

BLO/0726/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3800360

BY

HONGKONG DINGXIN INDUSTRY AND TRADE LIMITED

TO REGISTER THE TRADE MARK:

THORKITCHEN

IN CLASSES 11 AND 20

-AND-

THE OPPOSITION THERETO UNDER No. 435529

BY

MAEVE CATHERINE O'REILLY AND JACQUELINE ADAM

Background and pleadings

1. Hongkong Dingxin Industry And Trade Limited (“**the Applicant**”) applied to register the trade mark ‘THORKITCHEN’ (“**the Contested Mark**”) in the UK on 17 June 2022. It was accepted and published in the Trade Marks Journal on 8 July 2022. The goods for which registration is sought are:¹

Class 11

Cooking apparatus and installations; kitchen ranges [ovens]; roasters; gas cookers; gas cooking ovens for household use; cooking stoves; gas burners; domestic ovens; hot plates; Bakers' ovens; microwave ovens [cooking apparatus]; apparatus for filtering water; kitchen sinks; sterilizers for household use; wine cellars, electric; bath installations; refrigerators; cooker hoods; fireplaces.

Class 20

Containers, not of metal [storage, transport]; screens for fireplaces [furniture]; display boards; cupboards; washstands [furniture]; doors for furniture; furniture of metal; work benches; custom-made kitchen furniture; sideboards; tool boxes, not of metal [furniture]; cabinets; furniture; dinner wagons; chests, not of metal; bolsters; tool chests, not of metal; display cabinets; food racks; drawer units; cushions; decorations of plastic for foodstuffs; furniture fittings, not of metal; window fittings, not of metal; grab bars, not of metal; meat safes.

2. Maeve Catherine O'Reilly and Jacqueline Adam (whom together I shall refer to as “**the Opponent**”, which is in line with the parties’ submissions) partially oppose the application on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opposition is directed solely at the applied-for goods in Class 11.

¹ The Applicant had additionally applied for “*lamps*” in Class 11, however on 7 November 2022, following the initiation of opposition proceedings by a third party (unrelated to the current proceedings) – an opposition directed solely at the applied-for term “*lamps*” – the Applicant restricted its Class 11 by deleting that term from its application. As a consequence, those opposition proceedings were withdrawn (the Opponent in the current proceedings did not however withdraw its opposition following the Applicant’s amendment). Therefore the goods which remain in Class 11 are the goods for which application is sought – as set out at my paragraph 1.

3. The opposition is based on the Opponent's UK trade mark number 1352074 for the word 'THOR', which is registered in respect of goods in Class 11. Details of the Opponent's registration are below:²

Dates

Filing Date: 22 July 1988
Registration Date: 21 February 1992

Recorded licences

Licence number: RC000034132
Exclusive licence: Yes
Start date: 23 February 2015
Licence holder: Shomar Limited
Unit 9 Western Industrial Estate, Naas Road, Dublin 12,
Ireland

Goods

Class 11: *Installations, apparatus and appliances, all for domestic purposes; refrigerators, deep freezers; cookers, air extractor hoods for use with cookers; ovens; installations and apparatus for heating foodstuffs and beverages; grilling and roasting apparatus for cooking; barbeques; toasters; apparatus for making tea and coffee; coffee percolators; space heaters, water heaters; gas lighters; clothes driers and hair drying appliances; all included in Class 11.*

4. The Opponent claims that the respective marks are highly similar on the basis that the word 'THOR' is contained in, and appears at the beginning of the Contested Mark; and that the respective goods are identical and/or similar, giving rise to a likelihood of confusion. The Opponent submits that its earlier mark is "*inherently distinctive to a high degree*".

² The Opponent's mark is an earlier trade mark in accordance with section 6 of the Act.

5. As the Opponent's trade mark had been registered for more than five years at the filing date of the application, the Opponent made a statement that it has used its mark during the relevant period, in relation to all of the goods relied on. The relevant period being 18 June 2017 to 17 June 2022 (which is the period of five years ending on the filing date of the opposed application).

6. The Applicant filed a counterstatement denying the claims made and put the Opponent to proof of use of the earlier mark in relation to all the goods relied on.

7. Neither party filed submissions during the evidence rounds, and only the Opponent filed evidence in these proceedings. The Opponent's evidence goes to 'proof of use'. No hearing was requested and both parties elected to file submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers.

8. The Opponent is represented by Tomkins & Co, and the Applicant is represented by Trademarkit LLP.

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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts.

Preliminary Issues

Exclusive licence

10. The Opponent's evidence is provided in the Witness Statement of Paul Michael Adam, dated 16 January 2023. Mr Adam is a director of Shomar Limited, a position he has held since 21 June 1985. Mr Adam refers to Shomar Limited as an Irish company organised and existing under the laws of Ireland, whose registered office is based in Dublin, Ireland – accordingly, he has supplied in evidence, a copy of the company's certificate of incorporation which confirms this.³

³ Exhibit PMA1.

11. Mr Adam states that Shomar Limited is “*the supplier of THOR products and an exclusive licensee of THOR trade marks*”, in particular, that it is the exclusive licensee of the earlier UK registration (i.e. UK trade mark registration number 1352074 – that forms the basis of this opposition) and refers to licence number RC000034132, which is recorded against the registration.⁴

12. A copy of the licence agreement to which Mr Adam refers is retained by the Registry, and I have therefore reviewed the contents of it. I note that under the terms of the licence, in addition to granting Shomar Limited exclusive rights to use UK trade mark registration number 1352074, the Opponent also grants the company exclusive rights to use another two of its UK registrations throughout the UK;⁵ and exclusive rights to use three of its Irish trade mark registrations for the word ‘THOR’, throughout Ireland – the specifications of two of the Irish marks include, inter alia, Class 11 goods which can broadly be categorised as household appliances including cookers, ovens and ‘white goods’ such as freezers and refrigerators.

13. Given that the licence grants consent to Shomar Limited to use the earlier mark, in the event that the Opponent’s evidence proves that the earlier trade mark has been put to genuine use in the United Kingdom by Shomar Limited, such use shall be recognised as genuine use of the trade mark for the purpose of maintaining the registration.⁶

Approach

14. In order to rely on its earlier registration in these proceedings, the Opponent must first establish that it has made genuine use of the earlier registration in the relevant territory, which, since this is a UK trade mark, comprises England, Scotland, Wales and Northern Ireland. Therefore, I shall first assess whether, and to what extent, the Opponent’s evidence supports its statement that it has made genuine use of the earlier mark in relation to the goods relied on in this opposition. If no use is proven, then it

⁴ Exhibit PMA2 – which is a print-out of the publicly available online record of the earlier UK registration, available on the Registry’s website.

⁵ UK trade mark registrations 394047 and 394198 – both referred to as “*THOR (stylised)*” in the licence agreement.

⁶ In accordance with section 6A(3)(a) of the Act.

follows that the opposition must fail at that first hurdle since the Opponent will not be able to rely on its registration.

LEGISLATION AND CASE LAW

Proof of use

15. The relevant provisions of the Act are as follows:

Section 6A

- (1) This section applies where—
 - (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
- (1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if—
 - (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
 - (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

[...]

- (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.

Section 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.

16. The law relating to genuine use of a registered trade mark was summarised by Arnold J (as he then was), in *Walton International Ltd & Anor v Verweij Fashion BV*.⁷ This summary includes, inter alia, that genuine use means actual use of the trade mark by the proprietor or a third party (with the authority to use the mark) and that such use must be by way of real commercial exploitation of the mark on the market, for the relevant goods or services, sufficient to create or maintain a market share for those goods or services.⁸ The use must be more than merely token although there is no *de minimis* rule in relation to genuine use, and it is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use. The use must be consistent with the essential function of a trade mark which includes for example, affixing the mark to the relevant goods in order to guarantee to the consumer that the goods come from a single undertaking which controls the manufacture of those goods, and which is responsible for their quality.

17. In determining whether there is real commercial exploitation of the mark, all the relevant facts and circumstances must be taken into account, which include: (1) 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;

⁷ [2018] EWHC 1608 (Ch), paragraphs 114 and 115 detail the summary in full.

⁸ 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.

(2) the nature of the goods or services; (3) the characteristics of the market concerned; (4) the scale and frequency of use of the mark; (5) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (6) the evidence that the proprietor is able to provide; and (7) the territorial extent of the use.

18. The genuine use provision is not there to assess economic success or large-scale commercial use;⁹ rather, it is concerned with the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods and services.

19. The onus is on the Opponent to have filed evidence of genuine use of its mark. I must consider what the evidential picture as a whole shows me, not whether each piece of evidence shows use by itself.¹⁰

20. Whilst there is no requirement for the Opponent to produce any specific form of evidence, in *Awareness Limited v Plymouth City Council*,¹¹ the Appointed Person stated that:

22. [...] 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.

[...]

⁹ *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

¹⁰ *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

¹¹ Case BL O/236/13, paragraph 22 and 28.

28. [...] *Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered [...].*”

21. I also note Mr Alexander’s comments in *Guccio Gucci SPA v Gerry Weber International AG*.¹² He stated:

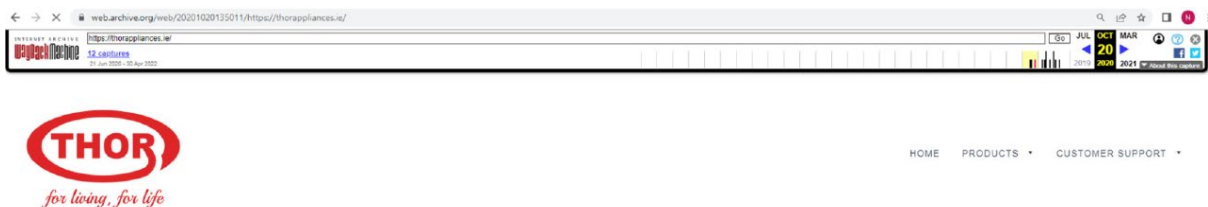
“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”.”

EVIDENCE

22. The Opponent’s evidence is provided in the Witness Statement of Paul Michael Adam, dated 16 January 2023, which has eleven exhibits attached, identified as PMA 1 – PMA11.

‘Thor Appliances’ website

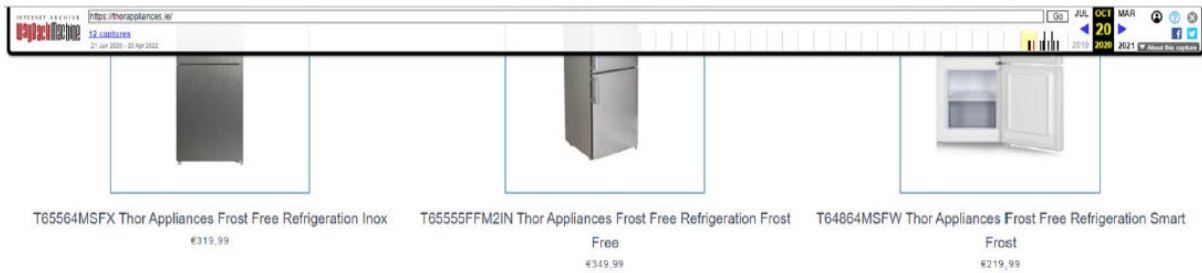
23. Mr Adam refers to the ‘Thor Appliances website’ (<https://thorappliances.ie/>), which he states is Shomar Limited’s website and that the range of ‘THOR’ branded products are displayed on this website. ‘Wayback Machine’ archived website pages dated 20 October 2020 show ‘THOR’ displayed as follows:¹³



¹² Case BL O/424/14. Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition proceedings.

¹³ Exhibit PMA4.

24. These archived webpages include three images of fridge freezers and the prices are in Euros as follows:



25. Text included in the website pages states that “*Thor Appliances supply products in every appliance category*”. The ‘Thor Appliances catalogue’ directory of the website lists the following categories of appliances: fridge freezers, chest freezers, cookers, dishwashers, integrated appliances, microwaves, ovens, hobs, cooker hoods, refrigeration, TV’s, washing machines. No prices are included in this directory and only one image of a cooker and one image of a dishwasher is displayed, the rest is merely text, as can be seen in the extract below:



26. Mr Adam further refers to print-outs dated 6 December 2021 taken from the ‘Thor Appliances website’ (<https://thorappliances.ie/>),¹⁴ stating that they show use of the ‘THOR’ trade mark in relation to the “*company’s range of THOR products (at the time)*”. The ‘THOR’ sign is displayed on the website as follows:



27. The 2021 website print-outs show images of the following appliances: fridge freezers, freezers, fridges, cookers, dishwashers, microwaves, microwaves with grill, washing machines, cooker hoods, electric ovens and hobs.

28. The description of each item displayed on the ‘thorappliances.ie’ website evidence includes the wording “*Thor Appliances*” in plain text, followed by the name of the appliance, for example:

T24EFSSS Thor Appliances Electric Oven

T65564MSFX Thor Appliances Frost Free Refrigeration Inox

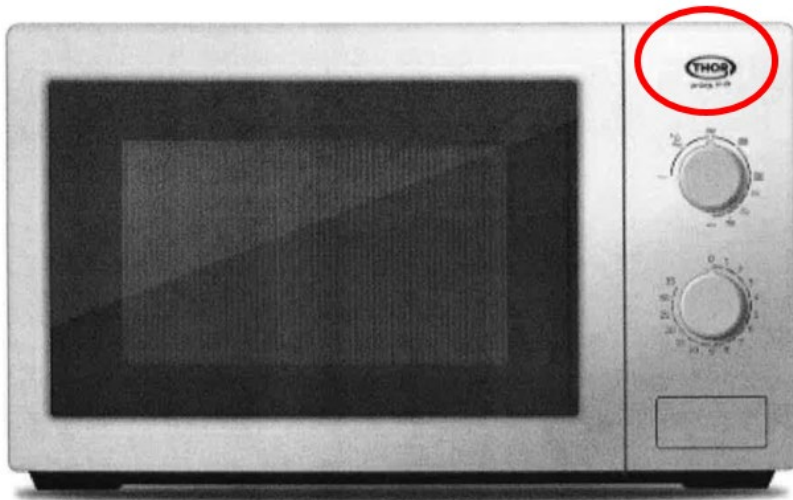
and the website text consistently refers to the appliances as “*Thor Appliances*”.¹⁵

29. Whilst not all of the images of the appliances contained in the ‘thorappliances.ie’ website evidence display the mark ‘THOR’ on them, (and some of the images are also poorly reproduced), there is nonetheless some discernible evidence that a stylised ‘THOR’ sign is affixed to certain appliances. Some examples are as follows (I have

¹⁴ Exhibit PMA3.

¹⁵ See Exhibits PMA3 and PMA4.

circled the relevant part of the images for ease of reference):¹⁶



¹⁶ Exhibit PMA3.

30. Mr Adam refers to a quote from the ‘thorappliances.ie’ website which states: *“Thor Appliances are supplied by Shomar Ltd who are a 100% Irish owned and managed business located in Dublin”*. I note that immediately following on from that quote, the website states that: *“This gives users of Thor Appliances peace of mind that we are local and only a message away if they need us”*. The website also goes on to state that Shomar Limited are committed *“to producing high-quality appliances making them the country’s best, fully Irish owned, Domestic Appliance Distributor”*; and that *“Our trusted Thor Appliances operate in thousands of homes across the island of Ireland [...] Thor Appliances have supplied products in Ireland for over 60 years”*.

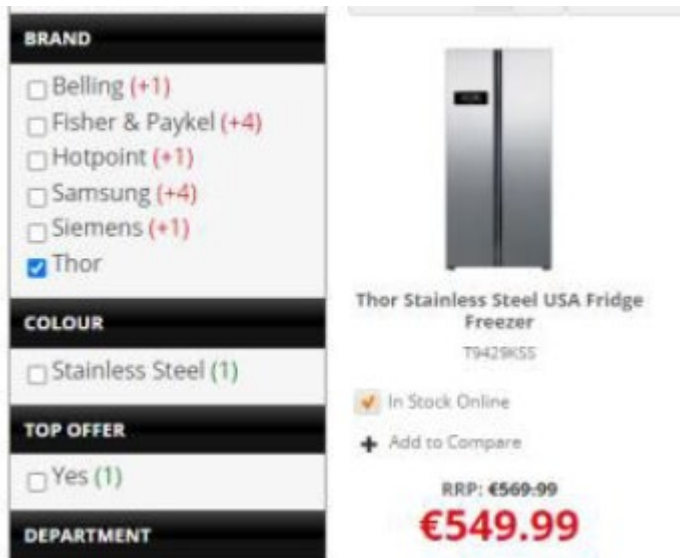
Distributors / stockists

31. The ‘thorappliances.ie’ website also includes the following information: *“Thor Appliances [...] can be found in DID Stores across Ireland or online www.DID.ie”*.

32. ‘Wayback Machine’ archived website pages dated between 6 July 2017 and 5 August 2020 for ‘DID Electrical’ (www.did.ie)¹⁷ display images of ‘Thor’ fridge freezers, washing machines and dishwashers. All the prices are displayed in Euros. Examples taken from this evidence are as follows (I note the wording *“get the best prices from an Irish brand you can trust”*):

The screenshot shows the DID Electrical website interface. At the top, there are navigation links: Store Locations, Opening Hours, Contact Us, Delivery Info, and My Account. The DID Electrical logo is on the left, and a search bar and a CHECKOUT button are on the right. Below the logo is a red navigation bar with categories: GIFTS, LARGE APPLIANCES, SMALL APPLIANCES, TV EXPERIENCE, TABLETS & TECH, and OFFERS. Underneath this is a secondary bar with icons for services: CLICK & COLLECT INSTORE, DELIVERY & RETURNS, INSTALLATION SERVICE, and RECYCLING. The main content area shows a breadcrumb trail: Home > Thor 60/20 Fridge Freezer. A large black banner reads "Black Friday all week long" with the subtext "Get the best prices from an Irish brand you can trust" and "Biggest ever sale". To the right of the banner is a checkout progress indicator with steps: 1 select your items, 2 install options, 3 Checkout. The product section features an image of the Thor 60/20 Fridge Freezer (TH251) with a "HOT" tag. The product name and model are listed, along with "In Stock Online" and a "MORE INFORMATION" link. A list of specifications is provided: Energy Rating: A+, Frost Free: No, Fridge Shelves: 3, Freezer Compartments: 1, and Size (cm) HxWxD: 143x54.5x56.6. On the right, the price is shown as RRP €289.99 and a sale price of €229.99, with a "SAVE €60.00" badge. Below the price is an "ADD TO CART" button and a list of included services: Home Delivery: €24.99, Store Pickup: FREE, Installation Service, Warranty Information, and Estimate Your Delivery Date.

¹⁷ Exhibit PMA10.



33. Mr Adam states that ‘Conway.TV’ is a supplier of electrical goods in Northern Ireland and refers to print-outs from their website (www.conway.tv) dated 16 January 2023 (which is outside of the relevant period).¹⁸ He explains that this evidence is the “*THOR brand page*” of the Conway.TV website, and that whilst “*Conway.TV presently do not have our THOR products listed on their website, the brand page is active and notes that our THOR products can be found in DID Stores across Ireland or online*”. Below are extracts from that evidence:



For Living, For Life

Our success is built on making quality & stylish appliances affordable. Thor Appliances supply products in every appliance category and these can be found in DID Stores across Ireland or online. Thor Appliances have supplied products in Ireland for over 60 Years.

¹⁸ Exhibit PMA9.

For Living, For Life

Thor Appliances are supplied by Shomar Ltd who are a 100% Irish owned and managed business located in Dublin. This gives users of Thor Appliances peace of mind that we are local and only a message away if they need us. We stand over all Thor Appliances by offering a FREE 2 Year Parts and Labour warranty on all our products.

34. Mr Adam reiterates that *“Thor products and appliances operate in thousands of homes across the island of Ireland”* and that his company supplies products to independent electrical stores throughout Ireland and Northern Ireland. He refers to Exhibit PMA5, an undated list which is titled *“Address list Accounts receivable – Shomar Limited”*. He describes this evidence as a list of distributors of the *“Thor products within Northern Ireland, UK”*, stating that *“it can be seen from the distributor list that Thor products are widely and readily available across Northern Ireland. Our distributors further deliver their products (including our THOR products) into Mainland UK.”*

35. The list comprises of the names and locations of 23 businesses, all of which are located in Northern Ireland. Included in the list is a business named ‘DAC Appliances’. I note that ‘DID Electrical’ is not included in the list. An extract from this evidence is as follows:

Code	Name / Contact person	Address / Phone	City / Fax
8098	BRYPOL ELECTRICAL [REDACTED]	[REDACTED] [REDACTED]	CO ANTRIM BT38 7AR NORTH IRELAND GB
8116	RJADA ELECTRICS SALES & SERVIC [REDACTED]	[REDACTED] [REDACTED]	CO ANTRIM GB
8135	MULTIFIX [REDACTED]	[REDACTED] [REDACTED]	CO.ARMAGH GB
8140	DAC APPLIANCES [REDACTED]	[REDACTED] [REDACTED]	CO TYRONE BT78 1ES CO TYRONE BT78 1ES GB

36. 'DAC Appliances' is described by Mr Adam as "our Northern Ireland distributor", based in Omagh and Cookstown, who "deliver throughout Northern Ireland and mainland UK". He refers to screenshots of the 'DAC Appliances' website (<https://dacappliances.com/>) which he states show two different 'THOR' model freezers for sale – I note the prices are in pounds.¹⁹ This evidence is dated 16 January 2023 (outside of the relevant period).

Invoices

37. In his witness statement, Mr Adams refers to Exhibit PMA6 (i.e. the invoice evidence) as follows:

"a selection of invoices issued from 11 December 2020 to 21 January 2022 to distributors within Northern Ireland in connection with the following goods: cookers, freezers, fridge freezers etc. These are not the entire amount of invoices during the relevant time period and our customer details have been redacted for confidentiality purposes. Should further invoices or information be required, these can be readily provided."

38. There are six invoices in total, all of which have customer addresses based in Northern Ireland, the currency is GBP, and all have a Shomar Ltd letterhead as follows:



39. The invoices range in value from £280 to £1,710 and relate to the sale of 32 items

¹⁹ Exhibit PMA8.

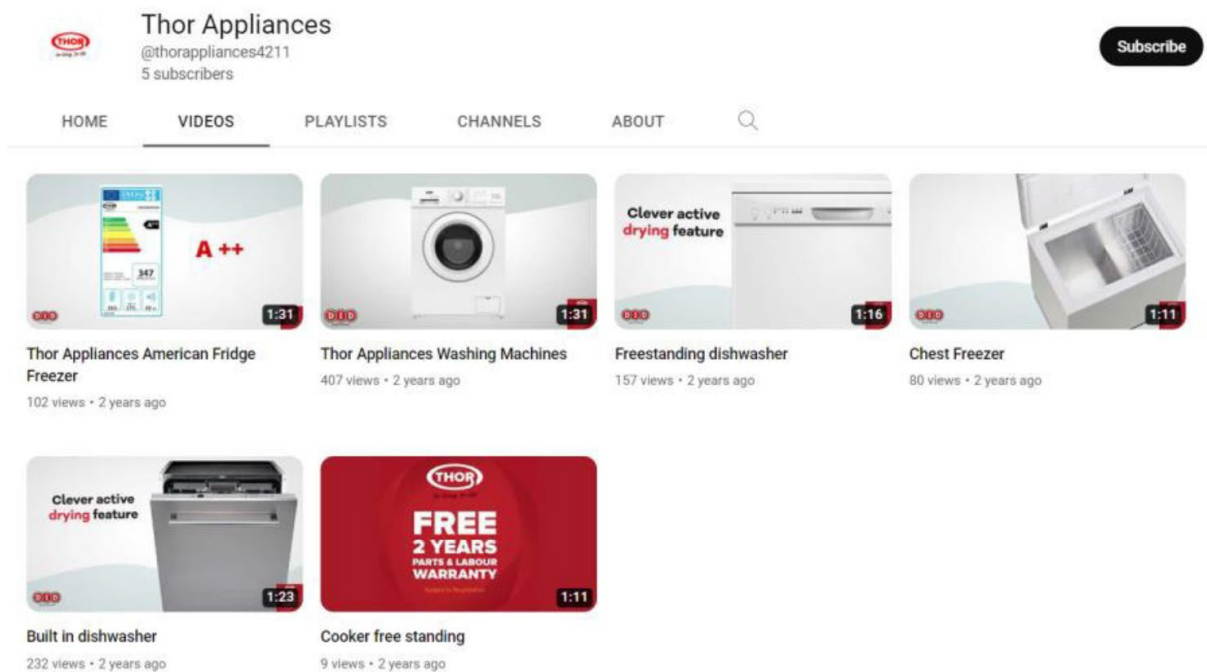
in total (30 of which include 'Thor' in the description). For ease of reference, I have set out some of the details of the invoices in the table below (my emphasis):

Date	Description	No. of units	Total Invoiced amount	Customer Location in Northern Ireland
11/12/2020	100L THOR CHEST FREEZER	18	£1,710	LONDONDERRY, UK
30/04/2021	538Lt Door with Water disp. Inox Thor	1	£450	LONDONDERRY, UK
30/06/2021	THOR 70/30 INTEGRATED FRIDGE FREEZER JUG KETTLE BRUSH STEEL DIGITAL CONTROL BASE	2 1	£533	LONDONDERRY, UK
26/07/2021	THOR 60CM SINGLE CAVITY COOKER	6	£858	DUNGANNON, UK
16/08/2021	60/40 FROSTFREE F/FREEZER BLACK 60/40 THOR FROSTFREE F/FREEZER INOX	1 1	£500	PORTGLENONE, UK
21/01/2022	130LT 4/2 50CM THOR FRIDGE FREEZER	2	£280	DUNGANNON, UK

40. Mr Adam has supplemented the invoice evidence with Exhibit PMA7, stating that it shows “*various print-outs of Shomar Limited’s website ‘https://thorapplicances.ie/’ dated 16 January 2023 showing the particular models of the goods noted within the invoices of EXHIBIT PMA6. I appreciate that these print-outs are after the relevant period in these proceedings, however as can be seen from the invoices, the products were sold and for sale during the relevant period.*” Having cross-referenced the two exhibits, I note that the ‘kettle’ and the ‘black frost-free fridge freezer’ included in the table above (the descriptions of which do not include ‘Thor’) are not included in the Exhibit PMA7 website evidence.

Advertising

41. One screenshot from the website 'youtube.com' dated 16 January 2023 has been produced as evidence of advertising.²⁰ Mr Adam states that: *"we joined YouTube on 21 September 2020 to further outwardly advertise our Thor products"* and that the 'Thor Appliances YouTube webpage' contains *"advertising videos in connection with fridge freezers, freezers, washing machines, dishwashers and free standing cookers [...] and each are heavily branded with the THOR mark"*. Below is an extract from this evidence:



42. The screenshot displays thumbnails of 6 videos all 2 years old (at the time of filing the evidence in these proceedings). The 'Thor Appliances YouTube' page had a total of 5 subscribers (as at 16 January 2023).

43. Each thumbnail displays the amount of views the video had (as at 16 January 2023) – with the lowest being just 9 views in the 2-year period, and the highest being

²⁰ Exhibit PMA11.

407 total views. I note that I am able to discern that the 'DID Electrical' logo is at the bottom left-hand corner of 5 of the thumbnails.

Form of the mark

44. The evidence shows that the Opponent's appliance products are often referred to as 'THOR' and 'Thor', and that the following sign is clearly affixed to some of the products shown in the evidence:



The evidence also shows use of the above sign on the Opponent's website.

45. I note that the Opponent may rely on use of a mark *"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"*.²¹ Put plainly, if the form in which it is used alters the distinctive character of the mark, then that form is not a 'variant form' and use of such sign cannot be relied on to establish genuine use of the registered trade mark.

46. The purpose of this provision is to avoid imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, and therefore to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enables it to be better adapted to the marketing and promotion requirements of the goods or services concerned. Where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the

²¹ Section 6A(4)(a) of the Act.

trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade.²²

47. The correct approach in assessing whether a mark has been used in a ‘variant form’ 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).²³

48. The Appointed Person in *Nirvana Trade Mark*,²⁴ summarised the approach to the test in relation to whether a sign has been used in a ‘variant form’ as follows:

“33. [...] The first question is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period [...]

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

49. In *Hyphen GmbH v EUIPO*,²⁵ the General Court held that use of the sign shown on the left below, constituted use of the registered mark shown on the right:



With regard to the approach of assessing of whether additional components are likely

²² See the General Court ruling in T-194/03 *Il Ponte Finanziaria* [2006] ECR II-445 at paragraph 50 (not overturned by the Court of Justice C-234/06 *Il Ponte Finanziaria* [2007] ECR I-7333).

²³ See *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, paragraph 13.

²⁴ BL O/262/06

²⁵ Case T-146/15

to alter the form of the registered mark to a material extent, the court stated:

“28. [...] a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark [...].

29. [...] The weaker the distinctive character [of the registered mark], the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the goods. The reverse is also true [...].

30. [...] where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole [...].

31. [...] the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character [...].

50. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In the above instance (the *Hyphen* case), the addition of a circle around the registered mark was not sufficient to alter the distinctive character of the registered mark.

51. The distinctive character of the earlier mark in the present case derives from the word ‘THOR’, which is inherently distinctive to a medium degree in relation to the goods for which it is registered. The stylised sign shown in use consists of the word ‘THOR’ in a plain, block-capital font. The notable differences between the mark registered and the sign shown in use, derive from the tail of the letter ‘R’, which extends and wraps around the word in an oval shape.

52. I do not think that the differences identified alter the inherent distinctive character of the earlier mark. The word 'THOR' is unaltered in the sign used and it remains the distinctive and dominant component in the sign. The oval shape is merely a banal, non-distinctive addition, that does not alter the distinctive character of the registered mark and, as such, I consider the sign shown in use to be an acceptable variant form of the registered mark. The Opponent can therefore rely on the evidence of use of that variant form of the mark.

Conclusions on the evidence

53. I remind myself that in determining whether there is real commercial exploitation of the earlier mark, some of the factors I must bear in mind include, inter alia, whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods in question; the scale and frequency of the use of the mark; the evidence that the Opponent is able to provide; and the territorial extent of the use. I also note that the onus is on the Opponent to file evidence of genuine use of its mark, and that I am entitled to be sceptical of a case of use if the material actually provided by the Opponent is inconclusive; and that broad statements purporting to verify use should be critically considered.

54. The 'Thor Appliances website' has a '.ie' top level domain ("TLD"), which I understand is the TLD for the country of Ireland, and the website states that the 'Thor' products and appliances can be found in thousands of homes (my emphasis) "*across the island of Ireland*" (which I interpret as a joint reference to the country of Ireland and the UK territory of Northern Ireland). In addition, it also states that "*Thor Appliances are supplied by Shomar Ltd who are a 100% Irish owned and managed business located in Dublin. This gives users of Thor Appliances peace of mind that we are local and only a message away if they need us*".

55. The 'Thor Appliances website' evidence only shows limited, clearly discernible examples of the 'THOR' sign affixed to some (not all) of its products, and that during the relevant period, the Opponent included the 'THOR' sign in the product names on its website, for the following goods: fridge freezers, freezers, fridges, cookers, dishwashers, microwaves, microwaves with grill, washing machines, cooker hoods, electric ovens and hobs.

56. That said there is no indication from this Irish website as to whether all the products were made available in Northern Ireland. Even when viewed in conjunction with the invoice evidence, I am only able to conclude with any degree of certainty, that during the relevant period,²⁶ the Opponent sold a small quantity of the following ‘Thor’ products to customers based in Northern Ireland: chest freezers, fridge freezers and cookers; and that such customers were located in Londonderry, Dungannon and Portglenone. There is no corroborated evidence at all in respect of other parts of the UK.

57. The Opponent states that “*should further invoices or information be required, these can be readily provided*”, but as I noted above, it is important that the Opponent puts its best case ‘up front’ and it is not incumbent on the Tribunal to call upon the Opponent to adduce further evidence at the decision stage of the proceedings.

58. What’s more, the Opponent has provided no information as to its annual turnover figures relating to its UK sales during the relevant period, nor has it provided any other financial information such as advertising spend etc. that would enable me to determine the scale and frequency of the use of the earlier UK mark. This information should have been readily available to the Opponent, but has not been provided.

59. The only reference to advertising is in relation to the Opponent’s ‘YouTube’ videos which have had unremarkable views and the channel has an insignificant number of subscribers. Since the screenshot produced in evidence is dated outside of the relevant period, it is in any event impossible to determine when the videos were viewed, the territorial reach of those videos, when the channel gained its subscribers, and where those subscribers are based.

60. I find that there are numerous other deficiencies within the Opponent’s evidence provided which I have set out in the following paragraphs.

61. There are several references throughout the body of evidence stating that ‘Thor Appliances’ are available in ‘DID’ stores; however, the ‘DID’ stores evidence only shows three categories of ‘Thor’ products, namely: fridge freezers, washing machines and dishwashers.

²⁶ The earliest date of the invoices being 11 December 2020, and the latest date being 21 January 2022.

62. Throughout the evidence, there are references to 'Thor Appliances' being available in 'DID' stores "*across Ireland*" and on the 'DID' website (such website having a TLD for Ireland). The evidence does not include any information or provide any clarity as to whether 'DID' stores are present in Northern Ireland (and/or mainland UK) since it does not provide details of store locations. What's more, the prices on the 'DID' website are in Euros.

63. 'DID' stores are not included in the list of the Opponent's Northern Ireland suppliers, nor can I determine whether any of the invoices (which are exclusively issued to customers based in Northern Ireland) were issued to 'DID'.

64. Considering the evidential picture as a whole, and taking into consideration the details of the licence agreement, it appears entirely plausible that the 'DID' evidence, and the evidence which references 'Thor Appliances' being available in 'DID' stores "*across Ireland*", is actually relating to the Opponent's use, in Ireland, of its Irish trade marks for 'THOR' (as opposed to use of the Opponent's earlier UK mark in the UK). As such, it is reasonable to conclude that the 'DID' evidence does not relate to the relevant territory i.e. it does not relate to the UK, and that where the evidence refers to the products being made available in 'Ireland' solus, it is a reference to the country of Ireland (not the island of Ireland and not encompassing the UK territory of Northern Ireland).

65. Whilst the Opponent has provided an undated list of business names which it states are distributors of its "*Thor products within Northern Ireland, UK*", and that "*it can be seen from the distributor list that Thor products are widely and readily available across Northern Ireland*", there appears to be no corroborating evidence to support this statement, and in any event, it is not clear from this list which businesses were distributors of 'Thor' products during the relevant period.

66. To illustrate my latter point, I note that the evidence relating to 'DAC Appliances' – a business included in the distributor list, and referred to by the Opponent as its "*Northern Ireland distributor*" – is dated outside of the relevant period. Therefore, I am not able to ascertain whether 'DAC Appliances' was a distributor of the Opponent's products during the relevant period (as the evidence only confirms that they advertised 'Thor' freezers for sale on their website, outside of the relevant period).

67. The Opponent also states that *“our [Northern Ireland] distributors further deliver their products (including our THOR products) into Mainland UK,”* yet there is no evidence provided that supports this statement, including no evidence as to where in mainland UK the Opponent’s goods were sold, what goods were sold, and the quantities sold for example.

68. The evidence informs me that Shomar Limited is a ‘domestic appliances distributor’, and there is nothing to suggest that the company’s business is restricted to the supply of only ‘Thor’ branded products – it may sell / distribute domestic appliances made by manufacturers other than ‘Thor’. With this in mind, I note the following:

(1) the distributor list is titled ‘Address list Accounts receivable – Shomar Limited’. It is merely an address list and does not contain any information as to what products the company sold to those distributors, and whether those products were indeed ‘Thor’ branded products;

(2) the invoice evidence contains details of two products which are not itemised as ‘Thor’ products, in particular, a kettle and a black fridge freezer. There is nothing contained in the Opponent’s other evidence that shows that kettles form part of the ‘Thor Appliances’ range. It is plausible therefore that the ‘kettle’ may not be a ‘THOR’ branded kettle, and there is no sufficiently solid evidence to corroborate whether it is or not.

69. In summary, whilst the Opponent’s evidence makes broad statements that *“Thor Appliances operate in thousands of homes across the island of Ireland”*; that *“Thor products are widely and readily available across Northern Ireland”*; and that their *“distributors further deliver their products (including our THOR products) into Mainland UK”*, the evidence does not support this.

70. The sum of the Opponent’s use in the UK relates to a short period of time during the relevant period i.e. between 11 December 2020 and 21 January 2022,²⁷ wherein the Opponent invoiced UK customers for 30 items that were listed as ‘Thor’ products;

²⁷ Being the date range of the invoices.

those products were chest freezers, fridge freezers and cookers only; and such sales were localised to merely three UK cities/towns, all located in Northern Ireland.

71. I do not have any evidence before me with regard to the features of the domestic appliances market, however, as a consumer myself, I am aware that it is a large sector and it relates to appliances that most likely are present in almost every UK home, such as fridge freezers, washing machines and cookers. Therefore, whilst I am mindful that there is no *de minimis* rule in relation to genuine use, and that the genuine use provision is not there to assess economic success or large-scale commercial use, I cannot ignore the large size of the domestic appliances market in the UK. With that in mind, as well as the various significant deficiencies that I have identified in the Opponent's evidence, I am not satisfied that the sum of the use shown in relation to the UK is sufficient to establish genuine use of (my emphasis) the **earlier UK mark** during the relevant period. The onus is on the Opponent to have filed evidence of genuine use that is sufficiently solid and conclusive – in my view the Opponent has fallen short in this task.

Final Remarks

72. As my finding is that the earlier UK mark has not been put to genuine use, there is no need to consider the claim under section 5(2)(b) as it is irrelevant to the outcome, because, under section 6A of the Act, the registrar shall not refuse to register the applied-for trade mark on the ground that there is an earlier trade mark if the use conditions of the earlier trade mark are not met.

OUTCOME

73. The partial opposition is unsuccessful. Subject to any appeal, trade mark application number 3800360, shall proceed to registration for all the goods applied for in Classes 11 and 20.

COSTS

74. The Applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Applicant the sum of £800 as a contribution

towards the cost of the proceedings. The sum is calculated as follows:

Preparation of the Notice of Defence and Counterstatement	£200
Considering and commenting on the Opponent's evidence	£300
Preparing written submissions	£300
TOTAL	£800

75. I therefore order Maeve Catherine O'Reilly and Jacqueline Adam, to pay Hongkong Dingxin Industry And Trade Limited the sum of **£800**. The sum 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 28th day of July 2023

Daniela Ferrari

For the Registrar