O/0285/26

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO. UK00003618702

IN THE NAME OF SINBON ELECTRONICS CO., LTD.

TO REGISTER

sinbon

AS A TRADE MARK IN CLASS 9

AND

THE OPPOSITION THERETO

UNDER NO. OP000428758

BY

SIMON, S.A.

BACKGROUND AND PLEADINGS

1. On 30 March 2021 SINBON Electronics Co., Ltd. ("***the Applicant***") applied to register in the UK the trade mark shown on the cover page of this decision, under number UK00003618702 ("***the Contested Mark***"). The application claims a priority date of 22 May 2020.[1] The application was accepted and published in the Trade Marks Journal on 3 September 2021 in respect of the following goods in class 9:

   Class 9 Electronic components and devices; Cables and conduits, including electric cables, USB cables, coaxial cables, cables for telecommunications, optical cables, fiber optic cables, connection cables, communication cables, charging cables, optical cables and adaptor cables; Telegraph wire; Optical connectors; Plugs, sockets and other contacts [electric connections]; Antennas for wireless, WiFi and cellular communication; Connection boxes; Telemetering and remote control apparatus; Radio receiving set; Bar code reader; Cable assembly; Notebook computer; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Charging stations for recharging electric vehicles.

2. On 3 December 2021 Simon, S.A. ("***the Opponent***") opposed the application under section 5(2)(b) of the Trade Marks Act 1994 ("***the Act***").[2] The partial opposition is directed against the following goods in the application:

   Class 9 Electronic components and devices; adaptor cables; Optical connectors; Plugs, sockets and other contacts [electric connections]; Antennas for wireless, WiFi and cellular communication; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Charging stations for recharging electric vehicles.

3. The Opponent relies upon the following trade marks ("***the Earlier Marks***"):

[1] The priority is based on the EU trade mark (EUTM) number 018243525. The mark is a pending EU filing pursuant to Article 59 of the Withdrawal Agreement.
[2] The Form TM7 was filed on 3 December 2021, subsequently amended a few times and ultimately accepted and served to the applicant on 11 January 2022.

(i) trade mark number UK00906035554 ("***the first earlier mark***")

Filing date: 25 June 2007

Registration date: 22 December 2010

Priority date: 14 March 2007 from Spanish trade mark number M2760841-7.

Representation: simon

Relying upon the following goods and services:

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Alarms, sound and whistle alarms, anti-theft alarms and fire alarms, electric alarm bells, presence sensors, water level, electric loss and gas leak indicators, temperature indicators, thermostats, electric buzzers, flashing light signals; Detectors, electric monitoring apparatus; Apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating or controlling electricity; Electric cables, control panels, connection boards and switchboards (electricity); Electric couplings; switch-breakers; Push buttons for bells, Sockets, plugs and other contacts [electric connections], coaxial socket outlets, Connectors (electricity), Contacts, electric, Terminals (electricity), Rectifiers, Rheostats, Resistances, electric; Temperature controlling apparatus; Ammeters, voltmeters; Identification sheaths for electric wires; Plug boxes, branch boxes and switchboxes (electricity), electrical outlet covers; Regulators [dimmers] (Light -), electric; Organic light-emitting diodes (OLEDs); Transistors (electronic); Electric probes; Ignition (Electric apparatus for remote -); Intercommunication apparatus; Cell pack; Relays, electric; Apparatus for recordings, transmission and/or reproduction of sound and/or images; Telephone sets, telephone wire; Cell phones; Radiotelephony sets; Portable radio transmitters; Telephone-answering machines,

videophones; Video conferencing apparatus; Magnetic data carriers, magnetic encoders, chips (integrated circuits), magnetic cards; Cards for integrated circuits or for microprocessors; Video cassettes, sound recording discs; Magnetic discs and optical discs; Compact discs (CDs); Interactive compact discs (CD-Is, CD-ROMs); Digital versatile discs (DVDs); MP3s; MP4 players; Automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines; Electronic publications, including on webpages; Data processing equipment, Computer programs [downloadable software]; Recorded computer programs, in particular for navigation systems (GPS) and location devices; Computers and peripheral devices; Fire-extinguishing apparatus.

Class 35 Presentation of electrical, electronic, computer and telephone goods, and lighting goods, on communications media of all kinds, for retail purposes; Wholesaling and retailing of electrical, electronic, computer and telephone goods, and lighting goods, in shops; Demonstration of goods.

Class 37 Installation, repair and maintenance, in particular of electric, electronic, computer, telephone and lighting devices.

(ii) trade mark number UK00906299408 ("***the second earlier mark***")

Filing date: 21 September 2007

Registration date: 21 July 2008

Priority date: 23 March 2007 from Spanish trade mark number 2763089 (7).

Representation: simon connect

Relying upon the following goods:

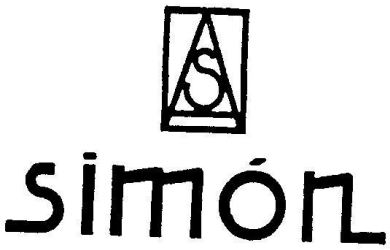
Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; alarms, acoustic alarms and whistle alarms, anti-theft alarms and fire alarms, electric alarm bells, digital programmes; presence sensors, water level indicators, electric loss and gas leak indicators, temperature indicators, thermostats, electric buzzers, flashing luminous signs; detectors, electric monitoring apparatus; apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating or controlling electricity; electric wires and cables, fibre optic cables; electrical wire; euro connector cables; control, connection and distribution panels (electricity); electric junction boxes; switches, illuminated switches, switches, push buttons for bells, power outlets, coaxial outlets, connections (electric), equipment connectors for telephone, television and telecommunications; electric contacts, terminals (electricity), terminal electric bases; columns and mini-columns for electric installations; electrical boards; current rectifiers, rheostats, electric resistors; thermostats; voltmeters, voltage indicator lamps; voltage boosters; ammeters; identification sheaths for electric wires; branch, junction and recording boxes (electricity), distribution cabinets (electricity); plug covers; light dimmers and regulators; light-emitting diodes (LEDs); transistors (electronic); electric probes; igniting apparatus, electric, for igniting at a distance; intercommunication apparatus; battery; electric relays; apparatus for recording, transmission and reproduction of sound or images; television sets and accessories therefor; telephone apparatus, wires and cables; telephone panels; mobile telephones; telephone adaptors and distribution frames; telephone bases; radiotelephony sets; portable radio telephones; telephone-answering machines, videophones; video-conferencing equipment; magnetic data and optical data carriers, magnetic encoders and wires, chips (integrated circuits), bar code readers, magnetic cards; cards for integrated circuits or for microprocessors; video cassettes, recording discs; magnetic discs and optical discs; compact Discs (CD's); interactive compact discs (CD-Is, CD-ROMs); digital versatile discs

(DVDs); MP3s; MP4 players; automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines; electronic publications, including on webpages; data processing equipment, modules for the editing of voice and data; computer programs (downloadable software); recorded computer programs, in particular for navigation systems (GPS) and location devices; computers and computer peripherals; fire-extinguishing apparatus.

(iii) trade mark number UK00900011429 ("***the third earlier mark***")

Filing date: 1 April 1996

Registration date: 29 January 1999



Representation:

Relying upon the following goods:

Class 9 Electric, signalling, checking (supervision) instruments and apparatus; electric metal cables and wires.

Class 11 Lighting equipment and installations.

(iv) trade mark number UK00903048949 ("***the fourth earlier mark***")

Filing date: 11 February 2003

Registration date: 1 March 2007

Representation:

Relying upon the following goods and services:

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Alarms, sound and whistle alarms, anti-theft and fire alarms, electric alarm bells, water level indicators, electric loss and gas leak indicators, temperature indicators, thermostats, electric buzzers; Flashing lights (luminous signals); Detectors, electric monitoring apparatus; Electric apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Electric probes; Ignition (Electric apparatus for remote -), Home automation devices (domotics), Intercommunication apparatus; Batteries and electric relays; Apparatus for recording, transmission or reproduction of sound images; Telephones; Radiotelephony sets; Portable radio transmitters; Answering machines; Magnetic data media; Magnetic encoders, Chips (integrated circuits), Cards (encoded -), magnetic, Cards for integrated circuits or for microprocessors; Video cassettes, CD-Is; Compact discs [read-only memory]; DVDs and Phonograph records, Electric cable and wires, Fiber optic cables, Automatic vending machines and mechanisms for coin operated apparatus, Cash registers, calculating machine, Data processing equipment, Computer programs (electronically downloadable software) and computers; Fire-extinguishing apparatus.

Class 37 Installation, repair and maintenance, in particular of electric, electronic, computer, telephone and lighting devices.

4. By virtue of their earlier filing (or priority) dates, the registrations qualify as earlier marks under section 6(1) of the Act. As the Earlier Marks completed their registration procedure more than five years before the priority date of the

application, they are, in principle, subject to the use provisions set out in section 6A of the Act. The Opponent has stated that it has used the marks for all the goods and services relied on.

5. In its notice of opposition, the Opponent states that the competing goods and services are identical or highly similar and that the Contested Mark is visually and aurally similar to the Earlier Marks as the respective marks share the first and last two letters. Therefore, there exists a likelihood of confusion including a likelihood of association between the marks. The Opponent requests that the application is refused in its entirety and an award of costs is made in its favour.

6. The Applicant filed a defence and counterstatement denying all of the Opponent's claims.[3] The Applicant also requested that the Opponent provides proof of use.

7. The Applicant is represented by Jones Day. The Opponent is represented by Howard Kennedy LLP.[4]

8. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the Earlier Marks were converted into comparable trade marks (UK). Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing (or priority) dates remain the same.

Relevance of EU law

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

EVIDENCE AND SUBMISSIONS

[3] Form TM8 dated 11 October 2022.
[4] The Opponent was initially represented by Mohun Aldridge Sykes Limited. On 29 May 2024 the Opponent appointed Gunnercooke LLP as new representative and on 14 February 2025 Howard Kennedy LLP was appointed as new representative.

10. During the evidence rounds the Opponent filed evidence in chief in the form of a witness statement from Marc Pérez Domedel Ahi, Managing Director of the Opponent for the EMEA region, dated 17 June 2024 and Exhibits MPD1– MPD14. The Applicant filed evidence in reply in the form of a witness statement of Jesse Huang, Vice President of Global Sales of the Applicant, dated 14 October 2024, along with Exhibit JH1. All the witnesses are duly authorised to provide evidence.

11. A hearing took place before me, by videoconference, on 25 March 2026. Prior to the hearing, only the Applicant filed a skeleton argument. At the hearing, the Applicant was represented by Andrew Norris KC, of Counsel, of Hogarth Chambers. The Opponent elected not to attend.

12. The parties' evidence and written and oral submissions will not be summarised here, but will be referred to as and where appropriate during this decision. This decision is taken following a careful perusal of the papers as well as a careful consideration of the submissions presented at the hearing.

PRELIMINARY MATTERS

The Applicant owns an earlier mark for "Sinbon" in class 9

13. The Applicant contends that it owns the registered UK trade mark number UK00903154556 for "sinbon" in class 9 which was filed on 24 April 2003 and it submits that it has built a considerable goodwill for this mark.[5] Whilst I note the Applicant's submissions, the alleged fact that the Applicant owns earlier rights in the "Sinbon" mark does not assist it to defend its application in the case at hand against an opposition filed under section 5(2)(b) of the Act for the reasons given in Tribunal Practice Notice 4/2009 which states (my emphasis):

> "4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.
>
> 5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered

[5] Applicant's counterstatement at [9].

proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

14. Therefore, I dismiss this argument made by the Applicant and I will not consider it any further.

Alleged statutory acquiescence by the Opponent

15. Section 48(1) of the Act states that a party may not seek to invalidate a later mark if it has acquiesced in the use of the mark for a continuous period of five years. Although the case at hand does not pertain to an invalidation action, the Applicant contends that the Opponent, by not opposing the registration of the Applicant' trade mark number UK00903154556 and by not objecting to the use of such mark, has accepted (acquiesced) that there is no risk of confusion between the marks at hand for the goods in class 9.[6] Thus, I find that the same principles apply here to determine whether the Opponent has, in fact, acquiesced to the Applicant's use of "sinbon" for a five-year period.

16. In *Budějovický Budvar Národní Podnik v Anheuser-Busch Inc*, Case C-482/09, the Court of Justice of the European Union ("CJEU") identified four conditions that must be met for the five-year period to start. It said:

"54. First, since Article 9(1) refers to a 'later registered trade mark', registration of that mark in the Member State concerned constitutes a necessary condition. The period of limitation in consequence of acquiescence cannot therefore start to run from the date of mere use of a later trade mark, even if the proprietor of that mark subsequently has it registered.

[…]

[6] Applicant's counterstatement at [31] – [38].

56. Second, the application for registration of the later trade mark must have been made by its proprietor in good faith.

57. Third, the proprietor of the later trade mark must use his trade mark in the Member State where it is registered.

58. Fourth, the proprietor of the earlier trade mark must be aware of the registration of the later trade mark and of the use of that trade mark after its registration."

17. In *Industrial Cleaning Equipment (Southampton) Limited v Intelligent Cleaning Equipment Holdings Co Ltd & Anor* [2023] EWCA Civ 1451, Arnold LJ held that the five-year period begins to run when the proprietor of the earlier trade mark becomes aware of the use of the later trade mark, whether or not it is aware of the registration of the later trade mark. In doing so, he concluded that the Court should depart from *Budvar* on this particular point.

18. The trade mark number UK00903154556 is a registered mark and so the first condition is clearly met. The Applicant does not provide any submissions on whether the Opponent acted in bad faith when filing the Earlier Marks.

19. The Applicant has not claimed that the Opponent was aware of the registered "sinbon" mark, but it merely argues that the Opponent never "*asserted trade mark rights over 'sinbon'*" resulting in the fact that the Opponent accepts that no confusion between the marks at hand is likely to occur.[7] In *Asolo Ltd v EUIPO*, Case T-150/17, the General Court ("GC") said that:

"35. […] the proprietor of a trade mark which is contested by way of an application for a declaration of invalidity cannot merely prove the potential awareness of the use of his trade mark by the proprietor of an earlier trade mark or establish consistent evidence giving rise to the presumption of the existence of such awareness (see, to that effect and by analogy, judgment of 20 April 2016, *SkyTec*, T-77/15, EU:T:2016:226, paragraph 34)."

[7] Applicant's counterstatement at [32].

20. It is necessary for the Applicant to prove the actual awareness the Opponent had of the use of the "sinbon" mark.[8] The Applicant has adduced no evidence to show that the Opponent was aware of the use of "sinbon", and so the Applicant's argument of alleged statutory acquiescence (and resulting acceptance of any lack of confusion) fails.

The parties operate in different market sectors

21. Ms Huang, in her witness statement, contends that the Opponent operates in a very different market from the Applicant. Ms Huang reports that although both parties manufacture electronic goods, the Opponent mostly markets light fitting and plug sockets whereas the Applicant markets wires, electronic connectors and components.[9]

22. Although I appreciate Ms Huang's statement in this regard, I am required to make the assessment of the likelihood of confusion notionally and objectively based on the Opponent's goods and services, as registered, and the applicants' goods, as applied for, in accordance with the relevant case law. That assessment requires that I must not take into account the actual way that either party has used their marks in the marketplace or the kinds of goods and/or services that those marks have been used in relation to thus far. Rather, I must consider all of the circumstances in which the mark applied for might be used if it were registered.[10] This is because trade mark registrations are items of property which may be sold by the Applicant and/or Opponent to third parties in the future and may therefore be used in a different way, or upon/in relation to different goods/services, than those used by the current proprietors of those marks. In this connection, in *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-171/06P, the CJEU stated:

> "59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take

[8] See *Asolo*, at [34].
[9] Jesse Huang's witness statement dated 14 October 2024 at [7] and [10].
[10] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, [66].

those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

23. As such, it is not appropriate to take that factor into account in my assessment. However, I will make an assessment, later in this decision, as to who the average consumer could be for the goods and/or services at issue.

DECISION

Proof of use

24. I will begin by assessing whether there has been genuine use of the Earlier Marks.

The law

25. Section 6A of the Act states:

"(1) This section applies where

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

26. As the Earlier Marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7. (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) […]

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day -

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union".

27. Section 100 of the Act states that:

> "100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

28. Consequently, the onus is upon the Opponent to prove that genuine use of the registered trade marks was made in the relevant period. The relevant period in which genuine use must be established is the five-year period ending on the priority date of the Contested Mark. The Opponent states that the relevant period is 22 May 2015 – 22 May 2020.[11] I find this calculation of the proof of genuine use period to be incorrect. In the case before me, the correct relevant period is **23 May 2015 to 22 May 2020**. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant for the entirety of the relevant period which falls prior to IP Completion Day (i.e., 31 December 2020).

Case law

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

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and*

[11] Witness statement of Marc Pérez Domedel Ahi dated 17 June 2024, at [6].

Designs) [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional

items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

107. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

> "19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.
>
> […]
>
> 22. […] it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal […] comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.'"

30. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated that:

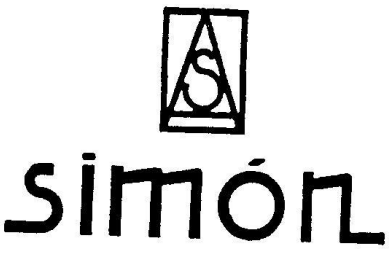
> "21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:
>
> > '[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.'
>
> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

31. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the marks in respect of the goods and/or services for which they are registered.

32. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[12] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

Form of the mark

33. Before I move on to assess if the Opponent has shown genuine use, I must first consider if I find the use of the Earlier Marks as shown in the evidence to be use of the marks as registered. For convenience, I reproduce the registered marks below:

The first earlier mark	
The second earlier mark	
The third earlier mark	

[12] *Jumpman* BL O/222/16.

The fourth earlier mark	SIMON

34. All the invoices in the evidence feature the first earlier mark as registered. This is clearly use upon which the Opponent can rely. Furthermore, the first earlier mark appears in the evidence in plain font as a word mark and in two colour variations: white wording on a blue background (Figure 1); blue wording on a white background (Figure 2):

simon

Figure 1

Figure 2

35. Notwithstanding some level of stylisation in the first earlier mark, its main distinctive element is the word “simon”. Therefore, I find that use of the first earlier mark in standard font (e.g., “Simon”) as well as in its colour variations amount to use of the mark as registered because the verbal component of the mark “simon” remains

clearly visible in such uses and the level of stylisation in the variant forms does not alter the distinctive character of the mark.[13]

36. In the evidence the first earlier mark (in both the acceptable standard font word "Simon" and the colour variations) appears also in combination with additional matter as shown in Annex A to this decision (e.g., "simon LIGHT UP EMOTIONS", "Simon 54", "Simon 500 CIMA", "simon brico", "simon lighting").

37. I consider that all the uses with additional matter listed in Annex A do not prevent the element "simon" (either as the first earlier mark or in the acceptable variants consisting of the plain word "Simon" or the colour variations) from being viewed independently to indicate the origin of the goods or services.[14] Therefore, I find that the uses of "simon" even when showed in combination with additional matter as shown in Annex A, they all remain acceptable uses of the first earlier mark.

38. Following from the above considerations, were I to find sufficient evidence of genuine use for the first earlier mark, this would lead to a finding of genuine use also for the second earlier mark and the fourth earlier mark. This is because the addition of "connect" in the second earlier mark and the style variation in the fourth earlier mark (i.e., absence of the dot on the "i", prolonged ending of the "n" and the addition of the device) do not affect the first earlier mark from being perceived independently and as the main distinctive element in the marks.

39. The third earlier mark consists of the word "simón" (being stressed on the second syllable) and it features the same device as the fourth earlier mark but slightly bigger in size and placed above the word "simón". I do not find the third earlier mark to be an acceptable variant of the first earlier mark. Whilst the presence of the device does not affect the mark's distinctiveness (as also found for the fourth earlier mark), the stress placed on the second syllable of "simón" means that the mark will be read differently and it is likely to acquire a different meaning from the first earlier mark. As it will be discussed further in this decision, it is my view that while the UK English speakers will understand "simon" as indicating a male personal name, they will not be familiar with the word "simón" and are likely to perceive it as a foreign term (perhaps resembling a Spanish word) devoid of a clear

[13] *LA Superquimica v EUIPO*, Case T-24/17, [39].
[14] As per *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12.

meaning. Therefore, in order to find genuine use of the third earlier mark, the Opponent must show evidence of independent use of the third earlier mark as I do not find this to be an acceptable variant of the first earlier mark. I will bear this in mind while assessing the evidence of use.

Evidence of use

40. Mr Perez Domedel reports that the Opponent's company was founded in 1916 in Spain, initially manufacturing electrical components, and later becoming an international business specialised in electrical installations, electronic control systems and lighting solutions including switches, sockets home automation systems and LED lighting.[15] In 2016 the Opponent published a book to mark 100 years of its history.[16] The book shows the evolution of the Opponent's mark. In 2016 the Opponent adopted the mark 

described as "the logo plus slogan 'Light Up Emotions'".[17] The evidence also shows that in 2016 the Opponent marketed a new type of switch called "Simon 100".[18]

41. Mr Perez Domedel provides sample invoices for the UK.[19] Although I appreciate that the prices in the invoices are in euro, Mr Perez Domedel states, in his witness statement, that the evidence shows the retail of the Opponent's goods and services in the UK. Furthermore, all the invoices are addressed to the UK. The evidence features seven sample invoices for the UK dated within the relevant period (February 2018 - October 2019) with individual total values spanning from a low of €84 to a high of €4,758. The total value of these sample invoices is over €13,000. In all the invoices the first earlier mark appears prominently in the header.

42. At the hearing Mr Norris pointed out that although the evidence features a table listing thirteen invoices for the UK,[20] only ten are within the relevant period and only seven of these invoices are actually provided in the evidence. Whilst this is noted,

[15] Mr Perez Domedel's witness statement dated 17 June 2024 at [7].
[16] Exhibit MPD1.
[17] Exhibit MPD1, page 5.
[18] Exhibit MPD1, page 13.
[19] Exhibit MPD3.
[20] Exhibit MPD4, page 51.

I will consider all the invoices listed in the summary table (within the relevant period) for the sake of my assessment.

43. Mr Perez Domedel provides a summary table providing a description of the products (and related sample images) to which the UK invoices refer (Figure 3).[21] Although some descriptions are in Spanish, those relating to the invoices within the relevant period are all in English. The evidence shows use of the first earlier mark for surface-mount-wall box, frame for wall-mount box, USB chargers, covers for USB chargers, socket outlet, and wall lights (lighting systems).

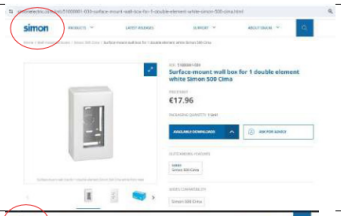
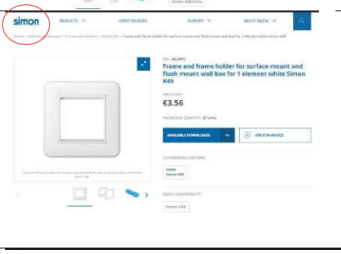
Article Description	Example images (image of the identical or similar product)	Invoice no./ Date / Territory			Goods under trademark
1 element surface wall box white		9100694524	03.01.2018	United Kingdom	Plug boxes, branch boxes and switchboxes (electricity), electrical outlet covers;
		9100719296	30.04.2018	United Kingdom	
		9100733790	26.06.2018	United Kingdom	
1 element frame+holder wall box white (KR245/9)		9100698059	24.01.2018	United Kingdom	Plug boxes, branch boxes and switchboxes (electricity), electrical outlet covers;
		9100700791	08.02.2018	United Kingdom	
		9100719296	30.04.2018	United Kingdom	
		9100733790	26.06.2018	United Kingdom	
		9100888483	24.09.2020	United Kingdom	
		9100972542	16.09.2021	United Kingdom	
		9101012087	24.03.2022	United Kingdom	
		9101020291	03.05.2022	United Kingdom	

Figure 3 – Exhibit MPD4, page 52

44. At exhibit MPD5 Mr Perez Domedel provides a summary table listing numerous invoice numbers (along with dates, product descriptions and products' images) for the EU.[22] The evidence also shows thirteen examples of invoices that are dated within the relevant period (April 2016 – February 2020) and that are addressed to Spain, Belgium, France, Romania, Bulgaria and the Netherlands. These invoices are for sums payable ranging from €270 to €14,000; with the total invoiced amount being over €52,000.[23] The nature of the products featured in these invoices is described in the summary table provided at exhibit MPD5. For example, the invoice number 9100721031 of 8 May 2018 (reproduced at exhibit MPD14, page 334) is featured in the table with the product description "switches" (see Figure 4).

[21] Mr Perez Domedel's witness statement at [10] and exhibit MPD4, pages 52 - 61.
[22] Exhibit MPD5, pages 63 - 110.
[23] Exhibit MPD14.

Apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating or controlling electricity;

Article Description	Example images (image of the identical or similar product)	Reference	Article Description	Invoice no./ Date / Territory			Goods under trademark
Switches	 [1]	**32101-35**[2]	INTERRUPTOR UNIPOLAR	9100590614	30/04/2016	Spain	Apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating or controlling electricity;
				9100608465	06/09/2016	Spain	
				9100618193	15/11/2016	Spain	
				9100631505	07/02/2017	Spain	
				9100645878	08/05/2017	Spain	
				9100673116	04/09/2017	Spain	
				9100687226	13/11/2017	Spain	
				9100702495	17/02/2018	Spain	
				9100721031	08/05/2018	Spain	
				9100752034	18/09/2018	Spain	
				9100762626	19/11/2018	Spain	
				9100776518	15/02/2019	Spain	
				9100799050	24/05/2019	Spain	
				9100823106	05/09/2019	Spain	
				9100841815	30/11/2019	Spain	
				9100854217	15/02/2020	Spain	
				9100864931	06/05/2020	Spain	
				9100877381	22/07/2020	Spain	
				9100921503	28/02/2021	Spain	
		32131-35[3]	INTERRUPTOR BIPOLAR	9100676574	23/09/2017	Spain	
				9100752018	18/09/2018	Spain	
				9100761153	12/11/2018	Spain	
		32201-35[4]	CONMUTADOR	9100587501	05/04/2016	Spain	
				9100610315	20/09/2016	Spain	
				9100618193	15/11/2016	Spain	
				9100674409	13/09/2017	Spain	
				9100690433	30/11/2017	Spain	
				9100700158	06/02/2018	Spain	
				9100724488	18/05/2018	Spain	
				9100752034	18/09/2018	Spain	
				9100777285	21/02/2019	Spain	
				9100795118	10/05/2019	Spain	
				9100837578	05/11/2019	Spain	
				9100854765	17/02/2020	Spain	
				9100868078	30/05/2020	Spain	
				9100874699	08/07/2020	Spain	

[1] Catálogo General 2018, p. 144
[2] https://www.simonelectric.com/32101-35-interruptor-unipolar-10-ax-250v-sistema-embornamiento-tornillo-blanco-simon-32.html - Catálogo General 2018, p. 144
[3] https://www.simonelectric.com/32131-35-interruptor-bipolar-16-ax-250v-sistema-embornamiento-tornillo-blanco-simon-32.html - Catálogo General 2018, p. 144
[4] https://www.simonelectric.com/32201-35-conmutador-10-ax-250v-sistema-embornamiento-tornillo-blanco-simon-32.html - Catálogo General 2018, p. 144

Figure 4 – Exhibit MPD5, page 63

45. Therefore, from the descriptions provided, the table shows the Opponent has issued invoices for parts of the EU (and within the relevant period) for switches (including dimmers, control/regulation modules, switch breakers and electric relays), electric cables, control panels, switchboards, switch covers/switch boxes (including switch covers for floors), covers for sockets, electric sockets (socket outlets), plugs, connectors, electric couplings, fuses, rectifiers, rheostats, resistances, relays, and electric transistors. I note that the evidence shows a relevant number of invoices for the Opponent's switches and pushbuttons (including dimmers), mount-wall plug boxes, sockets and covers for sockets, electric couplings and coaxial socket outlets. However, the evidence does not show use for all the goods listed. Accordingly, the table features images of some products that the Opponent generically categorises as "apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating or controlling electricity".[24] However, absent further clarification from the Opponent, I am unable to determine clearly what type of products these are. Furthermore, the table contains a few invoices, all mostly addressed to Spain, for some of the goods

[24] Exhibit MPD5, pages 66 – 68.

listed dated within the relevant period: electric cables (11 invoices), charging stations (8 invoices), connectors [electrical linkers] (7 invoices), fuses (19 invoices) relays (6 invoices), circuit breakers (4 invoices), relay changeover switches (25 invoices), plugs (24 invoices), remote control with FM tuners (12 invoices), digital radios with FM tuner and display (14 invoices), RF receiver mechanisms (9 invoices) and RF transmitter mechanisms (8 invoices). Absent further evidence showing the genuine use of the Earlier Marks for these goods, I do not find the invoices provided to be sufficient evidence of use for these goods.

46. The summary table at exhibit MPD5 indicates that the products' pictures derive from the Opponent's 2018 general catalogue, however the exhibit MPD5 only contains hyperlinks to the catalogue. I note exhibit MPD6 features extracts from the Opponent's catalogues (including the 2018 edition), but not all the goods described in the summary table are featured in the extracts provided. Furthermore, I note that, at the hearing, Mr Norris submitted that the product descriptions featured in exhibit MPD5 are in Spanish (or other foreign languages).

47. Whilst I note that not all the products are reproduced in the 2018 general catalogue and I agree that the column labelled "article description" provides descriptions in various languages, nonetheless in the summary table the Opponent provides English descriptions of the categories in which all the goods fall. Therefore, from the product descriptions (along with the related images) provided in the summary table, I can derive that the Opponent markets the goods listed above at paragraph [45]. This evidence shows distribution of the Opponent's products mostly in Spain along with other EU countries (i.e., Bulgaria, Belgium, Romania, Netherlands, Hungary, Portugal, Slovenia, Austria, Greece, Sweden, Lithuania, Estonia, Denmark, Republic of Ireland, Germany, France).

48. As shown above, in the summary table there are example images of the Opponent's products. I note that some of the images show the products along with the representation of a box featuring the first earlier mark (see, for example, Figure 3 and Figure 4). I infer from the evidence that the images show the packaging in which the goods are distributed. I will make further considerations on the Opponent's packaging below. As already indicated for the invoices relating to the UK, the evidence shows that also for the goods marketed in the EU, all the invoices

feature the first earlier mark.[25] Hence, this combined evidence clearly shows use of the first earlier mark in relation to the goods indicated above.

Type of product	Example images (image of the identical or similar product)
Cover for socket	

Figure 5 – Exhibit MPD5, page 101

Double Socket outlet	

Figure 6 – Exhibit MPD5, page 95

[25] Exhibit MPD14.

49. Mr Perez Domedel states that the "SIMON" mark was also featured in the Opponent's annual catalogues, online brochures, price lists and instructions sheets. Exhibit MPD6 features extracts of the product catalogues for 2016, 2018/2019 and 2020/2021. The evidence features the Opponent's catalogues in various languages (i.e., Spanish, English, French and Polish[26]). I note that whilst the Spanish catalogues are dated 2016 – 2021, the catalogues in the other languages are undated. However, Mr Perez Domedel states, in his witness statement, that the product catalogues featured in the evidence were published during the relevant period.[27] I also appreciate that one of the Spanish catalogues is dated 2020/2021, hence, it is partially dated outside of the relevant period.

50. Even if most of the evidence relating to the catalogues is in languages different from English, from the evidence in English and the images featured in the catalogues I can derive that the evidence mainly relates to the Opponent's switches and switch covers/frames, plugs, electrical sockets, cables, lighting, socket frames and cover boxes, digital programmers/thermostats. The first earlier mark is visible in various parts of all the catalogues.

51. Mr Norris at the hearing pointed out that there is no clarification from Mr Perez Domedel whether and to what extent the catalogues were distributed and the volume of catalogues distributed. I agree that Mr Perez Domedel could have clarified further on this point. However, the evidence also features various extracts from the Wayback Machine database showing some of the product catalogues available on the Opponent's websites in different countries (i.e., Spain, France and Poland) between 2016 and 2020.[28] As found for the product catalogues above, the first earlier mark is reproduced numerous times throughout this evidence as the mark appears in various parts of the catalogues.

52. The evidence also shows that third-party magazines and newspapers have referred to "SIMON" throughout the relevant period. The evidence features two articles in Spanish from "*Elle Decor España*" and "*La Vanguardia*" respectively dated May and July 2016. From the highlighted parts, I see there are references to

[26] I derive the catalogue's language from references to Poland such as the map and the country code top-level domain (ccTLD) "pl" featured in exhibit MPD6 at page 171.
[27] Mr Perez Domedel's witness statement at [13].
[28] I derive that the catalogues were available online in different countries because the evidence shows the extracts of the catalogues in different languages.

"Simon Barcelona" in relation to lighting[29] (according to the image in the magazine)[30] and "Simón" in relation to switches.[31] The evidence also features an online article from "*frieze.com*", dated September 2016, showing an image of a switch with the reference "Simon 100 light switch" and one online article from "*Arktera*" from 2016 referring to the fact that "SIMON" won the "Architecture Prize 2016".[32]

53. The evidence further contains a series of articles that albeit being in Spanish, they all refer to "SIMON" in relation to some of the Opponent's goods:

- One article from "*Arquitectura y Diseño*" (March 2019) shows images of indoor lighting and refers to "Simon 100".[33] The evidence indicates the article was published on "arquitecturaydiseno.es". From the ccTLD "es" the evidence refers to the Spanish market.
- One article from "*Electroeficiencia*" (February 2019) referring to "Simon" in conjunction with a few images of switches (or switch frames) and electric outlets.[34] The article is from "ledvance.es", thus, the ccTLD "es" indicates the article is addressed to the Spanish market.
- One article from "*districto oficina*" (September 2019). The cover says, "*Focus on Light Design*" and it contains a paragraph where "Simon" is referenced along with a picture of some sort of lighting exposition. I see the picture also shows the first earlier mark project on the wall of the lighting exposition.[35] The cover page of the magazine indicates "España", thus, I can infer this magazine is distributed in Spain.
- One article from "*simonelectric.com*" and "*manufacturasdeportivas.com*" referring to "Simon" in the title and featuring pictures of lighting devices along with pictures and schematics of an outdoor football field. I can infer from the evidence that the article talks about the lightning the Opponent provided and/or

[29] The article shows the wording "***Smon*** *Barcelona*". However, this is likely a typographical error.
[30] Exhibit MPD8, page 209.
[31] Exhibit MPD8, page 211.
[32] Exhibit MPD8, page 218.
[33] Exhibit MPD8, page 223.
[34] Exhibit MPD8, page 225.
[35] Exhibit MPD8, page 230.

designed, under the “SIMON” mark, for outdoor use.[36] I am unable to clearly determine if the article is addressed to the Spanish market.

- Two online articles (dated 2019) reporting on the fact that “Simon” provided lighting fittings for the covered market “La Boqueria” in Barcelona.[37]

54. The evidence also features one article from “*El País - Icon Design*” (April 2019) that refers to “Simon 100”. However, I am unable to determine the goods to which the article refers.

55. Overall, although being mostly in Spanish, the evidence shows some references to the “SIMON” mark from third-party magazines.

56. At paragraph [48] I noted that the evidence concerning the invoices for the EU showed instances where the first earlier mark was used on packaging. In this regard, Mr Perez Domedel reports that the “SIMON” mark has been used on the packaging for a variety of the Opponent’s products (e.g., electrical switches, sockets, socket outlets, connectors and lighting controls).[38] The evidence provided shows images of the first earlier mark used for the Opponent’s packaging as shown below (Figure 7 and Figure 8):

[36] Exhibit MPD8, page 232.
[37] Exhibit MPD8, pages 233 - 235 and 238 - 239.
[38] Mr Perez Domedel’s witness statement at [15].

Figure 7 – Exhibit MPD9, page 242

Figure 8 – Exhibit MPD9, page 247

57. The evidence further shows that the Opponent received the "IF DESIGN AWARD 2021" for its packaging. Although I appreciate that this evidence is dated outside of the relevant period, the Opponent, to be recognised for the award, must have developed and distributed its packaging before 2021. I reach this conclusion also because the evidence shows a timeline indicating that the packaging has been in use since 2014.[39] Furthermore, I already found above in this decision that the

[39] Exhibit MPD9, page 242.

invoice summary table contains instances showing the Opponent's packaging being used during the relevant period.

58. Mr Perez Domedel states that the mark "SIMON" has been in use throughout the relevant period on the Opponent's website "simonelectric.com" (first registered in 2002) as well as on other category-specific websites ("simonled.com", "simonlighting.com" and "simonbrico.com").[40] The evidence shows extracts from the Wayback Machine database featuring screenshots of some of the Opponent's products advertised on various of the Opponent's websites (including country-specific websites such as Spain and Poland). The evidence shows various instances where the Opponent has used, in the relevant period, the mark "SIMON" either by itself (the first earlier mark) or in combination with additional matter (all being acceptable uses as outlined at paragraph [37]), to advertise some of its goods (i.e., switches and covers/frames for switches, lighting (outdoor and indoor), electric sockets, plugs, boxes for electric outlets). The evidence also shows one instance where the second earlier mark is featured in one of the Opponent's product catalogues available online in relation to wall-mounted boxes for electric outlets.[41]

59. Mr Perez Domedel also reports that the Opponent's websites have had a high user traffic within the relevant period. The evidence shows that between March 2016 and February 2021, "simon.es" registered 1 million user traffic, "simonelectric.com" registered a traffic of 1.6 million users, "simonled.es" 110 thousand users and "simonlighting" almost 9 thousand users. The evidence shows that for all the websites, much of the user traffic derived from Spain. I appreciate that the evidence regarding 2021 is outside of the relevant period. Therefore, I bear in mind that the volume of the user traffic provided must be assessed without considering the traffic registered between May 2020 and February 2021. Although the evidence is not broken down by month, I nonetheless find that it shows a consistent level of user traffic for the Opponent's websites throughout the relevant period. Thus, this evidence when considered in combination with the evidence discussed in the paragraph above, shows an extensive exposure of the first earlier mark (also in its acceptable variant forms) at least for Spain within the relevant period.

[40] Mr Perez Domedel's witness statement at [16].
[41] Exhibit Mpd10, page 267.

60. Mr Perez Domedel states that the Opponent has advertised its goods and services under the "SIMON" mark on social media platforms within the relevant period. Mr Perez Domedel reports that the Opponent enjoys a following of over 78 thousand followers on Facebook, 36 thousand followers on LinkedIn and the Opponent's YouTube channel has over 400 videos and it registers 3,900 subscribers. The evidence shows extracts from the Opponent's social media platforms featuring the first earlier mark (in its acceptable colour variations) as account image for all the platforms along with uses of the mark "SIMON" as word only.[42] The evidence concerning the YouTube channel shows a mix of videos both in English and in Spanish. Although the YouTube channel seems to target, in part, the Spanish market, I find this to be relevant use being prior to IP Completion Day.

61. At the hearing Mr Norris correctly pointed out that neither Mr Perez Domedel's narrative nor the documentary evidence indicates whether the social media evidence refers to the UK (or other EU territories). Apart from my findings relating to the YouTube channel, I agree with Mr Norris that it is not clear to what territory the evidence refers. Since social media platforms can be accessed virtually from anywhere in the world, absent further clarification from the Opponent, I must consider this evidence as being global. Considering the virtual global coverage of such evidence, I find the following and reach of the Opponent's social media platforms to be relevant although not particularly high.

62. The evidence shows the Opponent has received various awards, within the relevant period, for some of its products (i.e., the "Red Dot Award 2018" for loop luminaire lighting, the "Red Dot Award 2018" for the "Simon 400" desktop connection panel and the "Red Dot Award 2017" for the "Simon 100" switch and socket range). From the evidence, I note the Opponent has further received three "iF Awards" between 2015 and 2018 for some of its products.[43] The evidence is in Spanish, so I am unable to determine for which products the Opponent received such awards apart from the "Simon|24" line that received the "iF Design Award 2016" for the Opponent's sockets.[44] Mr Perez Domedel reports, in his witness statement, that these awards show the excellence and innovation of the

[42] Exhibit MPD12.
[43] Exhibit MPD13, page 291.
[44] Exhibit MPD13, page 292.

Opponent's products.[45] From this evidence I can infer the Opponent has received, over the years, commercial recognition in the relevant market for the "simon" mark in relation, at least, some of its goods such as lighting, sockets and switches. This further contributes to show genuine use of the "simon" mark (either as the first earlier mark or its acceptable variants) in relation to these goods.

63. Mr Perez Domedel concludes his witness statement reporting that, between 2017 and 2021, the World Design Index has always ranked highly the "SIMON" mark. Mr Perez Domedel clarifies that the World Design Index is an international list of award-winning designers, artists, architects, creators, photographers, illustrators, interior designers, product designers, and industrial designers from across the globe. More specifically Mr Perez Domedel lists and the evidence shows that the World Design Index (2017 – 2021) ranked the Simon Group (identified by the first earlier mark in its acceptable variant with the slogan "light up emotions")[46] as the "Best of Spain" (out of 152 companies worldwide), the "Top 50 of Europe" (out of 2,729 companies worldwide), the "Top 10 companies in the lighting sector" (out of 257 companies worldwide) and the "Top 100" (out of 5,725 companies worldwide). I appreciate that neither Mr Perez Domedel's narrative nor the documentary evidence breaks down the awards by year, so I am unable to determine to what extent there are awards dated 2021 (i.e., outside of the relevant period). However, as already found above, it is my view that also the evidence relating to 2021 is relevant for my assessment because for a company (and related trade mark) to be recognised an award, it requires prior work and recognition. Therefore, although I appreciate that part of the evidence could be dated outside of the relevant period (2021), I find it contributes to show genuine use of the first earlier mark (and its acceptable variant forms) within the relevant period. Furthermore, I note the evidence shows eight more awards dated 2015 and 2016 listed in relation to the Opponent and the first earlier mark.[47] Although the evidence is in Spanish and it is unclear whether the 2015 award falls within the relevant period (i.e., after 22 May 2015), I nonetheless find that the evidence further contributes to show genuine use of the first earlier mark at least for Spain.

[45] Mr Perez Domedel's witness statement at [19].
[46] Exhibit MPD9, page 241.
[47] Exhibit MPD13, pages 290 and 291.

Sufficiency of use

64. In its skeleton arguments and at the hearing the Applicant provided a detailed critique of each item of evidence adduced by the Opponent. Although I remind myself that I am required to consider the evidence as a whole,[48] there is some force to some of the Applicant's criticisms as outlined above in this decision.

65. From my account of the evidence, I appreciate that it presents some gaps in that some parts of the evidence are dated outside of the relevant period (2021), the EU invoices in exhibit MPD14 do not cover all the references made in the summary table of exhibit MPD5, and most of the evidence is in Spanish. Furthermore, as Mr Norris correctly pointed out at the hearing, the Opponent did not provide any figures relating to the marketing of the Earlier Marks for its goods and/or services. More specifically, the evidence does not show the annual revenues, marketing expenditure and the market share it occupies. However, from the sample invoices provided, I can derive that the Opponent, within the relevant period, registered revenues at least of €13,000 for the UK and over €50,000 for parts of the EU. Whilst I appreciate that these figures are not particularly high, first, I have extracted them from sample invoices and, thus, they likely do not show the whole picture; second, I remind myself that the assessment of genuine use is not simply about sales figures, and I must consider them alongside other evidence of use.[49]

66. The evidence features some invoices showing some of the Opponent's goods being sold in the UK (i.e., surface-mount-wall box, frame for wall-mount box, USB chargers, covers for USB chargers, socket outlet, and wall lights (lighting systems) and a relatively high number of invoices showing the retail of some of the Opponent's goods in parts of the EU (mostly Spain): switches and pushbuttons (including dimmers), switch covers/switch boxes, covers for sockets, electric sockets (socket outlets), and coaxial socket outlets.

67. With regard to the Opponent's electric cables, control panels, switchboards, connectors, electric couplings, fuses, rectifiers, rheostats, resistances, relays, thermostats and electric transistors only a few invoices (mostly addressed to Spain) have been provided. Although I appreciate that some of these goods (e.g.,

[48] Case T-415/09, *New Yorker SHK Jeans GmbH & Co KG v OHIM*, [53].
[49] Case T-467/20, *Industria de Diseño Textil, SA (Inditex) v EUIPO*.

electric cables) are featured in the Opponent's catalogues, however, I find that the evidence for these goods is insufficient to show genuine commercial use. The same reasoning applies to the Opponent's "plugs".[50] I appreciate that exhibit MP5 lists around 24 invoices for plugs (all addressed to Spain) and that the product catalogues show images of plugs being advertised, however, I do not find that this evidence is sufficient to show genuine use of the Opponent's marks for these goods.

68. Turning to the Opponent's product catalogues, I find this evidence mainly shows use of the first earlier mark (also in its acceptable variants) for the Opponent's switches and switch covers/frames, electrical sockets, lighting, socket frames and cover boxes). Although I appreciate the Applicant's submission that the Opponent did not clarify the volume of the catalogues being distributed, the evidence shows that the Opponent made available its product catalogues in different EU languages and on various of its websites throughout the relevant period. Therefore, the evidence shows that the catalogues were available to access online from various parts of the EU. The evidence also showed that the Opponent's websites recorded a relevant user traffic for some of these websites (although mainly originating from Spain). Accordingly, I find that the Opponent has sufficiently advertised its products in different parts of the EU (mostly Spain) to justify some degree of genuine use (at least in Spain).

69. The evidence also shows that third-party magazines have referred to "SIMON" in relation to switches, switch frames and lighting, and that the Opponent has received a series of international awards for its products, packaging and corporate operativity besting the competition in Spain, Europe and globally. The evidence also shows the Opponent has some social media presence, although I could not ascertain its geographical reach, for the first earlier mark (and acceptable colour variations) with tens of thousands of followers on Facebook, LinkedIn and YouTube globally.

70. When determining whether the Opponent has made genuine use of the Earlier Marks, I must remind myself that there is no *de minimis* rule to show use of the

[50] With the word "plug" I refer to small plastic object with two or three metal pins which fit into the holes of an electric socket, connecting the equipment to the electricity supply.

mark,[51] and that the assessment of genuine use is a multifactorial one that must take into consideration all the facts and circumstances pertinent to the case. Accordingly, the territorial extent of the mark's use is only one of the elements to consider in my overall assessment. In this regard, the evidence submitted shows that the place of use is mostly Spain along with other parts of the EU and, in part, the UK.

71. In view of all the considerations above, overall, I conclude that the evidence before me establishes that there has been a real commercial exploitation of the first earlier mark (and its acceptable variants) during the relevant period for some of the goods in class 9, namely, switches and pushbuttons (including dimmers), switch frames and covers, switch boxes, cover boxes, electric wall boxes, USB chargers (electric outlets) and related covers, electric sockets, lighting, covers for sockets, electric sockets (socket outlets), electric couplings and coaxial socket outlets.

72. As stated above in this decision, having found genuine use of the first earlier mark and its acceptable variants, it follows that I also find genuine use for the second and fourth earlier marks for the same goods in class 9. Turning to the third earlier mark, the evidence only showed one instance where the word "simón" is used. The evidence does not show any use of the third earlier mark within the relevant period. Such lack of use of the third earlier mark seems to be consistent with the logo evolution timeline shown in the evidence where it is indicated that the third earlier mark has been discontinued since around 1960.[52] Accordingly, the Opponent has failed to establish genuine use of the third earlier mark for the relevant period.

73. I move on to consider a fair specification for the first, second and fourth earlier marks.

Fair specification

74. Having found use of the first, second and fourth earlier marks, I must determine a fair specification upon which the Opponent is entitled to rely, bearing in mind the use that has been demonstrated.

[51] *Ansul* at [39].
[52] Exhibit MPD1, page 5.

75. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

> "244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.
>
> 245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.
>
> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

76. This approach was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36:

"261. […] First, there can be no doubt that an application to register a mark in respect of a broad category of goods or services may be made partly in bad faith in so far as the broad description includes distinct sub-categories of goods or services in relation to which the applicant never had any intention to use the mark, whether conditionally or otherwise. In my view, that emerges clearly from the decision of the CJEU in this case. The approach to be adopted in such a case was explored and explained by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp* [2017] EWCA Civ 1834; [2018] ETMR 10, at paras 241-2491 and, so far as I am aware, that approach has proved workable and appropriate and has stood the test of time, save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 3653. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use."

77. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

78. From my account of the evidence, I find that the Opponent markets switches and pushbuttons (including dimmers), switch frames and covers, switch boxes, cover boxes, electric wall boxes, USB chargers (electric outlets) and related covers, electric sockets, lighting, covers for sockets, electric sockets (socket outlets), electric couplings and coaxial socket outlets. The first earlier mark's specification contains the terms "*electric buzzers*" and "*Push buttons for bells*" and the second earlier mark's specification contains the terms "*illuminated switches*" and "*push buttons for bells*" in class 9. I find these terms to fall within the wider definition of "switches" and/or "pushbuttons" for which I found genuine use and, thus, they can form part of the Opponent's fair specification.

79. Furthermore, I note that the first and second earlier mark's specifications feature the terms "*Organic light-emitting diodes (OLEDs)*" and "*light-emitting diodes (LEDs)*". The Opponent in the summary table at exhibit MPD4 merely describes its lighting goods as "wall light" and the product catalogues feature different types of indoor lighting products/systems. Although it is not clearly defined, I can derive from the evidence that wall lights can also encompass OLED and LED lighting.

80. I appreciate that the specifications of the first, second and fourth earlier marks feature the term "*apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity*". Whilst I appreciate that this term may encompass some of the terms for which I found evidence of use, this term is excessively wide to form part of the fair specification as it would encompass a series of apparatus and instruments for which evidence of use was not provided. In line with my findings above, I believe that this term should be limited accordingly as shown in the table below.

81. Whilst I found use for a variety of goods in class 9 (as detailed in the table below), the evidence does not show use for any of the Opponent's services. Regarding

class 35 services, these essentially consist of advertising and retail of a variety of goods (i.e., electrical, electronic, computer and telephone goods, and lighting goods). Whilst I appreciate that the Opponent advertises and retails its own electric and lighting goods, the Opponent carries out such activities exclusively for the promotion and distribution of its own goods and it does not offer such services to third parties. Accordingly, the evidence does not show any instance where the Opponent offered and/or provided such services outside of the commercial offer of its own goods.

82. The same reasoning applies to the Opponent's class 37 services. These services consist of the installation, repair and maintenance of electric, electronic, computer, telephone and lighting devices. Although the Opponent may offer installation/repair/maintenance services for the goods it provides (i.e., electric and lighting devices), the Opponent would do so exclusively in relation to its own goods. I appreciate that there are a few instances in the evidence where it seems that the Opponent installed lighting systems for third parties (e.g., for an outdoor football field or for the "La Boqueria" market in Barcelona).[53] However, such evidence is insufficient to show genuine use for such services.

83. I believe that a fair specification for the first, second and fourth earlier marks would be the following:

first earlier mark	*second earlier mark*	*fourth earlier mark*
Class 9 Apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating or controlling electricity, **namely**, electric buzzers, push buttons for bells, sockets and other	Class 9 Apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating or controlling electricity, **namely**, electric buzzers, switches, illuminated switches, push buttons for	Class 9 Electric apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, **namely**, electric buzzers.

[53] Exhibit MPD8, pages 232 - 239.

contacts [electric connections], coaxial socket outlets, plug boxes, regulators [dimmers] (Light -), electric; Organic light-emitting diodes (OLEDs); Electrical outlet covers.	bells, power outlets, coaxial outlets, light dimmers, light-emitting diodes (LEDs); Plug covers.	

Outcome

84. As the Opponent must establish that it has made genuine use of its Earlier Marks, during the five-year relevant period to be able to rely upon them for the purposes of these proceedings, the opposition is unsuccessful insofar as it concerns the earlier mark number UK00900011429 ("*the third earlier mark*"). The opposition continues for the remaining first, second and fourth earlier marks indicated above in this decision and for which evidence of use was provided.

Section 5(2)(b)

85. Sections 5(2)(b) and 5A of the Act state:

> "5(2) A trade mark shall not be registered if because –
>
> […]
>
> (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.
>
> 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."

The principles

86. 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

87. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

> "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."

88. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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

(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.

89. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

"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 für 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".

90. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:[54]

"The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

91. The goods to be compared are shown in the table in Annex B to this decision.

[54] BL O/399/10.

92. Having carefully considered the respective specifications, I find that some of the terms are identical. I have provided below an example of such identical terms.

93. The Applicant's term "*[…] sockets and other contacts [electric connections]*" in class 9 is self-evidently identical to the Opponent's "*Sockets and other contacts [electric connections]*" featured in the first earlier mark's class 9. I also note that, at the hearing, Mr Norris stated that if I were to find genuine use for some of the Opponent's goods, this would have led to a finding of identity between these two terms.

94. Furthermore, some of the Opponent's goods such as, for example, "*Plug boxes*" or "*light-emitting diodes (LEDs)*" are contained in the Applicant's wider term "*Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity*" and vice versa. Therefore, they are identical in line with the principle outlined in *Meric*.

95. In light of these findings, and for reasons which will later become apparent, I will first assess the likelihood of confusion with regard to these terms.

The average consumer and the purchasing act

96. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

97. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

98. The average consumer for the goods in class 9 for which I found identity (e.g., switches, plug boxes, electric sockets, lighting) will be a member of the general public as well as professionals. The former consists of users of the general public who will purchase the goods for personal use (e.g., for private use and/or DIY purposes), while the latter consists of professionals required to use or install the goods as part of their profession (e.g., contractors, electricians or engineers).

99. The goods are likely to be sold through a range of retail outlets (and their online equivalents) such as specialist stores (e.g., DIY and home improvement retail stores) and online marketplaces, in which case they are available to all consumers; in other instances, the goods may be directed primarily at commercial consumers for direct installing, for example, thermostats or electric sockets. Depending on the size of the goods (e.g., lighting systems), they are likely to be displayed on shelves or in dedicated display areas where they can be viewed and self-selected by the consumer. A similar process will apply online and with catalogues where the

consumer will select the goods having viewed an image of the goods displayed on a webpage/page. The selection of the goods is therefore primarily visual, although I do not discount that aural considerations may play a part by way of word-of-mouth recommendations and advice from sales assistants. However, even where the goods are selected by making requests to staff, the selection process prior to purchase would be visual in nature. Accordingly, visual considerations dominate.

100. I believe the purchase of the goods not to be very infrequent although these are not every-day goods. I consider the cost of the goods to be medium. The average consumer will likely consider the specific features of the products to determine their suitability for the consumers' individual requirements such as, for example, size, durability and voltage capacity (for apparatus/instruments relating to electricity) and other technical features along with other more aesthetic considerations such as colour and design (e.g., for switch covers/frames). The professional public is likely to carry out further considerations on the specific features of the products and, hence, will pay a higher level of attention. I therefore find the degree of attention will vary from medium for the general public to above medium for the professionals. However, the likelihood of confusion must be assessed from the perspective of the former (the general public) since they are the group who will pay the lower degree of attention.[55]

Comparison of trade marks

101. 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 states at paragraph [34] of its judgment in *Bimbo*, 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 relevant weight in the perception of the target public, and then, in the light of that overall

[55] Case T-356/14, [25] – [26].

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

102. 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 trade 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.

My approach

103. Following my findings on the evidence of use, the Opponent can rely on the first, second and fourth earlier marks. I find the first earlier mark represents the Opponent's strongest case as it consists of the word "simon" with minimum stylisation and it essentially covers the same specification as the other two earlier rights. The second earlier mark contains the additional word "connect" along with "simon". This introduces further points of visual, aural and conceptual difference. The fourth earlier mark features an additional logo device placed at the beginning of the mark before the word "simon". Further, the word "simon" in the fourth earlier mark lacks the dot on the "i". Therefore, also the fourth earlier mark contains further points of difference (at least visual). Therefore, for the purposes of this opposition, if the Opponent cannot succeed on the basis of its first earlier mark, it is clearly in no better position based upon the other earlier marks. I proceed accordingly.

104. The marks to be compared are as follows:

first earlier mark	Contested Mark
simon	sinbon

Overall impression

105. The overall impression of the Contested Mark resides in the single word "sinbon" of which it is composed. The first earlier mark consists of the word "simon" in lower letters represented with a slightly stylised typeface. The mark's overall impression is dominated by the word "simon" with the stylised typeface playing a much lesser role.

Visual similarity

106. The Opponent submits that the respective marks present a high degree of visual similarity especially because of their overlap in the first and last two letters.[56] In its counterstatement the Applicant states that the respective marks are dissimilar in that they are short marks and the placement of the letter "b" in the middle of the Contested Mark distinguishes one mark from the other.[57] In the skeleton argument the Applicant submits that there is some limited visual similarity.[58]

107. The first earlier mark "simon" is composed of five letters whereas the Contested Mark "sinbon" features one additional letter for a total of six letters. The respective marks overlap in their first two letters "si-" and in their last two letters "-on" whereas the first earlier mark features the letter "m" ("si**m**on"), in place of the Contested Mark letters "nb" ("si**nb**on"). Overall the marks coincide in "si – on". Although I appreciate that the beginning of words tends to have more visual impact,[59] I find both marks are relatively short. The fact that the respective marks are quite short words/letter combinations means that any difference is more noticeable than it may have been had both marks been longer, despite the marks sharing the same first and last two letters. Although the stylisation of the typeface in the first earlier mark is minimal, this creates, at least to some limited extent, a further point of visual difference. Overall, I find the marks have a <u>medium</u> degree of visual similarity.

Aural similarity

108. The Opponent submits that the respective marks present a high degree of aural similarity given their overlap in the first and last two letters.[60] No further

[56] Opponent's statement of grounds at [5] and [8].
[57] Applicant's counterstatement at [13] and [16].
[58] Applicant's skeleton arguments at [60].
[59] Joined Cases T-183/02 and T-184/02, *El Corte Ingles, SA v OHIM*.
[60] Opponent's statement of grounds at [5] and [8].

submissions are provided on this point. The Applicant contends that the respective marks are pronounced differently in that the relevant consumers will voice the first syllable in “simon” with a long “i” (i.e., SIGH – MON) whereas they will pronounce “sinbon” with a short “i” and the additional “n” sound (i.e., SIN – BON). The Applicant also submits that although the marks overlap in their ending sound “mon”, the addition of the letter “b” in the Contested Mark further aurally differentiates the respective marks.[61]

109. Both marks are two-syllable words overlapping in their initial “s” sound and “mon” ending. Given the meaning of the first earlier mark, as further discussed below, I agree with the Applicant that the consumers will pronounce the first earlier mark as “SAI – MON” (or “SIGH – MON” as indicated by the Applicant). With regard to the Contested Mark, as it does not have a clear meaning, I find that a significant proportion of the relevant consumers will voice it as “SIN – BON” whereas a separate significant proportion of the relevant consumers will voice it as "SAIN – BON”. In the former instance, the marks overlap in their initial “SAI” (“SIGH”) and end “MON” sounds whilst they differ in their respective “m” and “n” sounds after “SAI” as well as in the additional “b” sound in the Contested Mark. Overall, the marks share a between medium and high aural similarity. In the latter instance, the marks merely overlap in their respective “MON” sounds at the end and differ in all the other elements: “SAI-” versus “SIN”, the “m”/”n” sounds and the additional “b” sound in the Contested Mark. In this case the marks share a below medium degree of aural similarity.

Conceptual similarity

110. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

111. The Opponent did not file submissions either on the marks’ conceptual similarity (or lack of it) or on the meaning of the marks at hand. The Applicant argues that

[61] Applicant’s counterstatement at [18].

consumers would recognise “simon” as a common person’s forename despite not being capitalised whereas they would not attach any meaning to “sinbon”.[62] At the hearing, Mr Norris reiterated that the main difference between the marks lies in their conceptual dissimilarity.

112. I agree with the Applicant (and Mr Norris). I find that the average consumer will understand “simon” as indicating a conventional male forename notwithstanding its first lower letter. Conversely, “sinbon” is not an English dictionary word and it does not seem to have any meaning. The Applicant did not provide any meaning for this word and it is submitted that it is an invented word devoid of any meaning. Therefore, I find the marks are conceptually different.

Distinctive character of the earlier trade marks

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

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

[62] Idem at [20] and [21].

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

114. The Opponent did not provide specific submissions regarding either the inherent or the enhanced distinctiveness of the first earlier mark. The Applicant contends that the relevant consumer will understand "simon" as a common person's forename and as alluding to the meaning "Simon's products". For this reason, the Applicant argues the first earlier mark has a low degree of inherent distinctiveness.[63]

115. Dealing first with the inherent distinctiveness of the first earlier mark, the mark is an English dictionary word indicating a common male forename and a slightly stylised typeface. I do find that the consumers will understand the mark as indicating that the goods are of someone called "Simon" (i.e., Simon's goods) as the Applicant contended. It is my view that the relevant consumers will understand the mark as a reference to a male forename without extracting any additional meaning. Therefore, the mark does not have any semantic correlation with the goods (or services) for which it has been registered, and it possesses a medium degree of inherent distinctive character.

116. Turning to the question of whether the inherent distinctiveness of the first earlier mark has been enhanced through use, the evidence showed that the Opponent has marketed its products in the UK and parts of the EU (mostly Spain) and it engaged in some degree of advertising via product catalogues available on its websites and some social media presence. The Opponent also indicated its websites enjoyed some user traffic an "simon" has been mentioned by third-party magazines and online articles (mostly in Spain). The Opponent also received a series of awards for the quality of its products (marketed under the first earlier mark and its variants) and company operativity. However, the evidence is not particularly extensive, and it contains some gaps, such as missing UK and EU turnover, marketing expenditure and market size. Furthermore, the evidence does not clarify the geographical extent of the Opponent's social media reach. Therefore, taking all these factors into account, whilst I found the Opponent's evidence to be sufficient to show genuine use for the first earlier mark (including its acceptable

[63] Idem at [23] and [24].

variants), I remind myself that the bar for proving enhanced distinctiveness is considerably higher. Thus, I do not find that the first earlier mark's distinctive character has been enhanced through use.

Likelihood of confusion

117. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

118. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).

119. I elected to proceed on the basis that at least some of the respective goods in class 9 are identical to each other. The consumer is likely to pay a medium level of attention in the selection of the goods at issue. Part of the relevant public for the goods at issue could be professionals who would pay a higher level of attention, but another part of the relevant public will be members of the general public who will demonstrate a medium degree of attention. I will assess the likelihood of confusion from the perspective of the general public since they are the group who will pay the lower degree of attention. The purchasing process of the contested goods is considered to be mainly visual but the potential for aural use also bears some relevance.

120. I found the visual similarity to be medium, the aural similarity to be either between medium and high or below-medium depending on how the relevant consumers will voice "sinbon". I found the marks to be conceptually dissimilar. The inherent distinctiveness of the first earlier mark is medium, and its distinctiveness has not been enhanced through use.

121. Whilst the levels of visual and aural similarities between the marks are relatively high, I note in *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

> "20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

122. I consider that the difference in concepts between the marks along with the difference in their "m"/"n" sounds and the additional letter "b" in the Contested Mark outweigh those relatively higher levels of visual and aural similarity, especially when taking into considerations that consumers do not come across the marks side by side in the market. Therefore, even taking into account imperfect recollection, the first earlier mark's medium degree of inherent distinctiveness and the identity between some of the goods at hand, I find that the relevant consumer is unlikely to mistake one mark for the other especially when considering the first earlier mark's different meaning. Therefore, I find there is no likelihood of direct confusion.

123. It now falls to me to consider the likelihood of indirect confusion. The concept of indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

> "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)".

124. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.[64] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[65] The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.[66]

125. I found the respective marks are different especially considering the first earlier mark's meaning along with the additional difference crated by the presence of "nb" in "sinbon" in place of the letter "m" in "simon". Therefore, I cannot see any reason

[64] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.
[65] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.
[66] *Liverpool Gin Distillery*.

why the average consumer noticing these differences in the marks (resulting in the Contested Mark being a made-up word versus the first earlier mark having a clear concept) would view the marks as coming from the same undertaking or indicating the same or related brands. Although it may be that the shared letters between the marks may lead the average consumer to call to mind the other mark, however, this would amount to mere association and not indirect confusion. Therefore, I find there to be no likelihood of indirect confusion.

Conclusion

91. The opposition under section 5(2)(b) fails in total and the application, subject to any appeal, can proceed to registration.

Costs

92. As the Applicant has been successful, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice ("TPN") 2/2016 (as proceedings commenced prior to 1 February 2023). At the hearing, Mr Norris stated that the Applicant should be awarded off-scale costs because the Opponent acted unreasonably during the proceedings. It is Mr Norris' position that albeit the Opponent obtained from the Office to file 100 additional pages to the evidence,[67] the Opponent failed to provide evidence of use for three of the four earlier marks relied on in the opposition. Furthermore, it is contested that the Opponent relied on a wide specification (especially with regard to class 9) but it filed evidence concerning only a small part of such goods. In summary, Mr Norris argued that an off-scale costs award should be granted in the Applicant's favour because the Opponent acted unreasonably in so far as it could have restricted and focused its action better which would have reduced the Applicant's efforts to defend its application.

93. Rule 67 of the Trade Marks Rules 2008 provides: "The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid."

[67] See official letter of 17 June 2024.

94. TPN 4/2007 indicates that the Tribunal has a wide discretion when it comes to the issue of costs, including making awards above or below the published scale where the circumstances warrant it. The TPN stipulates that costs off the scale are available "to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour.

95. I appreciate that the Opponent could have better focused its action, however, I find that it is within the Opponent's right to rely on multiple earlier registrations. Further, whilst I appreciate that the evidence of use did not cover all the earlier rights and it concerned only part of the earlier specifications (i.e., some goods in class 9), in my view, there is nothing to suggest that the behaviour by the Opponent was an abuse of process, nor a tactic to delay the proceedings.

96. Consequently, I do not consider that off-scale costs would be appropriate in this instance. The Applicant can be adequately compensated for their time and expenditure within the parameters of the normal scale set out in TPN 2/2016. Bearing that scale in mind, I award costs to the Applicant as follows:

Consider the statement of grounds and prepare the defence and counterstatement	£200
Consider and comment on the Opponent's evidence	£500
Prepare for and attend the hearing	£800
Total	**£1,500**

97. I order Simon, S.A. to pay SINBON Electronics Co., Ltd. the sum of **£1,500**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of March 2026

Andrea Rossi
For the Registrar

Annex A – variant uses of the first earlier mark with additional matter

Exhibit MPD6, page 143

Exhibit MPD6, page 166

Exhibit MPD6, page 151

Exhibit MPD6, page 113

Exhibit MPD6, page 178

MPD10, page 254

MPD10, page 260

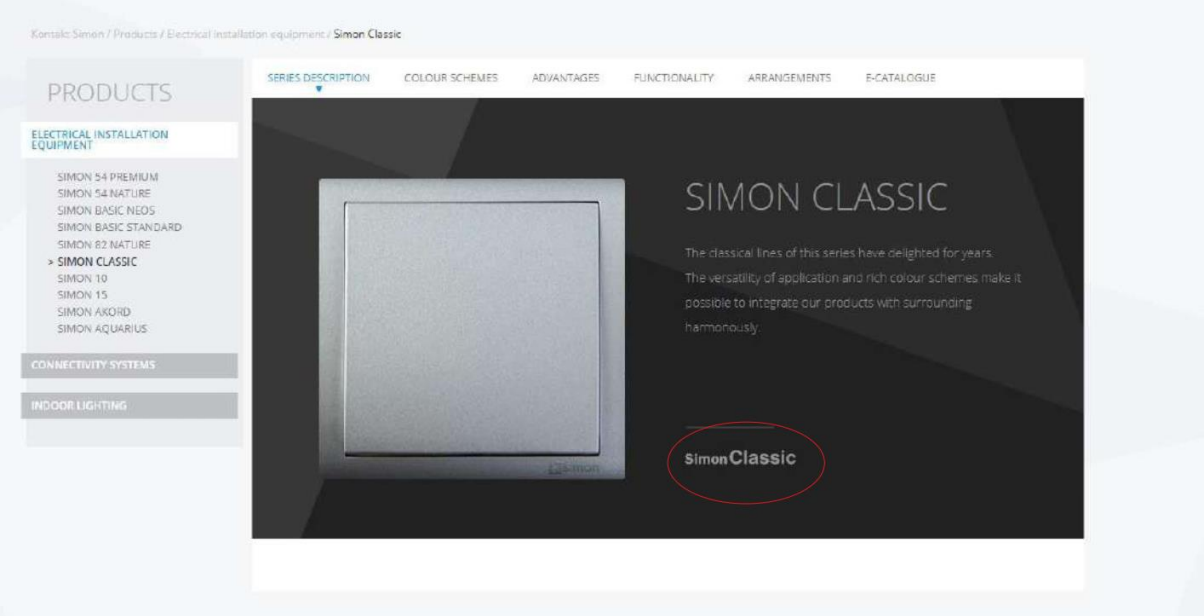


Exhibit MPD10, page 266

Exhibit MPD10, page 269

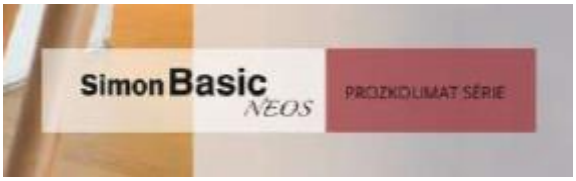


Exhibit MPD10, page 277

Exhibit MPD10, page 278

Annex B – comparison table of the parties' goods

The Opponent's goods	The Applicant's goods
("*the first earlier mark*") Class 9: Apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, electric buzzers, push buttons for bells, sockets and other contacts [electric connections], coaxial socket outlets, plug boxes, regulators [dimmers] (Light -), electric; Organic light-emitting diodes (OLEDs); Electrical outlet covers.	Class 9: Electronic components and devices; adaptor cables; Optical connectors; Plugs, sockets and other contacts [electric connections]; Antennas for wireless, WiFi and cellular communication; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Charging stations for recharging electric vehicles.
("*the second earlier mark*") Class 9: Apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, electric buzzers, switches, illuminated switches, push buttons for bells, power outlets, coaxial outlets, light dimmers, light-emitting diodes (LEDs); Plug covers.	

(“*the fourth earlier mark*”) Electric apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, electric buzzers.	