

O/0666/23

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003704232  
IN THE NAME OF EUROELECTRONICS.EU SP. Z O.O. SP. K  
FOR THE FOLLOWING TRADE MARK



IN CLASS 20

AND

AN APPLICATION FOR A DECLARATION OF  
INVALIDITY UNDER NO. 505029 BY  
ERGOTRON, INC.

## BACKGROUND AND PLEADINGS

1. Euroelectronics.eu Sp. z o.o. Sp. k (“the proprietor”) is the owner of the trade mark registration shown on the cover page of this decision (“the contested mark”). The contested mark was filed on 29 September 2021 and entered into the register on 3 June 2022. It stands registered for the following goods:

Class 20: Office desks; Desks; Typing desks; Cash desks; Desk tops; Standing desks; Desks (Standing -); Writing desks; Portable desks; Computer desks; Lap desks; Desks [furniture]; Desk units; Modular desks [furniture]; Roll-top desks; Mobile writing desks; Desk racks [furniture]; Desks and tables; Furniture for offices; Lap desks being furniture; Office armchairs; Office chairs; Office shelving; Office furniture; Furniture (Office -); Office tables; Desks of adjustable height; Office seats; Japanese style low desks (wazukue); Metal office furniture; Office requisites [furniture]; Wall screening [furniture] for offices; Movable office partitions.

2. By virtue of the contested mark being filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the European Union, it is deemed to have the same filing date as the proprietor’s identical EUTM, being 27 August 2020. This is, therefore, the relevant date for the purpose of these proceedings.
3. On 27 June 2022, Ergotron, Inc. (“the applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is brought under sections 5(2)(b) and 5(3) of the Act, is targeted at the entirety of the proprietor’s specification and is reliant upon the following marks:

ERGOTRON

UK registration no. 903767423<sup>1</sup>

Filing date 15 April 2004; registration date 12 August 2005

---

<sup>1</sup> The applicant’s marks are comparable trade marks based on the applicant’s pre-existing EUTMs, being EUTM nos. 003767423 and 017996475. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

Registered for the following goods:

Class 9: Data processing and systematizing equipment and computers; personal computers, computer keyboards, computer memories; parts and fittings for the aforesaid goods.

Class 20: Furniture; office furniture; office furniture for use with business machines, equipment and supplies, other furniture; computer work tables; furniture for use with computers, business machines, equipment and supplies; shelving units; shelves; computer work tables and support structures having adjustable suspension equipment for use with computers, monitors, keyboards and computer accessories; adjustable suspension support apparatus for use with computers, monitors, keyboards, and with computer accessories; parts and fittings for the aforesaid goods.

("the applicant's first mark"); and



UK registration no. 917996475

Filing date 6 December 2018; registration date 18 June 2019

Registered for the following goods and services:

Class 9: Adjustable computer monitor arms; a flexible pivoting arm designed to hold flat panel displays monitors and screens; electronic charging devices, namely, battery chargers in the nature of charging stations for electronic devices, computers and cell phones; electrical power devices, namely, intelligent electrical systems comprised of sensing, logic, mathematical, control, and display computer hardware and firmware, that sense the power needs of multiple attached electronic or electrical devices to safely and efficiently allocate power to each device without

exceeding the total power available; desk mounts, wall mounts, and ceiling mounts for computers and audiovisual equipment for use in fixed position; tilting and pivoting mountings specially adapted for audio-visual equipment, namely, audio speakers, microphones, personal stereos, video players, dvd players, audio players, amplifiers, sound mixers, frequency tuners, surround processors, digital sound signal synthesizers, stereos and stereo parts, televisions, liquid crystal display and plasma monitors, loudspeakers, computer peripherals, and projectors; support arm extensions for supporting flat panel monitors and televisions; adjustable platforms specially adapted for supporting computer monitors, computer keyboards, computer keyboard caddies and computer keyboard trays; display stands adapted for audio and video equipment; stands adapted for satellite and surround sound speakers; fixed and adjustable height stands adapted for audio speakers; single and multi-shelf racks adapted for audio and video equipment; multi-shelf towers specially adapted for audio and video equipment.

Class 20: Furniture; desks; standing desks; work surfaces; workstations having multi-use work surfaces for use in a variety of fields; computer workstations comprising tables, desks, cabinets, shelves and keyboard trays; desks for use with laptop computers; laptop computer workstation comprising adjustable tables, shelves and keyboard trays; wall mounted computer workstations comprising cabinets, shelves and keyboard trays; computer and accessory storage and work centers comprising desks, tables, cabinets and shelves; workstations having adjustable height multi-use work surfaces and platforms for supporting computing devices; workstations comprising rolling freestanding, adjustable computer furniture and wall mounts; television tables; video screen tables; multi-media home theater assembly display units comprising shelving; towers comprising shelving for audio and video equipment and peripherals; computer furniture for use with

computers, monitors and computer accessories; adjustable platforms being components of computer workstations for supporting computer monitors, computer keyboards and computer keyboard trays; display stands adapted for audio and video equipment.

Class 35: Online retail store services featuring office furniture, computer workstations, computer keyboard caddies, and ergonomic accessories and supports.

("the applicant's second mark")

4. Under its 5(2)(b) ground, the applicant relies only on those underlined goods in its first mark but relies upon all of the goods and services for which its second mark is registered. As for the 5(3) ground, the applicant claims to enjoy a reputation in all goods and services registered under both marks.
5. In respect of its 5(2)(b) ground, the applicant argues that the goods in the contested mark's specification are identical and/or similar to its own goods and services. While the applicant has made no specific argument regarding the similarity of the marks and a likelihood of confusion, this is not fatal to its claim as, by virtue of relying on section 5(2)(b), a claim of similarity and a likelihood of confusion can be implied. Further, I note that the applicant relies on a family of marks argument.
6. As set out above, the applicant claims to enjoy a reputation in all of the goods and services for which its marks are registered. Save for a claim that the marks are similar and that the relevant public would believe that they are used by the same or economically linked undertakings, no specific claim has been raised in respect of any heads of damage under this ground.
7. The proprietor filed a counterstatement denying the claims made and requested that the applicant provide proof of use in respect of its first mark.
8. The applicant is represented by Lane IP Limited and the proprietor is represented by Appleyard Lees IP LLP. Both parties filed evidence. No hearing was requested

and while the proprietor filed written submissions during the evidence rounds, neither party filed any written submissions in lieu. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **EVIDENCE**

10. The applicant's evidence came in the form of the witness statement of Louis Hall dated 23 November 2022. Mr Hall is the Marketing Creative Director of the applicant. Mr Hall's statement is accompanied by 16 exhibits, being LH1 to LH16.
11. The proprietor's evidence came in the form of the witness statement of Ms Beverley Robinson dated 19 January 2023. Ms Robinson is a Senior Associate and Chartered Trade Mark Attorney at the proprietor's representative firm and her statement is accompanied by two exhibits, being BR1 and BR2.
12. I do not propose to summarise the parties' evidence or the proprietor's submissions here. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

## **PRELIMINARY ISSUES**

### Proprietor's Evidence

13. The proprietor has filed evidence regarding results from a search of the UK trade mark register. The narrative evidence sets out that the search was undertaken on 28 December 2022 and that the term used for the search was 'ERGO'. The

proprietor confirms that the search returned over 400 results showing trade marks on the UK register that are registered for goods in classes 9 and 20. While the results are not provided, I note that the proprietor has included 28 print-outs showing various trade marks that include the prefix 'ERGO'.<sup>2</sup> In addition, the applicant has provided 32 internet print-outs showing the websites of some of these marks in respect of various types of furniture.<sup>3</sup> Some are current print-outs but some are taken from the internet archive facility, The Wayback Machine. Of these print-outs, I note that six are from UK-based websites prior to the relevant date in these proceedings, being 27 August 2020.

14. This evidence has been provided to show that there are several marks that have co-existed in the marketplace in the UK for a number of years and, as such, there would be no confusion between the marks at issue. I also note that the proprietor's accompanying submissions make reference to the evidence supporting a claim that the applicant's first mark enjoys only a weak degree of distinctive character. Having reviewed the evidence, I do not consider that it is sufficient to demonstrate either point. Firstly, the presence of just six website print-outs showing the existence of different marks are not, in my view, sufficient to demonstrate co-existence in the marketplace. Aside from the presence of these websites, I have nothing before me regarding the level of use associated with the marks shown and neither is there anything to demonstrate that average consumers are exposed to these marks to the point that they are able to differentiate between them and the applicant's first mark. Secondly, in respect of the weak distinctive character point, I refer to the case of *Zero Industry Srl v OHIM*, Case T-400/06 wherein the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that

---

<sup>2</sup> BR1

<sup>3</sup> BR2

evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II 4865, paragraph 68, and Case T 29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II 5309, paragraph 71).”

15. Without anything substantive to demonstrate use in the marketplace, I am not willing to infer that the mere existence of the marks on the trade mark register and the six print-outs provided are sufficient to point to a weakening of the distinctive character of the applicant's first mark. As a result, I find that the evidence provided by the proprietor is of no assistance and I will say no more about it.

#### EUIPO Decision

16. In the applicant's invalidation application, it made reference to the fact that the proprietor's corresponding EUTM was opposed by the applicant and was refused in its entirety and that, accordingly, the contested mark should be invalidated in its entirety. On this point, I note that the proprietor filed a copy of a subsequent decision of the First Board of Appeal in which the EUIPO upheld the proprietor's appeal and found that there was no likelihood of confusion. I also note that the proprietor filed an additional decision regarding the marks 'ERGOMOTION' and 'ERGOMATE' wherein the EUIPO Opposition Division found that there was no likelihood of confusion.

17. While these decisions are noted, they are not binding upon me and are not relevant to the decision I must now make. Instead, my decision will be based on the global assessment of the issues before me and not on the decisions of the EUIPO and I will say no more about them.

## Family of Marks

18. I note that the applicant has sought to rely on a family of marks argument in support of its 5(2)(b) grounds. The applicant's claim is as follows:

"The Applicant believes that the Proprietor's mark would be seen as part of the Applicant's family of marks. The Ordinary Consumer would see ERGO OFFICE as a natural extension of ERGOTRON & ERGOTRON HOME for a range of goods directed at the Office and not the home."

19. In its initial invalidity application, the applicant sought to rely on a third mark which, while figurative, could be categorised as the 'ERGOTRON HOME' mark. This application form was considered inadmissible and the applicant was asked to refile the same. Upon being refiled, the 'ERGOTRON HOME' mark was not relied upon. Therefore, it is not at issue here so the applicant's reliance upon it in support of its family of marks argument is of no assistance. The way in which the applicant pleaded its family of marks argument did not make reference to its second mark. As a result, the applicant's family of marks argument relies on just one mark and, clearly the presence of just one mark (whether evidence of it on the marketplace is provided or not) cannot constitute a family of marks. Even if it were the case that the applicant sought to rely on its second mark also, the presence of just two marks with seemingly no common element save for the letter 'e' would not constitute a family of marks either. This argument is, therefore, of no assistance and I will say no more about it.

## **DECISION**

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

"47. -

(1) [...]

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

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

(b) [...]

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.”

6. As the earlier marks are comparable marks, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9.—

(1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.

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

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union”.

## Proof of use

21. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

22. 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.”

23. Given their filing dates, the applicant’s marks qualify as earlier trade marks under the above provisions. The applicant’s first mark had completed its registration process over five years prior to the deemed filing date of the contested mark, however, its second mark did not. Therefore, only the first mark is subject to the proof of use assessment and, as set out above, the proprietor requested that the applicant provide proof of use in respect of the same. As a result, only the applicant’s first mark is subject to the proof of use assessment in respect of the goods relied upon. As for the applicant’s second mark, the applicant may rely on all of the goods and services for which that mark is registered.

24. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

25. Pursuant to Section 47(2B) of the Act, there are two relevant periods for assessing whether there has been genuine use of the applicant’s first mark, the first being the five-year period ending with the deemed filing date of the contested mark, being 27 August 2020 and the five-year period ending with the date of the application of the invalidity declaration, being 22 June 2022. Therefore, the relevant periods for this assessment are 28 August 2015 to 27 August 2020 (“the first relevant period”) and 23 June 2017 to 22 June 2022 (“the second relevant period”).

26. The applicant’s first mark is a comparable mark based upon an earlier EUTM, which means that use of the mark in the EU prior to IP Completion Day (being 31

December 2020) is relevant to the present assessment.<sup>4</sup> As the first relevant period falls entirely prior to IP Completion Day, the EU is the relevant territory for proof of use for this mark. In respect of the second relevant period, the relevant territory is the EU up until 31 December 2020 but, thereafter, it is the UK only. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union (“CJEU”) noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

27. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”<sup>5</sup> because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

---

<sup>4</sup> See paragraph 4 of Tribunal Practice Notice 2/2020

<sup>5</sup> *Jumpman* BL O/222/16

## Sufficient Use

28. I have detailed submissions from the proprietor wherein it has conducted its own assessment of the evidence provided. I do not intend to reproduce this here but note that, in short, it claims that the applicant has failed to provide cogent evidence in support of genuine use in its first mark. While I bear the points raised by the proprietor in mind, I will proceed to conduct my own assessment of the evidence.

## Evidence of use

29. The applicant's evidence sets out that it is a global leader in designing ergonomic solutions that connect people and technology to enhance human performance and health. The applicant first began in 1982 and the evidence confirms that it builds products and custom solutions in the field of healthcare, industrial and office settings.

30. While the applicant is based in Minnesota, USA, the evidence confirms that it has a global presence including Europe, North America, Middle East, Africa and Asia. The evidence goes into specifics regarding its activity in the UK and confirms that the applicant created a subsidiary company in the UK, being Ergotron (UK) Limited in May 2000. The details of the company are provided<sup>6</sup> and I note that this includes an excerpt from an annual report which confirms that its principal activity is to act on behalf of the applicant in relation to the distribution of ergonomic mounting equipment and furniture.<sup>7</sup> Given the UK-based company's relationship with the applicant as a subsidiary, I am content to conclude that any use by the UK-based company is with the requisite consent of the applicant. For the avoidance of doubt, I will still refer to any use as being by the applicant.

31. The evidence confirms that the applicant registered a UK based website in January 2000, being [www.ergotron.co.uk](http://www.ergotron.co.uk), which now redirects to [www.ergotron.com/en-gb](http://www.ergotron.com/en-gb). The evidence claims that this demonstrates that the applicant has been active in the UK since as early as January 2000. The evidence then goes on to discuss the

---

<sup>6</sup> Companies House details for the UK subsidiary can be found at LH1

<sup>7</sup> LH2

sale of the applicant to The Sterling Group in 2022 for \$650 million. While noted, the evidence is dated 6 June 2022 which, while within the second relevant period, only alludes to an agreement for a future sale and give the proximity with the end of that period, I am unsure as to how it is relevant to the present case.

32. Moving on to focus on use in the UK, the applicant has provided a number of print-outs of the applicant's website taken from the online archive site, The Wayback Machine.<sup>8</sup> I note that the print-outs provided are dated between 6 November 2017 and 14 August 2020. The print-outs show a range of products such as monitor mounts, standing desks, medical carts, charging systems, desks, desk chairs and storage cabinets. Another print-out taken from the applicant's UK website shows a list of resellers that stock the applicant's products in the UK.<sup>9</sup> These resellers include Amazon, Banner, ebuyer.com, HP and XMA, amongst others. Unlike the print-outs referenced above, this one is undated and I have nothing before me (save for Amazon print-outs that I will discuss further below) to suggest that the resellers listed were stockists of the applicant's goods during the relevant periods. While I note the presence of subsequent print-outs from the various resellers showing a range of products listed for sale,<sup>10</sup> the issue remains in that these are also undated and there is nothing (again, save for some Amazon print-outs that I will discuss below) to demonstrate the existence of these goods listed for sale on the resellers' websites during the relevant periods and neither is there anything to suggest their level of sales during that time.

33. As alluded to above, the only evidence before me regarding the sale of any actual goods in the UK (or the EU, for that matter) during the relevant periods is in the form of a number of print-outs taken from Amazon.co.uk.<sup>11</sup> Of these, I note that there are a number of reviews stemming from verified purchases made by UK-based customers. These include seven reviews for an Ergotron LX Desk Mount, 13 reviews for an Ergotron WorkFit Sit-Stand (for monitors) desk and two reviews for an Ergotron WorkFit Sit-Stand (for LCDs) desk. Given the different (but overlapping) relevant periods, I note that, of these reviews, 19 sit within the first

---

<sup>8</sup> LH6

<sup>9</sup> LH8

<sup>10</sup> LH9

<sup>11</sup> LH10

relevant period but all 22 sit within the second relevant period. Based on the fact that these reviews are listed as verified purchases from customers in the UK, I am willing to infer that they represent 22 sales of goods in the UK during the second relevant period and 19 in the first. I note that these print-outs also show total global ratings of 13,765, 197 and 137, respectively. Given the reference to *global* ratings, the nature of Amazon as a global retailer, the applicant's self-proclaimed global presence and the presence of a review from Canada, I am not satisfied that these ratings can be said to relate to solely sales in the UK or the EU. Even if I was to accept that these ratings did include those from UK and EU customers, I have no way to determine what proportion is made up from UK/EU sales. Further, I have nothing before me to confirm that the global reviews stem from verified purchases or not and, as such, it is possible that some ratings may be disingenuous. As a result, the only evidence I am willing to accept as UK sales (or EU sales, for that matter) are those stemming from the aforementioned reviews.

34. A range of awards that the applicant has won during the relevant periods are provided by way of a print-out taken from its website.<sup>12</sup> I appreciate that some of the awards are from the relevant periods and are shown on the applicant's UK-based website, however, there is nothing to confirm that these are UK or EU based awards or awards that would be known to the average consumer in those territories. On this point, I note that one award is from the Global Educator Institute which indicates an international award and, therefore, it could be said that such an award was given to the applicant in light of activities from outside of the UK or EU. If these awards related to the UK or EU markets, I consider it reasonable for evidence to be adduced to confirm as such. Further, there is nothing to confirm the reach of these awards (in the event that they are UK or EU based awards) and neither is there anything to suggest how the awards were voted upon, be that by members of the relevant public or a specialist industry judging panel.

35. Moving on to the social media evidence, I note that this shows that the applicant's Facebook account has 10,216 followers, its Twitter account has 6,873 followers, its Instagram account has 6,043 followers and its YouTube account has 3,320

---

<sup>12</sup> LH11

subscribers.<sup>13</sup> While noted, the print-outs post-date the relevant periods and it is, therefore, possible that the follower counts are not reflective of the position during that time. Further, the accounts are not the UK or EU accounts of the applicant but are, instead, their global accounts and, therefore, the follower figures shown cannot be said to relate solely to the UK or EU markets. In any event, the follower figures are not so significant that it would be reasonable for me to infer that, upon taking these issues into account, a sizeable UK or EU follower base were to have existed during the relevant periods.

36. On the point of social media evidence, I note that some print-outs are provided that show posts from within the relevant periods.<sup>14</sup> These are noted but the international nature of the social media evidence remains at issue here. Further, I note that the posts shown have a very limited level of engagement. While there are print-outs showing YouTube videos with a higher level of engagement (two videos, one with 887 views and the other with 5,500),<sup>15</sup> the aforementioned issues are still relevant. Lastly, the social media evidence includes two screenshots taken from YouTube videos from third party content creators.<sup>16</sup> The first video, which is posted by what appears to be a third-party review account, has 4.7 million views and relates to a review of the applicant's monitor arm (in comparison with a different, seemingly cheaper arm). The second video is from an account called Victor Technology and has 44,000 views and is a review of one of the applicant's desks (again, in comparison with another desk). While these videos have significant views and are from within the relevant periods, I have nothing to suggest the engagement with these videos in the UK or EU markets.

37. The final piece of evidence filed relates to podcasts and webinars published by the applicant, the topics of which are provided in the evidence.<sup>17</sup> While this is noted, the applicant's first mark is not registered for any goods or services that relates to the provision of podcasts or webinars. While I appreciate that the podcasts and webinars may be of assistance in demonstrating the spread of the applicant's

---

<sup>13</sup> LH12

<sup>14</sup> LH13

<sup>15</sup> LH14

<sup>16</sup> LH15

<sup>17</sup> LH16

branding, there is nothing before me to suggest the listener or viewership figures for the podcasts or webinars, respectively. As such, I am unable to determine how these podcasts or webinars assist the applicant in demonstrating genuine use of its mark.

### Conclusions on use

38. I have set out my issues regarding the applicant's social media accounts, awards obtained and webinars/podcasts produced above and, as a result, I do not consider that such evidence is of any assistance to the issue of genuine use of the applicant's first mark. As for the evidence regarding the applicant's website being in operation since January 2000 and the print-outs regarding the same, there is nothing before me to suggest the level of UK or EU visitors to this site during the relevant periods. Further, there is nothing to suggest any level of sales associated with the site meaning that it is also of no assistance to the issue of genuine use. In addition, I note that the evidence includes a range of products listed for sale on third party retailers' websites but the only supporting evidence in relation to these products being listed for sale is in the form of the 21 Amazon reviews of three different products. I note that nothing further has been provided in respect of turnover accrued from the listing of these goods on third party retailers' websites. On this point, I remind myself not only of Section 100 of the Act (cited above) but also the case of *Awareness Limited v Plymouth City Council*, Case BL O/236/13 ("*Plymouth Life*") wherein Mr Daniel Alexander Q.C., sitting as the Appointed Person, stated at paragraph 22 that:

"it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and

specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

39. While it could be said that the presence of goods for sale on a range of third party retailers’ websites would have led to a reasonable level of sales, I am not willing to infer as such, particularly given that the evidence regarding these third party retailers, save for the Amazon reviews, is dated after the relevant date. In line with *Plymouth Life*, I consider it is reasonable to expect that sufficiently solid evidence pointing towards turnover, market share and advertising expenditure, for example, would have been readily available to the applicant and, as such, should have been placed in evidence in these proceedings. Further, to make such an inference in light of these issues would, in my view, be prejudicial to the proprietor when, as set out above, the burden to file evidence is on the applicant.

40. Without anything further, the only evidence before me upon which I can pin a finding of genuine use is 22 total sales (or 19 for the first relevant period) covering 3 different types of product over a five year period. Such a level of use is extremely low and while I appreciate that use does not need to be quantitatively significant for it to be deemed genuine, I am of the view that the evidence before me cannot be considered as justified in the economic sector and neither is it consistent with a genuine attempt to create or preserve a market share for the goods at issue. In making this finding, I reiterate what I have said above in that the burden to file sufficiently solid evidence in support of a claim of genuine use falls on the applicant and, given the totality of the relevant evidence before me, I have no alternative but to find that the applicant has failed to prove that it has genuinely used its mark during the relevant periods. As a result, the applicant may not rely on its first mark in these proceedings.

41. Given the fact that the applicant’s second mark is not subject to proof of use, the applicant may proceed in reliance upon that mark only and, for the avoidance of doubt, I will hereafter refer to the applicant’s second mark simply as the applicant’s mark.

## Section 5(2)(b): legislation and case law

42. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

43. Section 5A of the Act states as follows:

“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.”

44. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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 and services**

45. The proprietor's goods are set out at paragraph 1 above and the applicant's goods and services are set out at paragraph 3 (albeit only those goods and services listed under the applicant's second mark are relevant here). I note that the proprietor's submissions accept some degree of similarity between the goods at issue.

46. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods (though it equally applies to services) are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

*Desks.*

47. The above term in the contested mark's specification also appears in the applicant's specification meaning that these goods are self-evidently identical.

*Office desks; Typing desks; Cash desks; Standing desks; Desks (Standing -); Writing desks; Portable desks; Computer desks; Lap desks; Desks [furniture]; Desk units; Modular desks [furniture]; Roll-top desks; Mobile writing desks; Lap desks being furniture; Desks of adjustable height; Japanese style low desks (wazukue); Desks and tables.*

48. The above terms in the contested mark's specification are different types of desks and, therefore, all fall within the broader category of "desks" in the applicant's

specification. These goods are, therefore, identical under the principle outlined in *Meric*.

#### *Desk tops.*

49. My initial view is that the above term in the contested mark's specification covers a type of desk and, therefore, falls within the broader term of "desks" in the applicant's specification. In the event that I am wrong on this point, the above term will, instead, cover work surfaces that are placed on top of desks and, therefore, falls within another term of the applicant, namely "work surfaces". I, therefore, find that the above term is identical under the principle outlined in *Meric* with either "desks" or "work surfaces" in the applicant's specification.

*Desk racks [furniture]; Furniture for offices; Office armchairs; Office chairs; Office shelving; Office furniture; Furniture (Office -); Office tables; Office seats; Metal office furniture; Office requisites [furniture]; Wall screening [furniture] for offices; Movable office partitions.*

50. The above terms in the contested mark's specification are all different types of furniture goods. Given that the applicant's second mark's specification includes "furniture" at large, it follows that all of these goods fall within it. These goods are, therefore, identical under the principle outlined in *Meric*.

#### **The average consumer and the nature of the purchasing act**

51. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services 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. (as he then was) 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.”

52. Given that the goods at issue cover both general furniture and more specific office furniture, I consider that the average consumer will consist of both members of the general public at large and business users who may be looking to furnish an office space, for example. The goods at issue will be available via general or specialist retailers and their online equivalents. The goods will be displayed in stores (be that on shelves or larger floor displays) and self-selected by the consumer. For online retailers, the goods will be displayed on webpages and will be selected by the consumer after having viewed an image of the products. In my view, the visual aspect will dominate the selection process, however, I do not discount the aural component playing a role by way of word of mouth recommendations or after discussions with sales persons. Even where this occurs, the consumer will still review the products visually.

53. The price of the goods at issue is likely to vary from relatively inexpensive goods such as lap desks to more expensive goods such as larger items of furniture. The goods are likely to be purchased relatively infrequently but I appreciate that for some business consumers, the selection may be more frequent in that they may need to restock office chairs on a more regular basis, for example. Regardless of who the average consumer is, I am of the view the same factors are likely to be considered during the purchasing process and this may include factors such as comfort, materials used, adjustability and suitability. With this in mind, I consider that the average consumer will, generally, pay a medium degree of attention during the purchasing process but I appreciate that this may extend to higher than medium (but not high) for some of the more expensive furniture goods at issue.

## Comparison of the marks



54. It is clear from *Sabel 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.

55. 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.”

56. 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.

57. The respective trade marks are shown below:

The applicant's mark	The contested mark
	

58. I have submissions from the proprietor in respect of the comparison of the marks at issue. I have considered these submissions in full and while I do not intend to reproduce these here, I will, if necessary, refer to them below. As for the applicant, I note that it has made no comment in respect of the similarity of the marks at issue.

### Overall Impression

59. The contested mark is a figurative mark. It consists of two words, being 'ergo' in a blue standard typeface placed above 'office' in the same typeface but in black. To the right of these elements is a figurative 'e' in black followed by a blue full-stop. For reasons I will come to discuss below, I am of the view that despite being the largest element of the mark, it will play a lesser role in the overall impression of the contested mark. As a result, I consider that the words 'ergo office' will play the greatest role in the overall impression of the mark. While the use of different colours will be noticed, I consider that any impact associated with this will be negligible.

60. The applicant's mark consists of a figurative letter 'e' which I note is displayed in a way wherein a small section of the letter is missing. This letter is surrounded by a circular border. Both elements are in black. The figurative 'e' will dominate the overall impression of the mark and while the border will be noticed, its impact is negligible due to its role as a banal border element.

### Visual Comparison

61. Visually, both marks contain a figurative representation of the letter 'e'. This is the dominant element of the applicant's mark but plays a lesser role in the contested mark. While this acts as a point of similarity (regardless of its role in the contested mark), the elements are stylistically different in the presence of a blue period and rounded edges in the contested mark (as opposed to 'sharper' edging in the applicant's mark). The marks differ in the presence of the word elements in the contested mark which form the dominant element of the contested mark and have no counterpart in the applicant's mark. Further, I note that they sit at the beginning

of the contested mark, being where average consumers tend to focus.<sup>18</sup> Taking all of this into account, I am of the view that the marks are visually similar to a low degree.

### Aural Comparison

62. Aurally, I consider that the applicant's mark will simply be pronounced as one syllable, being the letter E. The contested mark will be pronounced as four syllables, being 'URR-GO-OFF-ISS'. I note that the additional letter 'E' is present in the contested mark but I see no logical reason why the average consumer will pronounce it. On this point, I have no evidence or submissions to demonstrate otherwise. While the contested mark begins with the letter 'E', which is the sole element of the applicant's mark, it is not pronounced in the same way. This is on the basis that the 'E' in the applicant's mark will be pronounced as a long e sound whereas the 'E' in the contested mark will be pronounced as an open-mid central unrounded vowel. As a result, I am of the view that the marks are aurally dissimilar.

63. In the event that I am wrong to conclude that the 'e' in the contested mark will not be pronounced, I am of the view that the marks are still aurally dissimilar. This is on the basis that the point of similarity makes up just one syllable of the contested mark that is placed at the very end of that mark. Further, the points of difference are very significant and have no aural counterpart in the applicant's mark.

### Conceptual Comparison

64. The only concept that can be taken from the applicant's mark is the understanding that it is made up of the single letter 'e'. Aside from being a letter, the average consumer will not attribute any meaning to it and there is no indication in the mark itself that the 'e' is meant to stand for anything. As for the contested mark, I am of the view that the words 'ergo office' will be viewed together. The word 'office' will be attributed its ordinary meaning, being a room where people work. As for 'ergo', I consider that this will potentially have two meanings. The first of which is that it

---

<sup>18</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

will be viewed as short for 'ergonomic', which will be understood as being a reference to something such as a chair which is designed for efficiency and/or comfort. Alternatively, 'ergo' may be viewed as its own word, which is a term sometimes used instead of 'therefore'. In the context of the goods at issue, I am of the view that the former meaning is more likely but I do not dismiss the latter. As for the letter 'e', I am of the view that it will carry a concept but only to the extent that it will be understood as standing for 'ergo', being the only word in the mark that begins with that letter.

65. In comparing the marks, the only point that can be said to be similar conceptually is the fact that both marks share a figurative letter 'e'. Aside from being the same letter, the concepts attributed to them will differ. As above, the 'e' in the applicant's mark will have no obvious meaning whereas the 'e' in the contested mark will be seen as standing for 'ergo'. As a result and given the conceptual difference created by the additional words in the contested mark, I consider that the marks are conceptually dissimilar.

### **Distinctive character of the applicant's mark**

66. 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 *Windsurfing Chiemsee 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).”

67. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up 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 made of it. The applicant did not specifically plead that its marks enjoy an enhanced degree of distinctive character as a result of the use made of them, however, it has filed evidence of use. In proceedings before the Tribunal, it is not necessary for an applicant to specifically plead enhanced distinctiveness at the outset of a matter and, therefore, such an issue may be live regardless of the pleadings. While the evidence that I have summarised at paragraphs 29 to 41 above related an assessment of the applicant’s first mark (of which there was no genuine use), it was representative of the entirety of the evidence filed. The evidence does make reference to the mark at issue here, however, it is very limited in that it appears only as the profile picture on the applicant’s social media accounts<sup>19</sup> and in the footnote of two pages taken from a 2022 print-out of the applicant’s website.<sup>20</sup> Further, this evidence is from after the relevant date for this assessment (being 27 August 2020) so is of no assistance. Any claim that the applicant enjoys an enhanced degree of distinctive character in its mark must, therefore, fail. As a result, I have only the inherent position to consider.

68. As I have set out above, the applicant’s mark is a figurative representation of a letter ‘e’. While the stylisation will not go unnoticed, the mark will still be viewed as

---

<sup>19</sup> LH12 to LH14

<sup>20</sup> See the footnote images at pages 45 and 47 of LH9

a single letter mark and, on this point, I do not consider that the stylisation will contribute to the mark's distinctive character beyond that which is created by the letter. Aside from being recognised as the letter 'e', the mark has no obvious meaning and while it does not allude to or descriptive the goods for which it is registered, I do not consider that it is particularly remarkable. On this point, I remind myself that single letter marks will still be viewed as signs irrespective of the nature of the goods at issue and that the consumers' perception of a mark consisting of a single letter will not be any different from that of a mark comprised of two or more letters.<sup>21</sup> Taking all of this into account, I am of the view that the applicant's mark enjoys a medium degree of inherent distinctiveness.

### **Likelihood of confusion**

69. 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 and services 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 trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the applicant's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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.

70. I have found the parties' goods at issue are identical and that the average consumer for the goods to be both members of the general public and business users who will select the goods at issue via primarily visual means, although I do

---

<sup>21</sup> *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co. KG*, Case C-265/09 P

not discount an aural component playing a part. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods at issue but that, for some goods, this will extend to higher than medium (but not high). I have found that the applicant's mark is inherently distinctive to a medium degree. In respect of the similarity of the marks at issue, I have found that the parties' marks are visually similar to a low degree and aurally and conceptually dissimilar.

71. Taking all of the above into account, I see no reason why the average consumer would directly confuse the marks at issue with one another. The similarity (or lack thereof) between the marks is such that even on identical goods, the average consumer would easily notice the differences. Consequently, I find that there is no likelihood of direct confusion. I turn now to consider a likelihood of indirect confusion. I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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)".

72. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

73. It is my view that, upon being confronted by the marks at issue, the average consumer would see no logical reason why the marks originate from the same or economically linked undertakings. The only reason for such a finding is the shared use of a letter 'e' but the shared use of a single letter is not something that would be considered so strikingly distinctive that the consumer would believe that only one undertaking would use it, particularly given that (1) the 'e' in the contested mark will clearly be understood as standing for something whereas the 'e' in the applicant's mark will not and (2) the additional differences between the marks at issue. In any event, there is no indication in the applicant's mark as to what the 'e' stands for and I see no reason why the consumer would believe that it stood for 'ergo office' and, therefore, make the leap that it was an alternative mark used by

the same or economically linked undertakings. Further, I see no basis upon which to find that the average consumer would believe that the marks are sub-brands or brand extensions of one another. Aside from the sharing of a single letter, neither mark has any logical indicator consistent with sub-brands or brand extensions that would lead the average consumer to believe the marks originate from the same or economically linked undertakings. I do not consider that the consumer would believe it logical for an undertaking using the contested mark would remove its verbal elements to just an 'e' and, conversely, neither would they consider it logical for the applicant's mark to add elements such as 'ergo office' to its figurative 'e' element. Consequently, I find that there is no likelihood of indirect confusion, even when the marks are viewed on identical goods.

#### Final remarks on 5(2)(b)

74. My assessment under the 5(2)(b) grounds did not focus on the applicant's first mark as it did not survive the proof of use assessment. Even if it had, I am of the view that the same outcome of no likelihood of confusion would have been reached upon consideration of the same. I do not intend to go over the reasons for this in full, but will briefly set them out below.

75. I appreciate that the applicant's first mark and the contested mark have a higher degree of similarity than those assessed above due to the presence of the 'ERGO' element within the applicant's first mark being 'ERGOTRON'. However, I do not consider that this heightened degree of similarity would result in the average consumer being directly confused by the marks. It is my view that the differences between the contested mark and the applicant's first mark are such that they would be used to accurately recall or remember which mark was which. As for indirect confusion, I appreciate that there will be some shared concept between the marks due to the common use of 'ERGO', however, I do not consider that this will be so strikingly distinctive (particularly given the nature of the goods at issue, being goods that can be said to be ergonomic) that the consumer would believe that only the applicant would use it. Further, I do not consider that the average consumer would view the differences between the marks as indicators that they are logical and consistent with a brand extension or sub-brand. Put simply, I do not consider

that the differences between 'ergo office' and 'ERGOTRON' will be viewed by the average consumer as being consistent with such a connection.

76. As a result, I am of the view that regardless of whether I was wrong to find no genuine use for the applicant's first mark, it would not have resulted in a finding that there was a likelihood of confusion between the marks.

### **Section 5(3)**

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

"5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, and

(b) shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

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

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

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

79. The conditions of section 5(3) are cumulative. There must be similarity between the marks, the applicant must also show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. The applicant must also establish that the public will make a link between the marks, in the sense of the earlier marks being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

80. I am of the view that I can deal with this ground relatively briefly. The proprietor put the applicant to proof of use for its first mark and, as I have set out above, the applicant has failed to provide proof of such. As a result, the applicant is not permitted to rely on its first mark in respect of any grounds relied upon in the present application. In any event, I remind myself that the test for considering the existence of a reputation is more onerous than the one used to assess genuine use. On this point, I remind myself of the evidence summarised at paragraphs 29 to 41 above and am of the view that, even if I was to have accepted the evidence as being sufficient to find genuine use, I am of the view that it falls far short of the threshold required under the present ground. Therefore, I find that the applicant's

reliance upon its first mark must fail at this stage. As for the applicant's second mark, this was not subject to the proof of use assessment above. However, as I have discussed at paragraph 67 above when considering enhanced distinctiveness, the evidence in relation to the second mark is very limited and is from after the relevant date. Even if it could be said that the evidence as a whole was applicable to the applicant's second mark, the aforementioned outcome will apply, namely that it falls far short of the threshold under the present ground. As a result, I am of the view that the evidence before me is far from sufficient to warrant a finding that the applicant enjoys a reputation in either of its marks. Therefore, the applicant's reliance upon the 5(3) ground must fail.

81. As an aside, the way in which the present ground has been pleaded was not reliant upon any of the heads of damage under 5(3) (being unfair advantage, detriment to repute or detriment to distinctive character). In light of how the claim was pleaded, I am of the view that even if there were a reputation in either of the applicant's marks, it would be low at best and the only way in which the applicant's claim could have succeeded is if I found that the relevant public would believe the parties' marks to be from the same undertaking or think that there is an economic connection between them. I see no reason why such an assessment wouldn't be in line with the likelihood of confusion assessment I conducted under the 5(2)(b) ground. As a result, I fail to see how such an argument would have furthered the applicant's claim.

82. In light of all of the above, I find that the 5(3) ground fails in its entirety.

## **CONCLUSION**

83. The application has failed in its entirety and, subject to any appeal, the contested mark may remain registered for all goods.

## **COSTS**

84. As the proprietor has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I note

that while the proprietor did file evidence, it was of no assistance to these proceedings. Having said that, the proprietor was required to consider the applicant's evidence and I am of the view that it is appropriate to award some costs associated with the same.

85. In the circumstances, I award the proprietor the sum of **£900** as a contribution towards its costs. The sum is calculated as follows:

Considering the invalidation application and preparing a counterstatement:	£200
Considering evidence:	£400
Preparation of written submissions:	£300
<b>Total:</b>	<b>£900</b>

86. I hereby order Ergotron, Inc. to pay Euroelectronics.eu sp. Z o.o. Sp. k the sum of £900. The above sum should 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 17 day of July 2023**

**A COOPER**  
**For the Registrar**