

O/0063/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003981490

IN THE NAME OF HAIBO WANG

FOR THE TRADE MARK:



IN CLASSES 7 AND 11

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 446157 BY

SHARKNINJA OPERATING LLC

BACKGROUND AND PLEADINGS

1. On 20 November 2023, Haibo Wang (“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 1 December 2023 and protection is sought in respect of the following goods:¹

Class 7 Scissors, electric; Hand-held tools, other than hand-operated; Glue guns, electric; Electric screwdrivers; Power-driven wrenches.

Class 11 Bicycle lamps; Nail lamps; Pocket warmers; Bedside lamps; Studio lamps; Inspection lamps; Table lamps; Head torches; Searchlights; Solar lamps.

2. On 1 March 2024, the application was partially opposed by SharkNinja Operating LLC (“the opponent”) based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed only at those goods which are underlined in the previous paragraph. Under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade marks:

SHARK

UKTM no. 902718419

Filing date 31 May 2002; registration date 2 October 2003

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

Class 7 Vacuum cleaners.

(“the First Earlier Mark”)

SHARK

UKTM no. 3371049

Filing date 29 January 2019; registration date 14 June 2019

Priority date: 20 December 2018 (US)

¹ The underlined goods are those goods which are the subject of this opposition.

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

Class 11 Electric hair dryers and parts and fittings therefore; portable electric heaters for domestic use.

("the Second Earlier Mark")

(together "the earlier marks")

3. Under section 5(2)(b), the First Earlier Mark is relied upon to oppose the goods underlined in class 7 of the applicant's specification, and the Second Earlier Mark is relied upon to oppose the goods underlined in class 11 of the applicant's specification. The opponent claims that the marks are similar, and the goods are identical or similar, with the result that there is a likelihood of confusion.

4. Under section 5(3) of the Act, the opponent claims a reputation in respect of the goods listed in paragraph 2 above. It relies upon the First Earlier Mark to oppose the class 7 goods underlined above only. It relies upon the Second Earlier Mark to oppose all of the goods underlined in the applicant's specification. The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character, and/or repute of the earlier marks.

5. Under section 5(4)(a) of the Act, the opponent relies upon the sign SHARK which it claims to have been using throughout the UK since 2017 in relation to the same goods listed in paragraph 2 above. The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

6. The applicant filed a counterstatement denying the grounds of opposition, although I note that it did not comment upon the similarity of goods. I will return to this below.

7. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful consideration of the papers on file.

REPRESENTATION

8. The applicant is represented by IP LOILO.

9. The opponent was originally represented by Taylor Wessing LLP, but is now represented by Fox Williams LLP.

EVIDENCE AND SUBMISSIONS

10. The opponent filed evidence in the form of the witness statement of Alison Cole dated 9 September 2024, which is accompanied by 7 exhibits (AJC1 to AJC7). Ms Cole is a Trade Mark Attorney at the previous representative of the opponent in these proceedings. I note that exhibit AJC1 contains a witness statement given by William Seymour dated 28 October 2022. Mr Seymour is Associate General Counsel – Global Marketing and Robotics for the opponent. This statement was given in relation to a different set of proceedings before this Tribunal and is accompanied by 11 exhibits (WS1 to WS11).

11. The applicant did not file evidence.

12. The opponent filed written submissions in lieu dated 6 January 2025.

RELEVANCE OF EU LAW

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

DECISION

Section 5(2)(b)

14. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

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

16. Given their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the Second Earlier Mark had not completed its registration process more than 5 years prior to the filing date of the application, it is not subject to the use provisions in section 6A of the Act. Whilst the First Earlier Mark is vulnerable to the use provisions in section 6A of the Act, the applicant did not request that the opponent prove use of its mark and, consequently, the opponent can rely upon all of the goods identified.

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

18. I note that the opponent's Form TM7 states that the goods are identical or, in the alternative, that they are highly similar due to an overlap in nature, purpose and trade channels. The opponent also claims that the goods are complementary and/or in competition.

19. The applicant's counterstatement is silent as to the similarity of goods. In my view, the effect of this is that the opponent's case on similarity/identity of the goods is not denied. I could, therefore, proceed on the basis that the goods are identical for that reason alone. However, for the sake of completeness, I will undertake a full comparison.

20. The competing goods are as follows:

| Opponent's goods | Applicant's goods |
|---|--|
| The First Earlier Mark <u>Class 7</u> Vacuum cleaners. | <u>Class 7</u> Hand-held tools, other than hand-operated; |
| The Second Earlier Mark <u>Class 11</u> | <u>Class 11</u> Pocket warmers. |

| | |
|--|--|
| Electric hair dryers and parts and fittings therefore; portable electric heaters for domestic use. | |
|--|--|

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

Class 7

Hand-held tools, other than hand-operated.

22. A tool is an instrument that can be held by hand to do a particular kind of work. The reference in this term to the tools being “other than hand-operated” must, therefore, refer to the powering of those tools i.e. that they are, for example, electrically operated rather than require manual operation by hand. In my view, this term is broad enough to cover vacuum cleaners (which are electrically powered) in the opponent’s specification. Consequently, I consider the goods to be identical on the principle outlined in *Merici*.

Class 11

Pocket warmers.

23. A pocket warmer is a type of electric heater. My understanding is that these can be electrically powered and are a type of heater used to warm the hands. These would be covered by the portable electric heaters in the opponent’s specification. Whilst I note that that term makes reference to domestic use, this does nothing more than

identify that the goods are for use outside of a commercial setting. That may clearly apply to pocket warmers. In my view, the goods are identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing process

24. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

25. 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. (as he then was) 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.”

26. The average consumer for the goods will be a member of the general public. The average consumer is likely to consider factors such as reliability, functionality and effectiveness when purchasing the goods. The goods are likely to vary in price (with pocket warmers being cheaper than vacuum cleaners, typically), but are unlikely to be frequent purchases. In my view, the average consumer will pay a medium degree of attention during the purchasing process, but may be higher for vacuum cleaners due to the higher cost.

27. The goods are likely to be self-selected from the shelves of a retail outlet or online equivalents. Consequently, visual considerations are likely to dominate the purchasing process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.


Comparison of trade marks

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

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

29. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

30. The respective trade marks are shown below:

| Opponent's trade marks | Applicant's trade mark |
|------------------------|---|
| SHARK |  The logo for the applicant's trade mark features a stylized shark's head in profile, facing left, with a wide, toothy grin. To the right of the shark's head, the words "SMILING SHARK" are written in a bold, sans-serif font, with "SMILING" on the top line and "SHARK" on the bottom line. |

Overall Impression

31. The opponent's marks consist of the word SHARK. There are no other elements to contribute to the overall impression which resides in the word itself.

32. The applicant's mark consists of the words SMILING SHARK in a stylised font, with the A elongated to evoke the shape of a shark fin. These appear alongside a device of a shark. The eye is naturally drawn to the element of the mark that can be read, and so the words play the greater role in the overall impression. The device plays a slightly lesser role, with the stylisation contributing the least.

Visual Comparison

33. The word SHARK is the only element of the opponent's marks and is replicated in the applicant's mark. The word SMILING and the device in the applicant's mark are clearly points of visual difference. The opponent's mark is a word only mark and so could be used in any font. In my view, the marks are visually similar to between a low and medium degree.

Aural Comparison

34. The only element of the applicant's mark that will be pronounced is the word element. The word SHARK will be articulated identically in all three marks, with the word SMILING being a point of aural difference. In my view, the marks are aurally similar to a medium degree.

Conceptual Comparison

35. The word SHARK is an ordinary dictionary word referring to a type of large fish. In the applicant's mark, the word SMILING qualifies the word SHARK. This is reinforced by the shark device which depicts a cartoon shark with its teeth visible. In my view, the marks share a medium degree of conceptual similarity.

The distinctive character of the earlier marks

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

38. The earlier marks consist of the ordinary dictionary word SHARK, which has no connection with the relevant goods. In my view, the earlier marks are inherently distinctive to a medium degree.

39. I note that the opponent has filed evidence of use, some of which relates to the EU market at large. However, it is the UK that is relevant for the purposes of assessing enhanced distinctiveness. I also note that some of the opponent's evidence focuses upon the NINJA brand, which is also a brand owned by the opponent, but which is not in issue in these proceedings. Consequently, I will discount any evidence which relates to other markets or brands. With this in mind, I note the following from the opponent's evidence:

a. The earliest evidence of use of the earlier marks in the UK is 2016.² Mr Seymour explains that the opponent focuses on two brands: SHARK, which mainly produces vacuum cleaners and hair dryers and NINJA which focuses on kitchen appliances.

b. The opponent's UK sales of SHARK branded products are as follows:

| | |
|------|------------------|
| 2017 | Over £38million |
| 2018 | Over £87million |
| 2019 | Over £156million |
| 2020 | Over £272million |
| 2021 | Over £291million |

c. This is supported by two sample invoices dated 28 July 2017 and 3 November 2021. These demonstrate sales to national retailers (CostCo and John Lewis), the greatest proportion of which relate to vacuum cleaners.³

² Exhibit AJC1

³ Exhibit WS2

- d. The opponent has invested over £142million in marketing its products in Europe (which includes the UK). However, no breakdown is given for the UK market.
- e. The opponent's UK website (examples of which have been provided which are prior to the relevant date) focus upon vacuum cleaners, as well as products for hair styling and air-purifying. I note that a significant proportion of the opponent's social media accounts also appear to focus upon vacuum cleaners.⁴
- f. The opponent uses social media to promote its brand, with the opponent's UK-dedicated Instagram account having more than 100,000 followers in October 2022.⁵
- g. "Cleaning appliances" represented the highest sales by product category for the opponent in 2022.⁶

40. I bear in mind that the UK sales figures provided are not broken down by product category and this is problematic for the opponent given that it appears to offer a range of products. However, the evidence shows that the "cleaning appliances" category was a significant part of the opponent's business in 2022. I note that in the rest of the evidence, the vast majority of the goods that could be deemed 'cleaning appliances' are vacuum cleaners. This is further supported by the narrative evidence of Mr Seymour which is that the opponent's SHARK business focuses primarily on vacuum cleaners and hair dryers. This evidence is unchallenged. On this basis, taking the evidence as a whole into account, I am prepared to infer that a reasonable proportion of the sales figures provided relate to vacuum cleaners and, to a lesser degree, hair dryers. Even a reasonable proportion of the sales figures listed would represent a significant intensity of use in the UK.

⁴ Exhibits WS7 to WS9

⁵ Exhibit WS9

⁶ Exhibit AJC2

41. Further, there is likely to be significant geographical spread given that the opponent sells through national retailers. I bear in mind that I have no market share figures, although sales in the millions of pounds is likely to represent a reasonable proportion of the market. I also bear in mind that there is no evidence of advertising/marketing expenditure specific to the UK. However, taking all of the evidence as a whole into account, I find the distinctiveness of the earlier marks to be enhanced through use to a reasonably high degree for vacuum cleaners and, to a lesser degree, hair dryers. I am unable to conclude that there is any enhanced distinctiveness for the other goods relied upon (being portable electric heaters for domestic use) because there is simply not enough information in the evidence to enable me to assess the extent of the use that has been made of the mark in respect of those goods.

Likelihood of confusion

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

43. I have found as follows:

- a. The goods are identical.

- b. The average consumer for the goods is a member of the general public who will pay at least a medium degree of attention during the purchasing process, although it may be higher for vacuum cleaners.
- c. The purchasing process is predominantly visual, although I do not discount an aural component to the purchase.
- d. The marks are visually similar to between a low and medium degree, and aurally and conceptually similar to a medium degree.
- e. The earlier marks are inherently distinctive to a medium degree, which has been enhanced through use to a reasonably high degree in relation to vacuum cleaners and, to a lesser degree, hair dryers.

44. Bearing in mind the differences between the marks, particularly the visual differences in the context of a predominantly visual purchasing process, I do not consider that the marks are likely to be mistaken one for the other. This is the case even where they are used on identical goods. In my view, there is no likelihood of direct confusion.

45. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the

earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

46. In respect of the applicant’s class 7 goods, the opponent relies upon the First Earlier Mark which is registered for goods that I have found benefit from enhanced distinctiveness. Consequently, I find that the word SHARK is so strikingly distinctive for those goods that the average consumer would consider that no one except the opponent would be using it as per category (a) of *LA Sugar*. Consequently, even when used in conjunction with an additional word and device as per the applicant’s mark, the average consumer would assume a connection between the respective undertakings resulting in a likelihood of confusion.

47. In respect of the applicant’s class 11 goods, I bear in mind that I have found these to be identical to the opponent’s class 11 goods, which is a factor in favour of the

opponent. However, the opponent does not benefit from enhanced distinctiveness in relation to the goods that I have found to be identical to the applicant's class 11 goods. I do not consider that the word SHARK, in this context, is so strikingly distinctive that the average consumer would expect only one undertaking to be using it. The addition of the word SMILING is not, in my view, a non-distinctive addition, nor is it consistent with a sub-brand or brand extension. I bear in mind that the categories of *LA Sugar* are not exhaustive, but I am unable to identify any other basis for indirect confusion to arise, nor has the opponent identified any. I bear in mind that there must be a proper basis for finding indirect confusion.⁷ Consequently, I find there to be no likelihood of indirect confusion for the class 11 goods.

48. The opposition based upon section 5(2)(b) of the Act is partially successful.

Section 5(4)(a)

49. 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.”

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

⁷ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

“(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.”

51. 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

52. The prima facie relevant date is the filing date of the application i.e. 20 November 2023. I note that there is a reference in the counterstatement to the applicant using the mark which is the subject of the application in issue, but that appears to be in reference to other jurisdictions. Consequently, I do not consider there to be any earlier relevant date.

Goodwill

53. *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“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.”

54. I have summarised the opponent's evidence of use above. For the same reasons already explained, I find that the opponent had a reasonably strong goodwill in relation to vacuum cleaners and, to a lesser degree, hair dryers at the relevant date.

Misrepresentation and damage

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

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

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

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

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

56. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

57. *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.”

58. I have found the opponent to benefit from a reasonably strong goodwill in relation to vacuum cleaners and, to a lesser degree, hair dryers. For reasons given above, the opponent’s field of activity is identical to that of the applicant in so far as it seeks

protection for goods in class 7. The fields of activity are more distant insofar as the applicant seeks protection in class 11. However, in my view, there is still a reasonable degree of overlap due to both parties being concerned with electrical domestic appliances (vacuum cleaners on the one hand and pocket warmers on the other). The sign relied upon under this ground is identical to the mark relied upon under section 5(2)(b), and so I apply the same findings as to similarity of the mark/sign as discussed above. Taking all of the circumstances of the case into account, I find that a substantial number of the opponent's customers would be misled into believing that the goods of the applicant are those of the opponent. Damage through diversion of sales and loss of control is easily foreseeable.

59. The opposition based upon section 5(4)(a) of the Act succeeds in its entirety.

Section 5(3)

60. 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 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.”

61. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

62. I bear in mind the relevant case law set out in the judgments of the CJEU in *Case C-375/97, General Motors*, *Case 252/07, Intel*, *Case C-408/01, Adidas-Salomon*, *Case C-487/07, L’Oreal v Bellure* and *Case C-323/09, Marks and Spencer v Interflora*

and Case C383/12P, Environmental Manufacturing LLP v OHIM. I can deal with this ground relatively swiftly.

63. I can deal with this ground relatively swiftly. I have summarised the opponent's evidence of use above. Whilst the test for enhanced distinctiveness is different to the test for reputation, the same factors are relevant to each. For the same reasons given above, I would have found a reasonably strong reputation for vacuum cleaners and, to a lesser degree, hair dryers in the UK at the relevant date. As the threshold for a link is lower than it is for likelihood of confusion, I would have found a link in relation to the applicant's class 7 goods, which would inevitably have resulted in damage given the identical nature of the goods. However, for the goods that survived the 5(2)(b) ground of opposition, a narrower list of goods is relied upon under this ground than considered in relation to the 5(4)(a) ground (i.e. only the class 11 goods). Consequently, this ground of opposition does not give the opponent any advantage over the 5(4)(a) ground that I have already considered. As such, I decline to consider it further.

CONCLUSION

64. The opposition succeeds and, subject to appeal, the application is refused for all goods against which the opposition was directed, namely:

Class 7 Hand-held tools, other than hand-operated.

Class 11 Pocket warmers.

65. The application may proceed to registration for the unopposed goods, namely:

Class 7 Scissors, electric; Glue guns, electric; Electric screwdrivers; Power-driven wrenches.

Class 11 Bicycle lamps; Nail lamps; Bedside lamps; Studio lamps; Inspection lamps; Table lamps; Head torches; Searchlights; Solar lamps.

COSTS

66. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of **£1,850**, calculated as follows:

| | |
|---|---------------|
| Preparing a Notice of opposition and considering the applicant's counterstatement | £400 |
| Preparing evidence | £850 |
| Written submissions in lieu | £400 |
| Official fee | £200 |
| Total | £1,850 |

67. I therefore order Haibo Wang to pay SharkNinja Operating LLC the sum of **£1,850**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 29th day of January 2026

S WILSON

For the Registrar