

O/0667/23

TRADE MARKS ACT 1994

**IN THE MATTER OF THE UK DESIGNATION OF
INTERNATIONAL REGISTRATION NO. 1584271
BY HUIZHOU WISDOM POWER TECHNOLOGY CO., LTD
FOR PROTECTION OF THE FOLLOWING TRADE MARK
IN CLASS 9:**

The logo consists of the letters 'BSLBATT' in a bold, italicized, sans-serif font. The 'B' at the beginning has a grey triangular shape above it. The 'A' in the middle has a grey triangular shape above it. The 'T' at the end has a grey lightning bolt symbol inside it.

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 426457 BY
BRIDGESTONE CORPORATION**

BACKGROUND AND PLEADINGS

1. Huizhou Wisdom Power Technology Co., Ltd (“the holder”) designated the International Registration (“IR”) shown on the front cover of this decision for protection in the UK on 3 March 2021 in respect of the following goods:

Class 9

Battery jars; batteries, electric; accumulators, electric; battery chargers; photovoltaic cells; lithium-ion batteries; lithium secondary batteries.

2. On 27 August 2021, the application was opposed by Bridgestone Corporation (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods for which protection is sought.

3. Under section 5(2)(b), the opponent is relying on the following marks:

UKTM No. 903543253 (“the 253 mark”)



Filing date: 8 December 2003

Registration date: 9 April 2009.

Relying on the following goods and services:

Class 9

Measuring apparatus and instruments; apparatus and instruments for electrical distribution or control; electrical and electronic apparatus and instruments; cabling; switches and switch mechanisms; parts and fittings for all the aforesaid goods.

UKTM No. 801105491 ("the 491 mark")



Filing date: 27 July 2011

Registration date: 18 December 2012

Relying on the following goods:

Class 9

Phase indicators; rubber covered electrical wires; electronic buzzers; solar batteries; facsimiles; electronic displays utilizing electronic paper technology; computers; rollers such as transfer roller, toner supply roller, development roller, etc for printer, facsimile, copy machine; alarm devices for tire pressure; pressure gauges in vehicle tires; rubber testing machines; cameras; magnetic cores; gasoline gauges; gasoline pumps for service stations; cigar lighter for automobiles; protective masks; apparatus for consumer games adapted for use with an external display screen or monitor; electronic circuits and CD-ROMs recorded with programs for hand-held games with liquid crystal displays; weight belts for scuba diving; downloadable music files; downloadable image files; electronic publications; batteries, electric; batteries electric for vehicles; sunglasses.

UKTM No. 801540166 ("the 166 mark")



Colour claimed: The color(s) red and black is/are claimed as a feature of the mark; the mark consists of a stylized letter "B" in red and black; the color white appears as background and is not part of the mark.

Filing date: 19 December 2019

Registration date: 1 December 2020

Priority date: 9 December 2019 and 18 December 2019.¹

Relying on the following goods and services:

Class 9

Computer software for monitoring, analyzing flight data and predicting treadwear of tires; checking (supervision) apparatus and instruments; holders for hand-held computers; measuring apparatus and instruments; satellite and radio transmitter and receiver apparatus; signaling apparatus and instruments; software for operating electronic digital dictionaries; telecommunications installations, networks and apparatus; fixing racks for telecommunications hardware; telematics apparatus, namely wireless Internet devices which provide telematics services and have a cellular phone function; barcode/two-dimensional code scanners; printers; surveying apparatus and instruments; computer hardware and software for use with satellite and/or GPS navigation systems for navigation purposes; computer software for operating satellite navigational systems and global positioning systems [GPS], and for use of global positioning systems [GPS] for tracking, locating and security of vehicles and objects; computer software for use with route planners, electronic maps and digital dictionaries for navigation purposes; computer terminals, all in particular for the use of navigation systems, route planners, and/or digital maps; downloadable electronic maps; global positioning systems [GPS] consisting of computers, computer software, transmitters, receivers, and network devices; location, orientation and navigation, and global positioning systems [GPS] consisting of computers, computer software, transmitters, global positioning system [GPS] receivers and/or satellite receivers; mobile computing and operating platforms consisting of data transceivers, wireless networks and gateways for collection and management of data; navigation apparatus for vehicles in the nature of on-board computers; route planners in the form of hand-held personal computers (hand-held computers); satellite navigational systems, namely a global positioning systems [GPS]; software for information management for the transport and traffic sector; software for management and maintenance of groups of vehicles; software for operating route planners; software for travel information systems for providing or displaying travel advice on petrol stations, car parks, restaurants, car dealers and other travel and transport-related information; software for viewing electronic maps; software to indicate maintenance requirements and maintenance scheduling for vehicles; vehicle locating, tracking and security systems

¹ Priority is claimed from Japanese Trade Marks 2019-154264 and 2019-160155.

comprised of an antennas and radio transmitters to be placed in vehicles; electronic databases relating to tires, vehicle parts, vehicles and groups of vehicles; electronic publications relating to tires, vehicle parts, vehicles and groups of vehicles; electronic reports relating to tires, vehicle parts, vehicles and groups of vehicles; electronic sensing, checking, monitoring and communication devices used in relation to vehicles, tires, vehicle parts and groups of vehicles; electronic sensors for tires, vehicles and vehicle parts; software for use in relation to subscription services provided in relation to tires and vehicle parts; software for use in relation to the replacement, repair, inspection, installation, monitoring, management, maintenance, ordering or purchase of tires, vehicle parts and vehicles; software used in relation to tires, vehicle parts, vehicles and groups of vehicles; downloadable software applications for use in monitoring and tracking tires and tire data; computer software in the field of fleet management services; computer software for use in managing, tracking, and optimizing fleet operation costs and productivity based on commercial fleet tire data; computer software for use in monitoring tracking and reporting tire treadwear data, and predicting potential risky driving conditions for tires and allow vehicles to react to such conditions to prevent accident; downloadable software applications for analyzing treadwear of tires based on pictures; accident preventing systems primarily comprising sensors, operating software and computer hardware for measuring and transmitting tire treadwear data; tire treadwear detecting systems primarily comprising treadwear detecting sensors, low tire pressure automatic indicators, electric sensors, signal transmitters, signal receivers, and electronic display interfaces; computer software for reporting the performance and condition of tires in retreading tires; computer software for tire retread dealers to track, photograph, and provide receipts for retreaded tires; computer software for tracking inventory of retread tires; computer software for information tracking and reporting functions in the retread tire business in the field of customer relationship management, supply chain management, human services, and financial applications, all designed to help businesses in the retread, commercial, retail and wholesale tire industry; tire pressure monitoring systems; tire pressure and temperature monitoring and measuring machines and instruments; electronic machines and apparatus for measuring, monitoring and transmitting tire pressure and temperature; telecommunication machines and apparatus; electronic machines and apparatus, namely testing apparatus and devices, monitoring apparatus and devices, computer hardware, data processing apparatus and devices, data analysis apparatus and devices, electronic switching apparatus; electronic machines and apparatus for technological and scientific use comprising sensors,

antennas, GPS antennas, transmitters, receivers and computer software; computer software for vehicle drive information, vehicle kinetic information and tire pressure information; terminal devices for collecting information which have saving data measured by remote monitoring and transmitting saved data on demand functions; computer software for monitoring and managing pressure in tires; tire pressure management and monitoring systems comprising sensors, operating software, and computer hardware; tire pressure sensors; software applications for use in monitoring, tracking, and reporting tire pressure and temperature; tire pressure management and monitoring systems comprising sensors, operating software, and computer hardware; tire pressure management and monitoring systems primarily comprising sensors, operating software, and computer hardware for measuring and transmitting tire deflection and pressure data; tire pressure or temperature monitoring systems primarily comprising software for monitoring tire pressure and temperature, low tire pressure automatic indicators, tire pressure gauges, electric sensors, tire pressure sensors or temperature sensors, signal transmitters, signal receivers, and electronic display interfaces; sensors for detecting deterioration of road surface; sensors for detecting deterioration of bridge joints; road surface deterioration detecting systems; road surface deterioration detecting apparatus and instruments; electronic machines and apparatus for detecting, monitoring and transmitting deterioration of road surface; bridge joints deterioration detecting systems; bridge joints deterioration detecting apparatus and instruments; electronic machines and apparatus for detecting, monitoring and transmitting deterioration of bridge joints; computer software for deterioration information of road surface; computer software for deterioration information of bridge joints.

Class 37

Installation, maintenance and repair of telematics and navigation apparatus for vehicles, including apparatus for transmitting vehicles data, messages and information; installation, maintenance and repair of apparatus for locating vehicles, anti-theft equipment for vehicles, electronic navigation and tracking apparatus for use in vehicles; inspection of tires and vehicles prior to maintenance and repair; information, advice and consultancy provided in relation to all the aforesaid services; providing information on tire pressure and tire temperature for maintenance of vehicles tires via telecommunication; tire retreading, namely, retreading tires, and providing advice, repair and maintenance information in the field of retreading tires; consultancy, information and inspection services relating to repair and maintenance of tires and

vehicles; maintenance, installation and replacement services provided in relation to tire and vehicle parts; information, advice and consultancy provided in relation to all the aforesaid services.

Class 42

Consultancy in the field of computer software design; development and design of navigation systems and route planners; computer software and hardware design; development and design of computer software for use with navigation systems and route planners and with electronic maps and digital dictionaries; development and design of telecommunications and data communications services and networks; software as a services [SaaS] featuring software for tracking and monitoring in the field of fleet management; design, maintenance and development of computer software for use in relation to the replacement, repair, inspection, installation, monitoring, management, maintenance, leasing, ordering, purchase or hire purchase of tires, vehicle parts, vehicles and groups of vehicles; quality control services, namely monitoring, checking and testing status of tires, vehicle parts, vehicles and groups of vehicles; technical analysis and technological consulting services related to the selection, condition, maintenance, retreading or replacement of vehicle tires; technical analysis and technological consulting services related to the selection, condition, maintenance or replacement of vehicle component parts, spare parts and accessories; providing an online platform for managing information and data associated with tires, vehicle parts, vehicles and groups of vehicles; inspection services provided in relation to tires and vehicle parts; technical data analysis of vehicles or vehicle components, such as tires, brakes, batteries, engine oils or default signals; technical data analysis of bicycles or bicycle components, such as tires, brakes, batteries or default signals; providing analysing results of data in relation to vehicles or vehicle components, such as tires, brakes, batteries, engine oils or default signals; providing analysing results of data in relation to bicycles or bicycle components, such as tires, brakes, batteries or default signals; providing technological information, consultancy and advice in relation to vehicles or vehicle components, such as tires, brakes, batteries, engine oils or default signals; providing technological information, consultancy and advice in relation to bicycles or bicycle components, such as tires, brakes, batteries or default signals; providing technological information, consultancy and advice in relation to course of action to solve problem of vehicles or vehicle components, such as tires, brakes, batteries, engine oils or default signals; providing technological information, consultancy and advice in relation to course of

action to solve problem of bicycles or bicycle components, such as tires, brakes, batteries or default signals; providing technological information, consultancy and advice in relation to deterioration of road surface, bridge joints.

4. Under section 5(3), the opponent relies on the same marks as under section 5(2)(b). In the case of the 253 mark, it claims a reputation in the following goods:

Class 9

Electrical and electronic apparatus and instruments.

Class 12

Vehicles and parts and fittings for vehicles; apparatus for vehicles and tyres; treads for vehicles; brake pads and brake linings; tracks for vehicles; rubber goods for vehicles and tyres; tyres; wheels for vehicles; inner tubes; rims and covers for vehicle wheels; inner tubes for vehicle tyres; repair materials of rubber for tyres and inner tubes; repair outfits for tyres; non-skid apparatus and devices for vehicle tyres; golf carts and golf trolleys; non-metallic hoses for use in hydraulic systems in vehicles; fenders for ships; parts and fittings for all the aforesaid goods.

5. In the case of the 491 mark, it claims a reputation in the following goods:

Class 9

Batteries, electric; batteries electric for vehicles.

Class 12

Automobiles and their parts and fittings; tires for passenger cars; tires for trucks; tires for buses; tires for racing cars; tires for automobiles; retreaded tires for passenger cars; retreaded tires for trucks; retreaded tires for buses; retreaded tires for racing cars; retreaded tires; retreaded tires for automobiles; inner tubes for passenger cars; inner tubes for trucks; inner tubes for buses; inner tubes for racing cars; inner tubes for automobiles; wheels and rims for passenger cars; wheels and rims for trucks; wheels and rims for buses; wheels and rims for racing cars; wheels and rims for automobiles; tread rubber for retreading tires for the

above-mentioned vehicles; two-wheeled motor vehicles and their parts and fittings; tires for two-wheeled motor vehicles; inner tubes for two-wheeled motor vehicles; wheels and rims for two-wheeled motor vehicles; bicycles and their parts and fittings; tires for bicycles; inner tubes for bicycles; wheels and rims for bicycles; aircraft and their parts and fittings; tires and inner tubes for aircraft; adhesive rubber patches for repairing tubes or tires; tread rubber for retreading tires for two-wheeled motor vehicles or bicycles; tread rubber for retreading tires for aircraft; tread used to retread tires for tires of automobiles, two-wheeled motor vehicles, bicycles, aircrafts and the aforementioned vehicles; preformed tire treads for tires of automobiles, two-wheeled motor vehicles, bicycles, aircrafts and the aforementioned vehicles; rubber patches for repairing the aforementioned vehicle tire tread; shock absorbers (for land vehicles); air springs for land vehicles; shaft couplings or connectors (for land vehicles); fenders for vessels (boat side protectors); seat cushions for vehicles; air springs for railway cars; vehicle bumpers; suspension shock absorbers for vehicles; suspension springs for vehicles; four-wheeled go-carts; tricycles for infants; tires for off-the-road automobiles, two-wheeled motor vehicles and bicycles; tires for scrapers; tires for motor graders; tires for shovel loaders; tires for tire rollers; tires for wheeled cranes; tires for cranes; tires for snow plows; tires for pavers; tires for mining machinery.

6. Finally, in the case of the 166 mark, it claims a reputation in relation to all the goods and services relied on under section 5(2)(b).

7. All these marks qualify as earlier marks under the provisions of section 6(1) of the Act. As the registration processes for the 253 and 491 marks were completed more than five years before the date the contested IR was designated for protection in the UK, the opponent has stated that it has used these two marks for all the goods and services relied upon.

8. The opponent claims under section 5(2)(b) that there is a likelihood of confusion between the contested IR and the earlier marks as a result of the similarity between the marks and the identity, similarity and complementarity between the goods and services relied upon.

9. Under section 5(3), the opponent claims that the earlier marks have a substantial reputation for vehicle tyres and goods and services closely related to vehicle tyres, *“including clearly complementary goods such as batteries and electrical power supply goods”*, along with digital solutions and repair services. Use of the contested IR would, it claims, take unfair advantage of the distinctive character and repute of the earlier marks, and/or undermine the origin, investment and advertising functions of the earlier marks through dilution.

10. The holder filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of the 253 and 491 marks. In particular, it submits that the marks are not similar.

11. Both parties filed evidence. This is briefly detailed below.

12. Neither side requested a hearing and the opponent filed written submissions in lieu on 13 April 2023. In these proceedings, the opponent is represented by Marks & Clerk LLP and the holder by IPEY.

EVIDENCE

13. The opponent’s evidence in chief comes from Akane Mori, a manager within the IP Division of Bridgestone Corporation. She states that she has held this position since 2018. Her evidence goes towards the use made, and reputation, of the earlier marks. She also comments on the use of the IR by the holder as shown on its website. In particular, she claims that the colour scheme adopted for the IR is identical to that of her company and that the holder uses a stylised “B” logo as its browser window icon. The witness statement, accompanied by 21 exhibits, is dated 21 April 2022.

14. The holder’s evidence comes from Yi bing hu, the legal representative of Huizhou Wisdom Power Technology Co., Ltd, a position held for nine years. The witness statement is dated 19 December 2022 and states that the contested IR stands for

“Best Solution Lithium Batteries”. It is accompanied by an Annex containing a print-out from the holder’s website, with a date of printing of 12/5/2021.²

15. The opponent filed evidence in reply. This is in the form of a second witness statement from Ms Mori dated 9 February 2023. Ms Mori has reviewed the development of the contested IR and makes further comments on the colour and the size of the first “B” relative to the rest of the IR.

PRELIMINARY POINT

16. I have read the evidence and opponent’s submissions about the way in which the contested IR is used. However, I am required to make my decision on the basis of the contested IR as it appears on the register and all the circumstances in which it might fairly be used if it were registered. How it has been used is not an issue that I must consider in making my decision on the pleaded grounds.

PROOF OF USE

17. Section 6A of the Act is as follows:

“(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in sections 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

² It is not clear whether this is 12 May 2021 or 5 December 2021, but nothing turns on it.

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

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

(3) The use conditions are met if-

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

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

(4) For these purposes-

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

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

[(5) Repealed]

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

...”

18. As the 253 mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

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

(2) Where the relevant period referred to in section 6A(3)(a) (the ‘five-year period’) has expired before IP completion day-

- (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
- (b) the references in section 6A(3) and (4) 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 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
- (b) the references in section 6A to the United Kingdom include the European Union.”³

19. As the 491 mark is a comparable trade mark (IR), paragraph 7 of Part 1, Schedule 2B applies:

³ IP Completion Day means 31 December 2020 at 11pm.

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

(2) Where the relevant period referred to in section 6A(3)(a) (the ‘five-year period’) has expired before IP completion day-

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

(b) the references in section 6A(3) and (4) 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 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding (IR); and

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

20. Section 100 of the Act is as follows:

“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.”

21. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):⁴

⁴ 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 Trade Marks 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, although the UK has left the EU.

“114. *The law with respect to genuine use.* 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 *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 Bundersvereinigung 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 Marken 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 *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].

22. The relevant period in which use must be shown is the five years ending with the date of the contested designation, i.e. 3 March 2021. The relevant period is therefore 4 March 2016 to 3 March 2021.

23. Bridgestone Tyre Co., Ltd was founded in 1931 by Shojiro Ishibashi in Fukuoka Prefecture in Japan. Ms Mori states that the opponent is the world's largest manufacturer of tyre and rubber products, and that it is estimated that approximately 1 in 5 vehicles around the world are fitted with its tyres.⁵ The company entered Europe in 1972, opening a branch in Belgium.

24. For the purposes of the opposition under section 5(2)(b), the opponent is not relying on tyres. Instead, it relies on an extensive list of goods under Class 9 of the Nice Classification. In its written submissions, the opponent has provided a table which highlights the goods that it considers to be of particular relevance to the opposition under this ground and has helpfully indicated the exact parts of the evidence that, it submits, show that genuine use has been made of the 253 and 491 marks.⁶

⁵ First witness statement, paragraph 4.

⁶ Paragraph 24.

25. The opponent submits that the 253 mark has been genuinely used in relation to *Measuring apparatus and instruments; apparatus and instruments for electrical distribution or control; electrical and electronic apparatus and instruments; cabling; switches and switch mechanisms; parts and fittings for all the aforesaid goods*. It also submits that the 491 mark has been genuinely used in relation to *Computers; alarm devices for tire pressure; pressure gauges in vehicle tires; batteries, electric; batteries electric for vehicles; rubber testing machines*.

26. Ms Mori states that:

“... My Company’s products now include sensors as well as proprietary, dedicated software solutions which, in particular, help businesses in optimising the life of tyres, performance of vehicles, establishing when tyres are in need of replacement and in management of fleets of vehicles. Such products may include subscription services for replacement, inspection and maintenance of products utilising digital solutions and electronic hardware.”⁷

27. The tables below show approximate sales figures for hardware provided with tyre pressure monitoring services, MOBOX (a monthly subscription service for tyres and other vehicle-related services), and other tyre pressure monitoring solutions and consumer services. These figures cover the UK and EU. It is the first and third of these tables that are particularly relevant.

Tyre pressure monitoring services - hardware

	Sales Revenue (Euros)
2017	20,000
2018	76,000
2019	173,000
2020	120,000
2021	181,000

⁷ Paragraph 10.

MOBOX

2019	7,000,000
2020	8,000,000
2021	9,000,000

Other digital solutions

2019	200,000,000
2020	202,000,000
2021	236,000,000

28. Ms Mori states that the opponent has undertaken significant marketing and promotional activities in the EU and the UK. The approximate amounts spent are shown below. However, they do not differentiate between the products sold, so it is likely that some of this expenditure related to marketing the opponent's tyres.⁸

EU	
Year	Expenditure (Euros)
2018	90,000,000
2019	95,000,000
2020	85,000,000
2021	90,000,000
Total	360,000,000

UK	
Year	Expenditure (Euros)
2018	5,000,000
2019	5,000,000
2020	5,000,000
2021	0
Total	15,000,000

29. Brands shown in the evidence include TIREMATICS, TOTAL TYRE CARE SOLUTIONS, FLEETPULSE, MOBOX and WEBFLEET SOLUTIONS. These are systems that use hardware and computer software to monitor tyre pressure, manage tyre subscriptions, and/or use telematics to monitor fleet performance. Ms Mori states that they are often co-branded with the 253 or 491 marks. A brochure lists the options available. The 491 mark can be seen at the top left corner, with the same mark in the word BRIDGESTONE in the bottom right. The brochure appears to be undated.⁹

⁸ Exhibit 12.

⁹ Exhibit 5, page 93.

total tyre care

IDENTIFYING WITH YOUR FLEET

Find out more on www.bridgestone.co.uk/truck-and-bus/total-tyre-care

BRIDGESTONE
Solutions for your journey

30. A dated example is shown below. It is taken from a 2018 factsheet about TIREMATICS.¹⁰

BRIDGESTONE

TIREMATICS

Tyre pressure monitoring, exclusive for Bridgestone Partners.

Tirematics keeps your fleet moving. Automated pressure inspections and targetted alerting means quick and efficient resolution of low pressure problems.

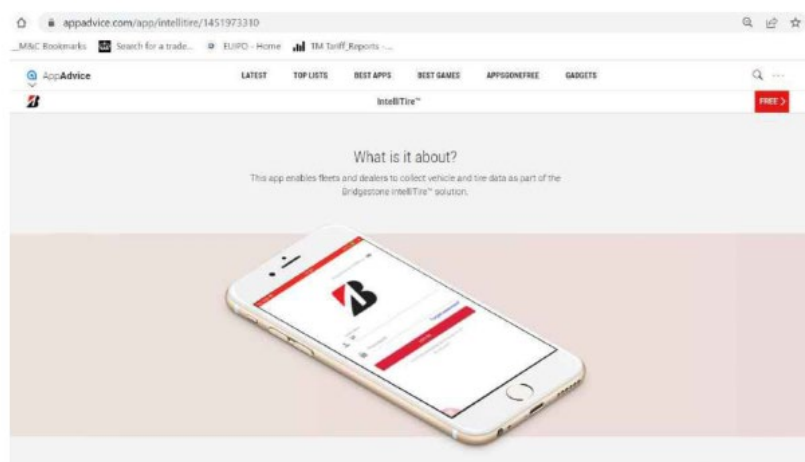
Regular maintenance reports by email as well as access to the **INSIGHTS** reporting tool allows fleet to proactively keep tyres in optimal condition with minimal service cost involved.

31. The 491 mark can be seen at the top of the factsheet as part of the word “BRIDGESTONE”, but it is also shown with the stylised “TIREMATICS” mark on the

¹⁰ Exhibit 5, page 77.

gate reader towards the left of the image. The opponent submits that Exhibit 5 shows that within the EU 90,000 sensors were installed on 13,500 vehicles, with 240 gate locations and 40 mobile receivers, but the date of this information is not given, apart from the fact that it is after 2016.¹¹ No figures are given for usage of the other products mentioned in paragraph 29 above.

32. The 491 mark also appears as the icon for the IntelliTire app. This service uses in-tyre and external sensors and receivers to monitor pressure, temperature and tread depth on every tyre in a fleet. The app was released on 15 February 2019.¹²



33. On the same page, a screenshot from the Google Play store also shows the 253 mark in use, but this screenshot is undated and, as prices appear in dollars, is targeted towards the US market.

34. Exhibit 5 contains a list of hardware products provided in 2016-2021 in connection with tyre pressure management services.¹³ These include sensors, readers and battery boxes. However, it is unclear how many of the individual items were sold.

35. Also shown in the evidence is a battery charger on which the 253 mark can be seen:¹⁴

¹¹ Page 100.

¹² Exhibit 5, page 88.

¹³ Page 91.

¹⁴ Exhibit 8, page 128.



36. Ms Mori explains that:

“It is also the case that as part of its marketing and commercial activities, My Company has produced promotional products to increase awareness of its brand. This has even included a specialist ‘battery charger’ product which displays the Logos. This product has been manufactured under authority from My Company’s motorcycle tyre division in the UK in bulk and sent to customers.”¹⁵

37. In *Silberquelle GmbH v Maselli-Strickmode GmbH*, Case C-495/07, the Court of Justice of the European Union (“CJEU”) held that it was not genuine use where a mark was used on promotional items that are handed out to reward customers for purchasing other goods or to encourage them to buy those other goods: see paragraphs 17-21. Ms Mori’s explanation suggests that this was the intention, and so the use would not constitute genuine use. However, I do note that Exhibit 8 contains a Facebook posting from a company called Crossan Motorcycles offering the battery chargers for sale and stating that the recommended retail price was £89.99. This post is dated 2 October 2020 and suggests that this may not necessarily be a *Silberquelle*-type situation. Nevertheless, even if there were genuine commercial use, I have no figures to tell me its scale so cannot say that such use was warranted in the sector concerned to create or maintain a share of the market for battery chargers.

38. On the basis of the above evidence, I am content that the opponent’s stylised B logo has been used for electrical and electronic apparatus and instruments for

¹⁵ Paragraph 12.

measuring and monitoring the condition of tyres. I can accept that it is probable that parts and fittings for these goods have also been sold and that this would include batteries for use in these apparatus and instruments. In addition, I find that the 491 mark has been used for *Alarm devices for tire pressure, pressure gauges in vehicle tires* and some types of battery. While it is clear that the tyre pressure monitoring systems use information technology, I can see no evidence that the mark has been used in connection with *Computers* more broadly. The evidence does not show genuine use of the remaining goods.

39. The mark that most commonly appears in the evidence is the 491 mark and there is scant evidence of its use in any other form. I shall therefore now consider whether use of this mark would constitute use of the 253 mark. In doing so, I am guided by the approach set out by Mr Phillip Johnson, sitting as the Appointed Person, in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EUIPO*, EU:T:2020:22, [63 and 64]).



14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

40. The respective marks are shown below:

253 mark	491 mark
	

41. The 253 mark is registered in black and white. The Court of Appeal has stated on two occasions that such a registration covers use of the mark in colour: see *Specsavers International Healthcare Ltd & Ors v Asda Stores Ltd* [2014] EWCA Civ 1294, paragraph 5, and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290,

paragraph 47. Therefore, a black and white mark should be considered on the basis that it could be used in any colour. However, it would not be appropriate to make a notional application of complex colour arrangements to a mark registered in black and white.

42. The 253 mark consists of a filled-in capital letter B divided into two sections by a contrasting upside-down tick. These elements in combination give the mark its distinctive character. The 491 mark has a slightly more rounded top left corner and the tick has a slight curve. These are minor differences, which would not be noticed by the average consumer. What would be noticed is the red triangle. However, this does not alter the distinctive character of the mark and so I consider that the 491 mark is an acceptable variant of the 253 mark.

43. The 491 mark is also used as part of the stylised word “BRIDGESTONE”, as shown in paragraph 30 above. In *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU held that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be

fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)."

44. The opponent submits that the public has been educated to identify the earlier marks as signifying the BRIDGESTONE brand.¹⁶ In my view, the evidence supports this submission. The 491 mark is used on the website and social media channels in both the BRIDGESTONE sign and on its own.¹⁷ Use as part of the stylised BRIDGESTONE mark is also acceptable.

45. I must now determine fair specifications for the marks. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as follows:

¹⁶ Written submissions, paragraph 27.

¹⁷ Exhibits 2 and 17 respectively.

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”¹⁸

46. In *Property Renaissance t/a Titanic Spa v Stanley Dock Hotel Ltd t/a Titanic Hotel Liverpool & Ors* [2016] EWHC 3103 (Ch), Carr J summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot

¹⁸ Pages 10-11.

reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”¹⁹

47. Earlier in my decision, I found that the opponent had shown use of the 253 mark for electrical and electronic apparatus and instruments for measuring and monitoring the condition of tyres. The specification of that mark includes *Measuring apparatus and instruments* and *Electrical and electronic apparatus and instruments*. These are broad terms that would encompass a wide variety of different subcategories. The evidence indicates to me that the opponent’s goods fall within a specialist field and so I consider that *Measuring apparatus and instruments for monitoring tyre pressure* and *Electrical and electronic apparatus and instruments for measuring and monitoring tyre pressure*, along with *Parts and fittings for all the aforesaid goods* would constitute a fair specification for this mark.

48. Turning now to the 491 mark, I consider *Alarm devices for tire pressure and pressure gauges in vehicle tires*. The majority of use during the relevant period appears to have been in relation to truck tyres, but it would not be fair in my mind to restrict the goods that can be relied on to devices and gauges for truck tyres, as the

¹⁹ Paragraph 47.

Class 9 goods are unlikely to be different in substance if they were to be used on tyres or other vehicles.

Section 5(2)

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

“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, or

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

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

50. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the CJEU 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation 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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be

reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater degree of similarity between the marks and vice versa;

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

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

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

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

Average consumer and the purchasing process

51. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”²⁰

52. The average consumer of the holder’s goods may be a member of the general public or a professional mechanic, electrician or engineer. This is because they range from *Batteries, electric* and *Battery chargers* which are aimed at a wide public to more specialist goods such as *Battery jars*, which I understand are used in the process of making the battery itself. The average consumer of the opponent’s goods and services will also be either a member of the general public, who, for example, buys a tyre pressure gauge that they can use at home, to a professional mechanic or a fleet management company.

53. The price of the goods and the frequency of purchase will also differ. Batteries are relatively inexpensive and may be bought often, suggesting that the attention paid during the purchasing process is no more than medium. A greater degree of attention will be paid by professionals, with fleet management companies paying a high degree of attention given the importance of tyre performance and safety for their businesses.

²⁰ Paragraph 60.

54. The average consumer is likely to see the mark on the goods themselves (in the case of batteries or battery chargers) or on brochures and other promotional material. Professional consumers may also have discussions with sales representatives of suppliers of the goods and services. Even the consumer who is a member of the general public may also seek advice in shops and other outlets, or order goods and services by telephone. Consequently, although the visual element of the mark is likely to be more important, I must also consider how the marks would be spoken.

Comparison of marks

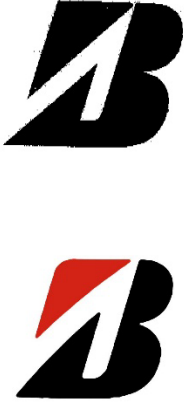

55. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”²¹

56. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components 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 marks are shown below:

²¹ Paragraph 34.

Earlier marks	Contested mark
	

58. The overall impression of the earlier marks is of a filled-in letter B with a contrasting upside-down tick. The 253 mark is in black and white, while the 491 and 166 marks are in colour. The 166 mark claims the colours red and black as features of the mark and states that the white is background and not part of the mark.

59. The distinctive character of the 253 mark lies in the device as a whole. The colour arrangement contributes to the distinctive character of the 491 and 166 marks, but the greater part is played by the filled-in letter B and the upside-down tick.

60. The opponent submits that the initial letter B is the dominant and distinctive element of the contested IR. It agrees with the holder that the average consumer would perceive the IR as the abbreviation “BSL” followed by a shortened form of the word “BATTERY”, with the meaning reinforced by the lightning bolt symbol in a box between the last two letters. The holder submits that this would be seen as a battery. I agree. The holder states that “BSL” stands for “Best Solution Lithium”.²² The opponent submits that these words would be considered to be non-distinctive for the goods for which protection is sought. There is, however, no evidence to suggest that the average consumer would know what the abbreviation stood for. The opponent also submits that the average consumer would pay less attention to the letters following “B”, as they are smaller. I am not persuaded by this argument. While I take note of the case law stating that the average consumer tends to pay more attention to the beginning of marks,²³ I

²² Witness statement of Yi bing hu, paragraph 4.

²³ See, for example, *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraphs 81-83.

note that there are six letters following the “B” and I do not consider that the average consumer’s attention would tail off so quickly. It is important to remember that the average consumer is “*reasonably circumspect*”.

61. In my view, the combination of the three-letter abbreviation, with the shortened form of “battery” makes the greater contribution to the overall impression of this mark. The stylisation of the letter Bs makes a lesser contribution, with the battery device a smaller one still, given its position at the end of the mark and its allusion to the goods for which protection is sought.

Visual comparison

62. The opponent submits that it is the first letter of the contested IR that should be the focus of my comparison. However, for the reasons I have already given, I rejected the argument that the average consumer’s attention would be drawn and retained only by the first letter. The only point of visual similarity between the contested IR and any of the earlier marks is the stylised letter B. The opponent draws my attention to the presence of diagonal lines in each of these and the shading of the B in the contested mark, which, as with the 491 and 166 marks, produces a contrasting triangle at the top left of the letter. I consider that it may be possible that the same colour combination might be used. However, in my view, the differences in the diagonal lines and particularly the greater length of the contested IR, outweigh any similarity in colour of the first letter. I find that the marks are visually dissimilar.

Aural comparison

63. The earlier marks will all be pronounced as “BEE”, while the contested IR will be pronounced as “BEE-ESS-EL-BAT”. It will be seen that the marks are significantly different in length. The opponent submits that the average consumer will be likely to shorten the contested IR, as “BATT” is descriptive of batteries. In *The Stockroom (Kent) Ltd v Purity Wellness Group Ltd (PURITY HEMP COMPANY IMPROVING LIFE AS NATURE INTENDED)*, Mr Philip Harris, sitting as the Appointed Person, said that descriptiveness did not in itself mean that an element of a mark was negligible or that

it would be ignored by a speaker: see paragraph 31. I consider that to be the case here. I find that the marks are aurally dissimilar.

Conceptual comparison

64. The opponent's submissions that there is conceptual similarity between the contested IR and the earlier marks is predicated on the average consumer perceiving that the letter "B" is the principal concept associated with the marks. I found against this view earlier in my decision. The parties are agreed that the average consumer will see the contested IR as a three-letter abbreviation, followed by a shortened form of "BATTERY". I can find no conceptual similarity between the marks.

65. Section 5(2)(b) requires the marks to be similar. Having found that they are dissimilar, the opposition under this ground fails.

Section 5(3)

66. Section 5(3) of the Act is as follows:

"A trade mark which –

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

[...]

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 the repute of the earlier trade mark."

67. This section also requires there to be at least a small degree of similarity between the marks. Having found that they are dissimilar, the opposition under this ground must fail.

OUTCOME

68. The opposition has failed and IR No. 1584271 will be designated for protection in the UK.

COSTS

69. The holder has been successful and is entitled to a contribution towards the costs it has incurred during these proceedings, according to the scale set out in Tribunal Practice Notice No. 2/2016. In the circumstances, I award the holder the sum of £800, which has been calculated as follows:

Preparing a statement and considering the other side's statement: £300

Preparing evidence and considering the other side's evidence: £500

TOTAL: £800

70. I therefore order Bridgestone Corporation to pay Huizhou Wisdom Power Technology Co., Ltd the sum of £800, which should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 18 day of July 2023

Clare Boucher

For the Registrar,

Comptroller-General