O/0893/23

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL REGISTRATION NO. 1657231 FOR THE TRADE MARK

Mountson

AND

TRADE MARK APPLICATION NO. UK3766670 TO REGISTER AS A TRADE MARK

MOUNTSON

BOTH IN THE NAME OF BIRGER BERTERMANN

IN CLASS 9

AND

IN THE MATTER OF OPPOSITIONS THERETO UNDER NUMBERS 600002445 & 600002446 BY NRG BRAND LIMITED

BACKGROUND AND PLEADINGS

1. On 11 January 2022, International Registration ("IR") No. 1657231 was registered for the word mark **Mountson**[1], based on European Union Trade Mark ("EUTM") No. 018562614 in class 9 with a priority date of 21 September 2021. With effect from the claimed priority date, Birger Bertermann (the holder) designated the United Kingdom for protection of the mark. The designation was accepted and published for opposition purposes on 20 May 2022.

2. On 17 March 2022, Birger Bertermann (the applicant) applied to register trade mark number UK3766670 for the word mark **MOUNTSON** in the United Kingdom. The application was accepted and was published for opposition purposes on 01 April 2022.

3. Both the designation and the application were made in respect of the following (identical) goods:[2]

Class 9: *Apparatus for recording, transmission or reproduction of sound or images; Hi-Fi apparatus, electronic apparatus for transmitting audio and/or video signals, apparatus for processing digital signals, apparatus for storing data, audiovisual, visual and photographic apparatus, cinematographic apparatus and instruments, optical apparatus and instruments; Interactive video game programs; Car radio accessories, namely radio faceplates, cables, plugs, adapters, connectors, mounting brackets; Antennas, antenna adapters, antenna rods, antenna extensions, exclusively intended for the spare parts vehicle market; Car radios, Loudspeakers, Reversing cameras; CAN bus adapters, exclusively intended for the spare parts vehicle market; CD interchangeable adapters, cables for the transmission of sounds and images, exclusively intended for the spare parts vehicle market; Speaker mounting brackets, Televisions and radio devices and equipment, Audio*

[1] I note that although it is registered as a 'word' mark, the mark appears in the format displayed on the cover page of this decision on the UKIPO system for International Registrations.
[2] I note that the only differences between the specifications of the goods of the designation and the application is in regard to the text case of some terms, and not the terms themselves.

apparatus, Video devices, Compact disc recorders, DVD recorders, CD players and DVD players, MP3 players, including cameras; Wireless weather stations; Loudspeakers, loudspeaker cabinets, Loudspeaker cables, Loudspeaker systems, Loudspeaker systems, Cases for loudspeakers, Speaker switches, Loudspeaker units, Speaker mounting brackets, Loudspeaker drive units, Speaker docks, Speakers [audio equipment]; Wireless speakers, Portable speakers, Smart speakers; Wireless audio speakers, Loudspeaker stands [adapted for], Portable speaker docks, Racks for loudspeakers, Horns for loudspeakers, Signal processors for audio speakers; Audio speakers for automobiles, Speakers for computers, Speakers for record players; Cabinets for loudspeakers, Pairable wireless speakers; Mobile phone speakers, Speakers for video conferencing, Audio speakers for vehicles; Audio speakers for vehicles, Speakers for portable media players, Loudspeakers with built in amplifiers, Personal speakers, Sound filters made of cloth, for radio apparatus; Electronic audio signal processors for compensating sound distortion in speakers, Desks or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free; CAN bus adapters, exclusively intended for the spare parts vehicle market.

4. Both the designation and the application are opposed by NRG Brand Limited ("the opponent"). The oppositions were each filed on 29 June 2022, and are both based upon Section 5(2)(a) and Section 3(6) of the Trade Marks Act 1994 ("the Act").[3] The oppositions are directed against all of the goods in the designation/application.

5. These oppositions have been consolidated. For ease, I will refer to Birger Bertermann as "the applicant".

6. The opponent relies upon the following mark:

Mountson

[3] See Preliminary Issues under paragraphs 12 - 13 of this decision.

UK trade mark registration number 3536487
Filing date: 23 September 2020
Registration date: 15 January 2021
Registered in Class 6
Relying on all goods, namely *Metal brackets*.

7. Under section 5(2)(a), for both oppositions, the opponent submits that the compared trade marks are all exclusively for the word element “Mountson” and are visually and phonetically identical. It submits that many of the opposed goods are electrical appliances which may include or require metal brackets to the extent that the average consumer may be confused and will wrongly believe that the respective goods come from the same or economically-linked undertakings.

8. Under section 3(6), for both oppositions, the opponent submits that the applicant was or should have been aware of the earlier mark and that the applicant had no genuine intention to use the opposed marks, but instead had a “detailed plan ... to prevent the opponent from using the trademark Mountson” and that as such, the opposed designation and application were each submitted in bad faith.

9. The applicant filed counterstatements admitting that the marks at issue are identical, all being for the word ”Mountson”. However, the applicant denies that there is any similarity between the goods and as such, it submits that the opposition under section 5(2)(a) should be rejected. The applicant further denies that either the UK designation of the IR or the UK application were filed in bad faith and that the oppositions should be dismissed in their entirety.

10. Both parties filed written submissions; only the opponent filed evidence. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

11. In these proceedings, the opponent is represented by Daniel Dimov and the applicant is represented by Forresters IP LLP.[4]

Preliminary Issues

12. Each of the oppositions were originally filed as Fast Track opposition proceedings, under 5(2)(a) grounds. On 31 August 2022, the opponent filed Form TM7G to request that grounds under Section 3(6) of the Act be added to each of the oppositions.

13. Having considered the submissions of both parties, a Hearing Officer issued the decision to allow the additional ground, and in so doing, directed that the Fast Track proceedings for both cases be converted to standard oppositions which allows for the filing of evidence, which is essential for a 3(6) ground of opposition.

EVIDENCE AND SUBMISSIONS

14. The opponent filed evidence in support of the opposition in the form of the witness statement of Glenn Brady MccLelland dated 16 January 2023, which is accompanied by 22 exhibits. Mr MccLelland is a Director of the opponent, a position he first held on 28 September 2020.

15. The opponent also filed written submissions on 17 January 2023; the applicant filed written submissions in lieu dated 24 May 2023.

16. I have taken the evidence and submissions into account in reaching my decision and will refer to the relevant material throughout the decision.

DECISION

17. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in

[4] Form TM33 appointing Forresters IP LLP as representatives to the applicant was filed on 9 September 2022.

accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

Section 5(2)(a) –

18. Section 5(2)(a) is relied on and reads 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 trade mark is protected, or
>
> …
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

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

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

20. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process less than 5 years before either the application date of the contested mark or the priority date claimed for the UK designation, it is not subject to the use provisions contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon it in relation to all of the goods indicated.

21. It is a prerequisite of Section 5(2)(a) that the respective trade marks are identical.

22. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ("CJEU") held that:

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

Identity of the marks

23. The respective trade marks are as follows:

Opponent's trade mark	**Applicant's trade marks**
Mountson	The IR: **Mountson** The application mark: **MOUNTSON**

24. The opponent's mark and the IR each consist of the same single word **Mountson** presented in a standard typeface in title case with no other elements to contribute to the overall impression, while the application mark consists of the same word **MOUNTSON** presented in a standard typeface in capital letters with no other elements to contribute to the overall impression.

25. It is well established that a 'word mark' protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks: *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14.[5]

[5] At [21].

26. The respective trade marks are self-evidently identical, and this has not been disputed by the applicant.

Comparison of goods

27. Section 60A of the Act provides:

> "(1) For the purposes of this Act goods and services —
>
> (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;
>
> (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
>
> (2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979."

28. The goods to be compared are:

Opponent's goods	**Applicant's goods**
Class 6 *Metal brackets*.	Class 9 *Apparatus for recording, transmission or reproduction of sound or images; Hi-Fi apparatus, electronic apparatus for transmitting audio and/or video signals, apparatus for processing digital signals, apparatus for storing data, audiovisual, visual and photographic apparatus, cinematographic apparatus and instruments, optical apparatus and*

	instruments; Interactive video game programs; Car radio accessories, namely radio faceplates, cables, plugs, adapters, connectors, mounting brackets; Antennas, antenna adapters, antenna rods, antenna extensions, exclusively intended for the spare parts vehicle market; Car radios, Loudspeakers, Reversing cameras; CAN bus adapters, exclusively intended for the spare parts vehicle market; CD interchangeable adapters, cables for the transmission of sounds and images, exclusively intended for the spare parts vehicle market; Speaker mounting brackets, Televisions and radio devices and equipment, Audio apparatus, Video devices, Compact disc recorders, DVD recorders, CD players and DVD players, MP3 players, including cameras; Wireless weather stations; Loudspeakers, loudspeaker cabinets, Loudspeaker cables, Loudspeaker systems, Loudspeaker systems, Cases for loudspeakers, Speaker switches, Loudspeaker units, Speaker mounting brackets, Loudspeaker drive units, Speaker docks, Speakers [audio equipment]; Wireless speakers, Portable speakers, Smart speakers; Wireless audio speakers, Loudspeaker stands [adapted for], Portable speaker docks, Racks for loudspeakers, Horns for loudspeakers, Signal processors for audio speakers; Audio speakers for automobiles, Speakers for computers, Speakers for record players; Cabinets for loudspeakers,

	Pairable wireless speakers; Mobile phone speakers, Speakers for video conferencing, Audio speakers for vehicles; Audio speakers for vehicles, Speakers for portable media players, Loudspeakers with built in amplifiers, Personal speakers, Sound filters made of cloth, for radio apparatus; Electronic audio signal processors for compensating sound distortion in speakers, Desks or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free; CAN bus adapters, exclusively intended for the spare parts vehicle market.

29. In *Gérard Meric v OHIM,* Case T-133/05, the General Court ("GC") stated that:

> "In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".[6]

30. In *Canon*, Case C-39/97, the CJEU stated that:

> "In assessing the similarity of the goods or services concerned, … all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".[7]

[6] Paragraph 29
[7] Paragraph 23

31. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* ("*Treat* ") [1996] R.P.C. 281 include an assessment of users and of the channels of trade of the respective goods and/or services.

32. 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. In *Boston Scientific Ltd v OHIM*, Case T-325/06, 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".[8]

33. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."[9]

34. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

[8] Paragraph 82
[9] Paragraph 5

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. … Nevertheless the principle should not be taken too far. ... Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."[10]

35. The opponent submits that there is a strong relationship between the opponent's products, being metal brackets, and the goods covered by the opposed applications, and as way of example, highlights the earlier mounts for loudspeakers and "*Desks or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free".* Meanwhile, the applicant submits that the nature of the respective goods "is very different", and that complementarity is not relevant as the class 6 goods are not indispensable or important to the user of the class 9 goods.

36. I am mindful of the fact that the Nice Classification is purely administrative,[11] and that the goods are not to be automatically found to be dissimilar simply because they fall in a different class.

Car radio accessories, namely … mounting brackets; Speaker mounting brackets, … ; … Speaker mounting brackets … .

37. I note the repetition of the exact same term "*Speaker mounting brackets"* within the applicant's specification. I further note that where the term "namely", is used, the scope of protection is restricted to those named goods only, rather than encompassing all goods under the preceding wider term. The broad term "brackets" falls in several different classes in the Nice Classification and is classified according to either the material of which the brackets are made (i.e. metal brackets in class 6), while non-metal brackets are found in Classes 7, 9, 12, 19 and 20, according to their purpose. I consider the applicant's mounting brackets in Class 9 to be similar in method of use and purpose (i.e. to support something) to the opponent's "*Metal*

[10] Paragraph 12
[11] See *Mould Pro* decision Case T-794/21 at {22-28].

brackets", and the goods may also be in competition, with the user selecting specifically adapted brackets for the purpose at hand, or they may select more general metal brackets which serve the same purpose. There will also be an overlap in channels of trade. Overall, I consider the applicant's mounting brackets in Class 9 to be similar to the opponent's "*Metal brackets"* in Class 6 to a high degree.

… Desks or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free.

38. While I do not dispute the opponents submissions that metal brackets can be used for fixation of loudspeakers and magnetic phone holders, I do not consider a bracket in itself to be the same as a desk or car mounted unit: I perceive the term 'unit' to imply more than just a plain bracket, and I am mindful of the guidance in *YouView* not to apply too liberal an interpretation. Further, I note that the applicant's goods incorporate a loudspeaker, rendering the goods a further step removed from the opponent's "*Metal brackets"* in Class 6. While there is likely to be some sort of fixing component included in the applicant's "*… Desks or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free"*, I consider the goods to be different in nature and method of use, although there is an overlap in purpose (i.e. to fix or mount something to a surface). However, I consider the fundamental purpose of the applicant's goods is "… *to allow a telephone handset to be used hands-free"*. Consequently, if there is any similarity between the goods, it is to a very low degree.

… loudspeaker cabinets, … Loudspeaker stands [adapted for], … Racks for loudspeakers, … Cabinets for loudspeakers… .

39. To my understanding, loudspeaker stands and cabinets are usually free standing, and as such do not use brackets to fix them to the wall. Even in cases where the applicant's goods may utilise brackets, I consider the fundamental nature of the respective goods to be different, as is the purpose and method of use to the opponent's "*Metal brackets"* in Class 6. There may be an overlap in users, and a degree of competition between the goods, in as much that the consumer may select a wall bracket on which to mount the speakers, rather than an adapted stand or

cabinet. While there may be an overlap in trade channels, the goods are unlikely to be found in close proximity. As per the guidance in *Boston Scientific*, I do not consider the opponent's "*Metal brackets"* to be important to the applicant's goods to the degree that the average consumer would perceive them as emanating from the same undertaking. In the absence of evidence to the contrary, I find the goods to be dissimilar.

Apparatus for recording, transmission or reproduction of sound or images; Hi-Fi apparatus, electronic apparatus for transmitting audio and/or video signals, apparatus for processing digital signals, apparatus for storing data, audiovisual, visual and photographic apparatus, cinematographic apparatus and instruments, optical apparatus and instruments; Interactive video game programs; Car radio accessories, namely radio faceplates, cables, plugs, adapters, connectors, …; Antennas, antenna adapters, antenna rods, antenna extensions, exclusively intended for the spare parts vehicle market; Car radios, Loudspeakers, Reversing cameras; CAN bus adapters, exclusively intended for the spare parts vehicle market; CD interchangeable adapters, cables for the transmission of sounds and images, exclusively intended for the spare parts vehicle market; … , Televisions and radio devices and equipment, Audio apparatus, Video devices, Compact disc recorders, DVD recorders, CD players and DVD players, MP3 players, including cameras; Wireless weather stations; Loudspeakers, … , Loudspeaker cables, Loudspeaker systems, Loudspeaker systems, Cases for loudspeakers, Speaker switches, Loudspeaker units, … , Loudspeaker drive units, Speaker docks, Speakers [audio equipment]; Wireless speakers, Portable speakers, Smart speakers; Wireless audio speakers, … , Portable speaker docks, … , Horns for loudspeakers, Signal processors for audio speakers; Audio speakers for automobiles, Speakers for computers, Speakers for record players; … , Pairable wireless speakers; Mobile phone speakers, Speakers for video conferencing, Audio speakers for vehicles; Audio speakers for vehicles, Speakers for portable media players, Loudspeakers with built in amplifiers, Personal speakers, Sound filters made of cloth, for radio apparatus; Electronic audio signal processors for compensating sound distortion in speakers, …; CAN bus adapters, exclusively intended for the spare parts vehicle market.

40. I acknowledge that the user may wish to mount some of the applicant's above listed goods, and as such, will need some sort of bracket or fixing to do so. While the applicant's finished product may be reliant on the opponent's goods, that in itself does not make them similar in nature: *Les Éditions Albert René v OHIM*, Case T-336/03.[12] I do not find the goods to be complementary in a trade mark sense as while it is possible that the same undertaking would provide the component parts and the finished article, I do not consider that the average consumer would automatically expect this to be the case for "*metal brackets"* and the applicant's various goods in Class 9, many of which are electrical items, or accessories for such goods. While there will be an overlap in users, the respective goods are different in nature, purpose and method of use and would not be found in close proximity in retail outlets. Overall, I consider the competing goods to be dissimilar.

41. A degree of similarity between the goods is essential for there to be a finding of likelihood of confusion: *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA. In relation to the goods which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(a), I will take no further account of those goods, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

42. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

43. The average consumer for the competing goods will most likely be the general public, with the goods in common sold through a range of channels, including hardware stores and their online equivalents. In bricks and mortar stores, the goods will be displayed on shelves where they will be viewed and self-selected by the

[12] At [61].

consumer, and a similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a web page. The selection process will be a predominantly visual one, although aural considerations will play a part. Although the price of the goods can vary, on balance, the cost of the purchase is likely to be relatively low, with considerations such as size and strength of the product being taken into consideration. Considered overall, I find that the level of attention will be to a medium degree when selecting the goods.

Distinctive character of the earlier mark

44. The more distinctive the earlier mark, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

45. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

46. The opponent's mark comprises the single word "Mountson", which is likely to be perceived by the average consumer as either an invented word with no semantic content, or possibly as a surname, although it is not a surname with which I am familiar. I remind myself that the opponent's goods are aimed at the general public. Even where it is seen as a surname, I do not consider "Mountson" to be a common name in the UK, and in my view, it is more likely to be perceived as an invented word with no allusive qualities in respect of the goods at issue. Overall, I consider the opponent's mark to be highly distinctive.

47. I note that the opponent has filed evidence, including use of the mark. Given the high degree of inherent distinctive character of the mark, I do not consider that examining that evidence to determine whether the distinctiveness of the mark has been shown to be enhanced through use in the UK during the relevant period would elevate the mark to a degree that would greatly improve the opponent's already strong position on this front.

Likelihood of confusion

48. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

49. I have found the earlier mark to be inherently highly distinctive, and that the average consumer will pay a medium degree of attention during selection of the goods. Given that I have found the competing marks to be identical, I consider there to be a likelihood of direct confusion between the marks in relation to all the goods for which a degree of similarity of medium or higher was found, but not for those goods which were considered similar to only a very low degree.

50. The opposition under section 5(2)(a) succeeds in relation to the following goods only:

Class 9
Car radio accessories, namely … , mounting brackets; Speaker mounting brackets, … ; … Speaker mounting brackets, … .

Section 3(6)

51. Section 3(6) of the Act states:

> "(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

52. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121, the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ,* Case C-104/18 P, *Hasbro, Inc. v European Union Intellectual Property Office ("EUIPO"),* Case T-663/19, *pelicantravel.com s.r.o. v OHIM,* Case T-136/11, and *Psytech International Ltd v OHIM,* Case T-507/08. Floyd LJ summarised the law as follows:

> "The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacilik* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacilik* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]".[13]

53. The opponent's pleaded case of bad faith is that the applicant was or should have been aware of the earlier mark and that the applicant had no genuine intention to use the opposed marks. It further submits that the applicant "created a plan" aiming to prevent the opponent from selling goods/services under the "Mountson" trade mark.

[13] Paragraph 67.

54. According to Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person in *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are as follows:

> (1) What, in concrete terms, was the objective that the party alleged to have acted in bad faith has been accused of pursuing?
> (2) Was that an objective for the purposes of which the contested application could not properly be filed?
> (3) Has it been established that the contested application was filed in pursuit of that objective?[14]

55. It is necessary to ascertain what the applicant knew at the relevant date: see *Red Bull GmbH v Sun Mark Limited & Anor* [2012] EWHC 1929 (Ch), paragraph 137. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors*, [2008] EWHC 3032 (Ch), paragraph 167.[15]

56. The relevant date for the opposition under **600002445** is 21 September 2021, and 17 March 2022 for the opposition under **600002446**.

Assessment of the evidence

57. In his witness statement, Mr MccLelland describes the contents of the accompanying exhibits as follows:

[14] Paragraph 8.
[15] Approved by the Court of Appeal in *Hotel Cipriani Srl & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2010] EWCA Civ 110.

Exhibit 1, Exhibit 2, Exhibit 5, Exhibit 11, Exhibit 12, Exhibit 13, Exhibit 16 and Exhibit 17 show that the Opponent was using the trademark Mountson in commerce prior to the 21st of September 2021, the earliest priority date of the opposed application No. WO0000001657231.

Exhibit 3 shows that the Opponent applied for UK trademark UK00003536487 for "MOUNTSON" on the 23rd of September 2020, almost an year prior to the earliest priority date of the opposed application No. WO0000001657231.

Exhibit 4 shows that the Opponent presented extensive evidence with regard to EU cancellation proceedings No. 000053159 against the EU Trademark Registration No. 018562614 for Mountson, owned by Birger Bertermann.

Exhibit 6 shows that a representative of the Opponent sent an email to Mr Gerald Ram on the 16th of August 2021 informing him about the website of the Opponent and Opponent's business activities under the trademark "MOUNTSON".

Exhibit 7 shows that Gerald Ram and the Applicant knew each other because Mr Gerald Ram posted a comment under a Facebook post of the Applicant dated the 24th of December 2020.

Exhibit 8 shows that Gerald Ram and the Applicant knew each other because Mr Gerald Ram posted a comment under a Facebook post of the Applicant dated the 19th of October 2020.

Exhibit 9 shows that Gerald Ram and the Applicant knew each other because Mr Gerald Ram posted a comment under a Facebook post of the Applicant dated the 14th of June 2020.

Exhibit 10 shows that Gerald Ram and the Applicant knew each other because Mr Gerald Ram posted a comment under a Facebook post of the Applicant dated the 14th of July 2018.

Exhibit 14 and Exhibit 15 shows that the Opponent raised awareness about the trademark Mountson prior to the 21st of September 2021, the earliest priority date of the opposed application No. WO0000001657231 application.

Exhibit 18, Exhibit 19, and Exhibit 20 show that metal brackets can be used for the fixation of loudspeakers.

Exhibit 21 shows that metal brackets can be used for the fixation of magnetic phone holders.

Exhibit 22 shows that the Applicant and Mr Gerald Ram were a part of the management team of a company called XRROSS COFFEE.

58. Exhibits 1, 2, 5, 11, 12, 13, 14, 15 all relate to use of the earlier mark prior to the priority date claimed for the designation of the contested mark, and the advertising and sale of goods under the mark, while exhibits 18 – 21 concern uses of the type of goods at issue sold by third parties. Exhibit 3 is a print-out showing registration details of the earlier mark at the UKIPO. Exhibits 16 and 17 are copies of distribution agreements between the opponent and third parties, although I note that the United Kingdom is not included in the relevant territory for either agreement. That the opponent was using the mark on the goods at issue prior to the filing date/date of designation of the contested marks is not in dispute. While I note that the exhibits

show the mark being used on the goods by the opponent through the likes of Amazon UK, this in itself does not prove that the applicant was aware of the mark.

59. Exhibits 6 is a copy of an email sent by Mr MccLelland to a Mr Gerald Ram updating him on the opponent's website and the availability of two new products. Exhibits 7 - 10 show a relationship between the applicant and Mr Ram through the comments posted on Facebook - these comments are in German and no translation has been provided: See *Pollini*, BL O/146/02. Even had a translation been provided, these exhibits do not appear to be particularly compelling. Exhibit 22 is a screen shot of a webpage showing that Mr Ram and the applicant are both on the same management team of "XRROSS COFFEE". However, this does not prove that the applicant and Mr Ram were conspiring against the opponent.

60. Meanwhile, Exhibit 4 is in relation to evidence presented by the opponent for EU cancellation proceedings between the parties. While the EU proceedings themselves have no bearing on the decision before me, I accept that this exhibit demonstrates the relationship between Mr Ram and both the applicant and the opponent. As such, I consider this evidence pertinent to the claim of bad faith before me.[16] I note that the Annexes mentioned in Exhibit 4 have not been provided, and consequently, the extent of the content of the exhibit is somewhat diminished.

61. In his written submissions, the opponent states that it "raised awareness about its Mountson products by using two PowerPoint presentations" (Exhibits14-15). However, there is nothing to show where or to who these presentations were directed. I note that Exhibit 4 refers to the FLEXSON products with which it states the applicant is associated as being in direct competition with the opponent's goods under the MOUNTSON trade mark. In the exhibit, it claims that the contested application (in the EU proceedings) was made in order to prevent the opponent from engaging in fair competition and that there was no intention to use the contested mark. I note that no mention of the FLEXSON mark has been made anywhere else in the evidence provided by the opponent in the proceedings before me. However, regardless of

[16] I note the applicant's written submissions dated 24 May 2023 regarding the validity of this piece of evidence (see, in particular, paragraphs 22-23), but I see no reason why it should not be accepted in these proceedings. I therefore consider the exhibit at face value.

whether the applicant has a financial and commercial interest in other trade marks, this does not prove that he had no intention to use the marks at issue. Neither have I been furnished with evidence of any "detailed plan ... to prevent the opponent from using the trademark Mountson" in the UK on the part of the applicant.

62. I remind myself that bad faith is a serious allegation and it is for the party alleging it to prove it. It is not enough to establish facts which are as consistent with good faith as bad faith.[17] I cannot agree with the opponent's submissions that "Exhibits 1 to 17 clearly indicate that, prior to the filing the opposed applications, the Opponent knew about the Opponent's business trading under the trademark Mountson and filed the opposed applications to prevent the Opponent from using its trademark Mountson in relation to its products …" (SIC).[18] Overall, I do not find the evidence sufficient to establish that either the application or the UK designation of the IR were made in bad faith.

63. Accordingly, the claim under Section 3(6) fails.

OUTCOME

64. The opposition has failed under the 3(6) grounds, but the opponent has been partially successful under Section 5(2)(a) of the Act in relation to the goods listed under paragraph 52 of this decision. Subject to any successful appeal, the application by Birger Bertermann may proceed to registration and the IR may be granted protection in the UK in respect of the remaining goods only:

Class 9

Apparatus for recording, transmission or reproduction of sound or images; Hi-Fi apparatus, electronic apparatus for transmitting audio and/or video signals, apparatus for processing digital signals, apparatus for storing data, audiovisual, visual and photographic apparatus, cinematographic apparatus and instruments, optical

[17] *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).
[18] See paragraph 6 of the opponent's written submissions filed on 17 January 2023. I take the first reference to the opponent as written in error and should read as "Applicant".

apparatus and instruments; Interactive video game programs; Car radio accessories, namely radio faceplates, cables, plugs, adapters, connectors; Antennas, antenna adapters, antenna rods, antenna extensions, exclusively intended for the spare parts vehicle market; Car radios, Loudspeakers, Reversing cameras; CAN bus adapters, exclusively intended for the spare parts vehicle market; CD interchangeable adapters, cables for the transmission of sounds and images, exclusively intended for the spare parts vehicle market; Televisions and radio devices and equipment, Audio apparatus, Video devices, Compact disc recorders, DVD recorders, CD players and DVD players, MP3 players, including cameras; Wireless weather stations; Loudspeakers, loudspeaker cabinets, Loudspeaker cables, Loudspeaker systems, Loudspeaker systems, Cases for loudspeakers, Speaker switches, Loudspeaker units, Loudspeaker drive units, Speaker docks, Speakers [audio equipment]; Wireless speakers, Portable speakers, Smart speakers; Wireless audio speakers, Loudspeaker stands [adapted for], Portable speaker docks, Racks for loudspeakers, Horns for loudspeakers, Signal processors for audio speakers; Audio speakers for automobiles, Speakers for computers, Speakers for record players; Cabinets for loudspeakers, Pairable wireless speakers; Mobile phone speakers, Speakers for video conferencing, Audio speakers for vehicles; Audio speakers for vehicles, Speakers for portable media players, Loudspeakers with built in amplifiers, Personal speakers, Sound filters made of cloth, for radio apparatus; Electronic audio signal processors for compensating sound distortion in speakers, Desks or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free; CAN bus adapters, exclusively intended for the spare parts vehicle market.

COSTS

65. In these consolidated proceedings, both parties have enjoyed a share of success, with the greater part going to the applicant, who is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. I also acknowledge the submissions made prior to the earlier hearing relating to the additional grounds. Taking into account the partial extent of the success, I have made a reduction to the costs to reflect this, and as such, I consider the following to be reasonable:

Considering the two notices of opposition and preparing counterstatements:	£400
Preparing written submissions in lieu of both hearings:	£500
Total:	**£900**

66. I therefore order NRG Brand Limited to pay Birger Bertermann the sum of £900. The above 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 19th day of September 2023

Suzanne Hitchings
For the Registrar,
the Comptroller-General