BL O/0567/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NUMBER 3890062
BY YUYAOSHI QIFENG E-COMMERCE CO., LTD
TO REGISTER THE TRADE MARK:

Vanpad

IN CLASSES 16 AND 21

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 441707
BY SHENZHEN DANGGE WINE TECHNOLOGY CO., LTD

BACKGROUND AND PLEADINGS

1. On 17 March 2023, Yuyaoshi qifeng E-commerce Co. Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision ("the contested mark") in the UK. The application was published in the Trade Marks Journal for opposition purposes on 31 March 2023 in respect of the following goods:

Class 16 Adhesive note paper; correcting tape for type; greeting cards; marking pens; memo pads; note books; school supplies [stationery]; writing pads; writing instruments; copy books; stickers [stationary].

Class 21 Brushes; brooms; cooking pot sets; bowls; bottles; moulds [kitchen utensils]; dustbins; cups; dusting clothes [rags]; saucers; pots; cake moulds.

2. On 30 June 2023, Shenzhen Dangge Wine Technology Co., Ltd ("the opponent") filed a notice of opposition, opposing the application in full, under section 5(1) and 5(2)(a) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon its United Kingdom Trade Mark ("UKTM") number 3854506, "Vanpad" ("the earlier mark"). The earlier mark was filed on 30 November 2022 and became registered on 24 February 2023. For the purpose of these proceedings the opponent relies upon all the goods for which the mark is registered, namely:

Class 16 Adhesive tapes for stationery or household purposes; Adhesive note paper; Ballpoint pens; Correcting tape for type; Envelopes; Greeting cards; Marking pens; Memo pads; Note books; Paper envelopes for packaging; Paper shredders for office use; Pencils; Bags [envelopes, pouches] of paper or plastics, for packaging; School supplies [stationery]; Writing pads; Writing instruments; Gel roller pens; Composition books; Copy books; Date books.

3. The opponent claims that the marks at issue are identical and that the respective goods are either identical or similar, resulting in a likelihood of confusion including the likelihood of association between the marks.

4. The applicant filed a counterstatement denying the grounds of opposition.

5. Given the filing date, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.

6. The opponent is represented by Yayipcom and the applicant is represented by QINBIN LI. Neither party filed evidence. Both parties were given the option of an oral hearing but neither requested to be heard on this matter, nor did they choose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers before me.

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.

PRELIMINARY ISSUES

8. The applicant has raised points in its counterstatement which I intend to address before going any further into the merits of this opposition. This is because, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

- <u>Goods comparison and the target market</u>

9. In its counterstatement, the applicant states the following:

"The protection scope of the trademark of the opponent is inconsistent with our trademark (our applicant's trade mark contains Classes 16 and 21)."

10. Differences between the goods currently provided by the parties, are irrelevant, except to the extent that those differences are apparent from each party's specification. Since the opponent's earlier mark is not subject to proof of use, it is entitled to protection in relation to all the goods for which it is registered. However, I confirm that it is the goods relied upon by the opponent and the goods applied for by the applicant that I will be comparing later in this decision. The assessment I must make between the goods is a notional and objective assessment, rather than a subjective one.

- The applicant's mark has priority as it has been used in commerce for nearly 7 years

11. For the avoidance of doubt, the fact that the applicant claims to have used its mark prior to the opponent's mark being applied for/registered, is not a defence in law to the opposition. Tribunal Practice Notice 4/2009 explains this as follows:

"*The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark.*

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the Applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the Applicant for

registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

12. Whilst it is noted that the applicant had originally sought to invalidate the opponent's mark,[1] this action has now been withdrawn.

13. Accordingly, Section 72 of the Act provides that registration shall be taken as prima facie evidence of the validity of a registered trade mark. The opponent's trade mark must be regarded as validly registered and, in these circumstances, the law requires that priority be determined according to the filing date of the application for registration. This means that the opponent's mark has priority.

- The applicant has applied for trade marks in the United States and other countries prior to the opponent's mark being applied for/registered

14. Trade mark rights are territorial. The fact that there are other registrations and trade mark applications owned by the applicant in other territories is not relevant to these proceedings, except where a registration has claimed a priority date from another country. It is noted that the application in these proceedings does not have an earlier priority date and so the relevant date is the filing date of the application in the UK, i.e. 17 March 2023. Accordingly, as decisions taken in other trade mark jurisdictions, such as the USPTO, are not binding on the Registrar, the applicant's US registration is not relevant to the decision I am required to make.

DECISION

Section 5(1) and 5(2)(a)

15. Section 5(1) of the Act states that:

[1] CA000505885

"A trade mark shall not be registered if because if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier mark is protected."

16. Section 5(2)(a) states that:

"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."

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

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

18. The following 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.

Identify of the marks

19. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA,* Case C-291/00, the Court of Justice of the European Union ("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 the average consumer."

20. The marks at issue are word only marks consisting of the single word "Vanpad". Accordingly, the marks are identical.

Comparison of goods

21. For the purpose of my assessment under section 5(1), the matter will only proceed if I find identity between the parties' goods. For any goods that are not identical, the opposition based on section 5(1) must fail but may, however, proceed under section 5(2)(a).

22. Section 60A of the Act provides:

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

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

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

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

23. In *Canon*, the CJEU stated at paragraph 23 of its judgment that:

"In assessing the similarity of the goods or services concerned, […] 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 Page 20 of 40 purpose and their method of use and whether they are in competition with each other or are complementary".

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

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

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

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

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

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

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

25. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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."

26. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

27. The competing goods are as follows:

Opponent's goods	Applicant's goods
Class 16: Adhesive tapes for stationery or household purposes; Adhesive note paper; Ballpoint pens; Correcting tape for type; Envelopes; Greeting cards; Marking pens; Memo pads; Note books; Paper envelopes for packaging; Paper shredders for office use; Pencils; Bags [envelopes, pouches] of paper or plastics, for packaging; School supplies [stationery];Writing pads; Writing instruments; Gel roller pens; Composition books; Copy books; Date books.	Class 16: Adhesive note paper; Correcting tape for type; Greeting Cards; Marking pens; Memo pads; Note books; School supplies [stationery]; Writing pads; Writing instruments; Copy books; stickers [stationary]. Class 21: Brushes; brooms; cooking pot sets; bowls; bottles; moulds [kitchen utensils]; dustbins; cups; dusting clothes [rags]; saucers; pots; cake moulds.

28. The opponent states in its notice of opposition that the goods covered by the contested mark are either identical or similar to the goods contained in the earlier mark. In its counterstatement, the applicant states that the scope of protection of the opponent's mark is inconsistent with the scope of protection of their mark, on the basis that as the contested mark not only contains goods in class 16, but it also contains goods in class 21.

Class 16 of the contested application

Adhesive note paper; Correcting tape for type; Greeting Cards; Marking pens; Memo pads; Note books; School supplies [stationery]; Writing pads; Writing instruments; Copy books; stickers [stationary].

29. With the exception of *stickers [stationary],* all the above contested goods have direct equivalents in the opponent's specification and are therefore identical due to their identical wording.

30. With regards to the contested *stickers [stationary],* broadly speaking a sticker is a small piece of paper which has an adhesive side allowing it to be fastened to surfaces,

etc. Similarly, in general, the opponent's *adhesive note paper* comprises a piece of paper with an adhesive strip on its back and can be used for attaching notes to documents and other surfaces, etc. Therefore, I find that there is a clear overlap between these stationery goods, on the basis that they share a similar nature and purpose and can coincide in channels of trade and users. Furthermore, they may also be in competition. Accordingly, I find the goods at issue to be similar to a medium degree.

Class 21of the contested application

Brushes; brooms; cooking pot sets; bowls; bottles; moulds [kitchen utensils]; dustbins; cups; dusting clothes [rags]; saucers; pots; cake moulds.

31. I do not find any obvious similarity between the contested goods and the opponent's Class 16 goods. The respective nature, methods of use, and intended purpose of the goods at issue are very different. Furthermore, it is not obvious to me that there would be any convergence of trade channels, nor do I have any evidence before me to suggest such an overlap. The goods at issue are not in competition with each other, nor are they complementary. Overall, I find that the above contested goods are dissimilar to all the opponent's goods.

Summary

32. As section 5(1) of the Act requires that the goods at issue be identical, the opposition under this ground will fail in respect of those goods that I have found to be only similar (and not identical).

33. Accordingly, the opposition under section 5(1) succeeds in respect of the following goods only:

Class 16 Adhesive note paper; Correcting tape for type; Greeting Cards; Marking pens; Memo pads; Note books; School supplies [stationery]; Writing pads; Writing instruments; Copy books.

34. As the section 5(1) ground of opposition is only partially successful, I will now consider the global assessment in relation to the section 5(2)(a) ground of opposition that only requires the goods to be similar. In regard to those goods that I have found to be dissimilar, there can be no likelihood of confusion under section 5(2)(a), and the opposition must fail under section 5(1).

The average consumer and the nature of the purchasing act

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

36. 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."

37. The average consumer for the goods at issue is likely to include members of the general public as well as business users. The goods will be available to purchase in retail stores or via online catalogues and websites. It will be a primarily visual process but I cannot discount an oral component to the purchase as word of mouth recommendations may be made. Various factors will be taken into account such as aesthetics, materials, quality and functionality and also suitability to satisfy specific requirements. The frequency of the purchase is likely to vary but the goods will not be

particularly expensive. Consequently, I consider that a medium degree of attention is likely to be paid during the purchase of the goods.

Distinctive character of the earlier marks

38. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

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

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

40. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use in relation to its mark. Consequently, I have only the inherent position to consider.

41. The earlier mark consists of the invented word “Vanpad”, which has no clear relationship with the goods relied upon. Accordingly, I find the earlier mark to be inherently highly distinctive.

Likelihood of confusion

42. In determining whether there is likelihood of confusion, I must take all of the above factors into account and consider if there is a likelihood of confusion for the average consumer.

43. 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. The first is the interdependency principle i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the marks and vice versa. I must bear in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing act. To do so, I must recognise that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

44. I have found the marks to be identical. I have found the earlier mark to be inherently distinctive to a high degree. I have found the average consumer of the goods will include members of the general public, as well as business users, who will purchase the goods predominantly 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 goods to vary from being identical to dissimilar.

45. As the marks are identical, there is nothing to assist the average consumer in distinguishing between them. Therefore, I consider that there is a likelihood of direct confusion where the marks are used on goods that are similar to a low degree or higher. For those goods that I have determined are dissimilar, there can be no likelihood of confusion.

Conclusion

46. For the goods I found to be identical, the opposition succeeds under section 5(1); for those goods with which I found similarity, the opposition succeeds under section 5(2)(a).

47. Accordingly, the opposition partially succeeds in relation to the following goods:

Class 16 Adhesive note paper; Correcting tape for type; Greeting Cards; Marking pens; Memo pads; Note books; School supplies [stationery]; Writing pads; Writing instruments; Copy books; stickers [stationary].

48. The application can proceed to registration for the following goods in relation to which the opposition was unsuccessful:

Class 21 Brushes; brooms; cooking pot sets; bowls; bottles; moulds [kitchen utensils]; dustbins; cups; dusting clothes [rags]; saucers; pots; cake moulds.

Costs

49. On balance, I consider that both parties have achieved a relatively equal level of success in these proceedings. In the circumstances, I do not consider it appropriate to make a costs award in favour of either party. Therefore, I order both parties to bear their own costs in these proceedings.

Dated this 19th day of June 2024

Joanne Roberts

For the Registrar