

O/0849/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004077867

BY ZHILIN WONG

TO REGISTER THE TRADE MARK:

semai

Semai

(series of 2)

IN CLASS 28

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 449216

BY DONGGUAN SHENGZHAO ELECTRONIC TECHNOLOGY CO., LTD

Background and pleadings

1. On 19 July 2024, Zhilin Wong (“the applicant”) applied to register the trade mark series shown on the cover page of this decision in the UK. The application was published for opposition purposes on 02 August 2024. Registration is sought for the following goods:

Class 28: Flying Toy Drone for Kids; Flying Orb Ball Toys; Remote-controlled toy planes; Toy aircraft; Radio-controlled toy helicopters; Radio-controlled toy airplanes; Toy airplanes; Drones [toys]; Remote controlled flying toys; Toy balloons.

2. The application was opposed by Dongguan Shengzhao Electronic Technology Co., Ltd (“the opponent”) on 21 August 2024. The opposition is based upon section 5(2)(a) of the Trade Marks Act 1994 (“the Act”) against all applied-for goods.

3. The opponent relies on the following trade mark:

UK00917399809¹

Semai

Filing date: 28 October 2017

Registration date: 12 February 2018

Relying on some goods for which it is registered as follows:

¹ On 1 January 2021 the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UKIPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark now recorded on the UK trade mark register has the same legal status as if it had been applied for and registered under UK law.

Class 8: Manicure sets; Curling tongs; Hand implements for hair curling; Electric hair straighteners; Pedicure sets; Razors, electric or non-electric; Nail files, electric; Tin openers, non-electric.

4. The opponent claims that the marks are identical and the goods are similar and this will give rise to a likelihood of confusion.

5. The applicant filed a counterstatement denying the claims made by the opponent.

6. The applicant is represented by Paul Wong and the opponent is represented by Peng Liu. Neither party filed admissible evidence (which I will address later in the decision) nor requested a hearing. No submissions in lieu were filed. This decision is therefore taken following careful consideration of the papers.

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

Preliminary matters

8. I note that the opponent attempted to file evidence within the initial evidence rounds; however, this was deemed inadmissible and the opponent was asked to re-file. The opponent did not re-file their evidence. The initial Form TM7 from the opponent included claims under sections 5(3), 5(4)(a) and 3(6) which require the filing of evidence to proceed. As no acceptable evidence was filed, these grounds were struck out as per the Registry's letter of 8 October 2025.²

² I note the letter states that the section 5(2)(b) ground will continue however, the ground pleaded by the opponent is section 5(2)(a)

9. Further, the applicant attempted to file evidence on 13 February 2026, after the evidence deadlines had ended. A request to admit the evidence via Form TM9R was submitted on 11 May 2026. The request to file evidence was refused.

Decision

Section 5(2)(a)

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

“5(2) A trade mark shall not be registered if because-

- a. it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, [...] there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

11. The opponent’s mark qualifies as an earlier mark, in accordance with section 6 of the Act. The earlier mark has been protected for more than five years before the application date of the contested mark, however, the applicant did not put the opponent to proof of use. Therefore, the opponent can rely upon all of the goods identified in its Form TM7.

Relevant case law

12. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed

and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Identity of the marks

13. It is a prerequisite of section 5(2)(a) of the Act that the marks at issue be identical. In considering whether marks are identical, I refer to *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, wherein the Court of Justice of the European Union (“CJEU”) held that:

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

14. A word trade mark registration protects the word itself, written in any normal font and irrespective of capitalisation or presentation in bold (see *Bentley Motors Limited v Bentley 1962 Limited*)³. Therefore, the opponent’s mark is identical to both marks within the applicant’s series.

Comparison of Goods

15. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

³ BL O/158/17.

purpose and their method of use and whether they are in competition with each other or are complementary”.

16. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods (or services). In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers

may think that the responsibility for those goods lies with the same undertaking”.

18. The goods at issue are as follows:

Contested goods	Earlier goods
Class 28: Flying Toy Drone for Kids; Flying Orb Ball Toys; Remote-controlled toy planes; Toy aircraft; Radio-controlled toy helicopters; Radio-controlled toy airplanes; Toy airplanes; Drones [toys]; Remote controlled flying toys; Toy balloons.	Class 8: Manicure sets; Curling tongs; Hand implements for hair curling; Electric hair straighteners; Pedicure sets; Razors, electric or non-electric; Nail files, electric; Tin openers, non-electric.

19. Within their Form TM7, the opponent states that the goods are all “likely to be obtained by self-selection from the general retail outlet, especially their online stores such as Amazon”.⁴ Further, they claim that the goods overlap in trade channels.

20. I disagree with the opponent’s submissions. The applicant’s terms are, broadly, flying toys. The opponent’s terms are personal self-care items and non-electric tin openers. The only overlap in users is at a very general level, namely the general public. The nature of the goods differs, as does the purpose. Regarding the trade channels, even if all of the above goods were found within the same stores, they would be in entirely different sections and not found together on the same shelves. The claim that they would all be found on Amazon is not persuasive as they would still be found in different ‘sections’ of the website and a consumer searching for toy aircraft is not likely to be suggested self-care products or tin openers by the website instead. The goods are not in competition nor are they complementary. A general overlap of user is insufficient for a finding of similarity and, as such, I find the goods to be dissimilar.

21. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

⁴ Q9, Page 6 Form TM7

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

22. As I have found no similarity for any of the applicant’s goods, the opposition in relation to them fails here.

Conclusion

23. The opposition fails in its entirety, and the application may proceed to registration, subject to any appeal.

Costs

24. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I award the applicant the sum of **£250**, calculated as follows:

Considering the Notice of opposition and preparing the counterstatement	£250
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Total	£250
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25. I therefore order Dongguan Shengzhao Electronic Technology Co., Ltd to pay Zhilin Wong the sum of £250. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 22nd day of September 2026

**L Nicholas
For the Registrar**