

O/0319/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003955458 AND UK00003955471

BY POWER ADHESIVES LIMITED

TO REGISTER THE TRADE MARKS:

TEC



IN CLASSES 7 AND 8

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 445183 AND 445184

BY JÖRG SCHNEIDER

AND

IN THE MATTER OF APPLICATION NO. UK00916495657

BY JÖRG SCHNEIDER

FOR THE FOLLOWING TRADE MARK:



IN CLASSES 1, 7, 8 AND 16

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 507149

BY POWER ADHESIVES LIMITED

BACKGROUND AND PLEADINGS

1. This decision involves cross-consolidated proceedings wherein Jörg Schneider (“JS”) and Power Adhesives Limited (“PAL”) brought actions against one another. I will summarise the relevant proceedings below, beginning with JS’s oppositions on the basis that they were brought first.

JS’ oppositions

2. On 11 September 2023, PAL applied to register the **TEC** word mark (“**458 Mark**”) and the **tec glue guns** figurative mark (“**471 Mark**”) on the cover page of this decision in the UK. The applications were published for opposition purposes 13 October 2023, and PAL seeks registration for the following goods:

Class 7 Apparatus for dispensing hot melt adhesives; hot melt glue guns.

Class 8 Apparatus for dispensing hot melt adhesives.

3. The applications were fully opposed by JS on 10 January 2024 based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), and JS relies upon the following mark:

The logo for TEC Adhesives features the word "TEC" in a large, bold, red sans-serif font. To the right of "TEC", the word "Adhesives" is written in a smaller, grey sans-serif font. A horizontal red line is positioned below the "Adhesives" text, extending from the left edge of the word to the right edge of the "C" in "TEC".

Comparable UK trade mark (EU) registration no. UK00916495657¹

Filing date 23 March 2017.

Registration date 24 May 2019.

(“**657 Mark**”)

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

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

- Class 1 Hot-melt adhesives used in industry.
- Class 7 Machine tools and mechanically operated devices exclusively for applying hot-melt adhesives.
- Class 8 Hand-tools and hand-operated devices exclusively for applying hot-melt adhesives.
- Class 16 Hot-melt adhesives for household purposes.

4. Under section 5(2)(b), JS claims there is a likelihood of confusion because all of the marks are visually, aurally and conceptually similar, and the goods are either identical or similar.

PAL's invalidation

5. JS applied to register its above **TEC Adhesives** figurative mark ("**657 Mark**") in the UK on 23 March 2017. It was registered on 24 May 2019 for the goods contained in paragraph 3 to this decision.

6. On 14 March 2024, PAL applied to have this mark declared invalid under section 47 of the Act based upon sections 5(2)(b) and 5(4)(a). Under section 5(2)(b), PAL relies upon the following 5 marks:

ECOTEC

UK trade mark registration no. UK00003095414

Filing date 20 February 2015; Registration date 25 September 2015.

(**"414 ECOTEC Mark"**)

TECBOND

UK trade mark registration no. UK00001214892

Filing date 16 March 1984; Registration date 16 March 1984.
(“892 TECBOND Mark”)

FOUNDRY TEC

UK trade mark registration no. UK00002180583
Filing date 26 October 1998; Registration date 6 April 1999.
(“583 FOUNDRY TEC Mark”)

KNOT-TEC

Comparable UK trade mark (EU) registration no. UK00909793837²
Filing date 18 February 2011; Registration date 18 July 2011.
(“837 KNOT-TEC Mark”)

HOBBY-TEC

UK trade mark registration no. UK00002251544
Filing date 6 November 2000; Registration date 27 April 2001.
(“544 HOBBY-TEC Mark”)

7. Under section 5(2)(b), PAL relies upon all of the aforementioned marks goods contained in Annex 1 to this decision. PAL also claims that there is a likelihood of confusion because the parties’ goods are identical and similar and all of its marks, which constitute as a “family of marks”, and JS’ mark, “wholly contain the dominant and distinctive element TEC”.

8. Under section 5(4)(a), PAL relies upon its **TEC** sign which it claims to have used throughout the UK since at least 1985 on apparatus for dispensing hot melt adhesives,

² Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

hot melt glue guns and applicators of adhesives. PAL claims that use of JS' **657 Mark** would be contrary to the law of passing off.

9. JS filed a counterstatement denying all of the claims made and subjected all 5 of PAL's earlier marks to proof of use.

10. JS is represented by Lincoln IP and PAL is represented by Withers & Rogers LLP. PAL filed evidence in chief and JS filed written submissions during the evidence rounds. PAL also filed further evidence. Neither party requested a hearing, however, both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

11. 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

12. PAL's evidence in chief consists of 3 witness statements. The first being the statement of Steven Edmeades dated 9 September 2024. Mr Edmeades is the Operations Director of PAL, a position he has held since July 2021. His statement is accompanied by 10 exhibits (1-10).

13. PAL's second witness statement is that of Alexander Zulewski, dated 7 February 2025. Mr Zulewski is the Commercial Manager of PAL, a position he has held since 9 January 2023. His statement is accompanied by 4 exhibits (AZ1-AZ4).

14. PAL's third witness statement is that of Ian Frank Kenyon, dated 24 February 2025. Mr Kenyon was the Director of Kenyon Group Limited from 23 August 1990 to 2

December 2024. His statement has been filed to confirm that when acting as the Director, Kenyon Group Limited and PAL traded with each other, and “has continued to do so thereafter”. His witness statement has no accompanying exhibits.

15. Whilst I do not propose to summarise them here, I have taken all of the evidence and the parties’ submissions into consideration in reaching my decision and will refer to them where necessary below.

PRELIMINARY VIEW

16. It is noted that in JS’ submissions in lieu of a hearing, at paragraph 8, they state that the “status of UK00003095414 is now “Expired” and therefore this mark should be discounted from the proceedings”. However, as per the UKIPO’s Register, the status of this trade mark is “Registered” and therefore can be relied upon by PAL.

MY APPROACH TO THESE PROCEEDINGS

17. PAL’s invalidation could have an impact on both of the opposition proceedings, in that the level of success (if any) will determine whether JS will be able to rely upon its **657 Mark** for its oppositions against PAL. If JS’ **657 Mark** is successfully invalidated, it will not constitute as an earlier mark for the purpose of its opposition against PAL’s **458 Mark** and **471 Mark**, and JS’ oppositions would consequently fall away. I will therefore consider the invalidation under sections 5(2)(b) and 5(4)(a) first.

SKRL’s invalidation

18. Sections 5(2)(b) and 5(4)(a) of the Act have application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

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

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

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

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

(c) the use conditions are met.

(2B) The use conditions are met if –

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

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

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

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

(2C) For these purposes –

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

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

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

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

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

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

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

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

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

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

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

(3) [...]

(4) [...]

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

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

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

Section 5(2)(b)

19. Section 5(2)(b) reads as follows:

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

(a)...

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

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

20. PAL’s 5 marks qualify as earlier marks in accordance with section 6(1)(a) of the Act as their filing dates are earlier than the filing date of JS’ mark. As PAL’s marks have completed their registration process more than five years before the filing date of JS’ mark in issue, they are subject to proof of use pursuant to section 6A of the Act.

Proof of use

21. I will begin by assessing whether there has been genuine use of the earlier marks. The relevant provisions about proof of use in invalidity proceedings are contained in Section 47 of the Act, which I have set out above. Section 100 of the Act is also relevant, which reads:

“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.”

22. Pursuant to section 47(2B) of the Act, if the earlier marks have been registered for five years or more at the date the challenged mark was filed then there are two relevant periods for assessing whether there has been genuine use of PAL’s 5 earlier marks;

the five-year period ending with the date of JS' **657 Mark** being filed, i.e. 24 March 2012 to 23 March 2017, and the five-year period ending with the date of the application for invalidity, i.e. 15 March 2019 to 14 March 2024.

23. By virtue of paragraph 9 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 (31 December 2020) for PAL's comparable (EU) **837 Mark**. After that date, only use in the UK will be relevant. For PAL's remaining UK marks, only use in the UK is relevant.

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

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

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

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the

characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

Evidence of use

25. Mr Edmeades confirms that his company is “a prominent manufacturer and supplier of hot glue adhesives and applicators” that have been sold under the TEC and TECBOND brand names, since 1993. He also confirms that PAL is “Europe’s leading shaped hot melt adhesive specialist and offers the largest range of high quality hot melt glue sticks and glue guns in the world”, which includes:

- a) Hot Melt Adhesives which are available in different forms, including sticks, pellets, and slugs, to accommodate different applicators.
- b) Applicators which are high-quality glue guns and dispensing systems that use both manual and automated systems to cater to different levels of production requirements.

- c) Customised solutions which are tailor-made to their clients and their specific requirements.

26. At paragraphs 22 to 26 of his witness statement, Mr Edmeades confirms that PAL has a variety of TEC marks that are used on different types of adhesives, such as:

1. Its TECBOND adhesives which can be used on plastics and wood to provide strong and durable bonds. This range has different formulas to help with high-temperature resistance, fast setting times or superior bonding strength, and these goods are widely used in the packing, woodworking and manufacturing industries.
2. Its HOBBY-TEC adhesives are designed to cater the needs of DIY enthusiasts, hobbyists and craftsmen, with its goods being aimed for small-scale projects such as crafting, home repairs and artistic endeavours. Therefore, these adhesives are good for materials such as paper, fabric, plastic and wood.
3. Its KNOT-TEC adhesives are designed for wood repair and knot-filling applications, and ensures that repairs blend seamlessly with the natural wood grain. Therefore, its goods are available in a variety of colours to match different wood types.
4. Its FOUNDRY-TEC adhesives which are designed to withstand extreme conditions of foundry environments, providing robust bonding solutions for core assembly, mould making and pattern repair.

27. In support of the above, Mr Edmeades' has provided 9 screenshots of PAL's website (poweradhesives.com) in **exhibit 2** dated between 23 September 2004 and 19 March 2017. The screenshots clearly show pictures of PAL's glue guns affixed with the "TEC" mark, like so:



28. The website also shows that they provide TEC glue guns, TECBOND glue sticks, TECBOND adhesives, Hobbytec adhesives and Foundrytec adhesives. The website does not provide any price for the goods, and I note that the prices within the distributor price lists dated between 1 February 2006 and 1 November 2014, contained in **exhibit 6**, are redacted.

29. I have been provided with sales figures contained in **exhibit 4**, which Mr Edmeades confirms is for PAL's products under their TEC mark for 2003 to 2024. The figures that pertain to both of the relevant periods are as follows:

Row Labels	12MM GLUE	12MM GUNS	15MM GLUE	15MM GUNS	43MM GLUE	43MM GUNS	ACCESSORIES	BEARDOW	BULK	BULK GUNS	REPAIRS SPARES & OTHER	Grand Total
2012	395,442.16	137,940.32	134,225.82	20,439.85	592,337.98	99,762.60	1,293.73		75,527.86		505.08	1,457,475.40
2013	354,453.55	122,388.25	208,100.25	23,294.85	532,997.43	72,289.90	888.68		84,229.05		272.92	1,398,914.88
2014	373,058.13	148,847.98	134,271.32	22,223.81	553,836.31	101,216.68	1,066.46		73,558.42	2,316.50	251.4	1,410,647.01
2015	369,430.81	140,556.18	162,966.48	23,508.90	527,448.53	74,180.14	1,009.90		65,512.36	18,365.00	239.2	1,383,217.50
2016	375,810.76	160,361.16	166,930.53	35,388.71	532,776.44	100,350.23	618.1		76,951.22	4,343.00	231.02	1,453,761.17
2017	389,232.37	158,597.82	184,812.22	29,645.10	494,649.40	93,247.20	332.23		50,335.59	9,064.00	243.46	1,410,159.39
2018	347,871.25	160,836.12	198,859.42	40,926.28	568,521.31	104,451.37	822.84		67,646.07	8,157.10	126.38	1,498,218.14
2019	301,788.21	129,947.37	163,552.75	39,290.62	470,606.59	82,835.71	1,134.52		73,999.66	6,287.89	215.05	1,269,658.37
2020	317,025.73	133,161.09	86,165.91	31,876.65	339,478.50	62,962.93	1,397.59		129,547.18	8,735.67	260.61	1,110,611.86
2021	366,379.41	175,314.17	85,623.06	41,329.56	472,340.90	101,827.41	992.49		206,022.29	11,320.47	192.93	1,461,342.69
2022	379,696.95	121,549.81	78,833.27	41,728.34	536,159.56	76,979.85	2,733.74		224,542.15	13,484.64	354.9	1,476,063.21
2023	304,120.91	142,438.70	75,404.02	40,642.41	470,070.18	80,416.57	6,340.00		124,782.39	9,739.99	477.56	1,254,432.73
2024	189,637.10	53,996.83	67,363.34	24,260.97	289,597.48	69,687.60	2,939.84	8,534.40	112,077.41	3,787.66	50.88	821,933.51

30. **Exhibit 10** contains the UK net figures made by PAL, which Mr Edmeades confirms is for PAL's "products sold under or by reference to the marks". The figures provided have been broken down into the different types of marks used, and relied upon, by PAL. I note the following breakdown of PAL's sales from this exhibit:

Year	Hobby-Tec	Foundry Tec	Tecbond
2012	N/A	£27,646.30	£1,834,747.20
2013	N/A	£39,381.20	£1,907,190.10
2014	£316.10	£44,290.00	£1,820,017.20
2015	£4,558.85	£32,919.40	£1,797,629.70
2016	£8,327.80	£51,518.02	£1,922,436.50
2017	£10,325.01	£61,358.70	£1,817,875.90
2019	£9,455.51	£64,981.70	£1,814,863.60
2020	£11,945.30	£38,348.19	£1,580,681.60
2021	£10,078.49	£71,645.35	£2,017,981.30
2022	£9,587.64	£62,886.94	£1,944,837.60
2023	£9,091.75	£54,418.06	£1,694,961.20
2024	£3,703.84	£51,957.60	£1,254,916.30

31. The first page of **exhibit 10** also contains the following set of UK sales figures:

2012	£1,877.67
2013	£540.39
2014	£476.72
2015	£912.83
2016	£1,907.97
2017	£2,217.31
2019	£8,254.85
2020	£6,420.05
2021	£14,362.70
2022	£14,690.22
2023	£10,522.77
2024	£7,397.20

32. However, these sales are unlabelled (unlike the above figures).

33. To support this, **exhibit 5** and **exhibit 9** contains a selection of PAL's invoices showing the sale of its goods in the UK. I note the following from these exhibits:

- a) The invoices are dated between 23 May 2012 and 19 February 2024, and therefore fall within the relevant periods.
- b) They show that the goods were shipped to Gillingham, Oldham, Bidford on Avon, Bedford, Cleveland, East Kilbride, Leeds, Bedfordshire, Bolton, Corby, Warwickshire and Peterborough.
- c) The invoices show the sale of "TEC6100", "TEC3200", "TEC7300", "TECBOND HM ADHESIVE", "TECBOND ADH CLEAR", "TECBOND BULK HM ADH", "FOUNDRY-TEC BULK ADH", "TECBOND LOW MELT ADHESIVE", "TECBOND ADH BLACK", "HOBBY-TEC", "KNOTTEC", "KNOT-TEC KIT".
- d) In regard to the above goods called "TEC6100", "TEC3200" and "TEC7300", I note that the price lists contained within **exhibit 6** (pages 5 and 6) confirm that these are TEC glue guns.
- e) The invoice amounts are all redacted.

34. I bear in mind that JS has provided criticisms of the above invoice evidence. This includes that **exhibit 5** does not make any mention of the marks FOUNDRY TEC,

HOBBY TEC or KNOT TEC, and that the invoices from **exhibit 9**³ “all date from 2012/2013”. Whilst the invoices contained in **exhibit 5** predominantly relate to the sale of TEC and TECBOND goods, there is one invoice which shows “FOUNDRY TEC” was sold in February 2012. Nevertheless, the invoices contained in **exhibit 9** are dated between 2012 to 2023, with FOUNDRY TEC and KNOT TEC being clearly listed in invoices from 2014, 2015, 2016, 2020, 2021, 2022, 2023 and 2024.⁴

35. I have also been provided with evidence of PAL’s advertising, including its following promotional spend in the UK for 2012 to 2017 which Mr Edmeades confirms refers to the TEC mark:

2012	£15,940
2013	£30,845
2014	£12,761
2015	£17,478
2016	£23,658
2017	£35,222

36. Whilst I bear in mind that some of the expenditure for 2012 and 2017 will fall before and after the first relevant period, the total spend from 2013 to 2016 (all of which falls within the first relevant period) amounts to £84,742.

37. At paragraph 20 of his witness statement, Mr Edmeades provides a list of promotional examples of PAL’s TEC mark, some of which are accompanied by printout evidence in **exhibit 7**. I note the following from this evidence:

- a) A Panel, Wood & Solid Surface Magazine, dated November 2015, contains an article titled “unique knot filling system from Power Adhesives”. This contains a picture of PAL’s glue gun affixed with the TEC mark, and the article itself refers to the “KNOTTEC” system which is to be used “for knot defects and other forms

³ Whilst the submissions refer to the invoices in **exhibit 10**, I find that this is a typographical error, whereby they meant to put “**exhibit 9**”.

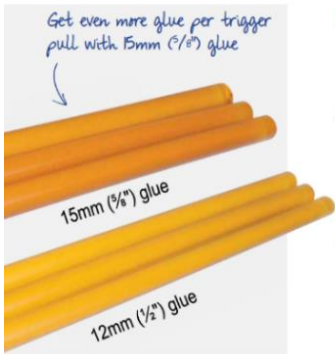
⁴ For example, pages 74, 75, 76, 77, 78, 79, 91, 93, 94, 97, 98, 99, 108, 114, 119, 122 and 123.

of deep wood damage”. It also refers to PAL’s choice of two 12mm glue guns, the “tec 305” and “tec 820”, which are used with the “KNOTTEC” system.

- b) Fastener & Fixing Magazine dated March 2016 contains a "Portable glue gun from Power Adhesives" article which again refers to PAL’s “tec 305” and “tec 820” 12mm glue guns.
- c) A Panel, Wood & Solid Surface, dated April/May 2016, contains an article titled "New applicator for unique knot filling system", (that being the knottec system). It also refers to its new portable glue gun, that being the “b-tec 807”, which can be used to fill knots and scratches in wood, as well as its “tec 305” and “tec 820” glue guns which are mains powered.
- d) The Furniture & Joinery Production Publication dated June 2017 also refers to the same information referred to in 37(c) above, as well as highlighting that PAL “manufactures the largest range of industrial glue guns and high-performance shaped hot melt adhesives” and that PAL has over 40 years industry experience.

38. I have been provided with examples of promotional materials used in relation to PAL’s TECBOND mark, contained in **exhibit 8**, which includes brochures Mr Edmeades dates as being from 2013, 2016 and 2017.⁵ The brochures make reference to the range of TEC glue guns and the TECBOND glue sticks which are available, and what they are ideal for i.e. packaging, product assembly, floristry, flooring, electrics, floristry and crafts. I also note that the glue stick and glue gun goods are presented, for example, as follows:

15mm (5/8") tecbond glue sticks



Get even more glue per trigger pull with 15mm (5/8") glue

15mm (5/8") glue

12mm (1/2") glue

Increased output
With 30% more molten glue per trigger pull, you can up your productivity just by using 15mm (5/8") adhesive.

Less downtime
Tec 15mm (5/8") glue guns hold up to 85% more glue when compared with their 12mm (1/2") counterparts, so they don't need to be reloaded as often. Plus, all 15mm (5/8") tools have highly efficient melt chambers which see them heat up in only 2-3 minutes.

Same easy application
All of these benefits with the same tecbond quality that you'd expect. Instant, permanent bonding on a wide range of materials, and no harmful solvents. Still safe and easy to store with a virtually unlimited shelf life.
And the 15mm (5/8") glue sticks are just as easy to load into our tec 15mm (5/8") glue guns. With a narrow profile for improved visibility, and an adhesion nozzle fitted as standard, accurate glue placement has never been easier.

43mm (1 3/4") tec glue guns & tecbond glue cartridges

Eco-friendly & efficient


New plug-in modules allow the gun to be set to different temperatures from 130°C - 210°C for max bond strength.

Features an automatic stand-by system that takes the temperature down in stages, protecting the gun from damage and saving energy. Stand-by is deactivated when the trigger is pulled.

A new, clever trigger boost system recognises when the gun's trigger is used continuously and increases the power to the heater in response, stopping the output even more.

Full length trigger that allows highly accurate control of the gun's adhesive flow.

tec 3400	
High output, electronically-controlled 43mm (1 3/4") glue gun for industrial use. A powerful tool featuring patented ECOTECH® technology for exceptional temperature precision with eco-friendly phased standby operation.	
Melt rate	3.8kg (8.5lbs)/hr
Glue size	43mm (1 3/4") glue cartridge
Voltage	120V and 230V
Wattage	400W
Heater	Cartridge
Temp Control	Electronic plug-in temperature modules
Hotmelt gun °C (°F)	190°C (362°F) fixed, Lowmelt 130°C (266°F), 150°C (302°F) and 210°C (402°F) modules included (additional modules available).
Lowmelt gun °C (°F)	Covered above
Power cable	3m (10 ft)
Weight	1.15kg (2.54lbs)
Packaging	Plain box (1 per ctn)



⁵ Paragraph 27 of his witness statement

39. **Exhibit 8** also includes promotional brochure and guide evidence in relation to PAL's KNOT TEC, FOUNDRY TEC AND HOBBY TEC marks. Mr Edmeades dates these as being from 2019, 2020, 2022, 2023 and 2024.⁶ The glue guns appear in the same form, affixed with the TEC mark, as shown in paragraphs 27 and 38 above, but the packaging for its adhesive goods are presented, for example, as follows:



FOUNDRY-TEC 5012LF-BK adhesive is pigmented red so that it can be easily seen once applied.

The high-quality ingredients and very low viscosity mean the glue can be processed at lower temperatures in a molten state, reducing viscosity build up and charring. 5012LF-BK will also maintain its strong bonding properties and low viscosity, even after long periods in its molten state. This reduces tank clean out and flushing costs.

Colour	Red for easy visibility of adhesive applied
Viscosity	450cps at 135°C and highly stable for extended periods
Adhesion	Excellent tough bonds on EPS
Heat	Resistance 114°C / 237°F
Odour	Extremely low odour from open tanks
Ash Content	Extremely low
Open time	Medium
Stability	Class leading stability for viscosity and adhesive parameters



FOUNDRY-TEC 5012LF-BK



⁶ Paragraph 27 of his witness statement

Form of the marks

40. As far as the form of the mark is concerned, I am satisfied that the **892 TECBOND Mark** and the **544 HOBBY-TEC Mark** have been used as registered in the invoice, brochure and website evidence. I am also satisfied that the **837 KNOT-TEC Mark** has been used as registered on PAL's brochures and website. Whilst on the invoices, the **837 Mark** has been presented as "KNOTTEC" I do not consider that deleting the hyphen between the words "KNOT" and "TEC" alters the distinctive character of the mark, as these elements are clearly visible and still continues to indicate origin.⁷ Consequently, I find that this is acceptable use of the **837 KNOT-TEC Mark**.

41. In relation to the **414 ECOTECH Mark**, PAL has not provided any evidence of use of this mark. The website, brochure and invoice evidence does not make reference to this mark and Mr Edmeades' witness statement also does not make any reference to an ECOTECH mark. Whilst the above evidence shows use of a solus "TEC" mark I do not consider that this is an acceptable variant of "ECOTECH". This is on the basis that the removal of the word "ECO", which changes the conceptual nature of the mark, consequently, alters its distinctive character. Therefore, the use of the word "TEC" is not an acceptable variant for "ECOTECH".

Assessment of genuine use

42. As I have found the mark used in the evidence to be acceptable, I will now consider an assessment of genuine use. This is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁸

43. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to

⁷ *Collosum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paras 31-35

⁸ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

maintain or create a share in the market for the goods or services protected by the mark”.

44. I have been provided with revenue made from UK sales under PAL’s TECBOND, FOUNDRY TEC and HOBBY-TEC marks, for the years 2012 to 2024. These are contained within the table at paragraph 30 to this decision. I also note that these sales, which pertain to both relevant periods, are significant. Whilst I have not been provided with sales figures that pertains to PAL’s KNOT-TEC mark, the invoice evidence provided shows the sale of these goods, as well as PAL’s TECBOND and FOUNDRY TEC goods, which were geographically spread across the UK during both relevant periods. I have been provided with promotional figures for the first relevant period, which I also consider to be notable. This is supported with marketing evidence, such as PAL’s goods being advertised in third party magazines and within its own promotional brochures across both relevant periods. It is also apparent from the brochure and website evidence above that the TECBOND, KNOT-TEC, FOUNDRY TEC and HOBBY-TEC marks are used on the adhesives i.e. glue sticks, pellets and hot melts (with the TEC mark only being used on glue guns). In my view, this evidence establishes genuine use of PAL’s 4 marks in relation to adhesives during both of the relevant periods.

Fair Specification

45. I must now consider whether, or the extent to which, the evidence shows use of the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. 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.”

46. 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 subcategories.

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.”

47. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, subject to the proviso that it must be seen in light of more recent guidance by the CJEU that 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 (for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paragraphs 36-53).

48. PAL’s **892 TECBOND Mark** and **583 FOUNDRY TEC Mark** are registered for “adhesives included in class 1”. I find that the evidence shows use of adhesives which are included in class 1, and therefore, PAL has established use for the full breadth of its specifications.

49. PAL’s **837 KNOT-TEC Mark** is registered for “adhesive substances used in industry for repairing defects in wood” in class 1, and “filler materials for repairing defects in wood, preservatives against deterioration of wood” in class 2. Throughout the evidence, PAL’s KNOT-TEC adhesives are described as being used “for knot defects and other forms of deep wood damage. I therefore find that PAL has established use for the full breadth of its class 1 and 2 specification.

50. Lastly, PAL’s **544 HOBBY-TEC Mark** is registered for “hot melt adhesives for use in apparatus for dispensing hot melt adhesives” and “hot melt adhesives for use in hot melt glue guns” in class 1, and “apparatus for dispensing hot melt adhesives” and “hot

melt glue guns” in class 9. As noted above, I have found that the evidence shows that PAL’s 4 marks have only been used on adhesives (which are found in class 1). There is no evidence before me showing use of the HOBBY-TEC Mark on PAL’s class 9 goods. I therefore find that PAL has established use for the full breadth of its class 1 specification only. Consequently, I consider a fair specification for PAL’s 4 marks to be:

The 892 TECBOND Mark & 583 FOUNDRY TEC Mark

Class 1 Adhesives included in Class 1.

The 837 KNOT-TEC Mark

Class 1 Adhesive substances used in industry for repairing defects in wood.

Class 2 Filler materials for repairing defects in wood, preservatives against deterioration of wood.

The 544 HOBBY-TEC Mark

Class 1 Hot melt adhesives for use in apparatus for dispensing hot melt adhesives; hot melt adhesives for use in hot melt glue guns.

Section 5(2)(b) - case law

51. 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

52. The parties' competing goods are as follows:

PAL's Marks	JS' 657 Mark
<p><u>The 892 TECBOND Mark</u> <u>Class 1</u> Adhesives included in Class 1.</p>	<p><u>Class 1</u> Hot-melt adhesives used in industry.</p>
<p><u>The 583 FOUNDRY TEC Mark</u> <u>Class 1</u> Adhesives included in Class 1.</p>	<p><u>Class 7</u> Machine tools and mechanically operated devices exclusively for applying hot-melt adhesives.</p>
<p><u>The 837 KNOT-TEC Mark</u> <u>Class 1</u> Adhesive substances used in industry for repairing defects in wood.</p>	<p><u>Class 8</u> Hand-tools and hand-operated devices exclusively for applying hot-melt adhesives.</p>
<p><u>Class 2</u> Filler materials for repairing defects in wood, preservatives against deterioration of wood.</p>	<p><u>Class 16</u> Hot-melt adhesives for household purposes.</p>
<p><u>The 544 HOBBY-TEC Mark</u> <u>Class 1</u></p>	

Hot melt adhesives for use in apparatus for dispensing hot melt adhesives; hot melt adhesives for use in hot melt glue guns.	
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53. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

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

55. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) stated that:

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

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

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

Class 1

Hot-melt adhesives used in industry.

57. I find that JS’ above goods fall within the broader categories of “adhesives included in Class 1” in the **892 TECBOND Mark** and the **583 FOUNDRY-TEC Mark’s** specifications. They are identical on the principle outlined in *Meric*.

58. I also consider that the term “adhesive substances used in industry for repairing defects in wood” in PAL’s **837 KNOT-TEC Mark’s** class 1 specification, and the terms “hot melt adhesives for use in apparatus for dispensing hot melt adhesives” and “hot

melt adhesives for use in hot melt glue guns” in its **544 HOBBY-TEC Mark’s** specification would fall within JS’ above broader term. They are also identical on the principle outlined in *Meric*.

Classes 7 and 8⁹

Machine tools and mechanically operated devices exclusively for applying hot-melt adhesives; Hand-tools and hand-operated devices exclusively for applying hot-melt adhesives.

59. I consider that PAL’s “hot melt adhesives for use in apparatus for dispensing hot melt adhesives” and “hot melt adhesives for use in hot melt glue guns” in its **544 HOBBY-TEC Mark’s** specification would overlap in trade channels with JS’ above goods. I find that the same undertaking would create and sell hot melt adhesives and devices for applying them, including holt melt glue guns. The goods clearly do not overlap in nature or method of use. Nevertheless, the end purpose of the goods is to apply the adhesive to its designated area. There will also be an overlap in user, and the goods are likely to be complementary on the basis that they are important and indispensable to one another and the consumer would believe that the goods originate from the same undertakings. On this basis, I find that the goods are similar to a medium degree.

Class 16

Hot-melt adhesives for household purposes.

60. I find that JS’ above goods will overlap in nature, purpose and method of use with “adhesives included in class 1” in the **892 TECBOND Mark** and **583 FOUNDRY-TEC Mark’s** specifications, and “hot melt adhesives for use in hot melt glue guns” in PAL’s **544 HOBBY-TEC Mark’s** specification. This is on the basis that all of the goods are

⁹ For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

adhesives (substances which are used to bond things together). I also note that JS' goods would encompass adhesives that can be used in glue guns. However, I appreciate that PAL's goods are intended for use in industry whereas JS' goods are intended for use in households. I also note that there is likely to be an overlap in trade channels, with the same undertakings selling a variety of adhesives. The goods are not complementary, and whilst the goods are to be used in different sectors, I still consider that they may be in competition (on the basis that they all have the same purpose). Nevertheless, even if they are not in competition, I still find that the goods are similar to between a medium and high degree.

The average consumer and the nature of the purchasing act

61. 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 in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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 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.

62. The average consumer for the goods will be members of the general public and professionals who work in the packing, woodworking and manufacturing industries. The cost of the goods in question is likely to vary, albeit it is likely to be on the lower end of the scale. The frequency of purchase is also likely to vary.

63. Whilst JS submits that the level of attention to be paid during the purchasing process will be a low to moderate degree, I find that the average consumer will take various factors into consideration, such as their cost, quality, quantity and suitability of the goods for the users specific needs. On this basis, I consider that for both sets of average consumers, a medium degree of attention will be paid during the purchasing process.

64. The goods are likely to be purchased from specialist retail outlets, their online equivalent or following inspection of a specialist catalogue. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or representative, or via word-of-mouth recommendations.

Comparison of the trade marks

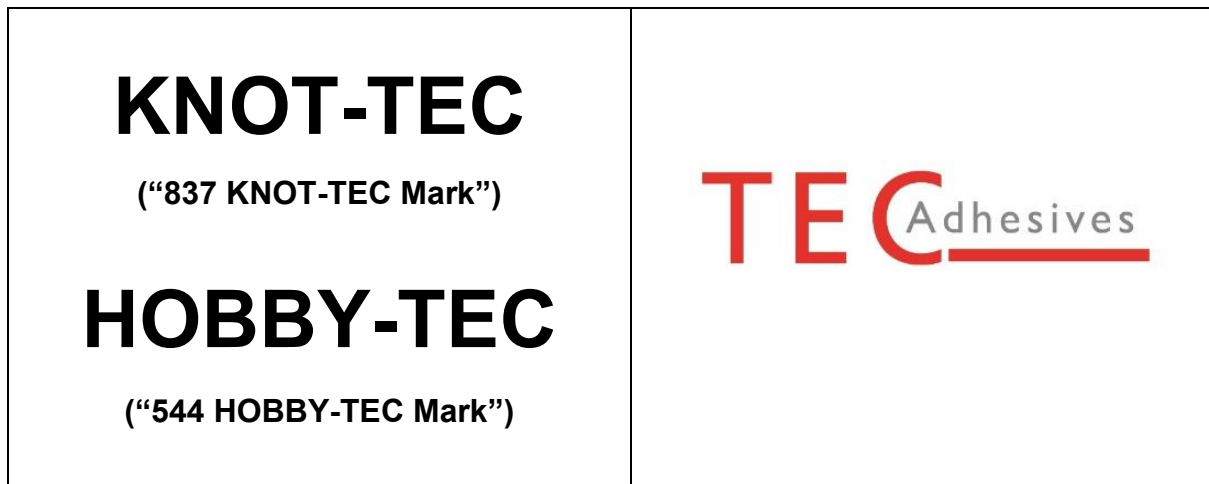
65. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

67. The respective trade marks are shown below:

PAL's Marks	JS' trade mark
<p data-bbox="304 1619 703 1686">TECBOND</p> <p data-bbox="325 1731 683 1767">("892 TECBOND Mark")</p> <p data-bbox="228 1839 783 1906">FOUNDRY TEC</p> <p data-bbox="288 1951 722 1986">("583 FOUNDRY TEC Mark")</p>	



Overall Impression

68. PAL's **892 Mark** consists of the word "TECBOND". There are no other elements to contribute to the overall impression which lies in the word itself.

69. PAL's **583 Mark** consists of the words "Foundry Tec". For reasons I shall come to discuss in the conceptual comparison, I find that the word "Tec" plays a greater role in the overall impression, being the dominant and distinctive element, with the ordinary dictionary word "Foundry" playing a lesser role.

70. PAL's **837 Mark** consists of the words "KNOT-TEC" and PAL's **544 Mark** consists of the words "HOBBY-TEC". For reasons I shall come to discuss in the conceptual comparison, I find that the word "TEC" plays a greater role in the overall impression, being the dominant and distinctive element, with the ordinary dictionary word "KNOT" and "HOBBY", and the hyphen, playing a lesser role.

71. JS' mark consists of the word "TEC" presented in a larger standard red capitalised typeface, with the letter "C" encasing the beginning of the smaller word "Adhesives" which is presented in a standard grey title-case typeface, which is also underlined by a red line.¹⁰ I note that the word "Adhesives" is descriptive of JS' goods and therefore will play a lesser role in its overall impression, with the word "TEC" playing a greater role, being the dominant and distinctive element of the mark.

¹⁰ Under the marks description/limitation on the Register, the colours claimed are listed as red and grey.

Visual Comparison

PAL's 892 Mark and JS' Mark

72. The parties' marks overlap in the letters "TEC", at the beginning of the marks, a position to which the average consumer usually pays more attention.¹¹ This acts as a visual points of similarity. PAL's **892 Mark** ends in the word "BOND" and JS' Mark ends in the word "Adhesives". I also note that the letters "TEC" in JS' mark are presented in a larger standard red capitalised typeface, with the letter "C" encasing the beginning of the smaller grey word "Adhesives". JS' mark also includes the red underline. Nevertheless, I find that the marks are visually similar to a medium degree.

PAL's 583 Mark and JS' Mark

73. The parties' marks overlap in the letters "TEC". This acts as a visual point of similarity. However, I note that these letters occur at the end of PAL's mark, and the beginning of JS' mark. PAL's **583 Mark** begins with the word "FOUNDRY" and JS' Mark ends in the word "Adhesives", along with the stylisation of its mark (the larger presentation of the red word TEC, encasing the grey word Adhesives, and the red underline). These all act as visual points of difference. Therefore, taking all of the above into account, I find that the marks are visually similar to between a low and medium degree.

PAL's 837 and 544 Marks and JS' Mark

74. The parties' marks overlap in the letters "TEC". This acts as a visual point of similarity. However, I note that these letters occur at the end of PAL's mark, and the beginning of JS' mark. PAL's **837** and **544 Marks** begin with the words "KNOT" or "HOBBY" followed by a hyphen. JS' Mark ends in the word "Adhesives", along with the stylisation of its mark. These all act as visual points of difference. Taking all of the above into account, I find the marks to be visually similar to between a low and medium degree.

¹¹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Aural Comparison

PAL's 892 Mark and JS' Mark

75. PAL's mark is likely be pronounced as TEC-BOND, and JS' mark is likely to be pronounced as TEC ADD-HE-SIEVE. On the basis that the first syllable of the marks is identical, the marks overall are aurally similar to no more than a medium degree.

PAL's 583 Mark and JS' Mark

76. PAL's mark would likely be pronounced as FOUND-REE TEC. Therefore, as the parties' marks only overlap in the "TEC" syllable, which is placed at different positions within the marks, I find that they are aurally similar to between a low and medium degree.

PAL's 837 and 544 Marks and JS' Mark

77. PAL's 837 Mark will likely be pronounced as NOT-TEC and PAL's **544 Mark** will likely be pronounced as HOB-EE-TEC. Therefore, as the parties' marks only overlap in the "TEC" syllable, which is placed at different positions within the marks, I find that they are aurally similar to between a low and medium degree.

Conceptual Comparison

PAL's 892 Mark and JS' Mark

78. At paragraph 16 of JS' submissions in lieu, they submit that the word "TEC" "has no meaning in relation to the goods". At paragraph 51 of PAL's submissions in lieu, they also submit that the word "TEC" has no meaning in respect of the goods. I agree with both parties, and I find that a significant proportion of average consumers would recognise "TEC" in JS' mark as being an invented word which evokes no conceptual meaning. I have also considered whether the average consumer would perceive the word "TEC" as denoting an abbreviation of the word "technology" (on the basis that they overlap aurally). However, as the abbreviation is spelt as "TECHH" and not "TEC",

I do not consider that the meaning of ‘technology’ would be assigned, or recognised in, the parties’ marks. Nevertheless, even if the average consumer were to assign meaning of “TECH” to the word “TEC”, I do not consider that this would amount to a significant proportion.

79. As noted above, the word “Adhesives” is descriptive of JS’ goods. On this basis, the word “TEC”, which I have found would be perceived by the average consumer as an invented word, is thus the dominant and distinctive element. Nevertheless, the word “Adhesives” clearly contributes to conceptual message of the mark and the stylisation of JS’ mark does not contribute to its conceptual message.

80. In regard to PAL’s **982 TECBOND Mark**, as noted above, I found that PAL’s mark would likely be pronounced as TEC-BOND. The word “BOND” is an ordinary dictionary word which would be recognised by the average consumer, and is highly allusive of PAL’s adhesive goods which are used to bond things together. I therefore find that the consumer would recognise and see the allusive ordinary dictionary word “BOND” at the end of PAL’s mark. On this basis, the consumer would also see the “TEC” element at the beginning of the mark, which would be perceived as an invented word which does not evoke any meaning.

81. I find that the meaning conveyed by the words “adhesives” and “bond” in the parties’ marks overlap to the extent that adhesives are used to bond things together. Nevertheless, I note that the word “TEC” in the parties’ marks is conceptually neutral.

PAL’s 583 Mark and JS’ Mark

82. In its submissions in lieu, JS claims that the word “FOUNDRY” is a “dominant prefix” at the beginning of PAL’s mark, “where consumers pay most attention to”.¹² However, “FOUNDRY” is an ordinary dictionary word which denotes a factory for casting and processing metal. I therefore consider that, bearing in mind the context of the goods,¹³ it is likely the average consumer will see the ordinary dictionary word

¹² Paragraph 9. I also note that this argument is used for PAL’s remaining marks.

¹³ *LIGHT VITAMIN* (word mark) BL O/1174/25.

“FOUNDRY” at the beginning of **PAL’s 583 Mark** as alluding to its use within foundry environments. The word “TEC” at the end of PAL’s mark would also be seen by a significant proportion of average consumers as an invented word with no conceptual meaning. Consequently, the invented word “TEC” in the parties’ marks is conceptually neutral, with the allusive and descriptive words “FOUNDRY” and “Adhesives” creating a conceptual point of difference.

PAL’s 837 and 544 Marks and JS’ Mark

83. The parties agreed that the word “TEC” has no meaning in respect of the goods, and I therefore find that this word at the end of PAL’s marks would be seen by a significant proportion of average consumers as an invented word.

84. The word “KNOT” at the beginning of PAL’s **837 Mark** is an ordinary dictionary word which primarily indicates something such as a rope that has been looped or tightened onto itself. However, it also has a meaning in regard to wood. A knot on wood is a circular or oval shape that has formed where there once was a branch.

85. I bear in mind that in *LIGHT VITAMIN* (word mark) BL O/1174/25, Mr Thomas Mitcheson KC sitting as the Appointed Person stated that the assessment of a conceptual meaning should take place with reference to the parties’ goods where there is a potential link between the conceptual meaning of the mark and the goods to which it is affixed. On this basis, I consider that the meaning of a knot in wood is likely to be assigned to the word “KNOT” on the basis that PAL’s goods are adhesive or filling substances used to repair defects in wood. I therefore find that this meaning is allusive of the goods, and thus the invented word “TEC” is the dominant and distinctive element of PAL’s mark. Nevertheless, I note that the word “KNOT” provides a point of conceptual difference between PAL’s **837 Mark** and JS’ mark.

86. The word “HOBBY” at the beginning of PAL’s **544 Mark** is an ordinary dictionary word which evokes the meaning of an activity done for leisure. I find that this could be allusive of when these goods can be used (when doing ones hobby such as crafting). On this basis, the invented word “TEC” is the dominant and distinctive element of

PAL's mark. However, the words "HOBBY" and "Adhesives" still provides a point of conceptual difference between PAL's **544 Mark** and JS' mark.

Distinctive character of the earlier trade marks

87. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

88. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. Before assessing whether PAL's 4 earlier

marks have acquired distinctiveness, I will begin by assessing their inherent distinctive character.

892 TECBOND Mark

89. The average consumer will see the word “TECBOND” as consisting of the ordinary dictionary word “BOND”, which is highly allusive of its adhesive goods, with the beginning element “TEC” being an invented word which does not denote any conceptual meaning. As a whole, the mark is inherently distinctive to a high degree.

583 FOUNDRY TEC Mark, 837 KNOT-TEC Mark & 544 HOBBY-TEC Mark

90. As noted above, PAL’s above marks begin with ordinary dictionary words which I have found to be allusive of the goods. The word “FOUNDRY” alludes to the use of the goods within foundry environments. The word “KNOT” is allusive of PAL’s adhesive or filling substances to repair defects in wood, and the word “HOBBY” is allusive of the goods being used when doing ones hobby (such as crafting, for example). The word “TEC” at the end of the marks will be seen as an invented word which evokes no meaning. On this basis, as a whole, the three marks are inherently distinctive to a high degree.

91. I will now assess whether the evidence filed by PAL is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market and I have summarised PAL’s evidence in paragraphs 25 to 39 above.

92. **Exhibit 10** contains the sales for TECBOND adhesive goods, from 2003 to 2024, which every year amounted to over 1 million. As noted above, PAL has also provided significant sales made under its FOUNDRY TEC and HOBBY-TEC marks, for the years 2012 to 2025. However, I bear in mind that I have no supporting invoice evidence for the HOBBY-TEC goods, and I also have no invoice evidence for the sale of FOUNDRY TEC goods, between 2007 and 2012.

93. From 2012 to 2016, PAL spent a total of £100,682 on its marketing, for which article and brochure evidence has been provided in **exhibits 7** and **8**. All of PAL’s

marketing clearly advertises its adhesive goods under its TECBOND, KNOT TEC, FOUNDRY TEC and HOBBY-TEC marks. However, I bear in mind that some of the brochure evidence provided falls after 2017 (the filing date of the **657 Mark**). I also have not been provided with any information as to how many UK consumers would have been exposed to the brochure advertising, or the article advertising. PAL has not provided evidence of its market share, and based on the sales figures provided, I find that it would likely amount to a small proportion of the adhesives market (which I consider to be a relatively large sector). Therefore, taking all of the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness for any of PAL's 4 earlier marks.

Family of marks

94. Before proceeding to consider a likelihood of confusion in the ordinary way, I wish to firstly address PAL's family of marks argument. On this point, I refer to the case of *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the Court of Justice of the European Union stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or

services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

95. For PAL's marks to constitute as a 'family', there must be several of them which possess common characteristics, all of which must be present on the market.

96. In the case of its ECOTEC mark, PAL has not provided any evidence in relation to this mark. I am therefore unable to establish that this mark is present on the UK market, and, thus, it cannot be relied upon as part of the family. Nevertheless, in regard to PAL's remaining marks, that being its **892 TECBOND Mark**, **583 FOUNDRY TEC Mark**, **837 KNOT-TEC Mark** and **544 HOBBY-TEC Mark**, I have been provided evidence of use of these marks, as summarised in paragraphs 25 to 39 and 92 to 93 above. I find that this evidence establishes that these 4 marks were present on the UK market at the relevant date.

97. PAL's **892 TECBOND Mark** consists of the invented word "TEC" followed by the word "BOND", which is highly allusive of PAL's adhesive goods which are used to bond things together. PAL's **837 KNOT-TEC Mark** begins with the allusive word "KNOT", indicative of the goods being used for wood repair, followed by the invented word "TEC". Lastly, PAL's **544 HOBBY-TEC Mark** and **583 FOUNDRY TEC Mark** both begin with an allusive word ("HOBBY" alluding to when the goods can be used—such as when doing one's hobby— and "FOUNDRY" alluding to the goods being used within foundry environments), followed by the invented word "TEC". Therefore, only PAL's **837 KNOT-TEC Mark** and **544 HOBBY-TEC Mark** display characteristics which render them capable of association with a family (i.e. they begin with an allusive word followed by the invented "TEC" word, both of which are connected with a hyphen). PAL's **583 FOUNDRY TEC Mark** also fits this pattern but without the use of the hyphen. The **892 TECBOND Mark** does not fit this pattern.

98. As noted above, the case law makes it clear that there must be a sufficient number of marks on the market for a party to demonstrate that there is a family of marks. However, if I consider that PAL's **837 KNOT-TEC Mark**, **544 HOBBY-TEC Mark** and **583 FOUNDRY TEC Mark** would be capable of forming a part of a family (finding that the lack of hyphen in the **583 Mark** does not prevent it being a part of the family), I find that there is unlikely to be a sufficient amount of marks for PAL to have a family of them.

99. However, for the sake of completeness, if the 3 marks were enough, I bear in mind that in order for a family of marks argument to be satisfied, the applied-for mark must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series. This is because for the trade marks forming part of the series to enjoy greater protection than each individual mark, the purchasing public must recognize that the shared characteristic indicates common origin. As the GC clarified in *BAINBRIDGE*,¹⁴ that could not be the case where, for example, "**the element common to the earlier serial marks is used in the trade mark applied for either in a different position from that in which it usually appears in the marks belonging to the series or with a different semantic content.**" This is supported by

¹⁴ *Il Ponte Finanziaria v OHMI - Marine Enterprise Projects (BAINBRIDGE)*, Case T-194/03

the case of *W3 Ltd v easyGroup Ltd* [2018] EWHC 7 (Ch) which highlights that the later mark is required to display characteristics which render it capable of association with the family.

100. In this case, PAL's KNOT-TEC, HOBBY-TEC and FOUNDRY TEC Marks start with the allusive word element and end in the word "TEC" (2 of which are connected by a hyphen). In JS' mark, the invented word "TEC" is used at the beginning of the mark, and ends with the descriptive word "Adhesive". This means that the common "TEC" element is clearly in a different position in the parties' marks, and the secondary word element in JS' mark is outright descriptive (rather than allusive like in PAL's marks). Consequently, I do not find that JS' mark follows the same pattern shown in PAL's marks, and so I find it unlikely that the average consumer would assume that it belongs to that family. As such, the family of marks argument is of no assistance to PAL.

Likelihood of confusion

101. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. Nevertheless, 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.

102. The following factors must be considered to determine if a likelihood of confusion can be established:

892 TECBOND Mark

- I have found the marks to be visually similar to a medium degree.
- I have found the marks to be aurally similar to no more than a medium degree.
- I have found that the words “BOND” and “Adhesives” in the parties’ marks overlap conceptually, however, the invented word “TEC” in the parties’ marks is conceptually neutral.
- I have found the **892 TECBOND Mark** to be inherently distinctive to a high degree.
- I have identified the average consumer as members of the general public, and professionals who work in the packing, woodworking and manufacturing industries, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties’ goods to be identical, similar to between a medium and high degree, or similar to a medium degree.

103. Taking all of the above into account, even bearing in mind the principle of imperfect recollection, I find that the parties’ marks could be mistakenly recalled as each other. Both of the parties’ marks begin with the invented word “TEC”, a position which tends to make more of an impact than its ends. JS’ mark ends is the wholly descriptive word “adhesives” and PAL’s mark ends in the highly allusive word “BOND”

(in which the adhesive goods are used to bond goods together). On this basis, I find that the average consumer could overlook the descriptive and highly allusive words at the end of the parties' marks. I also find that the average consumer would easily overlook the stylisation of JS' mark, and I also consider that the average consumer could misremember that the words "TEC" and "BOND" are presented as one word in PAL's mark. On this basis, I find there to be a likelihood of direct confusion.

104. It now falls to me to consider the likelihood of indirect confusion. 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)".

105. I consider that the shared common use of the invented "TEC" word at the beginning of the parties' marks will lead the average consumer to conclude that they originate from the same or economically linked undertakings. The ordinary dictionary word "Adhesives" used at the end of JS' mark is descriptive of the goods. I also find that in the context of the goods, the addition of the ordinary dictionary word "BOND" at the end of the **892 Mark** is highly allusive that the adhesives are used for bonding purposes. These words therefore overlap conceptually on the basis that adhesives are used to bond things together. They would, therefore, be seen as natural and logical alternatives for one another. Consequently, the average consumer will see the parties marks as an updated version of the same mark, updating the way in which they refer to their adhesive products, to alluding to its bonding qualities. I therefore find that this is indicative of re-branding.¹⁵ I consider that it is not uncommon for undertakings re-brand themselves from time to time to accommodate changes in marketing considerations. Consequently, taking the above into account, I consider there to be a likelihood of indirect confusion.

583 FOUNDRY TEC Mark, 837 KNOT-TEC Mark and 544 HOBBY-TEC Mark

- I have found the marks to be visually and aurally similar to between a low and medium degree.
- I have found the invented word "TEC" in the parties' marks are conceptually neutral, with the words "FOUNDRY", "HOBBY", "KNOT" and "Adhesives" creating a conceptual point of difference between them.

¹⁵ Rather than the marks being seen as a house mark and its sub-brand.

- I have found the **583 FOUNDRY TEC Mark**, the **837 KNOT-TEC Mark** and the **544 HOBBY-TEC Mark** to be inherently distinctive to a high degree, on the basis that they contain the invented word “TEC”.
- I have identified the average consumer as members of the general public, and professionals who work in the packing, woodworking and manufacturing industries, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties’ goods to be identical, similar to between a medium and high degree, or similar to a medium degree.

106. Taking all of the above into account, even bearing in mind the principle of imperfect recollection, I consider that the parties’ marks could to be mistakenly recalled as each other. This is on the basis that all of the parties’ marks contain the invented word “TEC”, with the addition of either allusive wording (FOUNDRY, HOBBY and KNOT in PAL’s mark), or descriptive wording (Adhesives in JS’ Mark). Whilst I note that the wording is positioned differently, with PAL’s Marks beginning with the allusive wording and ending with the invented word TEC, and JS’ mark beginning with the invented word and ending in a descriptive word, the average consumer could still easily overlook the addition of the descriptive and allusive word elements, whether they are placed at the beginning or the end of the marks. They would also easily overlook the stylisation of JS’ mark. Consequently, I find a likelihood of direct confusion on all of the parties’ goods.

107. I also consider that the shared common use of the invented “TEC” word within the parties’ marks will lead the average consumer to conclude that they originate from the same or economically linked undertakings. I have found the ordinary dictionary words “KNOT”, “HOBBY” and “FOUNDRY” at the beginning of PAL’s Marks are allusive of the goods. I have also found the ordinary dictionary word “Adhesives” used at the end of JS’ mark is descriptive of the goods. On this basis, the average consumer will see the parties’ marks as sub-brand marks (“TEC Adhesives” being the house brand and “KNOT-TEC” being the sub-brand mark focussed on adhesives that repair

defects in wood, “HOBBY-TEC” being the sub-brand mark focussed on adhesives for use in crafting and “FOUNDRY-TEC” being the sub-brand mark focussed on adhesives for use within foundry environments). Therefore, I find there to be a likelihood of indirect confusion.

108. Taking all of the above into account, the invalidation based upon section 5(2)(b) is fully successful.

Section 5(4)(a)

109. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

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

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

111. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

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

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

113. As JS has filed no evidence of use, I have only the prima facie relevant date to consider i.e. 23 March 2017.

Goodwill

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

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

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

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not

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

116. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

117. Whilst I have summarised PAL's evidence in paragraphs 25 to 39 above, I bear in mind that under section 5(4)(a), PAL relies upon its **TEC** sign, and that I can only consider PAL's use until 23 March 2017. As noted above, I found that the TEC sign is clearly used on PAL's glue guns, as demonstrated by the website, article and brochure evidence. For the sake of completeness, I note that the brochure evidence dated before the relevant date (that being the TECBOND brochures) contained in **exhibit 8** consistently refers to PAL's TEC glue guns as follows:

tec™ glue guns

tec™ glue guns are designed to apply the wide range of **tecbond®** hotmelt adhesives, easily, quickly and reliably.

They are low-cost capital items, highly portable and designed to be totally reliable in tough industrial environments.

tec™ glue guns can apply hotmelt adhesive in bead, dot and even spray patterns, depending on the glue gun selected.

The wattage of the tool normally determines the melt-rate and should be selected based on the amount of adhesive required per assembly, as well as the number of assemblies needed to be produced per hour.

In general the larger tools are more powerful and provide greater volumes of hotmelt adhesive at the correct temperature for optimum bonding.

5 43mm (1¾") tec glue gun

tec3150



15mm (5/8") tec glue guns & glue sticks 4

tec805



Low cost medium size industrial 15mm (5/8") glue gun, eco heater chamber design for low power consumption, robust & easy to use. Medium output, 3 minute warm up time & illuminated on/off switch.

tec810



Heavy duty medium size 15mm (5/8") glue gun, robust & easy to use with medium output, 2 minute warm up time, fast recovery & illuminated on/off switch.

tec820



Adjustable temperature, heavy duty medium size 15mm (5/8") glue gun. Robust and easy to use, fast recovery, medium output, 2 minute warm-up time & illuminated on/off switch.

1 12mm (1/2") tec glue guns

tec150



Hobby and craft 12mm (1/2") glue gun, lightweight and easy to use, removable stand & full hand trigger. Supplied with 4 clear general purpose glue sticks.

tec175



Reliable low cost 12mm (1/2") glue gun, lightweight and easy to use, removable stand and full hand trigger.

tec250



Light industrial 12mm (1/2") glue gun, lightweight and easy to use, power on light, removable stand & full hand trigger and removable nozzle.

118. It is also clear from the above that the guns themselves are affixed with the "TEC" mark.

119. I am able to cross-reference the above brochure evidence and the price list evidence contained in **exhibit 6** to confirm that all of the invoices contained in **exhibits 5, 9** and **AZ1**, which refer to goods such as "TEC6100", "TEC3200", "TEC7300", "TEC6100", "TEC3200" and "TEC7300", are all glue guns. I also bear in mind that many of these invoices are dated from 2012 to 2017, and they show that the sale of PAL's TEC glue guns were geographically spread across the UK.

120. Goodwill arises as a result of trading activities, and it is clear from the invoice evidence above, and the turnover figures and unit sales provided by Mr Zulewski in **exhibit AZ3**, that PAL has been trading under the “TEC” sign since 2012. **Exhibit AZ3** was provided to show the sales made under the TEC mark alone, between 2012 to 2024. The sales made between 2018 to 2024 clearly fall after the prima facie relevant date. Nevertheless, I note the following turnover from this exhibit:

Year	Turnover	Units
2012	£200,210	4,841
2013	£170,669	4,018
2014	£167,468	3,673
2015	£185,715	4,070
2016	£200,852	3,802
2017	£303,388	4,274

121. I also bear in mind that some of the sales made in 2017 would have fallen after the relevant date. Nevertheless, all of the aforementioned TEC glue guns (“TEC6100”, “TEC3200”, “TEC7300”, “TEC820” and “TEC805”) are clearly listed within this spreadsheet, with the sales made from 2012 to 2016, all of which fall before the relevant period, amounting to £924,914.

122. Taking the evidence as a whole into account, I am satisfied that PAL has demonstrated a modest degree of goodwill prior to the relevant date in relation to all of the goods for which PAL relies upon, that being; apparatus for dispensing hot melt adhesives, hot melt glue guns and applicators of adhesives.

123. I bear in mind that JS criticises PAL’s evidence on the basis that the “evidence does not show consistent use of the TEC as a stand-alone trade mark”, because “it is more often used in conjunction with additional letters or numbers, resembling a technical code or model number.¹⁶ However, as rightly noted by JS, these numbers are clearly indicating a model number. On this basis, the numbers are not designating the origin of the goods, the word “TEC” is. Also, as shown above, the brochure evidence introduces PAL’s goods as “tec glue guns” and then proceeds to list the

¹⁶ Paragraph 5 of JS’ submissions filed during the evidence rounds.

individual models, all still using the “TEC” sign. In light of the above, I am also satisfied that the “TEC” sign was distinctive of PAL’s goodwill at the relevant date.

Misrepresentation and damage

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

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

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

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

And later in the same judgment:

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

125. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”.

126. The goods for which PAL has shown goodwill (that being apparatus for dispensing hot melt adhesives, hot melt glue guns and applicators of adhesives) are identical to JS’ class 7 and class 8 “*Machine tools and mechanically operated devices exclusively for applying hot-melt adhesives*” and “*Hand-tools and hand-operated devices exclusively for applying hot-melt adhesives*”. The goods for which PAL has shown goodwill are similar to JS’ class 1 “*Hot-melt adhesives used in industry*” and class 16 “*Hot-melt adhesives for household purposes*” for the same reasons set out in paragraph 59 above.

127. I also bear in mind that PAL’s “TEC” sign is wholly encompassed at the beginning of JS’ “TEC Adhesives” mark, and the only difference between them is the descriptive word “Adhesives” at the end of JS’ mark and the stylisation of JS’ mark (the use of the red and grey typeface and red underline). These elements would be easily overlooked by the average consumer, and I therefore find that the PAL’s sign and JS’ mark would be misremembered as each other.

128. Therefore, taking the closeness of the parties’ fields of activity into account, as well as the marks being very similar, I consider that a substantial number of members of the relevant public would be misled into purchasing JS’ goods in the mistaken belief that they are the goods of PAL. Damage through diversion of sales is easily foreseeable.

129. The invalidation under section 5(4)(a) succeeds in full.

CONCLUSION of PAL’s invalidation

130. PAL’s invalidation has been successful under sections 5(2)(b) and 5(4)(a). Under section 47(6) of the Act, JS’ registration UK00916495657 (**657 Mark**) is deemed never to have been made.

131. On the basis that JS' **657 Mark** has been successfully invalidated, it cannot constitute as an earlier mark for the purpose of its opposition against PAL's **458 Mark** and **471 Mark**. JS' oppositions consequently fall away, and PAL's UK00003955458 and UK00003955471 applications may proceed to registration.

COSTS

132. PAL has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £1,650 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing the application for invalidity and considering the Counterstatement	£250
Considering the Notice of opposition and preparing a counterstatement (x2)	£400
Preparing and filing evidence and written submissions in lieu	£800
Official Fee for the invalidation	£200
Total	£1,650

133. I therefore order Jörg Schneider to pay Power Adhesives Limited the sum of £1,650. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of April 2026

L FAYTER
For the Registrar

ANNEX 1

The 414 ECOTEC Mark

Class 7

Glue guns: glue guns with a digital controller for maintaining temperature within the glue guns.

The 892 TECBOND Mark

Class 1

Adhesives included in Class 1.

The 583 FOUNDRY TEC Mark

Class 1

Adhesives included in Class 1.

The 837 KNOT-TEC Mark

Class 1

Adhesive substances used in industry for repairing defects in wood.

Class 2

Filler materials for repairing defects in wood, preservatives against deterioration of wood.

The 544 HOBBY-TEC Mark

Class 1

Hot melt adhesives for use in apparatus for dispensing hot melt adhesives; hot melt adhesives for use in hot melt glue guns.

Class 9

Apparatus for dispensing hot melt adhesives; hot melt glue guns.