O/0357/24

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO. 3801120

IN THE NAME OF PENTAGON TECHNOLOGY LTD

TO REGISTER

BENFEI

AS A TRADE MARK IN CLASS 9

AND

OPPOSITION THERETO (UNDER NO. 437082)

BY

SHENZHEN BENFEI TRADE LTD

Background and pleadings

1. On 21 June 2022, Pentagon Technology Ltd ("***the Applicant***") applied to register the trade mark 'BENFEI' in the UK, under number 3801120 ("***the Contested Mark***"). Details of the application were published for opposition purposes on 22 July 2022. Registration is sought for the following goods:

   Class 9: '*USB cables; USB hubs; USB chargers; USB card readers; Electricity connectors; Electronic connectors; Cable connectors; Plug connectors; Adapter connectors (Electric -); Audio cable connectors; Audio adaptors; Audio transmitters; Audio cable; Audio receivers; Audio-video receivers; Video transmitters; Video cables.*'

2. On 24 October 2022 Shenzhen BENFEI trade ltd ("***the Opponent***") opposed the application under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (***"the Act"***). The Opponent relies upon its UK trade mark number 3153676 'BENFEI' ("***the Earlier Mark***"). The Earlier Mark was filed on 8 March 2016, claiming partial priority from USA trade mark 86907538, with a priority date of 15 February 2016. It became registered on 10 June 2016. The Opponent relies upon all the goods covered by its registration, namely:

   Class 9: '*Laptop and cellphone cable adapters; computer card adapters*'.

3. The Earlier Mark qualifies as an earlier mark under section 6(1) of the Act by virtue of its earlier filing date. As the Earlier Mark completed its registration procedure more than five years before the filing date of the Contested Mark, it is subject to the use provisions set out in section 6A of the Act. The Opponent has stated that it has used the mark for all the goods relied on and given that the Applicant requested proof of use of such mark, the Earlier Mark is subject to the proof of use requirements.

4. In its notice of opposition, the Opponent essentially contends that the competing marks are identical and that the parties' goods are identical or highly similar, giving rise to double identity or likelihood of confusion.

5. Pentagon Technology Ltd filed a counterstatement, denying the grounds of opposition. In its counterstatement, the Applicant indicated that it would require the Opponent to provide proof of use of the Earlier Mark.

6. On 9 March 2023 the Opponent filed submissions, entitled 'Statement of Grounds', however it did not submit evidence of use. The Office informed the Opponent it was requested to file proof of use and the Opponent filed for a retrospective extension of time. The Office initially refused to allow the retrospective extension of time, but, following a Case Management Conference (CMC) held on 25 April 2023, the Office allowed the Opponent a retrospective extension of time to file evidence of use. On 11 May 2023 the Opponent filed evidence of use.

Relevance of EU law

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

Evidence and submissions

8. The Opponent is represented by Katarzyna Eliza Binder-Sony. The Applicant, exclusively for the purposes of this opposition, was represented by CMS Cameron McKenna Nabarro up until the end of the evidence rounds. It is now without legal representation.[1] The Opponent filed submissions (as referred to above) and evidence of use in the form of the Witness Statement of Xiaodong MA dated 11 May 2023. Xiaodong MA is the General Manager of Shenzhen BENFEI Trade Limited. He states that he has covered this role since 4 April 2014 and is, therefore, duly authorised to file evidence on its behalf.

9. Neither party requested a hearing, but the Opponent filed written submissions in lieu. I will not summarise the parties' submissions here, but I will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

Decision

Proof of use

[1] As per the letter of the Applicant's representative dated 11 August 2023.

10. I will begin by assessing whether there has been genuine use of the Earlier Mark.

The law

11. Section 6A of the Act states:

"(1) This section applies where

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether

or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5)-(5A) [Repealed]

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

11. Section 100 of the Act is also relevant, which reads:

"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."

12. Consequently, the onus is upon the Opponent to prove that genuine use of the registered trade mark was made in the relevant period.

Case law

13. 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 Bundervsvereinigung 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]."

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

15. The relevant period in which genuine use must be established is the five-year period ending on the date of filing of the Contested Mark. In the case before me, that period is **22 June 2017 to 21 June 2022**.

Preliminary considerations

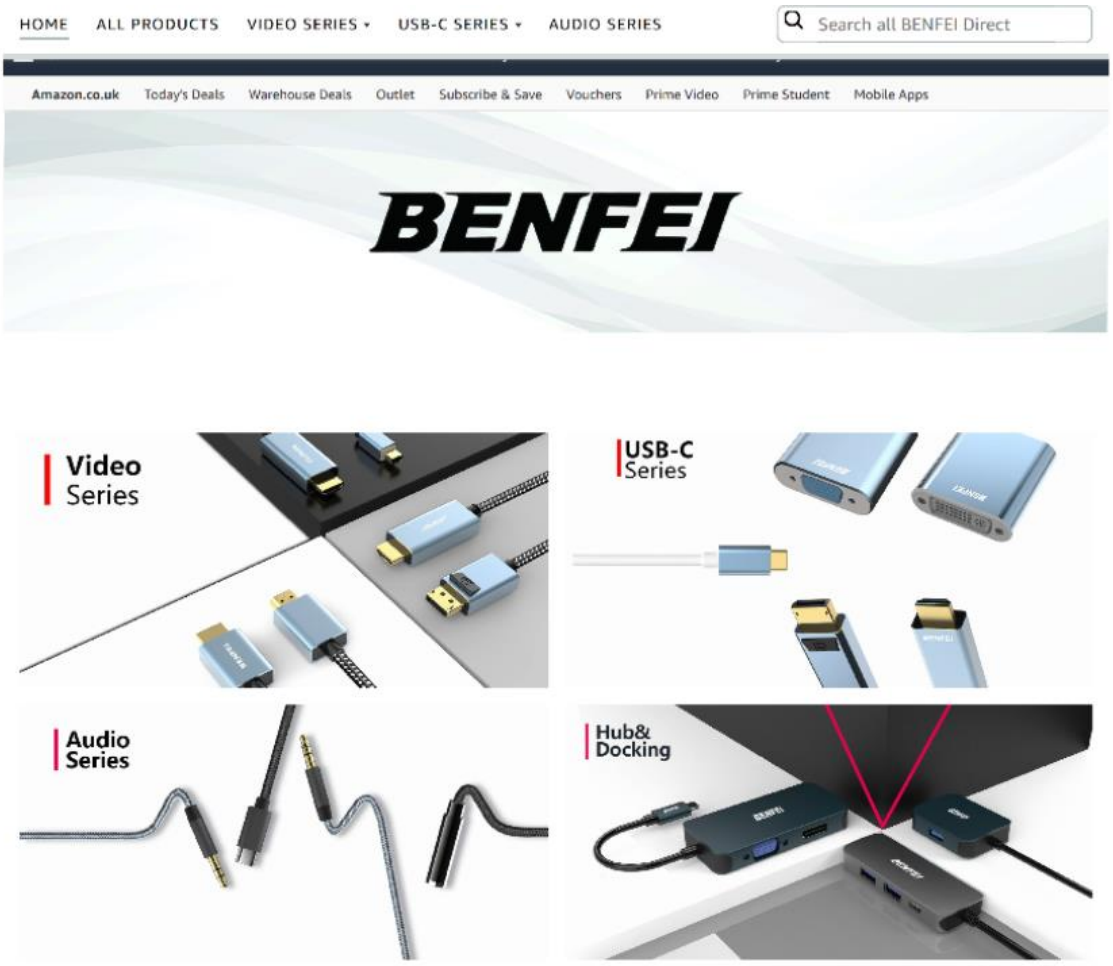
16. The Opponent, in its evidence of use, along with screenshots of its Amazon pages, provided two weblinks to redirect me to additional examples of use of its mark on the

earlier goods. I must point out that in reaching my final determination, I can exclusively consider the material as presented and I cannot follow weblinks. Strictly speaking, this matter should have been brought to the opponent's attention when it filed its evidence. However, for reasons which will become apparent, this is not detrimental to the opponent's case and I therefore say no more about it.

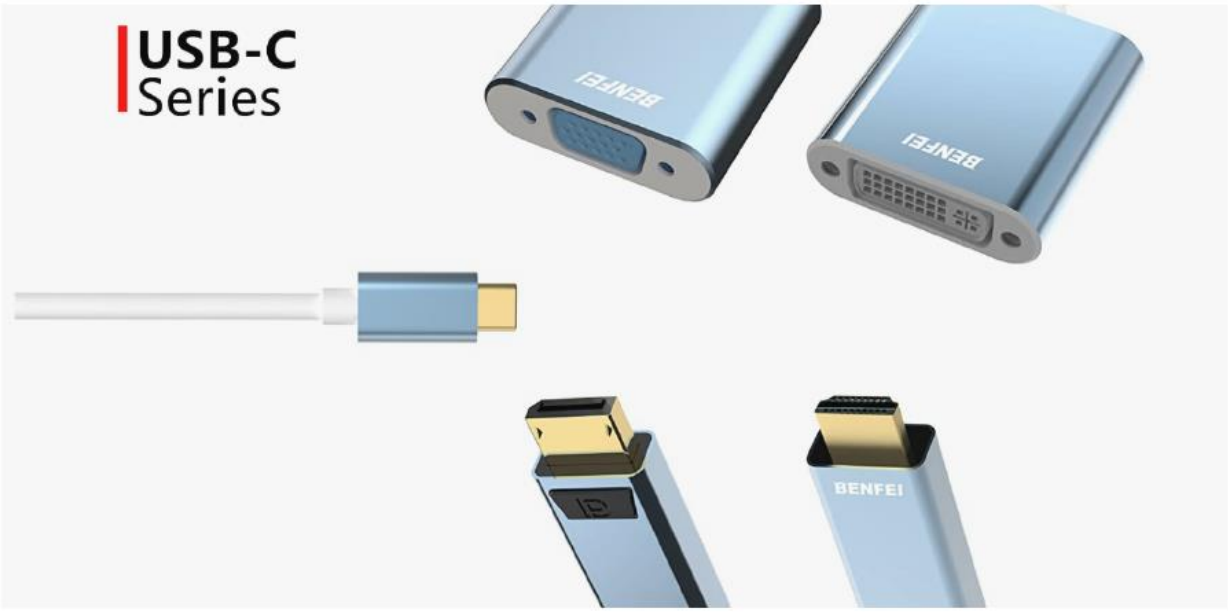
Form of the mark

17. For the sake of completeness, before I move on to assess if the Opponent has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered. As outlined in *Lactalis McLelland Limited v Arla Foods AMBA*, Case O/265/22,[2] the use of the mark in a different form may also constitute use of the mark as registered. While the Earlier Mark is registered as a word-only mark, I note that some evidence shows use of the mark with some stylisation (i.e., the letters are slightly prolonged along the corners):

18.



[2] At [13 – 15]. See also *Hyphen GmbH v EUIPO*, Case T-146/15, at [28-32].



19. Where the Opponent has used the mark in its registered word only form this is clearly use upon which it may rely. Most of the evidence displays the mark used as word only, whilst few pieces of evidence show the Earlier Mark used with some stylisation.

20. I find that use of the Earlier Mark, also in its minimal stylisation, amounts to use of the mark as registered because that particular form of use does not alter the distinctive character of the mark. Consequently, it is use upon which the Opponent can rely.

Evidence of use

21. The Opponent has claimed that genuine use has been made in relation to all the goods on which it relies under the Earlier Mark. I must consider whether, or the extent to which, the evidence shows genuine use of the Earlier Mark in relation to the goods covered under class 9, being:

Class 9: '*Laptop and cellphone cable adapters; computer card adapters*'.

22. The Opponent's evidence shows Amazon display pages, Amazon purchase history, customer comments and feedbacks. More specifically, the evidence of use refers to shipment records of the Opponent's products to UK customers for each year from 2017 to 2022, Amazon UK Customer Reviews pages from 2016 to 2023, and invoices issued between 2016 and 2023.

23. I note the following from the Opponent's evidence:

- **Exhibit XM1** contains the 'BENFEI' page on Amazon UK showing examples of products available for purchase.
- **Exhibit XM 2** shows details of products available on Amazon UK to purchase. The products shown are laptop and phone cable adapters of different types, including card adapters.
- **Exhibit XM 3** to **Exhibit XM 8** provide examples of shipment records of the Opponent's products purchased on Amazon and distributed in the UK between 2017 and 2022.
- **Exhibit XM 9** to **Exhibit XM 14** provide examples of Amazon UK customer reviews for the Opponent's products between 2017 and 2023.
- **Exhibit XM 15** to **Exhibit XM 21** comprise a selection of invoices issued to UK clients during the relevant period. The invoices' descriptions contain the mark 'BENFEI' to identify the Opponent's goods.

24. In its Witness Statement Xiaodong MA submits that the annual sales for the Opponent's goods in the UK amounted to the following:

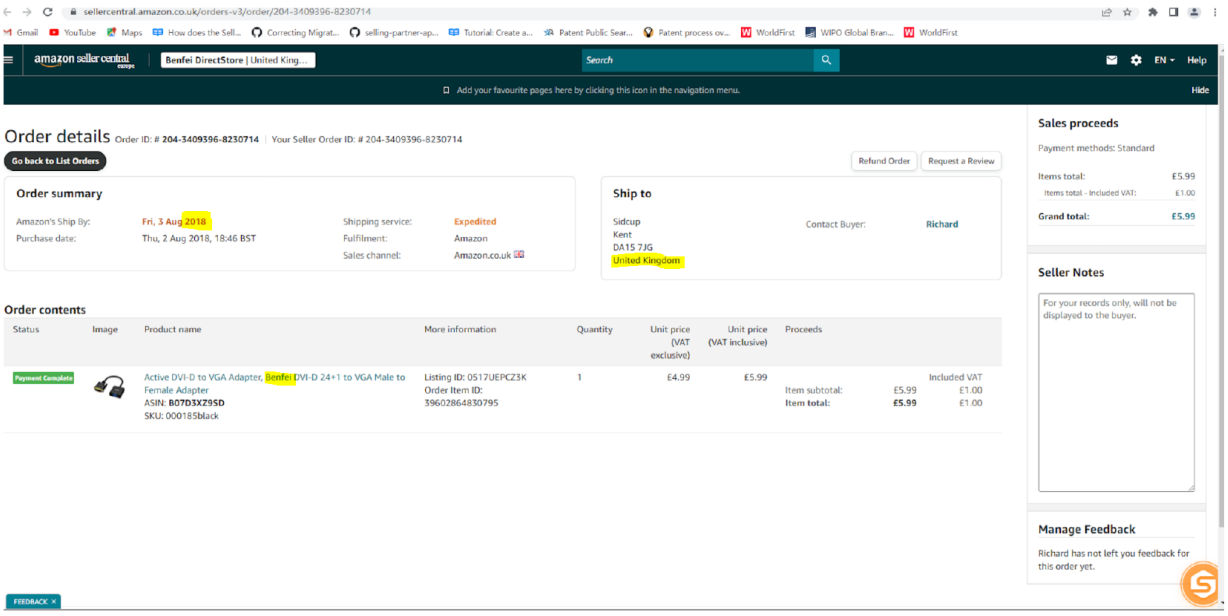
2018	Amount (Around 680,000 £'s)
2019	Amount (Around 2,100,000 £'s)
2020	Amount (Around 2,200,000 £'s)
2021	Amount (Around 4,000,000 £'s)
2022	Amount (Around 3,000,000£'s)

Assessment on genuine use

25. **Exhibit XM 1** shows use of the Earlier Mark on the Opponent's Amazon UK store homepage in relation to the Opponent's goods. **Exhibit XM 2** shows that the mark 'BENFEI' is applied on the goods themselves. From this evidence derives that the end consumers are likely to be faced with the Earlier Mark when purchasing the Opponent's products. While the Amazon UK website is not dated, when viewed in conjunction with the invoices, turnover figures and consumer feedbacks provided, I accept that the Opponent has displayed the Amazon UK homepage, featuring the 'BENFEI' mark, throughout the relevant period.

26. **Exhibit XM 3** to **Exhibit XM 8** show examples of shipment records of the Opponent's goods bearing the 'BENFEI' mark, distributed within the relevant period (2017 – 2022)

to various parts of the UK. This evidence clearly shows use of the Earlier Mark in the UK consistently throughout the relevant period as each exhibit refers to one year of shipment records showing the sale of goods bearing the mark 'BENFEI' (see below one extract as example for the year 2018):



27. I note that from the screenshots provided in **Exhibit XM 3** to **Exhibit XM 8**, all the evidence exclusively refers to cable adapters (more specifically, HDMI cables), whilst none of that evidence concerns card adapters.

28. Additional evidence of the Earlier Mark's use within the UK for most of the relevant period is shown in the **Exhibit XM 9** to **Exhibit 14** containing various customer reviews for the 'BENFEI' products purchased on Amazon UK. Most of the reviews do not refer to the products being reviewed, so I cannot determine for all of the reviews which products have been purchased. However, I notice that the vast majority of reviews concern HDMI adapters or video adapters for laptops. I cannot find in the evidence any review clearly referring to card adapters.

29. In the Witness Statement the Opponent also provides its annual sales figures. The Opponent submits that the annual sales refer to: "*laptop and cell phone cable adapters and computer card adapters in the UK before the date of application*". However, I notice that the invoices in **Exhibit 15** to **Exhibit 21**, mainly concern HDMI cables or other cable adapters whilst there is no reference to card adapters.

30. In light of the above, I find that the Opponent has successfully demonstrated use of the Earlier Mark for '*Laptop and cellphone cable adapters*'. On the other hand, I do not find the Opponent has sufficiently showed use of the Earlier Mark for '*computer card adapters*'.

31. Having reached the above conclusion, I must determine a fair specification upon which the opponent is entitled to rely, bearing in mind the use that has been demonstrated. The Opponent's term '*laptop and cellphone cable adapters'* in the Earlier Mark is apt to reflect the use that has been demonstrated and is how the average consumer would fairly describe such use. I therefore find that the Opponent can rely upon a fair specification of '*laptop and cellphone cable adapters'*.

Approach

32. It seems to me that the Opponent's strongest case clearly lies with its grounds under Section 5(2)(a). I will therefore begin by considering this ground. If the Opponent succeeds under that ground, there will be no need to also consider the other ground under Section 5(1).

Section 5(2)(a)

The law

33. Section 5(2)(a) of the Act is as follows:

> "5(2) A trade mark shall not be registered if because-
>
> > (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, [...] there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".
>
> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

34. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-

342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

35. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

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

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

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services;

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

d) 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;

e) 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.

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

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

38. The competing goods are as follows:

Opponent's goods	Applicant's goods
Class 9	**Class 9**
Laptop and cellphone cable adapters;	USB cables; USB hubs; USB chargers; USB card readers; Electricity connectors; Electronic connectors; Cable connectors; Plug connectors; Adapter connectors (Electric -); Audio cable connectors; Audio adaptors; Audio transmitters; Audio cable; Audio receivers; Audio-video receivers; Video transmitters; Video cables.

39. 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. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

'USB cables; USB chargers; Electricity connectors; Electronic connectors; Cable connectors; Plug connectors; Audio cable connectors; Video cables; Audio cable; USB hubs; Adapter connectors (Electric -); Audio adaptors'

40. The Opponent submits that:

"*Both sets of products are designed to be physically integrated with electronic devices, playing a crucial role in their functionality. The items in both trademarks are used alongside or in conjunction with each other, creating a high likelihood of consumers encountering them simultaneously.*"

41. An 'adapter' is defined as a "*connecting device for parts that would not otherwise fit together*".[3] I agree with the Opponent's view that the Applicant's goods above consist of adapters used to connect one device (e.g., laptops or cellular phones) to another for different purposes. Regarding the Opponent's '*Laptop and cellphone cable adapters',* the Applicant's goods have the same nature being cables, purpose (i.e., connect different devices) and method of use, and can be purchased by the same users. The respective goods are also likely to be in competition when used for the same purpose as users might prefer to purchase one type of adapter over another, and these goods are likely to be sold through the same trade channels. It follows that I find the respective goods to be similar to a high degree.

'USB card readers'

42. USB card readers can have cables to connect to laptops (usually through a USB port) or phones and are normally used as adapters to read cards when used in connection to laptops or phones. Thus, I find that '*USB card readers'* and '*Laptop and cellphone cable adapters'* have the same nature as they both are adapters, the same purpose (i.e., enable card reading for laptops or phones), the same method of use (i.e. plug into laptops or phones), and are likely to share the same users. Therefore, I find these goods to be identical or highly similar.

'Audio receivers; Audio-video receivers; Video transmitters; audio transmitters'

43. With regard to the Applicant's goods above, I find that they have a different nature from the Opponent's '*Laptop and cell phone cable adapters*' because while the former would be a device to receive or transmit audio/video signals, the latter consist of cables to connect different devices. These goods might have different methods of use if the audio/video receivers or transmitters do not need to be connected to another device to function; however, it is likely that most audio/video transmitters need to be connected to another device to function. It follows that these respective goods would

[3] ADAPTER definition and meaning | Collins English Dictionary (collinsdictionary.com).

be complementary and have the same intended purpose (i.e., allow the user to receive or transmit audio or video signals). Therefore, I find the goods to be similar to a medium degree.

The average consumer and the nature of the purchasing act

44. It is necessary to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited*, *The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median".

45. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.[4]

46. The average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheideand Tusky* [1998] ECR I-4657, paragraph 31).

47. The contested goods will be purchased by the general public as well as those working professionally, such as IT experts (e.g., computer technicians). Both the general public and the professionals will take various factors into consideration such as quality, price, device compatibility, and suitability for the user's needs. The cost of the purchase is likely to vary, although it is unlikely to be particularly high. The frequency of the purchase is also likely to vary, but these goods are likely to be bought with a

[4] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

medium to low frequency. Accordingly, the level of attention paid will be average by the members of the general public and fairly above average for professional purchasers.

48. The goods are likely to be obtained directly from the provider via websites or specialised retail outlets. As such, it is my view that the purchasing process will be predominantly visual in nature. However, aural considerations in the form of word-of-mouth recommendations or verbal discussions with the provider, for instance, cannot be excluded entirely.

Comparison of trade marks

49. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

> "54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

50. The trade marks to be compared are as follows:

Earlier trade mark	Contested trade mark
BENFEI	BENFEI

51. Both marks consist of the same word, BENFEI, absent any stylisation. They are clearly identical.

Distinctive character of the Earlier Mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings

(see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

53. Dealing first with the inherent distinctiveness of the Earlier Mark, as discussed above, the Opponent did not indicate any potential meaning for the word 'BENFEI' that might have in the English language. The Earlier Mark is not a dictionary word, it does not seem to have any meaning in the English language (or other foreign language), and it does not seem to describe or allude in any way to the goods for which the Earlier Mark has been registered. Since the Earlier Mark is likely to be perceived as a meaningless invented word, without any semantic link to the goods in question, I believe the Earlier Mark possesses a high degree of inherent distinctive character.

54. Turning to the question of whether the inherent distinctiveness of the Earlier Mark has been enhanced through use, the Opponent provided evidence that the Earlier Mark has been used in relation to laptop and cellphone cable adapters in the UK at least since 2016. The Opponent provided evidence of widespread distribution of its goods in various parts of the UK, consumer engagement given by multiple product reviews online, and an average of 3-million-pound revenues per year between 2018 and 2022. However, the Opponent did not provide evidence showing the market share it occupies or the investments made in promoting the mark. Therefore, although I find that the Opponent sufficiently proved use of the Earlier Mark for certain goods, I do not believe that the evidence provided shows that the Earlier Mark has acquired enhanced distinctiveness through use.

Likelihood of confusion

55. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused.

56. The goods at issue are identical, highly similar, or similar to a medium degree, the members of the general public are likely to pay an average level of attention for the contested goods, while the portion of relevant public comprised of professionals will pay a higher-than-average level of attention. The distinctiveness of the Earlier Mark is high. The marks are identical.

57. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind. Weighing all of these factors I find that the average consumer, whether paying an average or above average degree of attention, is likely to mistake one mark for the other. Thus, there is a likelihood of direct confusion between the marks in relation to all of the relevant goods.

Conclusion

58. The opposition succeeds and the application will be refused.

Costs

59. The opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice ("TPN") 2/2016. In my calculation of costs, I have also considered whether it is appropriate to award the opponent any costs in relation to the CMC that took place on the 25 April 2023. However, given the nature of the issue which gave rise to the CMC, and that it was the opponent who requested the CMC, I do not consider that it would be appropriate to order the applicant to pay to the opponent any costs associated with it. Therefore, I award costs to the Opponent as follows:

Official fee:	£100

Preparing the notice of opposition and considering the counterstatement:	£200
Preparing submissions and evidence	£500
Filing Submissions in lieu	£300
Total:	**£1,100**

60. I order Pentagon Technology Ltd to pay Shenzhen BENFEI trade ltd the sum of **£1,100**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of April 2024

Andrea Rossi

For the Registrar