away. I will therefore begin by considering

the application for invalidation, and I will then proceed to consider the opposition relying on that earlier mark if it becomes necessary to do so.

Cancellation no. 506024

Section 47 of the Act

18. The relevant parts of section 47 of the Act are set out below:

> "47. (1) […]
>
> (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.
> >
> > […]
>
> (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.
> >
> > […]

(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."

Section 5(2)(a)

19. 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".

20. 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.

The principles

(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 the marks

21. It is a requirement of section 5(2)(a) that the marks are identical. The parties in this matter have agreed that the marks are identical. In any case, it is self-evident that the earlier mark JOYTUTUS is identical to the contested mark JOYTUTUS. In addition, a word mark offers protection for the mark in both uppercase and lowercase lettering, or any customary combination of the two.[3] The earlier marks Joytutus are therefore also identical to the contested mark JOYTUTUS.

Comparison of goods and services

22. 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".

23. 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;

[3] *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

(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.

24. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

25. 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 Office for Harmonization in the Internal*

*Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, the General Court ("GC") stated that there is complementarity where:

> "...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".

26. In *Gérard Meric v Office for Harmonisation in the Internal Market,* 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". With that in mind, the goods and services for comparison under this ground are as follows:

27. With the above in mind, the goods for comparison are as follows:

Earlier goods	**Contested goods**
UK comparable mark no. 917884990 Class 21: *Kitchen utensils; Cooking utensils, non-electric; Cleaning instruments, hand-operated; Tea services [tableware]; Coffee services [tableware]; Liqueur sets; Drinking glasses; Works of art of porcelain, ceramic, earthenware or glass; Combs; Brush goods; Hair for brushes; Material for brush-making; Toothpicks; Toothpick holders; Cosmetic utensils; Toilet cases;*	Class 12: *Automobile windshield sunshades; Fenders for land vehicles; Interior trim parts of automobiles; Steering wheel covers for automobiles; Ashtrays for automobiles; Tire snow chains [land vehicle parts]; Vehicle seat covers; Drinks holders adapted for use in land vehicles; Cigarette lighters for cars; Fitted vehicle covers.*

Oven gloves; Oven heat resistant pads; Dishwashing brushes; Glass, unworked or semi-worked, except building glass. Class 28: *Playing balls; Baseball balls; Racketball balls; Tennis balls; Rugby balls; Beach balls; Golf balls; Shuttlecocks; Basketballs; Table-tennis balls; Nets for ball games; Body-building apparatus; Exercisers [expanders]; Machines for physical exercises; Dumb-bells; Archery implements; Belts for weightlifting; Appliances for gymnastics; Play swimming pools; Ice skates; Athletic protective sportswear; Rods for fishing; Fish hooks; Lines for fishing; Fishing tackle; Playthings; Ornaments for Christmas trees, except illumination articles and confectionery.* UK comparable trade mark no. 917947108 Class 22: *Tents; Tents for mountaineering; Tents for camping; Awnings; Hammocks; Awnings of textile; Awnings of fabric; Awnings of plastic; Eiderdown; Eiderdown feathers; Feathers for stuffing upholstery; Feathers for bedding; Tarpaulins; Glass fibers for textile use; Flock [stuffing].* Class 24: *Sleeping bags; Travelling rugs [lap robes]; Cotton blankets; Sleeping bags [sheeting]; Fabric;*	

Frieze; Towels of textiles; woolen cloth; jersey [fabric]. UK trade mark no. 3556082 Class 25: *Clothing for cycling; Cycling shorts; Cycling shoes; Caps; Sports caps and hats; Cycling caps; Headbands against sweating; Headbands; Sport stockings; Gloves [clothing]; Driving gloves; Riding Gloves; Sports bibs; Motorcycle jackets; Cycling tops.*	

28. Within its TM26(I), GI highlights that its earlier marks cover kitchen utensils, playing utensils, tents, bags and towels, cycle and motorcycle clothes. It argues that these goods are offered to the same end consumers via the same channels of trade and advertising means as the contested goods, and that both sets of goods can be sold via physical retail stores or online. GI argues that a consumer searching for GI's products may well come across SX's products in the course of its search, which may result in confusion.

29. However, it is my view that there is no meaningful similarity between the goods highlighted by GI in its pleadings and the contested goods. The nature, purpose and method of use of the goods will differ. They will not be complementary or in competition with one another. Whilst I note GI's submissions regarding the channels of trade and users, it is my view that in both instances, any crossover will be at a fairly general level. I consider it might be the case that in respect of some of the goods, for example, *tents* and *automobile windshield sunshades,* both may be available to purchase at an 'outdoors' shop by the general public. Further, I consider there may be a chance that vehicle accessories such as steering wheel covers, seat covers and drinks holders for example, may be purchased at the same stores as motorcycle jackets and both by members of the general public who drive vehicles. However I have no evidence of shared trade channels in either case. In any case, in all instances, it appears unlikely that even if the goods are sold in the same stores, they will be placed next to each

other. Considering all the relevant factors, the possibility for a general crossover in trade channels and consumers is not in my view, sufficient in and of itself to render the goods similar. Overall, I consider the goods to be dissimilar.

30. I note that, following the filing of the initial TM26(I), the Tribunal wrote to GI highlighting that this ground of invalidation appeared to have no prospect of success due to the apparent differences between the goods. GI responded to this, arguing that, as an example, the contested class 12 goods *automobile windshield sunshades* are similar to the earlier *tents; awnings; awnings of textile; awnings of fabric; awnings of plastic* and *tarpaulins* in class 22. Detailed reasoning as to why these goods are similar was not provided. It is my view that the nature of these goods will be different, with the *windshield sunshades* being much smaller generally mostly flat goods, likely made of some sort of reflective or mesh fabric, whereas the class 22 goods will, for the most part, be much larger, sturdier three-dimensional structures. The purpose of the goods will differ, with the *automobile windshield sunshades* being for the purpose of preventing a vehicle from heating up in the sunshine, or for diffusing the sun's glare whilst driving, whilst goods such as tents and awnings are for the purpose of providing, or extending, a sheltered pace within which a person may sleep, eat, relax or cook. Whilst I note tarpaulins may be a simple flat sheet of waterproof or water-resistant material, their nature will still differ to windshield sunshades somewhat, as will their intended purpose. None of the earlier goods appear to share a method of use with the contested goods highlighted by the opponent, and they will not be complementary or in competition. Again, I do not consider the possibility for a general crossover in trade channels or users will be sufficient to render the goods similar.

31. It is my view there is no obvious similarity between the remaining goods, and no additional arguments have been put forward by GI as to why I should consider these to be similar. In *Muhammad Ali v Abus August Bremicket Sohne KG*, BL O/0911/24, Iain Purvis KC sitting as the appointed person considered an argument from the opponent that where a general pleading of similarity had been made in relation to all of the goods and relying on all of the goods, the Hearing Officer is obliged to compare each category of goods in the earlier marks with each category of goods in the application, and consider any points of similarity which might exist between them,

whether they had been identified or relied upon by the opponent or not. In that case, Iain Purvis KC found:

> "…
>
> (iv) The Hearing Officer should have considered the Opposition on the basis of the case put forward in the written submissions. This was the case which the Applicant would have understood was being put forward by the Opponent, and it can be assumed that he relied on this when decided that he was happy for the matter to be decided by the Hearing Officer without making further submissions of his own.
>
> (v) In fact (as I have pointed out) the Hearing Officer went beyond the written submissions in making findings of similarity in respect of a number of groups of goods on the basis of arguments which had not been raised by the Opponent. If the Applicant had complained about this by way of an Appeal, there would probably have been a good argument that he had been the victim of procedural unfairness. But this has of course not happened and to this extent the Opponent has benefited from the Hearing Officer's generosity. However, it would obviously be perverse to say that the Hearing Officer ought therefore to have taken every other unpleaded and unargued point in the Opponent's favour."

32. Therefore, as I see no obvious similarity between the remaining goods relied upon by the opponent and the contested goods, and as the opponent has not advanced any particular argument with regards to the same, I do not consider it appropriate to conduct a further comparison at this stage. However, I note in any case and for completeness that it is my view that the remaining goods are dissimilar.

33. In order to succeed under section 5(2)(a) of the Act, there must be some similarity between the goods.[4] As I have not found any of the goods to be similar, the application for invalidation based on this ground must fail.

34. I will now move on to consider the application for invalidation based on sections 47(2)(b) and 5(4)(a) of the Act.

[4] See *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77

Section 5(4)(a)

35. Section 5(4)(a) states:

> "(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."

36. Subsection (4A) of Section 5 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."

The principles

37. 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)."

38. 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 reputation 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 source 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."

The relevant date

39. 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.'"

40. In this instance, SX has not filed evidence of use of its mark, and as such the relevant date is the date the contested mark was filed, that being 5 July 2022.

41. The opponent's evidence in these proceedings includes a number of screenshots showing Amazon listings for a range of goods, including antiglare shades for vehicle

drivers or passengers, vehicle cup holders and vehicle laptop holders, steering wheel covers and vehicle storage nets. These all show the goods being sold under the sign JOYTUTUS on Amazon.co.uk with the goods listed in GBP.

42. Whilst the screenshots have been taken on 16 November 2023, the pages themselves provide “first available” dates. One page showing the antiglare shades shows that this product was “first available” on 20 August 2020, whilst another listing for what appears to be the same product gives the “first available” date as 14 May 2022. However, in both cases, whilst the products have had “global reviews”, there are no ratings or reviews listed from the UK. The listing for the cup holders under the sign shows these were “first available” on 3 June 2018, but again there are no ratings or reviews from the UK.

43. The Amazon UK listing for the car laptop holder under the sign shows it was “first available” on 21 February 2021. This listing identifies that there are 1,409 global ratings of the product. The “Top reviews from United Kingdom” are shown on this listing, however, the earliest provided dates from 4th July 2022, whilst the rest are dated after the relevant date.

44. The listing for the steering wheel cover under the sign shows it was “first available” on 6 February 2021. However, again there are no UK reviews or ratings. The listing for the car storage net under the sign shows it was “first available” on 6 September 2022, after the relevant date, and the only UK review provided dates from 16 July 2023.

45. Details of orders for the products under the sign have also been provided. In the case of the antiglare/sun car screens, a total of 14 orders are shown on the first document provided. However, of these, 10 are from Amazon.es, with the billing country/region also listed as ‘es’. It appears these orders are therefore likely to be from Spanish customers. The remaining 4 orders do not provide these details, and only state that the sales channel was not Amazon, although the fulfilment method was. There is nothing to indicate where the customers placing these orders were located. The next document provided identifies that there have been 41 orders for the same product, but all those that are shown list the sales channel as Amazon.de and the

billing country/region as ‘DE’. It appears likely these are all orders from customers located in Germany.

46. The next page of orders states that 361 orders have been placed in relation to the car cup holders under the sign. Only the first page of the orders has been provided. Again, none of the orders shown specify that they were placed via Amazon.co.uk or that the billing country/region is the UK. The majority appear to have been purchased via Amazon.de, and the billing country/region for most of the orders is also listed as ‘DE’, although the billing country/region ‘AT’ is also mentioned a couple of times, and there are a couple of orders that simply list the sales channel as “non-amazon”. It is not clear whether any of the orders shown were placed by UK customers.

47. The next pages of orders identify that there have been 556 orders of the car laptop holder under the sign. This time, of the orders shown (which is not all of the orders identified), five are listed as being from the UK. The orders from the UK are dated 1 July 2022, 2 July 2022 (x2), 3 July 2022 and 4 July 2022. The sales channel and billing region for the rest of the orders shown appears to be outside of the UK, via Amazon.de, Amazon.se and Amazon.nl.

48. The following pages state there have been 67 orders of the steering wheel covers under the sign. Again, none of the orders shown in the evidence provide a sales or billing region as the UK. Instead, again the billing country/region is shown as ‘DE’ and orders were placed via Amazon.de in all but one of the orders. This one order does not specify the billing country or region and states only that the sales channel was “non-Amazon”.

49. The final pages of orders show that 453 orders of heated car seat covers under the sign have been placed. Of the orders shown, there is a mix of orders placed via Amaon.de, and orders placed via a “non-Amazon” sales channel. There is nothing to show that any of the “non-Amazon” orders placed derive from the UK.

50. The evidence set out above is the majority of the evidence filed. There is also the witness statement provided by GI’s representative Ms Bertaux, but this appears to be primarily filed for the purpose of introducing the exhibits, and there is little useful or specific commentary evidence provided on the same. I note Ms Bertaux’s general statement that the pages provided at Exhibit IBE01 (which I have detailed above)

"provide examples of the goods that have been during the relevant period, made available for purchase throughout the United Kingdom and continue to be".[5] I also note her statement that GI "and its predecessors in title have sold automobile products under the mark JOYTUTUS in the UK since June 2018." However, this is as far as the statement goes. No sales or turnover figures are provided, there is no indication of how many units have been sold in total or in relation to each product under the sign, and there are no details of any advertising or marketing spend. There is no indication of how the goods under the sign are marketed, or how many UK consumers have viewed the Amazon listings.

51. I remind myself that it is the picture that the sum of the evidence creates that I need to consider, and not what each and every piece of evidence individually shows (or fails to show). However, in this case, the evidence filed is exceptionally sparce, and fails to provide me with a number of fundamental pieces of information, without which, it is difficult to draw any conclusion as to the extent of the business and the number of customers of the goods under the sign in the UK. For the purpose of establishing goodwill in the UK, it is the presence of actual customers within the jurisdiction that is required.[6] Whilst I can conclude that a number of car accessories have been listed on Amazon.co.uk under the sign prior to the relevant date, the only product that I can find has been sold to UK customers before this date is the car laptop holder. Further, from the sum of the evidence, I can only conclusively state that a total of five items were sold in total to UK customers, in the few days leading up to the relevant date.

52. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill is defined 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."

[5] See paragraph 5 of the witness statement of Ms Bertaux
[6] *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others,* [2015] UKSC 31

53. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

> "62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

54. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> "... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

55. With consideration to the definition of goodwill provided, and the additional comments in the case law above outlining what is required for a successful passing off claim, is my view that the evidenced total of five sales to UK customers in the few days leading up to the relevant date, does not suffice to generate actionable goodwill in GI's business under the sign in the UK at the relevant date. Further, even if I take the sales where no jurisdiction is shown to be sales of the goods in the UK (which, to my mind, requires one too many assumptions to be made to be the correct approach), I still do not consider the evidence of these few additional sales prior to the relevant date sufficient to find the opponent's business will hold actionable goodwill in the UK as distinguished by the sign, sufficient to succeed in the invalidation based on section 47(2)(b) and 5(4)(a) of the Act. The application for invalidation based on this ground must therefore fail.

56. The application for invalidation has failed in its entirety. I will therefore now consider the opposition filed by SX based on its earlier mark.

Opposition no. 441498

57. As mentioned at the outset of this decision, SX opposed GI's applications based on section 5(2)(a) of the Act. Within its counterstatement, GI did not deny any of the claims made by SX. Instead, GI stated (emphasis added):

> "The Opponent is relying on relative grounds of refusal on sections 5(2)(a) of the Trade Marks Act.
>
> The opposition is based on the Opponent's UK trademark registration No. UK00003806067, " JOYTUTUS " (verbal mark), applied for on 5 July 2022, registered on 7 October 2022 (the "Opponent's trademark") opposing goods in class 12.
>
> **The Applicant cannot deny that the trademarks in dispute are identical covering goods in class 12.**

However, the Applicant would like to draw the attention of the examiner on cancellation proceedings (CA000506024) which have been initiated by GUANGZHOU ISSYZONE TECHNOLOGY CO.,LIMITED against the earlier UK trademark JOYTUTUS No. UK00003806067, on which the pending Opposition proceedings are based.

Indeed, the Applicant, GUANGZHOU ISSYZONE TECHNOLOGY CO.,LIMITED., is demonstrating that the earlier non-registered trade mark Joytutus has been used in the course of trade significantly earlier than the filing of the Opponent's trademark No. UK00003806067 and prohibits then the use of the Opponent subsequent UK trademark JOYTUTUS No. UK00003806067.

In this context, my client has decided to initiate Cancellation proceedings based on this prior use of the brand name *Joytutus*.

Please see attached the confirmation receipt of the cancellation proceedings pending before the UKIPO (CA000506024).

Thus, for the right to a good administration, we kindly ask you to stay the present pending opposition proceedings (No. OP000441498) until a decision on the prior cancellation proceedings (CA000506024) has been issued."

58. In *Delta Air Lines, Inc v Ontro Limited,* BL O/044/21 ("*Skyclub*") Phillip Johnson, sitting as the Appointed Person, considered the implications associated with the lack of an express denial of similarity in relation to goods and services within opposition proceedings based on section 5(2)(b) of the Act. In that case, although the applicant had not expressly denied the similarity of the goods and services (or a likelihood of confusion), the Hearing Officer had nonetheless gone on to consider whether he found this to be present. Mr Johnson stated that without any denial of similarity of the goods and services (or a likelihood of confusion), or any amendment to the applicant's pleadings:

> "…the Hearing Officer was wrong to proceed on the basis that the similarity of goods and services, confusion and anything other than similarity of the marks was in issue."

59. It is clear in this case that the identity of the marks is not in issue between the parties. Further, keeping the above comments in mind, and with consideration to the wording set out in GI's counterstatement, it is my view that to the extent it has been pleaded by SX, the similarity of the goods in this instance is also not in issue, nor in fact, is the likelihood of confusion between the marks. The opposition appears to have been defended only on the basis that GI has attacked the validity of SX's earlier mark. As the attack on the validity of the earlier mark has failed, **the opposition filed against GI's application must therefore succeed**.

60. I note at this stage, that in accordance with rule 62(1)(a) of the Trade Mark Rules 2008 I have the power to request clarification from the parties, and also that I may invite GI to apply to amend its pleadings if I consider it appropriate. However, I do not consider this to be an appropriate course of action in this instance. There has been no indication from GI that it wishes to do anything other than rely on the cancellation application as a defence, and no further submissions have been made putting the similarity of the goods or the likelihood of confusion between the marks in the opposition in issue. GI has made a direct and deliberate statement on its position in respect of the marks in its counterstatement, and what appears to be a deliberate (albeit slightly non-committal) statement about the goods. I note GI was in the slightly awkward position of running an application for cancellation against an earlier mark when it chose to defend its application, but it could have offered a fall-back position within its TM8 if it had wished to. It is my view that GI's counterstatement conveys simply that it wishes to defend the opposition against its mark on the basis of its cancellation application, which was an entirely reasonable, albeit ultimately ill-fated, position to take. As such, it would not be appropriate for me to interfere, and invite GI to amend its pleadings where these appear to simply reflect its chosen position in these proceedings.

61. However for completeness, I note here that if I am wrong to take the likelihood of confusion point as not in issue, it is nonetheless still the case that in accordance with the comments of Mr Johnson in *Skyclub,* the identity of the mark and the similarity of

the goods are not. As a precaution, I will therefore continue to consider the opposition filed against the contested mark on this basis. As SX has not specified the exact level of similarity between the goods, stating instead that "in nature, purpose and complementarity, the products of both parties exhibit significant similarities", I will proceed on the basis that the contested goods are similar to the earlier goods to at least a low degree.

Average consumer and the purchasing act

62. 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.

63. 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."

64. Many of the goods are likely to primarily be purchased by members of the general public who will consider factors such as the quality, aesthetics and compatibility of the goods offered with any vehicle already owned. They are not likely to be everyday purchases, nor are they likely to warrant the highest level of care, and as such it is my view the level of attention paid will range from medium to slightly above medium in respect of the same. There are some exceptions to this, in respect of the contested goods such as *Tops [folding roofs] for vehicles; Rearview mirrors; Bumpers for automobiles; Portholes* and *Windscreens.* Whilst end users of these goods will include

members of the general public, it is also true that professionals including those in the car or marine industries as well as mechanics may make up the majority of consumers of these types of goods, although I note that the general public may also purchase the goods from either specialist companies or via a mechanic or car or marine dealer when only that part of their vehicle requires replacing. Again, factors such as quality, aesthetics and compatibility will be considered. However, when replacing integral parts of a car or a boat for example, it is likely the general public will pay an above-medium level of attention to the goods due to any safety and/or insurance implications. Professionals are likely to pay a slightly higher level of attention due to the impact making the correct purchases may have on an overall product or their trade and in turn the business as a whole. The level of attention paid by professionals is therefore likely to fall between above-medium and high.

65. The goods are likely to be purchased visually, via online or physical retail or wholesale stores, or via catalogues and brochures. However, I cannot discount the possibility for verbal recommendations or for orders to be placed over the phone, and as such aural considerations are also relevant.

Distinctive character of the earlier mark

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

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

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

67. SX has not filed any evidence of use in relation to its earlier mark, and as such I only have the inherent position to consider. It is my view that the earlier mark appears to be a made-up word and therefore holds a high degree of inherent distinctiveness. However, if it is instead considered to be the combination of two English words (those being JOY and TUTUS) I note neither of these are allusive or descriptive of the goods, and combined the two words, which both seem like an unusual choice in the context of the goods, hold in any case a slightly above medium level of inherent distinctiveness.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

68. Prior to reaching a decision under section 5(2)(a), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 20 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.[7] I must keep

[7] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are obtained will have a bearing on how likely the consumer is to be confused.

69. There are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.[8]

70. In this case, it is not in dispute that the marks are identical, and the goods are similar at least to a low degree. Further, the earlier mark has at least a slightly above medium degree of inherent distinctiveness, if not a high degree, depending on whether it is considered to be an entirely made-up word. I found the degree of attention paid to the goods may range from medium to above medium where the general public are concerned, or slightly higher where the goods are purchased by professionals. Considering all of the factors, and keeping in mind that the marks are identical, it is my view that even when paying a higher degree of attention in respect of goods which are similar only to a low degree, there is a likelihood of direct confusion between the marks.

71. Therefore, even if I am wrong to consider GI's defence to be purely reliant on the success of the cancellation applicant filed against the earlier mark, I nonetheless find the opposition to succeed based on section 5(2)(a) of the Act.

Final Remarks

72. The application for the invalidation of registration no. 3806067 registered in the name of Shenzhen Xuyong Electronic Technology Co., Ltd. has failed in its entirety. Subject to any successful appeal, this registration will continue to stand as a valid mark on the UK trade mark register in its current form.

[8] *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

73. The opposition filed against trade mark application no. 3896399 in the name of GUANGZHOU ISSYZONE TECHNOLOGY CO., LIMITED has succeeded in its entirety. Subject to any successful appeal, the application will be refused in full.

COSTS

74. Shenzhen Xuyong Electronic Technology Co., Ltd. has been successful in both the invalidation and the opposition proceedings, and is therefore entitled to a contribution towards its costs. In the circumstances, and in accordance with TPN 1/2023, I award Shenzhen Xuyong Electronic Technology Co., Ltd. the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Costs prior to consolidation

Considering the TM26(i), preparing and filing the TM8:	£250
Preparing and filing the TM7:	£250
Official fee:	£100

Costs following consolidation

Considering the evidence filed:	£400[9]
Total:	£1000

75. I therefore order GUANGZHOU ISSYZONE TECHNOLOGY CO., LIMITED to pay Shenzhen Xuyong Electronic Technology Co., Ltd. the sum of £1000. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 10th day of December 2024

[9] I have awarded costs at lower than the scale minimum for preparing and considering evidence on the basis that SX did not file its own evidence in these proceedings.

R. Le Breton

For the Registrar