

O/0105/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003807628
IN THE NAME OF BIGNEAT LIMITED
FOR THE FOLLOWING TRADE MARK:

gBrite

IN CLASSES 9, 11, 37 AND 42

AND

IN THE MATTER OF AN APPLICATION FOR A DECLARATION
OF INVALIDITY UNDER NO. 506532
BY LED INNOVATION LTD

BACKGROUND AND PLEADINGS

1. On 08 July 2022, Bigneat Limited (“the proprietor”) applied to register the trade mark shown on the cover page of this decision in the UK (“the contested mark”). Registration was granted on 07 October 2022. The contested mark stands registered for the following goods and services:

Class 9: *Scientific, research and laboratory apparatus and instruments; apparatus and instruments for use in creating repeatable environments, including but not limited to, environmental chambers, photostability chambers, incubators, fingerprint development chambers, baths and circulators; apparatus and instruments for use in scientific, laboratory or medical research to control temperature and humidity; apparatus and instruments for use in biological research; laboratory incubators; constant humidity and temperature incubators for laboratory use; refrigerated incubators; diurnal incubators; insect growth chambers; steam-free humidity control equipment; plant growth chambers; biological safety cabinets; laboratory filters; carbon filters for laboratory use; parts and fittings for the aforesaid goods.*

Class 11: *Sterilization, disinfection and decontamination equipment; hydrogen peroxide chambers for sterilization, disinfection and decontamination purposes; hydrogen peroxide generating equipment for sterilizing, disinfecting and decontaminating incubators; decontamination chambers; dust and fume containment systems; dust and fume extraction and removal equipment, apparatus and installations; dust and fume extraction systems; installations for air extraction; ventilating hoods for laboratory use; air purification and air treatment equipment, apparatus and installations; parts and fittings for the aforesaid goods.*

Class 37: *Installation, maintenance and repair services.*

Class 42: *Research services; industrial research services; product research, design and development services; scientific, medical and laboratory research services.*

2. On 22 September 2023, LED Innovation LTD (“the applicant”) made an application for a declaration of invalidity in respect of the proprietor’s mark pursuant to Section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

3. For the purposes of its claims under Section 5(2)(b) and 5(3), the applicant relies on the following trade mark:

UK00003793302



Filing date: 28 May 2022

Registration date: 26 August 2022

Class 11: *Lighting; Strobe lights [light effects]; Lighting tracks [lighting apparatus]; Lighting and lighting reflectors; Light Emitting Diode lighting fixtures; Strings of lights [rope lights]; Plasma Lighting System [PLS] lighting; Vehicle lighting and lighting reflectors; Light reflectors; Map lights; Street lights; Diffusers (Light -); Display lighting; Bicycle lights; Lighting armatures; Security lighting; Gas lights; Lighting panels; Emergency lights; Lighting glasses; Ceiling lights; Desk lights; Light projectors; Flood lights; Spot lights; Mood lights; Strip lights; Light diffusers; Garden lights; Light fittings; Electric lights; Wall lights; Lighting transformers; Trailer lights; Road lights; Light shades; Lighting louvres; Decorative lighting; Book lights; Automobile lights; Lighting tubes; Pen lights; Light bulbs; Garden lighting; Aquarium lights; Lighting lamps; Bulkhead lights; Motorcycle lights; Search lights; Diving lights; Lights (Diving -); Decorative lights; Inspection lights; Vehicle lights; Fluorescent lights; Lighting units; Light fixtures; Helmet lights; Outdoor lighting; Light assemblies; Lighting fittings; Lighting elements; Electric lighting; Cycle lights; Light bars; Emergency lighting; Solar lights; Reading lights; Lighting installations; Light installations; Lighting apparatus; Lighting fixtures; Klieg lights; Lighting towers; LED*

[light-emitting diode] lighting fixtures; Light-emitting diodes [LED] lighting apparatus; Light emitting diode lights for automobiles; Organic light emitting diodes (OLED) lighting devices; Strobe lights [decorative]; Electric fairy lights; Electric light fittings; Commercial lighting fixtures; Strings of lights; Electrical lighting fixtures; Vehicles (Lights for -); Pocket search lights; Mobile light towers; Electric holiday lights; LED mood lights; Bulbs for lighting; Electric light bulbs; Plant grow lights; Industrial lighting fixtures; Roof lights [lamps]; Fluorescent lighting apparatus; LED light machines; Lanterns for lighting; LED landscape lights; Sconce lighting fixtures; Emergency lighting installations; Electric lighting fixtures; Stage lighting apparatus; Casings for lights; Ceiling light fittings; Halogen light bulbs; Lights for vehicles; Bicycle dynamo lights; Boat trailer lights; LED lighting installations; Light bulbs, electric; Architectural lighting fixtures; Vehicle headlamps; Portable headlamps; Headlamp bulbs; Automobile headlamps; Automotive headlamps; Headlamps for automobiles; Headlamps for vehicles; Headlamps for use on automobiles; Headlamps for use on cycles; Headlamps for use on motor cycles; Tail lamp bulbs; Vehicle tail lights; Tail lights for vehicles; Lamps; Lamp reflectors; Lamp finials; Lamp holders; Standing lamps; Wall lamps; Lamp shades; Lamp mantles; Lamp glasses; Overhead lamps; Desk lamps; Fluorescent lamps; Projector lamps; Germicidal lamps; Lamp bulbs; Floor lamps; LED lamps; Hanging lamps; Lamp fittings; Lamp stands; Electric lamps; Infrared lamps; Inspection lamps; Aquarium lamps; Solar lamps; Chimneys (Lamp -); Spot lamps; Incandescent lamps; Nail lamps; Arc lamps; Lamp assemblies; Vacuum lamps; Lamps (Electric -); Bicycle lamps; Gas lamps; Safety lamps; Emergency lamps; Tanning lamps; Lamp casings; Lamp chimneys; Table lamps; Projection lamps; Discharge lamps; Reflector lamps; Reflectors (Lamp -); Washstand lamps; Standard lamps; Pedestal lamps; Lamps for vehicles; Electric lamp bulbs.

4. The invalidity under Section 5(2)(b) is directed at the contested goods in class 11, whereas the invalidity under Section 5(3) and 5(4)(a) is directed at the entire registration.

5. Under Section 5(2)(b) the applicant claims that the proprietor has an identical name, that the proprietor has copied the applicant's name, that the contested mark is registered for an identical class, and that there is a likelihood of confusion. Within this

ground, the applicant states that it has been using the earlier mark for two years prior to the registration.

6. Under Section 5(3) the applicant claims that its mark has acquired a respectable reputation over the years with thousands of loyal customers and a national online presence. It is claimed that due to the similarity of the marks, the relevant public will believe that the marks originate from the same or economically connected undertakings. As a result, the applicant's position is that use of the proprietor's mark would take unfair advantage of the applicant's mark. In addition, the applicant claims that use of the proprietor's mark is likely to jeopardize the applicant's company image because consumers are likely to believe that the brands are connected causing detriment to the reputation and/or distinctive character of the applicant's mark.

7. Lastly, under the Section 5(4)(a) ground, the applicant relies on the earlier unregistered right 'GBrite' which it claims to have used throughout the UK since August 2020 in respect of *car/vehicle lighting bulbs, car/vehicle headlamps/lights, car/vehicle taillamps/lights, led bulbs and lighting fixtures, display lighting, bicycle lighting, mood lights, strip lights, reflector lamps, electric lamp bulbs, light emitting diode, light projectors, xenon bulbs, landscape lights*. Whilst these goods are listed beneath the earlier sign rather than in the Q2 box, it is clear that those are the goods for which the earlier sign has allegedly been used. In addition, the applicant states that the earlier mark has been used on all product packaging, online advertisement and platforms. Within this ground, the applicant states they have been using the earlier sign for three years. As a result of this use, the applicant claims to have gained a very respectable reputation in the UK.

8. The proprietor filed a counterstatement wherein it denied the claims against it.

9. The applicant is a litigant in person. The proprietor is represented by HGF Limited.

10. Only the applicant filed evidence. No hearing was requested and both parties filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

The evidence

11. The applicant's evidence in chief consists of a witness statement from Jawad Malik dated 1 May 2024 and accompanied by eight exhibits being those labelled Exhibits JM1 – JM8. Mr Malik is the applicant's director and gives evidence about how the earlier mark was coined and how it has been used. Mr Malik's evidence also includes evidence about the proprietor's use of the contested mark.

12. I do not intend to summarise the parties' evidence (or their submissions, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

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

Relevant statutory provision: Section 47

14. Sections 5(2)(b), 5(3) and 5(4)(a) of the Act have application in invalidation proceedings because of the provisions of Section 47 of the Act, which states as follows:

“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.

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

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

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

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

(c) the use conditions are met.

(2B) The use conditions are met if –

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

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

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

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

(2C) For these purposes –

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

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

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

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

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

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on

the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

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

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

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

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

(3) [...]

(4) [...]

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

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

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

15. The trade mark relied upon by the applicant qualifies as an 'earlier trade mark' pursuant to Section 6 of the Act. As it had not completed its registration process more than five years before the date on which the application for a declaration of invalidity was filed, it is not subject to the use provisions set out at above.

Section 5(2)(b)

16. 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.”

17. 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.”

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

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of goods

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

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

22. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that the responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC (as he then was) noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

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

23. Whilst on the other hand:

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

24. 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.”

25. The competing goods are as follows:

The contested goods	The earlier goods
<p>Class 11: <i>Sterilization, disinfection and decontamination equipment; hydrogen peroxide chambers for sterilization, disinfection and decontamination purposes; hydrogen peroxide generating equipment for sterilizing, disinfecting and decontaminating incubators; decontamination chambers; dust and fume containment systems; dust and fume extraction and removal equipment, apparatus and installations; dust and</i></p>	<p>Class 11: <i>Lighting; Strobe lights [light effects]; Lighting tracks [lighting apparatus]; Lighting and lighting reflectors; Light Emitting Diode lighting fixtures; Strings of lights [rope lights]; Plasma Lighting System [PLS] lighting; Vehicle lighting and lighting reflectors; Light reflectors; Map lights; Street lights; Diffusers (Light -); Display lighting; Bicycle lights; Lighting armatures; Security lighting; Gas lights; Lighting</i></p>

fume extraction systems; installations for air extraction; ventilating hoods for laboratory use; air purification and air treatment equipment, apparatus and installations; parts and fittings for the aforesaid goods.

panels; Emergency lights; Lighting glasses; Ceiling lights; Desk lights; Light projectors; Flood lights; Spot lights; Mood lights; Strip lights; Light diffusers; Garden lights; Light fittings; Electric lights; Wall lights; Lighting transformers; Trailer lights; Road lights; Light shades; Lighting louvres; Decorative lighting; Book lights; Automobile lights; Lighting tubes; Pen lights; Light bulbs; Garden lighting; Aquarium lights; Lighting lamps; Bulkhead lights; Motorcycle lights; Search lights; Diving lights; Lights (Diving -); Decorative lights; Inspection lights; Vehicle lights; Fluorescent lights; Lighting units; Light fixtures; Helmet lights; Outdoor lighting; Light assemblies; Lighting fittings; Lighting elements; Electric lighting; Cycle lights; Light bars; Emergency lighting; Solar lights; Reading lights; Lighting installations; Light installations; Lighting apparatus; Lighting fixtures; Klieg lights; Lighting towers; LED [light-emitting diode] lighting fixtures; Light-emitting diodes [LED] lighting apparatus; Light emitting diode lights for automobiles; Organic light emitting diodes (OLED) lighting devices; Strobe lights [decorative]; Electric fairy lights; Electric light fittings; Commercial lighting fixtures; Strings of lights; Electrical lighting fixtures; Vehicles (Lights for -); Pocket

	<p><i>search lights; Mobile light towers; Electric holiday lights; LED mood lights; Bulbs for lighting; Electric light bulbs; Plant grow lights; Industrial lighting fixtures; Roof lights [lamps]; Fluorescent lighting apparatus; LED light machines; Lanterns for lighting; LED landscape lights; Sconce lighting fixtures; Emergency lighting installations; Electric lighting fixtures; Stage lighting apparatus; Casings for lights; Ceiling light fittings; Halogen light bulbs; Lights for vehicles; Bicycle dynamo lights; Boat trailer lights; LED lighting installations; Light bulbs, electric; Architectural lighting fixtures; Vehicle headlamps; Portable headlamps; Headlamp bulbs; Automobile headlamps; Automotive headlamps; Headlamps for automobiles; Headlamps for vehicles; Headlamps for use on automobiles; Headlamps for use on cycles; Headlamps for use on motor cycles; Tail lamp bulbs; Vehicle tail lights; Tail lights for vehicles; Lamps; Lamp reflectors; Lamp finials; Lamp holders; Standing lamps; Wall lamps; Lamp shades; Lamp mantles; Lamp glasses; Overhead lamps; Desk lamps; Fluorescent lamps; Projector lamps; Germicidal lamps; Lamp bulbs; Floor lamps; LED lamps; Hanging lamps; Lamp fittings; Lamp stands; Electric lamps; Infrared lamps; Inspection lamps;</i></p>
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	<i>Aquarium lamps; Solar lamps; Chimneys (Lamp -); Spot lamps; Incandescent lamps; Nail lamps; Arc lamps; Lamp assemblies; Vacuum lamps; Lamps (Electric -); Bicycle lamps; Gas lamps; Safety lamps; Emergency lamps; Tanning lamps; Lamp casings; Lamp chimneys; Table lamps; Projection lamps; Discharge lamps; Reflector lamps; Reflectors (Lamp -); Washstand lamps; Standard lamps; Pedestal lamps; Lamps for vehicles; Electric lamp bulbs.</i>
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26. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

27. The only goods that the applicant seeks to invalidate under this ground are those in class 11. Whilst the competing goods are in class 11, as set out in Section 60A of the Act, goods are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

28. In its statement of grounds, the applicant did not provide any reason as to why it considers the goods to be identical or similar. However, in its submissions in lieu, the applicant stated that regardless of the sector, both parties' goods use the same LED technology also stating that this is the most significant similarity between the goods.

29. The proprietor's goods are various types of sterilization, disinfection and decontamination equipment in class 11, namely *Sterilization, disinfection and decontamination equipment; hydrogen peroxide chambers for sterilization, disinfection and decontamination purposes; hydrogen peroxide generating equipment for sterilizing, disinfecting and decontaminating incubators; decontamination chambers; dust and fume containment systems; dust and fume extraction and removal equipment, apparatus and installations; dust and fume extraction systems; installations for air extraction; ventilating hoods for laboratory use; air purification and air treatment equipment, apparatus and installations; parts and fittings for the aforesaid goods.*

30. The earlier goods include various types of lamps, lights, and light bulbs. The goods have a different nature, purpose and method of use (i.e. lighting equipment *versus* sterilization, disinfection and decontamination equipment), and target different consumers (i.e. electricians and members of the general public *versus* labs, manufacturers and builders). Though an occasional overlap in terms of consumers is not impossible (insofar as the user of sterilization, disinfection and decontamination equipment might also need to purchase a light bulb or other lighting equipment), it would not be the norm. Since the goods target different consumers, are not used together and are not fungible, they are neither complementary nor in competition. Lastly, there is no evidence that the goods are distributed through the same trade channels or are produced by the same companies; on the contrary, given the highly specialised nature of the contested sterilization, disinfection and decontamination equipment, it is unlikely that they will be provided by suppliers of lighting equipment.

31. As regards the applicant's argument that the goods use the same LED technology, the latter refers to the use of light-emitting diodes (LEDs), which are semiconductor devices that emit light when an electric current passes through them. First, there is no evidence that the proprietor's sterilization, disinfection and decontamination

equipment use LED technology – in this connection, the applicant has provided only one screenshot showing a LED plant growth chamber,¹ however, it is not obvious that this item would fall within the proprietor's terms *chambers for sterilization, disinfection and decontamination purposes* and *decontamination chambers*. Second, even if it was established that both sets of goods use LED technology (which is not), that fact alone would not create a meaningful similarity between the goods in a trade mark sense. Accordingly, I find that the contested goods in class 11 and the earlier goods in class 11 are dissimilar.

Conclusion of the goods comparison

32. Under the Section 5(2)(b) ground, a likelihood of confusion can only exist where there is at least some similarity between the goods and services.² This means that as a result of my findings above, the present ground fails in its entirety.

33. I will now proceed to consider the Section 5(3) ground.

Section 5(3)

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

“5(3) A trade mark which –

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.”

¹ Exhibit JM4

² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

35. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that

this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

36. The conditions of Section 5(3) are cumulative. Firstly, the applicant must show that the marks at issue are similar. Secondly, the applicant must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them. Finally, assuming the first three conditions have been met, Section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of Section 5(3) that the goods or services be similar,

although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

37. In order to consider whether there exists a reputation in the applicant's mark, I turn to the evidence filed.

38. Mr Malik states that the applicant is a UK lighting company and that it was incorporated on 10 March 2018. Mr Malik also says that he has been trading from 2013 under the company name Xenon Bulbs Ltd and that the latter was incorporated on 4 March 2013. Mr Malik says that one of their three eBay stores fulfilled more than 243,000 orders since it was launched and received over 80,000 feedback with a 99.1% positive rating. He also says that their second largest store sold over 152,000 products with a positive rating of over 98.4%. Mr Malik further states that "*with a proven track record spanning over fifteen years in the retailing of LED and bulb products to a substantial customer base*" he recognised the importance of establishing distinct brand identities to thrive in the competitive market and for this purpose the applicant strategically developed the brand name 'Gbrite' under which to market its LED products. In this connection, Mr Malik explains that he coined the term 'Gbrite' by combining the verbal elements 'GB' and 'Bright', that he conducted some prior online searches which did not reveal any prior use of this term, and that it is unlikely that someone created the word 'gBrite' independently, given that it is a neologism and not a dictionary word.

39. Mr Malik says that the final printed packaging featuring the 'Gbrite' trade mark was produced on 28 November 2018³ and that this marked the inception of 'Gbrite' branded products, which has since proliferated into multiple product lines.

40. I pause here to observe that (a) it appears that the first use of the trade mark 'Gbrite' by the applicant occurred at the end of 2018; (b) Mr Malik says that he has been trading from 2013 under a different company name; (c) Mr Malik suggests that it

³ Exhibit JM1

uses multiple brands, and that the brand 'Gbrite' was developed for the purpose of marketing a line of LED lighting products. Bearing in mind all of this, it is reasonable to conclude that the reference to 243,000 and 152,000 products sold includes sales achieved prior to November 2018 (i.e. when the brand 'Gbrite' was launched) under different brands.

41. Mr Malik provides copy of an invoice⁴ dated 23 October 2018 showing the purchase of 500 'Gbrite' light bulbs by the applicant from a manufacturer based in China. Mr Malik says that this is only a fraction of the sales figures achieved by the applicant and that the rest of the sales are not disclosed. Whilst Mr Malik also states that from the latter half of 2018 until the date of the witness statement cumulative sales of over 4,000 units of the bulb products shown on the invoices have been recorded, it is not clear what proportion of these sale falls prior to the relevant date of 08 July 2022. Mr Malik says that this disclosure "*is intended to underscore the substantial volume of sales attributed under the 'Gbrite' brand*".

42. Mr Malik states that the first production of 'Gbrite' lighting products dates back to the end of 2018 and that the brand 'Gbrite' has been firmly established for a duration of five years. However, the relevant date for assessing the existence of a reputation is the filing date of the contested mark, which is 8 July 2022, approximately 3 and a half years after first production of Gbrite lighting products at the end of 2018.

43. In terms of marketing, Mr Malik says that they are very active and that his customers "*have further got to know [them] via the Gbrite name*". No further information about the marketing of the brand 'Gbrite' is provided. Mr Malik also states that "*as a small business owner heavily involved in marketing, [he] regularly conducts market research to stay informed about products and competitors*" and that prior to this dispute, [he] had never encountered another entity using the 'Gbrite' trade mark. Finally, Mr Malik exhibits an undated screenshot showing the result of a Google search for the term 'Gbrite' which he claims shows results exclusively related to the applicant's brand.⁵

⁴ Exhibit JM2

⁵ Exhibit JM8

44. The rest of the evidence is about the use of the proprietor's mark by a different company and the alleged lack of use of the same mark by the proprietor. In particular, Mr Malik says that an online search he conducted revealed that the proprietor's mark has been used only in relation to "*LED powered products*" including a 'Gbrite' plant growth chamber by a company called Caron.⁶ However, neither this evidence nor the fact that the applicant has used the earlier mark prior to the proprietor using the contested mark (or applying to register the contested mark) assists the applicant in establishing reputation. This is because, as correctly observed by the proprietor in its submissions in lieu, the contested mark is less than five years old, and the proprietor is under no requirement to have used the mark at this stage. Likewise, Mr Malik's statement that "*our own brand has sold thousands of units to UK consumers, demonstrating our significant presence and market share*" is completely unsupported as the evidence does not even establish how many units were sold under the earlier mark prior to the relevant date. In this connection, in its written submissions the applicant states:

"Given the ease with which sales data and its existence can be independently verified, exact financial figures have not been disclosed in this witness statement. Instead, a general indication of sales performance has been provided, which sufficiently supports the claim while preserving confidentiality and protecting commercially sensitive information".

45. This is a completely wrong approach by the applicant as these are adversarial proceedings between the parties and it is neither my nor the Tribunal's job to investigate matters and actively seek evidence. The burden of establishing a reputation falls on the proprietor of the earlier mark.⁷

46. Lastly, Mr Malik's evidence that the applicant's snapchat account has over 5,000 followers, and that their Facebook page has 6.2K followers and over 6,000 likes is not helpful. This is because, first, the screenshot provided does not feature the earlier mark and second, it is undated.⁸ In this connection, the applicant confirmed in its

⁶ Exhibit JM4

⁷ Sacentro – Cinerocio de Texteis SA v Michael Codd, BL O/360/20

⁸ Exhibit JM7

written submissions that www.xenonbulbs.co.uk is the applicant's website which is also the name on the applicant's Facebook page from which the screenshot appears to have been taken.

47. Taking all of the above into account, in particular: (a) the absence of turnover and marketing figures which would enable me to assess how many products the applicant has sold under the earlier mark and how much the applicant has invested in promoting the mark prior to the proprietor applying for the contested mark on 08 July 2022 (i.e. the relevant date); (b) the absence of any information about market share and geographical spread of the sales; and (c) Malik's admission that the applicant is a small business, I am of the view that the evidence before me is insufficient to give rise to a finding that the applicant's mark enjoys a level of reputation in the UK. Lastly, bearing in mind that the screenshot exhibited is undated and it is likely to have been obtained when the witness statement was drafted, the fact that a Google search for the term 'Gbrite' brought up some results relating to the applicant's products shows, at best, that the applicant's 'Gbrite' goods were marketed after the relevant date - this cannot establish reputation at the relevant date. Put simply, the use by the applicant is at too low a level in order to demonstrate that a significant part of the relevant public would know of its earlier mark. The consequence of this is that the present ground fails at the first hurdle.

48. I will now proceed to consider the last ground of opposition, being the Section 5(4)(a) ground.

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:

“(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).”

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

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

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

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

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

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

Relevant Date

53. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander Q.C., 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.’ ”

54. The proprietor’s mark does not have a priority date. Further, there is no evidence filed to show any earlier use of the proprietor’s mark (as the evidence of the proprietor’s activities is either undated or from after the relevant date) and, as such, the relevant date for the purposes of the applicant’s claim under the Section 5(4)(a) ground is the filing date of the proprietor’s mark, being 8 July 2022.

Goodwill

55. The first hurdle for the applicant is to show that it had the necessary goodwill in its sign at the relevant date and that the sign relied upon was distinctive of or associated with that goodwill.

56. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), 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.”

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

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

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the

prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

58. 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.”

59. Goodwill must be more than trivial in extent. 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.”

60. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (now KC), 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.”

61. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

“The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi’s witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of “reCUP” ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca’s Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the

size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

62. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales

held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, "*very limited*", the claimant's goodwill was found to be sufficient to entitle it to restrain the defendant's trade under LUMOS.⁹

63. Under this ground, the applicant relies upon the sign 'GBrite' which it claims to have used in relation to various lighting products, including lights and bulbs. Further, although under Section 5(2)(b) the applicant directs the invalidity action against the goods in class 11 only, the attack under Section 5(4)(a) is broader being directed against the entire specification.

64. Goodwill results from trading activities in the UK. I have summarised the applicant's evidence above for the purpose of assessing reputation, however, the same evidence is also relevant to the present ground.

65. As it will be recalled, the only specific figure that the applicant has provided in relation to goods branded under the sign 'GBrite' is an invoice showing that the applicant shipped 500 'Gbrite' light bulbs from a manufacturer based in China. However, there is no evidence of these goods being sold by the applicant in the UK, so it is not possible to determine when the goods were sold, and to whom. On that basis, I find that the evidence not being sufficient to establish with any real degree of certainty any sales in the UK prior to the relevant date, the applicant has failed to establish goodwill in the UK. But even if I were to proceed on the assumption that those 500 bulbs or lights that the applicant had imported in the UK were subsequently sold to UK consumers prior to the relevant date, the amount of trade is so small that would not give rise to any actionable (i.e. more than trivial) goodwill. Lastly, even if I

⁹ See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); (COA)

was wrong about goodwill, the outcome under Section 5(4)(a) is unlikely to be different from that under Section 5(2)(b). This is because, I have already found that the parties goods in class 11 are dissimilar, a finding which I would extend to the remaining goods and services in classes 9, 37 and 42 because (a) it is not obvious to me that they are similar and (b) the applicant did not put forward any reason as to why the proprietor's goods and services in classes 9, 37 and 42 are similar to its goods in class 11; on the contrary, in its submissions in lieu the applicant appears to admit that the goods and services are dissimilar as it states as follows:

“The goods or services of the later mark may not even be similar to those covered by the earlier mark. However, the reputation of the earlier mark can still create a risk of unfair advantage or dilution when the later mark is used.”

66. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

67. Although this was an infringement case, the principles apply equally under Section 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

68. Accordingly, the invalidity based on Section 5(4)(a) also fails.

OUTCOME

69. The invalidity has failed, and the proprietor's mark UK00003807628 will remain on the register.

COSTS

70. The proprietor 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 proprietor the sum of £600 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a counterstatement and considering the
applicant's TM26(I): £300
Submissions in lieu: £300
Total: £600

71. I, therefore, order LED Innovation LTD to pay Bigneat Limited the sum of £600. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 10th day of February 2026

TERESA PINTO
For the Registrar