

O/0012/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003921766  
BY IMPEX INNOVATION GENERAL TRADING LLC  
TO REGISTER THE TRADE MARK:



IN CLASSES 7, 8, 9, 11 AND 21

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 443591  
BY IMPEX LIGHTING LIMITED

## BACKGROUND AND PLEADINGS

1. On 12 June 2023, IMPEX INNOVATION GENERAL TRADING LLC (“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 14 July 2023. The applicant seeks registration for the following goods under the above application:

Class 7 Juicer; Mixer; Grinder; Blender; Food processor, electric; vegetable and meat chopper; vacuum cleaner; steam cleaners; food chopper; Ironing Machines; 3D Printers; Washing Machine.

Class 8 Cutlery; hand-operated food processors; blenders and choppers of vegetables and meat; instruments for slicing, peeling, scraping and bottle opening; Beard clippers; budding knives; ceramic knives; cheese slicers, non-electric; choppers curling tongs; cutters; depilation appliances, electric and non-electric; drawing knives; egg slicers, non-electric; fingernail polishers, electric or non-electric; nail buffers, electric or non-electric; hair clippers for personal use, electric and non-electric; hair braiders, electric; kitchen mandolins; pizza cutters, non-electric; razors, electric or non-electric; scissors; shaving cases; table knives; forks and spoons of plastic and for babies; vegetable slicers; vegetable knives; vegetable shredders; vegetable choppers; vegetable spiralizers, hand-operated; vegetable peelers [hand tools]; wine bottle foil cutters, hand-operated; electric iron box; electric iron for styling hair; electric hair trimmers.

Class 9 Weighing and measuring apparatus; sensors and data storage instruments used in automated cooking and cleaning equipment; Multimedia Speaker Systems; DVD Player; Portable DVD Players; Receivers; LED TV; Dish Antenna; Projectors; Television Apparatus; UPS [Uninterruptible power supply]; VR glasses; Video Games; Dish Antenna, Projectors, TV Kit; Wireless Karaoke Microphone; Wireless Headphone; Portable Radio; Colour Television; Kitchen Scales; Digital Scale; Personal Scale; Tablets; Mobile Phones; Portable Telephones;

Power Bank; Car Stereo; Electric Bag; Inverter; Electronic book readers; electronic interactive whiteboards; electronic notice boards; electronic numeric displays; electronic pens; fire alarms; headsets for playing video games; holograms; ignition batteries; modems.

Class 11 Glass top gas stove; stainless steel gas stove; induction cooktop; pressure cooker; electric kettle; coffee maker; tea maker; microwave oven; oven; toaster griller; hood; electric chimney; Hob; Air Fryer; Rice Cooker; Toaster; sandwich maker; roti maker; chilla and Dosa maker; pizza and omelet maker; Atta and bread maker; Noodle and pasta maker; egg boiler; deep fryer and Curry Cooker; Infrared Cooktop; Kitchen Hood; Kitchen Hob; Electric Hot Plate; Electric Kettle; Stainless Steel Flask; Led Lanterns; Emergency Lantern; Flash Lights; Torch; Electric Fans; Air Cooler; Air Conditioner; Water Dispensers; Water Coolers; Refrigerator; Fridge and other cooling apparatus; Water Heater; Water Bottle; Freezers; fruit roasters; full-body drying apparatus; ice-cream making machines .

Class 21 Nonstick Cookware; Enamel Cookware; Stainless Steel Flasks; Pressure Cookers; Water Bottles; Nonstick Ceramic Die-Cast Cookware; Thermosteel Flask; Choodarapetti; OCP/Thermal Rice Cooker; Puttu Makers; Household or Kitchen Utensils and Containers (not of precious metal nor coated therewith); Small Hand-Operated Kitchen Apparatus for Mincing, Grinding, Pressing or Crushing; Cosmetic and Toilet Utensils; Combs and Sponges; Brushes (Other Than Paint Brushes); Brush-Making Material; Instruments and Material For Cleaning Purposes; Mop; Steel Wool; Glassware; Baskets For Household Purposes; Blenders For Household Purposes; Bottle Openers Electric And Non-Electric; Boxes For Dispensing Paper Towels; Bread Baskets For Household Purposes; Car Washing Mitts; Ceramics For Household Purposes; Chopsticks; Coffee Filters; Coffee Grinders; Cookery Moulds; Diaper Disposal Pails; Nappy Disposal Bins; Graters For Kitchen Use; Perfume Vaporizers; Stands For Portable Baby Baths; Teapots; Toilet Paper Dispensers; Vessels Of Metal For Making

Ices And Iced Drinks; Watering Cans; Trays For Household Purposes; Baking mats; drinking glasses; ironing boards; lunch boxes; watering devices; sprinkling devices.

2. The application was opposed in full by Impex Lighting Limited (“the opponent”) on 13 October 2023 based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under sections 5(2)(b) and 5(3), the opponent relies upon the following trade mark:

# IMPEX

Comparable UK trade mark (EU) registration no. UK00905723879<sup>1</sup>

Filing date 28 February 2007.

Registration date 15 April 2008.

Relying on all of the goods for which the mark is registered, namely:

Class 11      Lighting apparatus and equipment; decorative lighting; light fittings; chandeliers; wall lights; standard lamps; table lamps; crystal lighting apparatus and equipment, decorative lighting, light fittings, chandeliers, wall lights; parts and accessories for all of the aforementioned.

4. Under section 5(2)(b), the opponent claims there is a likelihood of confusion because the marks are similar to a high degree and the goods are either identical or similar.

5. Under section 5(3), the opponent claims that the opponent’s mark has a reputation for lighting in the UK, with its products known for being high quality and having the appropriate electrical certification. The opponent claims that due to their similarity, use

---

<sup>1</sup> Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

of the applicant's mark would take unfair advantage of the opponent's mark, which would lead to users believing that the applicant's goods are of a higher quality and from a long standing UK company. Moreover, the opponent claims that use of the applicant's mark would be detrimental to the distinctive character of its mark as "dilution would be inevitable", stating that "if the applicant's lighting products or electrical goods are of inferior quality to those offered by the opponent, consumers will falsely attribute this decline in quality to the opponent".

6. Under section 5(4)(a), the opponent relies upon its **IMPEX** sign which it claims to have used throughout the UK since 1946 for all of the goods contained in paragraph 3 of this decision. The opponent claims that use of the applicant's mark on led lanterns, emergency lanterns, flash lights and torches would be contrary to the law of passing off.

7. The applicant filed a counterstatement denying the claims made and subjected the opponent's mark to proof of use.

8. The opponent is represented by Snipe Chandrahasen LLP and the applicant is represented by Olga Vahatova. Both parties filed evidence in chief and filed written submissions during the evidence rounds. The opponent also filed further evidence and submissions. Neither party requested a hearing, however, the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

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

## **EVIDENCE**

10. The opponent's evidence in chief includes the witness statement of Benjamin Snipe dated 8 April 2024. Mr Snipe is a member of Snipe Chandrahasen LLP, the

representatives of the opponent. His statement is said to be accompanied by 8 exhibits (BS1-BS8) and goes to the use of the earlier mark and the claim to reputation and goodwill. However, no accompanying exhibits were filed.

11. The opponent's evidence in chief also includes the witness statement of Warren Bryan Dagul dated 8 April 2024. Mr Dagul is the Managing Director of the opponent, a position which he has held since April 2006. His statement is accompanied by 7 exhibits (WBD1-WBD7) and goes to the use of the earlier mark and the claim to reputation and goodwill.

12. The applicant's evidence includes the witness statement of Olga Vahatova dated 11 July 2024. Ms Vahatova is representing the applicant and her statement is accompanied by 3 exhibits (OV1-OV3). This evidence provides categories and subcategories of lighting, the definition of a torch, flashlight and lantern, and UK lighting marketing reports.

13. The applicant's evidence also includes the witness statement of Nuvais Chenengadan Mohamed Ali Chenangadan dated 27 July 2024. Mr Chenangadan is the Manager of the applicant, a position which he has held since 2016. His statement is accompanied by 2 exhibits (CN1-CN2). This evidence contains the applicant's trade mark licences and certificates.

14. Evidence in reply was filed by the opponent, which includes the second witness statement of Mr Snipe dated 17 October 2024. I note that this statement is an exact replica of the statement dated 8 April 2024, however, this statement is accompanied by exhibits BS1-BS8.

15. The opponent's evidence in reply also includes the witness statement of Alan Graham Hart dated 16 October 2024. Mr Hart is the Finance Director of the opponent, a position which he has held since 16 January 2009. Mr Hart's statement is accompanied by 5 exhibits (AGH1-AGH5).

16. On 26 October 2025, the Registry issued an official letter noting that exhibits BS1-BS8 which were filed alongside the second witness statement of Benjamin Snipe

amounted to additional evidence. This is on the basis that the opponent's evidence in chief, that being the first witness statement of Benjamin Snipe, clearly made reference to these exhibits, but did not attach them. Therefore, as exhibits BS1-BS8 were filed during the period to file evidence in reply, (and the exhibits clearly did not reply to the applicant's evidence), it was deemed as inadmissible, and the opponent was given until 10 November 2025 to make a formal request to file this additional evidence into the proceedings.

17. On 20 November 2025, the Registry issued another official letter noting that the opponent did not file the aforementioned request. Furthermore, the official letter acknowledged that the witness statement of Alan Graham Hart was also additional evidence on the basis that it was not filed in reply to the applicant's evidence. As it was filed during the period to file evidence in reply, it was also deemed as inadmissible, and there was no formal request to file this evidence either. Therefore, the Registry issued a preliminary view that the Hearing Officer was only to make a decision on the papers based on the opponent's evidence that had been admitted, that being:

- a) The first witness statement of Benjamin Snipe dated 8 April 2024 which has no accompanying exhibits.
- b) The witness statement of Warren Dagul dated 8 April 2024 accompanied by 7 exhibits.

18. If either party were to disagree with this preliminary view, they were given until 28 November 2025 to request a hearing. If no response was received, the preliminary view was to be automatically confirmed. No response was received, and therefore, the only evidence of the opponent that I shall consider within my decision is the aforementioned evidence listed at paragraph 17(a) and (b) above.

## **DECISION**

### **Section 5(2)(b)**

19. Section 5(2)(b) 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.”

20. The opponent’s mark qualifies as an earlier mark in accordance with section 6(1)(a) of the Act as its filing date is earlier than the filing date of the applicant’s mark. As the opponent’s mark has completed its registration process more than five years before the filing date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

### **Proof of use**

21. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

22. Section 6A of the Act states:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),  
(aa) or (ba) in relation to which the conditions set out in section 5(1),  
(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.”

23. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five years ending on the filing date of the applicant’s mark, i.e. 13 June 2018 to 12 June 2023.

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence

that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

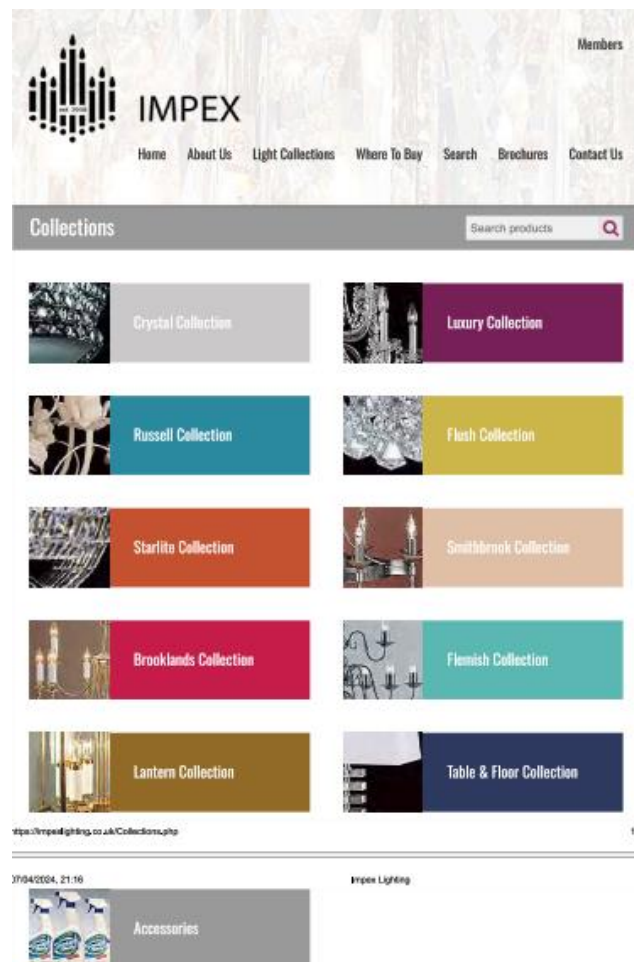
(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

### Evidence of use

25. Mr Snipe’s first witness statement only consists of statements that pertain to **exhibits BS1 to BS8**. For example, paragraph 4 states that “at BS3, a photo shows isles at Dunelm (Eastern Ave, Shoreham-by-Sea) with lighting apparatus being positioned at the end of an isle opposite heaters” **[sic]**. However, as highlighted above, this statement was filed without any accompanying exhibits. On this basis, Mr Snipe’s witness statement does not assist the opponent. I also bear in mind that this statement does not contain any sales figures, marketing figures or any other narrative evidence that would help demonstrate genuine use of the opponent’s mark. Nevertheless, I note the following from the narrative evidence contained within Mr Dagul’s witness statement, accompanied by **exhibits WBD1 to WBD7**:

- a) The opponent’s mark is used by the opponent and Impex Lighting with the opponent’s consent. Impex Lighting owns 100% of shares in the opponent.

- b) The opponent supplies lighting products to above 500 customers annually which has been “done since long before the filing date of the application”. The opponent’s customers include John Lewis, Argos, Sainsburys, Costco, Wayfair and TJX Europe.
- c) The opponent “has a multimillion pound turnover annually and a strong balance sheet of over £1m”. “A high proportion of revenue of [the opponent] is from sales of lighting products and accessories” and they also sell “mirrors and cleaning products for lights, and a small proportion derives from that”.
- d) The opponent’s website (impexlighting.co.uk), home page, and collection pages are exhibited at **WBD1**. I note that these only have a printout date of 7 April 2024. Nevertheless, Mr Dagul confirms that “these web pages are substantially unchanged since” before the applicant filed its mark. I note that its website is depicted as follows:



- e) The opponent's brochure is also exhibited at **WBD2**. The brochure clearly depicts ceiling lights (including chandeliers), lamps, chandelier and shade cleaner and ceiling roses. The brochure also uses the IMPEX word mark on its front page. However, it is undated and I note that the brochure does not contain any prices for the opponent's products (it only shows the product name and item code).
- f) A lighting book is contained in **exhibits WBD3** and **WBD4**. I note that again the IMPEX word mark is clearly used on the front page of both books. Moreover, on the front page of the lighting book contained in **exhibit WBD3**, the following mark is used:



- g) I find that this device shows the word "Impex" presented in a standard title case, white typeface, encompassed in an abstract chandelier device. However, I note that, again, the lighting book is undated and does not contain any product names or prices.
- h) **Exhibit WBD5** contains printouts from John Lewis' website showing IMPEX ceiling lights and lamps. These are priced between £116 and £1,514.00. Mr Dagul states that John Lewis stocks 100 of the opponent's IMPEX products. He acknowledges that the printouts are dated 7 April 2024, and are therefore from after the relevant period. However, he states that "the products for sale before the filing date were substantially the same". Mr Dagul also states that the opponent "has supplied John Lewis with lighting products for over 60 continuous years using the trade mark IMPEX".

- i) **Exhibit WBD6** contains printouts from Argos' website showing 6 IMPEX ceiling lights. These are priced between £206 and £436. However, again, the printouts are dated 7 April 2024, and are therefore from after the relevant period. However, Mr Dagul again states that "the products for sale before the filing date were substantially the same".
- j) Mr Dagul states that the opponent incurs marketing costs "in maintaining relationships with [their] resellers" who pay to market the opponent's lighting products. Mr Dagul has provided printouts from Google, showing search results for "impex lighting" in **exhibit EBD7**, and he states that the results marked "sponsored" are their resellers pay-per-click advertising. Again, I note that the search results are dated after the relevant period, that being 7 April 2024, however, Mr Dagul states that their "resellers have paid for pay-per-click advertising for [the opponent's] lighting products for several years".

#### Assessment of genuine use

26. As far as the form of the mark is concerned, I am satisfied that the mark has been used as registered in the screenshot evidence. For the sake of completeness, the evidence above also shows use of the word "Impex" presented in a standard title case, white typeface, encompassed in an abstract chandelier device. I bear in mind that fair and notional use of a word-only mark covers use in any standard typeface and colour, and the abstract chandelier device is descriptive of, and depicts/represents, the opponent's lighting goods.<sup>2</sup> I also note that the word "IMPEX" is clearly visible and still continues to indicate origin.<sup>3</sup> Therefore it is acceptable variant use.

27. I will now consider whether the evidence shows that the earlier mark has been genuinely used.

28. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows

---

<sup>2</sup> I also bear in mind that the opponent's earlier mark is registered for the term "chandeliers".

<sup>3</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paras 31-35

use by itself.<sup>4</sup> As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

29. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

30. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed

---

<sup>4</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

31. The case law summarised in the passage from *easygroup* quoted above makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e. it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd’s Application*, BL O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put

to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark, and the evidence indicated that they were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

32. Where proof of use is required, it is typical to see evidence such as turnover figures and invoices showing the sale of its goods to distributors and/or UK customers. While Mr Dagul clearly states that the opponent “has a multimillion pound turnover annually and a strong balance sheet of over £1m”, I have not been provided with any supporting evidence such as invoices showing the sale of the opponent’s goods to retailers (such as those referred to by Mr Dagul: John Lewis and Argos, for example) or the general public. On this point, I bear in mind that in the *PILLOW TALK* case,<sup>5</sup> Thomas Mitcheson KC, sitting as the Appointed Person, upheld the Hearing Officer’s decision to reject as evidence of use of a trade mark the statement: “average annual turnover of the goods in Class 28, using the ‘Pillow Talk’ mark, during the relevant period, was £45,000” on the basis that additional material in support of this statement (that was likely to exist) was non-existent.

33. The only evidence that has been provided to support Mr Dagul’s statement on turnover made by the opponent is undated brochure evidence and screenshots from the opponent’s and third party retailer’s websites (John Lewis and Argos), showing IMPEX lighting goods for sale after the relevant period. Nevertheless, Mr Dagul states that the opponent’s website pages “are substantially unchanged since” before the applicant filed its mark, and that the products for sale on John Lewis and Argos “before the filing date were substantially the same”. However, this wording seems to suggest that the screenshots are not parallel or identical to how all three websites were presented during the relevant period, and Mr Dagul has not provided any further information to clarify to what extent the webpages differ. Therefore, without any

---

<sup>5</sup> BL O/1160/23

website evidence before me that is dated during the relevant period, I am unable to determine what goods were offered for sale, and how they were presented to the relevant public. I also bear in mind that I have not been provided with any evidence of UK user engagement with the opponent's website, or any confirmation of what sales were made from it. I have also not been provided with a breakdown of what sales were made to John Lewis, Argos or any other aforementioned retailers contained in paragraph 25(b) of this decision.

34. Parallel to the *PILLOW TALK* case above, I find that the absence of any dated material during the relevant period amounts to "a fundamental inadequacy" which allows to me to be sceptical of the approximate turnover figure provided by Mr Dagul.<sup>6</sup> Thus, taking all of the above into account, I find that none of Mr Dagul's evidence supports his statement on the sales made under the IMPEX mark during the relevant period, and I therefore reject it as it is insufficiently solid.

35. Nevertheless, without any invoice evidence dated from the relevant period, I find that the opponent's approximate annual turnover alone does not allow me to discern the scale, frequency, and territorial extent of the use of the opponent's mark in the UK, which are all vital factors in establishing genuine use. The invoice evidence is plainly information which should have been available and relatively easy to provide, which would have allowed me to determine what and how many goods were sold to the opponent's retailers, or if its sales were geographically spread across the UK, for example. It is not necessarily fatal to the assertion of genuine use that there is no such evidence, if other material filed by the opponent is sufficient to show that there has been a real attempt to exploit the mark in the sector. However, as highlighted above, there is very little evidence of other activity in this case. I also bear in mind that I have not been provided with any marketing figures, and its brochure evidence, which would be classified as marketing material, is undated and therefore is of no assistance on the basis I am unable to determine if and when it was distributed during the relevant period. Furthermore, the opponent has not provided any information as to how many brochures were printed and distributed during the relevant period, and therefore, I am unable to ascertain how many UK consumers would have been exposed to this

---

<sup>6</sup> Paragraph 14 of *PILLOW TALK* BL O/1160/23

advertising. Lastly, the pay-per-click advertising which Mr Dagul states is shown by the google printouts is also dated after the relevant period and therefore does not assist me.

36. Taking the evidence as a whole, including the absence of any information about the distribution of the undated brochures, combined with zero dated website evidence from the relevant period showing the opponent's goods for sale and the absence of any invoice evidence of sales from the relevant period, leads me to find that the opponent's evidence is insufficiently solid in showing that its mark has been genuinely used during the relevant period on any of its goods. The consequence of my finding on use is that the opponent's UK00905723879 mark cannot be relied upon under section 5(2)(b). As this is the only registered earlier right being relied upon by the opponent in these proceedings, the section 5(2)(b) claim fails.

### **Section 5(3)**

37. Section 5(3) of the Act states:

“5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

38. Section 5(3) also relies on the opponent having an earlier trade mark. However, as noted above, the opponent has failed to establish use of its earlier mark and therefore the UK00905723879 mark may not be relied upon under section 5(3) either. As this is the only registered earlier right being relied upon by the opponent in these proceedings, the section 5(3) claim also fails.

## **Section 5(4)(a)**

39. 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”.

40. 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.”

41. 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**

42. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated 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.'"

43. In Mr Chenangadan's statement, he confirms that the applicant was incorporated in 2016 under the laws of the United Arab Emirates, and has provided accompanying trade mark licences and certificates confirming the registration of its IMPEX trade marks in New Kuwait, India, Tanzania and Zanzibar. However, I have not been provided with any UK evidence of use to support this (i.e. use in the UK market, such as website screenshots, or sales figures etc). On this basis, I have only the prima facie relevant date to consider i.e. 12 June 2023.

## Goodwill

44. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“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 customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

45. 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 off 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; 54 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.”

46. 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 of 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.”

47. This ground can be dealt with relatively swiftly.

48. Under section 5(4)(a), the opponent relies upon its IMPEX sign, which mirrors the opponent's earlier mark relied upon under sections 5(2)(b) and 5(3). The evidence that the opponent relies upon for section 5(4)(a) is the same evidence as summarised in paragraph 25 above. I also note that this evidence failed to establish genuine use of the opponent's earlier mark.

49. Goodwill arises as a result of trading activities, and the only evidence provided to support this is Mr Dagul's witness statement which states that:

1. The opponent “has a multimillion pound turnover annually and a strong balance sheet of over £1m”.
2. “A high proportion of revenue of [the opponent] is from sales of lighting products and accessories”, but they also sell “mirrors and cleaning products for lights, and a small proportion derives from that”.

50. However, my criticisms of the opponent's evidence as contained in paragraphs 32 to 36 are repeated, and apply here. I have no supporting invoice evidence to show the sale of the opponent's goods geographically spread across the UK, and I have not been provided with any marketing figures, nor any brochure or website evidence dated before the prima facie relevant date showing how the opponent's goods were sold.

51. Therefore, taking all of the above into account, I consider the opponent's evidence of trading activities to be vague, imprecise and incapable of leading to a finding that the opponent enjoyed any protectable goodwill in its business in the UK at the relevant date.

52. The opponent's reliance upon 5(4)(a) of the Act fails as, without goodwill, there can be no misrepresentation or damage.

## **CONCLUSION**

53. The opposition is unsuccessful, and the application may proceed to registration.

## **COSTS**

54. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of **£1,250** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£300
Considering the opponent's evidence and filing evidence in reply	£600 <sup>7</sup>
Filing written submissions in lieu	£350
<b>Total</b>	<b>£1,250</b>

55. I therefore order Impex Lighting Limited to pay IMPEX INNOVATION GENERAL TRADING LLC the sum of £1,250. This sum is to be paid within 21 days of the expiry

---

<sup>7</sup> The evidence award is lower on the scale on the basis that the evidence provided by both parties was light.

of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 12<sup>th</sup> day of January 2026**

**L FAYTER**

**For the Registrar**