O/1018/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO. 3694874
IN THE NAME OF PARABOLICA LTD
IN RESPECT OF THE TRADE MARK

TESLA

IN CLASSES 12, 25 & 28

AND

THE OPPOSITION THERETO UNDER NO. 432471
BY TESLA HOLDING A.S.

Background and pleadings

1. PARABOLICA LTD ("the applicant") applied to register the trade mark application no. 3694874 for the mark TESLA in the UK on 14 September 2021. The application was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union and the EU filing date was 17 April 2007. It also holds a priority date of 17 October 2006, as claimed from an earlier filed Austrian trade mark application. It was accepted and published in the Trade Marks Journal on 7 January 2022 in respect of the following goods:

> Class 12: *Passenger vehicles included in class 12; Electric motorcycles, included in class 12; Electrically powered mopeds, included in class 12; Electrically operated motorcycles, included in class 12; Electrically operated bicycles, included in class 12; Electrically operated tractors, included in class 12, electrically operated motor homes and caravans, included in class 12; Aircraft, included in class 12, namely motorised and non-motorised lighter-than-air electrically operated aircraft and motorised and non-motorised heavier-than-air electrically operated aircraft; Electrically powered space vehicles, included in class 12; Electrically operated rail vehicles, included in class 12; Electrically powered tracked vehicles, included in class 12; Electrically powered water vehicles, included in class 12, namely underwater vehicles and electrically powered underwater vehicles; Electrically powered amphibious vehicles, included in class 12; Electrically operated wheelchairs; electrically powered mobility scooters; Electric golf buggies; Electric prams; Vehicle parts, included in class 12, namely bodywork components; Drives; Motors; Chassis components, in particular brake parts; Springs; Steamers; Steering; Wheel suspensions; Wheels; Tyres; Hub caps; Wheel trims; Axle suspensions; Transmission components, in particular couplings, gearboxes, chains, transfer cases, cardan shafts, differential gears; Accessories for vehicles, included in class 12, Namely trailer hitches, Bicycle carriers, Roof racks, Travel baggage Of the following materials, Leathers, Aluminum, Titanium, Fabrics made from natural fibres, Namely cotton, Jute, Flax, Viscose, restraints and Fine animal hairs (wool), synthetic fibre industry and Plastics, For transport in electric vehicles, Child's seats, Tarpaulins, namely The aforesaid relating to the*

following vehicles, electric land vehicles, Electrically operated air vehicles, Electric amphibious vehicles and Electrically powered water vehicles; Snow chains, namely the aforesaid for cars, two-wheeled vehicles, buses, utility vehicles, forestry machines, military vehicles, 4x4 and SUV vehicles, tractors, electrically operated special-purpose vehicles.

Class 25: *Clothing, footwear, headgear.*

Class 28: *Gymnastic and sporting articles; games.*

2. TESLA Holding a.s. ("the opponent") opposed the trade mark on the basis of section 5(1), 5(2)(a), 5(3) and 3(6) of the Trade Marks Act 1994 ("the Act"). The section 5 grounds are on the basis of its four earlier trade marks below:[1]

1. UK comparable[2] Trade Mark no. 903411758 for the mark TESLA ("the first earlier mark").
   Filing date: 24 October 2003
   Registration date: 1 June 2005.
   Relying on goods in classes 9, 10 and 11 and set out at Annex A to this decision.

2. UK trade mark no. 1254000 for the mark TESLA ("the second earlier mark".
   Filing date: 9 November 1985
   Registration date: 22 June 1990
   Relying on goods in classes 9, 10 and 11 set out at Annex B to this decision.

[1] There have been a considerable amount of procedural amendments and some confusion regarding the marks relied upon by the opponent in these proceedings. Following an application to add earlier rights into the proceedings, on 13 March 2024, the Tribunal wrote to the parties to confirm it considered the opponent to be relying on these four marks only in respect of the grounds I have set out.

[2] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry 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 is 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, and retains its original priority date.

3. UK comparable trade mark no. 903411923 for the mark below ("the third earlier mark"):

Filing date: 24 October 2003

Registration date: 22 February 2005

Relying on goods in classes 9, 10 and 11 set out at Annex C to this decision.

4. UK comparable trade mark no. 916177487 for the mark below ("the fourth mark"):

Filing date: 2 February 2017

Registration date: 27 November 2018

Relying on goods in class 16 as set out at Annex D to this decision.

3. In respect of the opposition based on section 5(1) of the Act, the opponent claims the marks are identical and the goods are identical. In respect of the opposition based on section 5(2)(a) of the Act, the opponent argues that the respective goods are identical or similar and that the marks are identical, and that as such, there will be a likelihood of confusion between the same.

4. In respect of the opposition based on section 5(3) of the Act, the opponent claims to hold a reputation for its mark in respect of all of its goods relied upon, and that use of the contested mark would lead consumers to believe the parties are economically connected and take unfair advantage of the opponent's reputation under the marks.

5. In respect of the opposition based on section 3(6) of the Act, the opponent claims the applicant is a dormant company and is therefore not in a position to use the mark filed. It argues that the applicant's objective in filing its application was either to deliberately take unfair advantage of the opponent's goodwill and cause confusion

and/or detriment, or to file the application without any intent to use the same, in order to "garner […] a financial award, from the opponent, within the United Kingdom's jurisdiction". It is also argued that its intention was to file the trade mark without any intention to use the same, in order to negotiate payment of a licence fee or a fee for an assignment of the rights from the opponent.

6. The applicant filed a counterstatement denying that the opponent has any "reputation, standing, or other prior rights in respect of the sign TESLA and the goods covered by the application in classes 12, 25 and 28" and denies that the opponent's goods are "confusingly similar" to the applicant's goods. It also denies that the applicant has no intention to use the trade mark, submits that the trade mark was created genuinely, and denies that it was "merely taking over third party rights".

7. The applicant also requested proof of use of the opponent's first earlier mark only.[3] However, as this mark had not been registered for a period of five years at the priority date of the contested application, it is not subject to proof of use in these proceedings in accordance with section 6A of the Act. The opponent may therefore rely on all of the goods listed under its earlier rights relied upon in these proceedings.

8. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. The opponent also filed submissions alongside its evidence, which will not be summarised but will be referred to if necessary.

9. A Hearing took place before me via telephone conference on 21 March 2025. The opponent has been represented throughout these proceedings by Stuart Southall of Kang Solicitors and was represented at the hearing by the same. The applicant represents itself in these proceedings and opted not to attend or be represented at the hearing, nor did it file any submissions in lieu of the same.

[3] Whilst I note the opponent filed an amended version of its TM7 adding additional marks after the applicant filed its counterstatement, I also consider the applicant was provided with a period of two weeks to make amendments to its original TM8 and it chose not to make any amendments. I therefore consider the request for proof of use extends only as far as the opponent's first earlier mark, which was specifically referenced in answer to question 7 of the form.

10. 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.

Earlier rights and relevant dates

11. The contested mark was applied for pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union. This provision allows those who had a pending EU Trade Mark ("EUTM") at the end of the transition period to file a comparable UK application and claim the filing or priority date of the earlier EUTM as the priority date for the UK application. At IP completion day, namely 31 December 2020, the applicant had a relevant pending EUTM and it filed the comparable UK trade mark application within the nine month period allowed for doing so. Therefore, in accordance with section 6(2A) and paragraph 25 of Schedule 2A of the Act, the Applicant is entitled to rely on the priority date of its EUTM as the priority date for its comparable UK application for the purpose of establishing which rights take precedence. This means that the priority date of the EUTM, which was 17 October 2006, is the relevant date for determining priority against any conflicting third party trade mark applications. However, the relevant date for determining whether the trade mark is subject to refusal on absolute grounds, in this case the section 3(6) ground, is the actual filing date of the application in the UK. Consequently, the relevant date for the purposes of the opposition based on section 3(6) of the Act is 14 September 2021.

12. I note at this stage that the fourth mark relied upon by the opponent in its opposition based on section 5(1) and section 5(2)(a) of the Act has a filing date of 2 February 2017. This falls after the priority date of the contested application in 2006. It is therefore not a valid earlier right in accordance with section 6 of the Act. I will therefore not consider the opponent's reliance on this mark any further. In respect of the remaining marks, by virtue of their filing dates which fall prior to the priority date of the contested application, in addition to their subsequent registration, these constitute earlier marks

in accordance with section 6 of the Act and will therefore be considered in the context of these grounds.

Evidence

13. The opponent filed its evidence in the form of a witness statement in the name of Jan Vyborny, Head of the Trade Mark and Patent Department for the opponent. The statement introduces a single exhibit, namely Exhibit JV1, which comprises a number of different documents and 264 pages. The majority of the evidence appears to go to the determination of similar issues within other proceedings outside of the UK, as well as to the similarity of various goods. There is also some limited evidence going to the use of the earlier marks. The statement is dated 16 October 2023.

Decision

Section 5(1)

14. Section 5(1) of the Act is as follows:

> 5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

15. Section 5(A) of the Act is as follows:

> 5A Grounds for refusal relating to only some of the goods or services 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.

16. At the hearing, I noted to Mr Southall for the opponent that this ground is reliant on both the marks and the goods being identical. Mr Southall was initially under the impression that the earlier marks covered goods in class 12, and after establishing

that they did not, I asked if he still intended to rely on this ground. He indicated that it would be foolish to do so in the circumstances. I take this as an indication from Mr Southall that the opponent no longer wishes to pursue the 5(1) grounds of opposition. I note in any case if I am wrong to do so, that I find no identity between the goods as filed and the goods relied upon by the opponent under its earlier marks in these proceedings. This ground must therefore fail.

Section 5(2)(a)

17. 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".

18. Section 5A of the Act (as previously set out) is also relevant under this ground.

19. Section 5(2)(a) of the Act is dependent on the marks being identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA,* Case C-291/00, the Court of Justice of the European Union 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."

20. The first and second marks relied upon by the opponent are the mark TESLA. This is clearly identical to the contested mark, which is also TESLA. However, the third mark relied upon by the opponent is as below:

Earlier mark	Contested mark
	TESLA

21. The earlier mark is stylised, and contains a number of elements that are not present in the contested mark, including the star, the wave and the circle elements. These differences are not, in my view, so insignificant that they may go unnoticed by the average consumer, and as such the marks cannot be considered identical. The opposition based on section 5(2)(a) therefore cannot succeed based on the opponent's third earlier mark, and I will continue with this ground on the basis of its first and second earlier mark only.

22. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of the goods

23. 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 of its judgment 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 purpose and their method of use and whether they are in competition with each other or are complementary".

24. 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.

25. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Each involved a straining of the relevant language, which is incorrect. 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."

26. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, the General Court ("GC") stated that there is complementarity where:

> "...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".

27. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the GC stated that:

> "29. 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 fur 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".

28. With this in mind, the goods for comparison are as follows:

Earlier goods	**Contested goods**
<u>Under the first earlier mark</u> Various goods in classes 9, 10 and 11 as outlined at Annex A, including: Class 9: *electric and electronic vehicle equipment and accessories, namely automotive fuses and ignition leads.* And Class 11: *Electric light sources, especially bulbs, discharge lamps, fluorescent lamps, lighting installations, lighting fittings and their parts.*	Class 12: Passenger vehicles included in class 12; Electric motorcycles, included in class 12; Electrically powered mopeds, included in class 12; Electrically operated motorcycles, included in class 12; Electrically operated bicycles, included in class 12; Electrically operated tractors, included in class 12, electrically operated motor homes and caravans, included in class 12; Aircraft, included in class 12, namely motorised and non-motorised lighter-than-air electrically operated aircraft and motorised and non-motorised heavier-than-air electrically operated aircraft; Electrically powered space vehicles, included in class 12; Electrically operated rail vehicles, included in class 12; Electrically powered tracked vehicles, included in class 12; Electrically powered water vehicles, included in class 12, namely underwater vehicles and electrically powered underwater vehicles; Electrically powered amphibious vehicles, included in class 12; Electrically operated wheelchairs; electrically powered mobility scooters; Electric golf buggies; Electric prams; Vehicle parts, included in class 12, namely bodywork components; Drives;
<u>Under the second earlier mark</u> Various goods in class 9, 10 and 11 as outlined at Annex B, including: Class 9: *electric batteries; electrical alarm systems.* And Class 11: *Light bulbs; apparatus included in Class 11 for lighting.*	

	Motors; Chassis components, in particular brake parts; Springs; Steamers; Steering; Wheel suspensions; Wheels; Tyres; Hub caps; Wheel trims; Axle suspensions; Transmission components, in particular couplings, gearboxes, chains, transfer cases, cardan shafts, differential gears; Accessories for vehicles, included in class 12, Namely trailer hitches, Bicycle carriers, Roof racks, Travel baggage Of the following materials, Leathers, Aluminum, Titanium, Fabrics made from natural fibres, Namely cotton, Jute, Flax, Viscose, restraints and Fine animal hairs (wool), synthetic fibre industry and Plastics, For transport in electric vehicles, Child's seats, Tarpaulins, namely The aforesaid relating to the following vehicles, electric land vehicles, Electrically operated air vehicles,[4] Electric amphibious vehicles and Electrically powered water vehicles; Snow chains, namely the aforesaid for cars, two-wheeled vehicles, buses, utility vehicles, forestry machines, military vehicles, 4x4 and SUV vehicles, tractors, electrically operated special-purpose vehicles. Class 25: Clothing, footwear, headgear.

[4] The opposition based on the opponent's first earlier mark appears to exclude these goods, however, they are included in the opposition based on the opponent's second earlier mark.

	Class 28: Gymnastic and sporting articles; games.

29. I consider firstly, the contested goods in classes 25 and 28. Whilst I have considered the opponent's submissions provided alongside its amended TM7 and in response to the applicant's subsequently unamended counterstatement, it is my view that these do little to assist the opponent's case.

30. In respect of class 25, the opponent appears initially to be intending to compare these goods with its medical devices and goods in class 10, but it goes on to make arguments referring to clocks and watches in class 14, for which it does not have protection in these proceedings. In any case, I see no reason to find the contested goods in class 25 similar to the opponent's goods relied upon, either listed in the table above or as outlined in full in the Annexes attached. In the absence of any convincing submission on this point, I find these goods to be dissimilar to those relied upon by the opponent.

31. In respect of the class 28 goods, the opponent appears to list these next to goods such as light sources and heat consumers for comparison, but goes on to make arguments based on "games", in respect of which the opponent again has no protection in these proceedings. In the absence of any convincing submissions on this point, I see no reason to find these goods similar to those relied upon by the opponent in these proceedings.

32. I therefore move on to consider the goods in classes 9 and 11 relied upon by the opponent, particularly those outlined in the table above, against the following contested goods in class 12:

> Class 12: *Passenger vehicles included in class 12; Electric motorcycles, included in class 12; Electrically powered mopeds, included in class 12; Electrically operated motorcycles, included in class 12; Electrically operated bicycles, included in class 12; Electrically operated tractors, included in class 12, electrically operated motor homes and caravans, included in class 12;*

Aircraft, included in class 12, namely motorised and non-motorised lighter-than-air electrically operated aircraft and motorised and non-motorised heavier-than-air electrically operated aircraft; Electrically powered space vehicles, included in class 12; Electrically operated rail vehicles, included in class 12; Electrically powered tracked vehicles, included in class 12; Electrically powered water vehicles, included in class 12, namely underwater vehicles and electrically powered underwater vehicles; Electrically powered amphibious vehicles, included in class 12; Electrically operated wheelchairs; electrically powered mobility scooters; Electric golf buggies; Electric prams.

33. The opponent has argued that the earlier goods are all included within the class 12 goods. It argues on this basis, that the nature, purpose and method of use is therefore identical or very similar. Whilst I have considered these submissions, I do not agree with all of the conclusions that the opponent has reached. I do not find the nature of vehicles such as those above, and the earlier goods to be shared. Just because these may include, for example, *electric batteries, automotive fuses and ignition leads* or *lighting fittings* such as headlights, all of which may be parts of vehicles, the nature of a vehicle compared with these component parts will clearly be very different. Further, the main purpose of a vehicle is to transport a person from one location to another. On the other hand, the component parts mentioned have different purposes, for example, for use as part of an engine or for lighting the way ahead, and all may be for the purpose of building a complete vehicle. The method of use is different, with the contested goods being sat in or driven by the consumer, whilst the earlier goods are not. Considering the aforementioned differences, it is my view there is also no competition between the goods. However, I do accept that these goods may be important or essential to each other, for example an electric battery may be essential for the operation of electric vehicles, and automotive fuses and ignition leads important or essential for automotive vehicles. Further, it is my view that when a battery, fuse or ignition requires replacing, the consumer, whether that be a member of the general public or a mechanic for example, may well assume that it will be provided by the same economic undertaking responsible for the vehicle itself, considering the overlap in expertise required. I therefore find an element of complementarity between these goods, in addition to the obvious overlap in users and

trade channels on this basis. Overall, I find between a low and medium level of similarity between these contested goods and those covered by the earlier marks.

34. Next, I consider the following goods in class 12:

> *Vehicle parts, included in class 12, namely bodywork components; Drives; Motors; Chassis components, in particular brake parts; Springs; Steamers; Steering; Wheel suspensions; Wheels; Tyres; Hub caps; Wheel trims; Axle suspensions; Transmission components, in particular couplings, gearboxes, chains, transfer cases, cardan shafts, differential gears.*

35. The above are all parts of vehicles. Whilst I do not consider the nature to be shared with the earlier goods highlighted in the table above, I consider that these may be used together for the purpose of building of a complete vehicle. Whilst the goods do not appear to be strictly complementary, I consider they will likely share trade channels including specialist vehicle part suppliers and vehicle/vehicle part manufactures. The users will be shared, including mechanics as well as members of the general public looking to replace elements for their vehicles. For example, the owner of an electric bike or an electric mobility scooter, might seek both an electric battery and a new wheel for the item themselves. I do not consider the goods to be in competition. Overall, I find these goods to be similar to the earlier goods relied upon to a low degree.

36. Next, I consider the following contested goods:

> Class 12: *Accessories for vehicles, included in class 12, Namely trailer hitches, Bicycle carriers, Roof racks, Travel baggage Of the following materials, Leathers, Aluminum, Titanium, Fabrics made from natural fibres, Namely cotton, Jute, Flax, Viscose, restraints and Fine animal hairs (wool), synthetic fibre industry and Plastics, For transport in electric vehicles, Child's seats, Tarpaulins, namely The aforesaid relating to the following vehicles, electric land vehicles, Electrically operated air vehicles, Electric amphibious vehicles and Electrically powered water vehicles; Snow chains, namely the aforesaid for cars, two-wheeled vehicles, buses, utility vehicles, forestry machines, military*

vehicles, 4x4 and SUV vehicles, tractors, electrically operated special-purpose vehicles.

37. Whilst I note the above goods are all related to and may be used with vehicles, I consider these to be accessories for the same, rather than intrinsic parts of the vehicles themselves, like the opponent's most similar earlier goods. I do not consider the nature, purpose or method of use to be shared. Whilst I have considered the evidence provided by the opponent relating to vehicle manufactures selling various other items, I do not consider this to be particularly convincing, especially considering there is no evidence dating prior to the relevant date in these proceedings, and there is little to indicate the pages provided are reflective of the position in the UK.[5] The goods are not in competition and are not complementary as such. Whilst I note there may be an overlap in users and trade channels at a fairly general level, I do not find this overlap sufficient for a finding of similarity in this instance. In the absence of any convincing submissions, I find these goods dissimilar to those relied upon by the opponent in these proceedings.

38. Where the goods are considered dissimilar, the opposition based on section 5(2)(a) of the Act must fail.[6] The opposition on this ground therefore fails at this stage in respect of the following goods:

Class 12: *Accessories for vehicles, included in class 12, Namely trailer hitches, Bicycle carriers, Roof racks, Travel baggage Of the following materials, Leathers, Aluminum, Titanium, Fabrics made from natural fibres, Namely cotton, Jute, Flax, Viscose, restraints and Fine animal hairs (wool), synthetic fibre industry and Plastics, For transport in electric vehicles, Child's seats, Tarpaulins, namely The aforesaid relating to the following vehicles, electric land vehicles, Electrically operated air vehicles, Electric amphibious vehicles and Electrically powered water vehicles; Snow chains, namely the aforesaid for cars, two-wheeled vehicles, buses, utility vehicles, forestry machines, military*

[5] Many of the pages provided in Exhibit JV1 show prices in US Dollars.
[6] See *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA.

vehicles, 4x4 and SUV vehicles, tractors, electrically operated special-purpose vehicles.

Class 25: *Clothing, footwear, headgear.*

Class 28: *Gymnastic and sporting articles; games.*

39. The opposition will proceed on this ground in respect of the remaining similar goods.

Average consumer and the purchasing act

40. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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.

41. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> *"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."*

42. The average consumer for many of the vehicles in class 12 will be a member of the general public. The goods will likely be a relatively infrequent and expensive purchase, and there will no doubt be multiple considerations made when purchasing these goods, such as to the comfort, functionality and safety features of the same. It

is my view that the attention of the general public in respect of these goods is likely to range from above medium for those such as electric bicycles, to high for goods such as motorcycles and motorhomes for example.

43. There will also be a group of professional consumers of the class 12 vehicles, particularly in respect of for use in rail, air and space travel for example. Again, these will be expensive and likely infrequent purchases on all accounts, and close attention to safety features, functionality and capacity, for example, will be paid. Overall, I consider the level of attention given to these types of goods will be high.

44. In respect of the component parts of vehicles, these may be purchased by both professionals such as mechanics, as well as members of the general public. The cost of the goods will generally be lower, and there will not be as many features of the same to consider. That said, attention will likely be paid particularly to the compatibility of the goods with those already owned by the consumer, and consumers will pay no lower than a medium level of attention to the same.

45. I consider the majority of the goods will be primarily purchased visually, either online or via physical retail or wholesale stores, garages and showrooms, in brochures or catalogues, or following the digestion of visual advertisements. However, I note that there may an important aural aspect to the purchase, particularly where orders are placed over the phone or through retail, wholesale, garage or showroom staff, and this may be particularly prevalent in respect of component parts for vehicles. I therefore take both the visual and aural factors into account.

Distinctive character of the earlier trade mark

46. 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).

47. The earlier mark still in play under this ground is TESLA. It is my view that this will be considered by the consumer as a made up word with no meaning in relation to the goods and services. I therefore consider it to hold a high level of inherent distinctive character.

48. The opponent has filed evidence in these proceedings, and I must therefore also consider whether the distinctive character of the earlier mark has been enhanced through use. When considering whether the distinctive character of a mark has been enhanced, it is the perception of the UK consumer at the relevant date that is key.

49. I note the relevant date in these proceedings is the priority date of the application, that being 17 October 2006. The opponent has not provided any evidence of use that obviously dates from prior to this date. Further, notwithstanding this, I note the opponent has not provided any significant evidence of use of its mark in respect of the goods relied upon in these proceedings. The sales figures provided, whilst substantial, are not only dated after the relevant date but are also not broken down into relevant goods. There is the same issue regarding the dates of the marketing figures, and it is also true that there is nothing to really show the goods marketed. There are several invoices provided at Exhibit JV1, but even if the relevant date were not an issue, these would not be sufficient alone to show the distinctive character of the earlier mark has been enhanced. Finally, pages referring to web traffic which are either undated or dated from 2022 are of no assistance, and this is even more apparent as there is very little context given to the same. Overall, with consideration to the sum of the evidence provided, it is my view that this falls considerably short of showing that the distinctiveness of the earlier mark had been enhanced through use, in respect of the goods relied upon, at the relevant date.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

50. Prior to reaching a decision under section 5(2), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 22 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.[7] I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that how the goods are obtained may have a bearing on how likely the consumer is to be confused.

51. Direct confusion occurs where the average consumer mistakenly confuses one trade mark for another. Indirect confusion occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings. However, considering section 5(2)(a) of the Act is dependent on a finding that the marks are identical, only direct confusion will be relevant in this instance.

52. I found in this instance the opponent's first two earlier marks (these both being the same mark TESLA) to be identical to the contested mark. I found the goods left in contention to be similar to the earlier goods to either a low degree or to between a low and medium degree. I found the earlier mark to be inherently distinctive to a high degree, but that the evidence filed is not sufficient to find that the distinctiveness of the

[7] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

same had been enhanced further through use. I found that consumers of the goods will include both members of the general public, as well as professionals, and that in all instances the level of attention paid towards the goods will be medium or higher, with this being high in some instances. Overall, considering all of these factors and particularly noting the identity of the marks themselves and the level of distinctiveness of the same, it is my view that notwithstanding the sometimes high level of attention paid, there will be a likelihood of direct confusion between the marks in respect of all of the similar goods. The opposition based on section 5(2)(a) therefore partially succeeds in respect of all of the goods other than those set out at paragraph 38 of this decision.

Section 5(3)

53. I now move on to consider the opposition under section 5(3) of the Act.

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

> "5(3) A trade mark which is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

55. Section 5A of the Act (as previously set out) is also relevant under this ground.
56. As the first and third earlier marks relied upon under this ground are comparable marks, paragraph 10 of Part 1, Schedule 2A of the Act is also relevant. It reads:

> (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union.

57. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

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

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

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

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

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

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is

clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure).*

58. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements, which together may form the basis of a successful claim. To be successful on this ground, the opponent must prove that the earlier mark relied upon has a reputation amongst a significant portion of the public. It must also be established that the marks are similar. If it is found both that the marks are similar and that the earlier mark holds a qualifying reputation it must then be shown that this reputation, combined with the similarity between the marks, will result in the relevant public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage.

59. The relevant date for consideration under section 5(3) of the Act is the priority date of the opposed mark, that being 17 October 2006.

Reputation

60. I have summarised the evidence of use filed by the opponent in my considerations relating to enhanced distinctive character earlier in this decision. Whilst I note that an assessment of a marks reputation is not the same as an assessment of its enhanced distinctive character, the flaws I have highlighted in the evidence previously do also hinder the opponent in its attempt to show its reputation for the marks relied upon under this ground. There is very little evidence showing the use of the opponent's marks, and no evidence placing this use prior to the relevant date under this ground, which as previously stated, is in 2006. Whilst I note TESLA is now, to my mind, clearly a known mark in the UK, I am certainly not willing to take judicial notice that the opponent had established any reputation for its mark in respect of the goods relied upon in these proceedings and at the relevant date. As the opponent has not established it held the requisite reputation for a finding based on section 5(3) of the Act, the opposition under this ground must fail.

Section 3(6)

61. I now move on to consider the opposition based on section 3(6) of the Act. I remind myself that the relevant date for consideration under this ground is the date the application was filed in the UK, that being 14 September 2021.

62. 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."

63. In SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1) [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

> "(i) […]
>
> (ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (Lindt, para 35).
>
> (iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker (C-320/12) EU:C:2013:435 ("Malaysia Dairy")], para 29; [Sky plc v SkyKick UK Ltd (C-371/18) EU:C:2020:45 ("Sky CJEU")], para 73).
>
> (iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition 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 consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (Lindt, para 45; [Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO) (C-104/18) EU:C:2019:724 ("Koton")], para 45). (v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (Koton, para 46; Sky CJEU, para 75). (vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case ([Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening) (Case T-663/19) EU:T:2021:211 ("Hasbro")], paras 39 and 40; Koton, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (Hasbro, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (Lindt, para 37). (ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (Sky CJEU, para 76; [AS v Deutsches Patent-und Markenamt (C-541/18) EU:C:2019:725], para 22). (x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims

referred to in Regulation 40/94 and Directive 89/104 (Sky CJEU, para 77). (xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (Sky CJEU, para 77). (xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (Sky CJEU, para 78). (xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (Sky CJEU, para 81)

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, Hasbro, para 72). (xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a bona fide intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (Sky CJEU, paras 86 and 87)."

64. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are: (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing? (b) Was that an objective for the

purposes of which the contested application could not be properly filed? and (c) Was it established that the contested application was filed in pursuit of that objective?

65. It is necessary to ascertain what the proprietor knew at the relevant date: Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

66. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited [2012] EWHC 1929 (Ch).

67. I make my consideration with reference to the three questions set out in *Alexander Trade Mark* below.

<u>What, in concrete terms, was the objective that the applicant has been accused of pursuing?</u>

68. The opponent's pleadings on the bad faith ground are fairly spread out across a number of paragraphs in its statement of case. However, as far as I understand, it accuses the applicant of the following objectives in filing its mark:

- Having no intention to use the mark, the application was filed by the applicant:
    - For the purpose of deliberately taking unfair advantage of, and/or causing damage or detriment to the opponent and its goodwill under the sign; and/or
    - To garner a financial award, licence fee or assignment fee for the mark from the opponent.

Was that an objective for the purposes of which the contested application could not be properly filed?

69. I consider that filing an application with the sole aim of taking advantage of third party rights, to gain an unfair competitive advantage by doing so, is an objective under which a trade mark cannot be properly filed.[8] In addition, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat* Trade Mark, [2003] RPC 11*,* or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch)*.*

70. I therefore accept that the objectives of which the applicant has been accused are those under which it may be found to be acting in bad faith at the time of filing.

Was it established that the contested application was filed in pursuit of that objective?

71. I note firstly that the applicant has to an extent, denied that its applications were filed in pursuit of the objectives above. In its TM8, the applicant pleads as follows:

> "The opponent has no reputation, standing, or other prior rights in respect of the sign TESLA and the goods covered by the application in classes 12, 25 and 28.
>
> […]
>
> The current trademark owner is a trademark rights exploitation company. The trademark originator is Mr. Erich Auer, Austrian (like Nikola Tesla), who has been a pioneer in the field of interdisciplinary development of new trademark rights since 2001.

[8] *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH,* Case C-529/07

As long as the trademark is contested and not yet registered, logically it cannot be licensed or (partially) sold.

Logically, therefore, the trademark owner has not yet been able to generate any turnovers at this time.

For example, once the oppositions are dismissed and the trademark can be licensed and royalties flow accordingly, the status of the company can be changed from "dormant".

[…]

It is a slander and a lie that there is no genuine intention to use the newly developed trademark TESLA. It is even (legally) logical that there is an intention to use the developed new trademark, because the trademark creator or trademark owner must amortise the development costs by licensing or (partially) selling the trademark to third parties.

The trade mark owner does not need to use the trade mark itself, but a licensee can use the trade mark.

New trademarks are created through a complex, creative trademark development process. The trademarks are created genuinely and not by merely taking over third-party rights. This was also the case with the trademark development TESLA, which the Austrian Erich Auer got inspired by the old Austrian Nikola Tesla.

The managing director of the applicant has been a well-known trademark creator since the beginning of 2001, who creates the trademark functions of new trademarks, especially the advertising, licensing and investment functions, and has been running a trademark agency since 2001. His companies are trademark rights exploitation companies, which manage and exploit the trademarks (pre-)developed by Mr. Erich Auer.”

72. I note firstly, that the first objective the applicant has been accused of in particular, is dependent on the opponent having a goodwill in the UK, of which the applicant may take advantage or to which it may cause damage or detriment. As I have outlined previously elsewhere in this decision, the opponent's evidence of its own use of the mark in the UK is exceptionally limited, however, I note the large sales figures exhibited by Mr Vyborny in his witness statement for use of the mark across the EU and UK (ranging approximately between 34 – 45 million euros each year between 2017 – 2022), as well as the significant marketing spend figures (in the approximate region of half a million euros a year for the same period). There are also a number of invoices provided in the evidence, most of which reference the goods "electron tubes", and web traffic figures with little context. It seems the lack of evidence on this point was possibly an intentional one in this instance, with Mr Vyborny commenting in his witness statement as follows:

> "27. Our TESLA brand is significant throughout the EU and the UK (the territories I understand are relevant for this opposition). I understand from Mr Southall that the registration TESLA holds is a prima facie case that TESLA has established the goodwill and reputation needed - it should not be put to strict proof to show that it has achieved a trading standard of goodwill and reputation as the registration certificate is sufficient in that regard (albeit in the crudest of senses)."

73. I feel it is necessary to clarify at this point, that the registration of the mark in the UK does absolutely nothing to establish that there exists goodwill and/or reputation under a sign or mark. A trade mark can be registered in the UK despite never having been used, with the only requirement being that there is a genuine intention to use the mark in future. However, even this intention to use is not routinely tested, and without challenge from a third party, a trade mark can sit on the register for decades without ever having been used. It goes without saying that in most cases, it would be impossible to prove any goodwill or reputation in the UK in those circumstances. The opponent appears to have been somewhat naïve to this when filing its own evidence in these proceedings.

74. That said, I am, in the appropriate circumstances entitled to take judicial notice of facts are too notorious to be the subject of serious dispute.[9] Having considered this matter carefully and with caution, and in the knowledge that I am neither the consumer of electric cars and nor do I have any particular knowledge of or interest in the subject, I am on this occasion, willing to accept that by the relevant date in 2021, there would have been some level of goodwill in the opponent's business under the sign Tesla in the UK in respect of electric cars. Whilst I note the applicant's denial of this fact, I do not accept that this position can really be in serious dispute.

75. I therefore move on to consider whether the applicant's mark was filed with the objective of taking advantage of or causing detriment to that goodwill in the UK. I find the opponent's pleading on this somewhat contradictory. On this point, the opponent sets out:

> "6.1 Pursuant to the Applicant's filings (and inter alia recordings) at Companies House, the Applicant is a dormant company (and has been since its incorporation). The Opponent therefore avers that the even if the Application was successful, the Applicant would not be in a position to use the Mark in commerce;
>
> 6.2 There is no presence online for the Applicant, save for Companies House information, which the Opponent avers is evidence that this Mark has not been registered with the intention of use (in commerce or otherwise) but merely to cause damage and/or, detriment and/or confusion with the Opponent and inter alia, other well-known brands."

76. If it is indeed the case that the applicant has no intention to use its mark, I cannot see how it can also, on this basis, be its intention to cause detriment to the opponent, or take unfair advantage of its goodwill under the sign on the UK market. I cannot see how a mark simply sitting on the trade mark register can do any of these things. Whilst I note that the applicant has denied it has no intention to use (stating it may license the use of the trade mark to others), I still do not consider that the opponent's pleaded

[9] *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08

objective can be established in this instance. I therefore move on to consider its second objective, and that is, whether the mark has been filed for the purpose of achieving a license fee, assignment fee or other financial reward from the opponent.

77. The opponent's evidence to this effect primarily comprises previous decisions issued involving Mr Auer, who is said to be the controlling mind of both the applicant in this case and the different applicants named in the decisions provided. The first decision filed was issued by the General Court ("GC"), that being *Copernicus-Trademarks Ltd v EU IPO* T-82/14 EU:T:2016:396. Mr Vyborny explains in his witness statement that the in that case, Mr Auer, referred to as Mr A.,[10] was found to have been pursuing "unlawful filing strategies". The decision dismisses the appeal against a previous decision of the Board of Appeal, the conclusion of which was summarised by the GC as follows:

> "35. In the contested decision, the Board of Appeal found that the application for registration of the mark at issue was part of an unlawful strategy to file applications for registration of trade marks, seeking to claim priority for an application for registration of a European Union trade mark by circumventing the six-month period of reflection provided for by Article 29(1) of Regulation No 207/2009 and the five-year grace period provided for by Article 51(1)(a) of that regulation. The application for registration of the mark at issue was filed solely so as to be able to oppose the application for registration of the European Union trade mark LUCEA LED filed by the intervener and to derive economic advantages from that opposition. The filing strategy underlying the application for registration of the mark at issue lacked transparency for third parties."

78. Also filed in late evidence was a decision issued by the Cancellation Division of the EU Intellectual Property Office, dated 17 December 2024. This was filed alongside along side the opponent's skeleton arguments, and as the opponent appeared to be

[10] From reading the decision filed in evidence, I note the Board of Appeals decision referred to a company called Copernicus who was found to have links with Mr Auer, and that it was necessary for its finding to take into account the conduct not only of this company, but all companies with links to Mr Auer. I also note the Companies House documents provided in evidence in this case listing only one person with significant control for Corpernicus-Trademarks Limited, that being Mr Eric Auer.

relying on this for the purpose of showing the applicant's conduct, rather than for a point of law, its admission into proceedings was considered in accordance with the factors set out in Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors [2016] EWHC 3103 (Ch) at [47]. A preliminary view was given at the hearing to allow this late evidence into the proceedings, and as the applicant did not attend the hearing, it was provided with the opportunity to object to this preliminary view or make further submissions after the fact. No formal objection or submissions were made,[11] and as such I consider this evidence to have been admitted.

79. This decision relates to the application for invalidity of the EU Trade mark from which the UK mark contested in this case stems. The decision in that case states:

> "Thus, the Cancellation Division notes that references to 'he' or '(Mr) E.A.' necessarily refer to the man behind the creation (and original filing) of the EUTM in the present case and the companies he uses to 'develop' or 'exploit' the marks, including the EUTM proprietor, are owned and run by him and are under his control.
>
> […]
>
> The […] circumstances would indicate that the EUTM proprietor is filing marks speculatively and in order to achieve earlier filing dates to later use in opposition proceedings or to try and sell or lease the mark, as in the present case. This behaviour points to the fact that not only are the trade mark applications filed, but they are filed with the intention of later opposing legitimate trade mark applications, and that the EUTM proprietor is well-aware of the other companies intention to file trade marks in the EU at the time it files these applications. In the present case only days after the applicant filed its own EUTM applications the EUTM proprietor paid the fee (or at least part of the fee) of the Austrian

[11] Whilst comments on this were made by the applicant in an email of 21 March 2025, these were not copied to the other side. The Tribunal responded requesting these were copied to the other side so that they may be considered in the final decision. Nothing further was received from the applicant, and it is therefore assumed this action was never taken. In any case, I note for completeness that the contents of those submissions would not have altered my decision on this particular issue.

mark and filed an EUTM application based on the earlier priority date of said mark. Then, shortly after this, it filed opposition proceedings against both of the applicants EUTMAs. The EUTM proprietor argues that had he known about the applicant he would have paid the fees as quickly as possible in order to secure the right but this argument is not particularly convincing given all of the circumstances outlined above and hereinafter.

[…]

Normally when an applicant files an EUTM application it is because it wants to protect the mark, to use it itself in relation to specific goods and services in order to indicate the commercial origin of the goods. Their interest is to register the mark as quickly as possible in order to obtain such a right. In the present case the EUTM proprietor clearly was not in any rush to obtain the registered mark but merely used it as a blocking method to hinder the applicant and to try and obtain compensation from the applicant.

[…]

In the present case the EUTM proprietor did not file a trade mark in order to use it in the course of business to identify the commercial origin of its goods (or services). It filed a mark in order to speculatively sell it to an, as yet, unidentified party. Therefore, it was not created for trade mark functions but to obtain an exclusive right for purposes other than those falling within the functions of a trade mark. Furthermore, examining many of the marks that the EUTM proprietor has filed in Class 12 it becomes clear that there is a pattern of the EUTM proprietor fortuitously coming up with trade marks that are identical or similar to those used by other companies for Class 12 goods already on the market (whether for a short or long period, or due to speculation as the companies have formally used the name of stars or constellations for its vehicles and thus it would be probable that they would continue this pattern of naming cars etc.). The EUTM proprietor argues that often people or software, when trying to come up with trade marks, choose the same signs, but it is the one that files it first that holds the rights to the sign. If this were a once-off

occurrence, then it could perhaps be put down to coincidence or mere chance. It further argues that others also came up with the sign ‘TESLA’ and the applicant had to buy the rights to these other signs to use the mark. However, the sheer number of trade mark applications which have been filed by the EUTM proprietor that coincide with the names of third party brands, particularly in the automotive industry, as detailed in the applicant’s observations and in the cited case law, cannot be put down to mere chance. Indeed, it appears that the EUTM proprietor’s creation and development of trade marks is carried out by identifying companies that are beginning to use signs (or have used similar signs) and which have as yet not secured any trade mark protection in relation to same in the EU (or at all). It thus becomes clear that the EUTM proprietor is filing these trade marks in order to speculate as it sees that the marks, although being used by others, are not yet registered in the EU (or at all). Thus it files the marks in order to force the hand of the third parties to buy the trade marks from Mr E.A. or suffer the consequences of being prohibited/hindered from entering or staying on the relevant market.

[…]

Taking into consideration all of the above, the Cancellation Division considers that the EUTM proprietor (Mr E.A.) must have been aware of the applicant’s use of the sign ‘TESLA’ in relation to electric vehicles at the time of filing. As a result, Mr E.A. then filed the Austrian application to secure priority rights to the sign ‘TESLA’ without immediately paying the filing fee. He then waited until the applicant filed EUTM applications for signs containing ‘TESLA’ and then filed his own EUTM, the contested EUTM, and shortly afterwards paid EUR 100 as filing fees for the Austrian mark (whether that was a full or partial payment of the fee is undetermined and can be left open). Then, having secured the contested EUTM with a priority date (which was not properly substantiated as seen above) it attacked the applicant’s EUTMAs in opposition proceedings. When the contested EUTM was then opposed it delayed the proceedings for over 15 years by carrying out restrictions of the goods which achieved no real aim (such as listing many very specific examples of goods to later delete them one by one) in order to avoid the EUTM being registered and to hinder and

block the applicant's EUTMAs, thus amounting to an abuse of the trade mark system. When the applicant offered a settlement for EUR 5,000 to purchase the Austrian application and the contested EUTM to the EUTM proprietor in 2010 this offer was rejected as Mr E.A. considers that the sum should have been much higher. The EUTM proprietor has also complained that the applicant never approached it to try and buy the EUTM. This may be because the EUTM proprietor (Mr E.A.) thought it would look more suspicious if it (he) approached the applicant and waited for the applicant to come to the table. In any event, the EUTM proprietor did not intend to use the mark for the goods for which the mark was filed, and also admitted that he had no intention to produce or sell vehicles or the other contested goods but only to lease, sell or broker the mark to a third party in the relevant sector. Mr A.E., who initially filed the EUTM, states that he had no particular buyer/licensee lined up at the time (and even now, despite claiming he could sell the mark to a Chinese company), thus the mark was filed speculatively. As stated above, Mr A.E. was aware or must have been aware of the existence of the applicant's 'TESLA' brand at the time of filing and thus the applicant would have been his target to sell the mark. The EUTM proprietor (Mr A.E.) did not have any company who commissioned it or Mr E.A. to develop a mark and it had no practical use for the mark except to speculate its sale, all clearly proving the EUTM Proprietor's dishonest intentions at the time of filing. Considering all of the above, the Cancellation Division considers that the EUTM was filed in bad faith and the EUTM proprietor has failed to put forward sufficiently convincing arguments or evidence to dispel this finding."

80. I note however, the appeal process has not been exhausted in respect of the proceedings above.

81. I have had very little in these proceedings from the applicant, and in short, there has been nothing following the TM8 filed disputing any of the evidence or further claims made by the opponent in respect of the same.

82. Whilst each case must turn on its own merits, and I note considerably more evidence appears to have been filed in the previous proceedings than I have been provided with here, I consider that where it has been established that the applicant (or

its controlling entity as in this case), has displayed a pattern of bad faith, that may be taken into account, so long as it does not form the sole basis for such a finding (see *Rui Qu (Shanghai) Enterprise Management Consulting Company Limited v Accessible Labs Ltd*, BL O/0534/25). Further, in this same case, Mr Daniel Alexander KC, sitting as the appointed person, set out as follows:

> "72. Cases in which there are prima facie grounds for considering that there has been bad faith and in which no evidence is provided by the applicant to rebut that inference are comparatively straightforward. Lidl v. Tesco (referred to above) was an example of such a case. Cases of alleged bad faith are harder where the applicant for registration provides some explanation in a witness statement (including describing other activities they have conducted which are potentially consistent with an intention to trade in a given jurisdiction using a given mark).
>
> 73. In such cases, the task of the tribunal is to evaluate whether the applicant has provided sufficient material to address a prima facie case of bad faith."

83. In my view in this case, whilst the evidence put forward by the opponent is somewhat limited, this in addition to the circumstances as a whole are sufficient to make a prima facie case for bad faith based on the second objective as pleaded by the opponent. I consider the conduct of Mr Auer's companies in previous cases in the EU and the pattern of behaviour displayed by Mr Auer when operating his other companies. In addition to this, I note my acceptance that there will have been goodwill under the Tesla sign in the UK at the time of filing, and it is my view this is something Mr Auer and the applicant will have been aware of. Further, even if I am wrong to find the opponent to hold goodwill in the UK under its sign, I note that at the very least it is clear from the ongoing proceedings between the parties in the EU that Mr Auer and the applicant would have been aware of the opponent's potential use and/or desire and intention to use the mark in the UK at the time of filing. I also note the applicant's own pleadings inferring that it is indeed its intention to license the trade mark to third parties, rather than to make any use of it itself. Whilst none of these factors alone are sufficient to make a finding of bad faith, combined I consider these enough to establish the opponent's prima facie case that the applicant filed the mark without intention to

use the same, but instead with the sole purpose of gaining a license fee or other financial award from the opponent.

84. Having accepted that the opponent has established a prima facie case that the application was filed in bad faith, it is my view that this matter falls into the first category set out by Mr Daniel Alexander KC sitting as the Appointed Person in BL O/0534/25 as referenced above, in that this is a comparatively straight forward case to decide. I note the very brief explanation from the applicant in its counterstatement that it is a "trademark rights exploitation company" (wording that I do not find very helpful to the applicant's case), that the creation of the mark was inspired by Nikola Tesla and that it is "…(legally) logical that there is an intention to use the developed new trademark, because the trademark creator or trademark owner must amortise the development costs by licensing or (partially) selling the trade mark to third parties". However, I also note there is no evidence showing the creative process involved in thinking up the trade mark, no evidence of who Nikola Tesla is, or why he should be the inspiration for a trade mark, no evidence of any third party requesting the creation of such a trade mark for its goods from the applicant, and no evidence of any approaches to or correspondence with third parties other than the opponent to license or use the mark. Further still, and crucially, there is no evidence establishing any plausible justification or explanation for the filing of the mark TESLA by the applicant in the UK in 2021 for the goods as filed. There is in short, nothing from the applicant that is sufficient to rebut the opponent's prima facie case. I therefore agree with the opponent and find that on balance, it appears that the mark was filed in bad faith, in the knowledge of the opponent's use or desire to use the mark in the UK, and with the intention of receiving some sort of license fee or other payment from the opponent in return for using or owning the mark in future.

85. The opposition based on section 3(6) of the Act therefore succeeds in its entirety.

Final remarks

86. The opponent has achieved partial success based on its opposition relying on section 5(2)(a) of the Act, and has been entirely successful in its opposition based on

section 3(6) of the Act. Subject to any successful appeal, the application will therefore be refused in respect of all of the goods filed.

COSTS

87. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1900 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 2/2016. The sum is calculated as follows:

Official fee:	£200
Preparing and filing the TM7 and considering the TM8:	£400
Preparing and filing the evidence:	£600
Preparing for and attending the hearing:	£700
Total:	**£1900**

88. I therefore order PARABOLICA LTD to pay TESLA Holding a.s. the sum of £1900. 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 31st day of October 2025

R. Le Breton
For the Registrar

Annex A

Goods relied on under 903411758, the opponent's "first earlier mark".

Class 9: Electrochemical current supplies; passive devices, especially resistors, thermal resistors, connectors, other connecting devices, small transformers, choke coils and other inductors; telecommunication relays, namely for military use; switches; protection elements; electric current interrupters; printed wiring, printed circuit cards (electric and printed), circuits (electric, integrated and printed); active devices; screens as components of electronic access control systems; X-ray tubes, other electron tubes, especially photomultiplier tubes, glow-tubes, microwave electron tubes, diodes, transistors; piezoceramic equipment and devices, radio frequency ceramics; transmitting tubes, storage tubes, microwave tubes; microelectronic circuits, especially monolithic integrated circuits (ICs), hybrid ICs, switching ICs, storage ICs; optoelectronic devices and equipment, especially photoelectric devices; microwave components and circuits; magnetic and electromagnetic devices and equipment, various electronic elements, especially filters and microscopes, including electron microscopes, namely protection and filtration modules and electron microscopes; terrestrial, cable and satellite transmission equipment, namely special telephone sets for industrial purposes and antenna units; local and integrated telecommunication network equipment, namely special telephone sets for industrial purposes and antenna units; remote signalling, control and measuring devices, namely radio relays for military use and antenna units; satellite data transmission antennas; receivers and decoders, radio-communication and TV devices and equipment, especially broadcast and TV transmitters, translators, antennas and antenna arrays, radio-relay links, radio link and control devices, namely DVB-T receivers, radio relay for military use and antenna units; CCTV; TV and radio signal receivers and distribution equipment, localisation equipment, measuring and regulation equipment, namely DVB-T receivers, radio relay for military use and antenna; measuring equipment, namely for radioactive emissions; wire-bound communication systems accessories and equipment, intercommunication equipment, communication facilities, videophones, namely videophones, video recording machines, camcorders, video cameras all as components for electronic access systems and security systems; industrial electronics, especially electronic and electric signalling and interlocking systems and monitors, namely special telephone sets for industrial purposes, security systems and electronic access control systems; voice-controlled systems, namely for electronic

access control systems; detectors, sensors, actuators; control units, namely control modules for power tools and motor control modules; electric and electronic vehicle equipment and accessories, namely automotive fuses and ignition leads; electronic and electric instruments, namely apparatus for indication, measuring and control of radioactive emissions, electron microscopes, antenna units, radio relays for military use, DVB-T receivers, security systems, electronic security apparatus against theft, electronic access control systems and their electric and electronic components, scales (for kitchen or personal use), consumer weather stations and special telephone sets for industrial purposes; analyzers, especially electric and electronic recorders, indicating, measuring, monitoring and testing instruments and devices including non-electronic quantity measuring instruments; radioactive emission indicator, measuring and monitoring instruments; meteorological devices, namely consumer weather stations; scientific and laboratory apparatus, namely electron microscopes; weighing equipment, namely scales for kitchen and personal use; vacuum apparatus, especially vacuum interrupters; special electrical technology and electronics materials, especially semiconductors; consumer electronics devices, especially radio and TV sets including the combination thereof with other equipment, monitors, displays and display devices, namely DVB-T receivers, scales for kitchen and personal use, weather stations; video recorders, video cameras, all as components for electronic access systems and security systems; electronic amplifiers, electromechanical, electromagnetic and electroacoustic converters, amplifiers; all-format sound, video and image recorders, cameras all as components for electronic access systems and security systems; cables, namely ignition leads; interactive set-top boxes for data reception and sending; cables including optical cables and accessories; namely ignition leads; components, parts and accessories of all the above mentioned products.

Class 10: Medical examinational and therapeutic electronic devices and equipment including devices for the stimulation of living bodies functions; accessories to and components of all the previous devices and equipment.

Class 11: Electric light sources, especially bulbs, discharge lamps, fluorescent lamps, lighting installations, lighting fittings and their parts; all types of heat consumers based on both direct and indirect heating systems, especially electric cookers, kettles, hair driers and microwave ovens.

Annex B

Goods relied upon under trade mark no. 1254000, the opponent's "second earlier mark".

Class 9: Electrical and electronic valves and tubes, cathode ray tubes, photomultipliers, microwave tubes; integrated circuits, memory devices; microprocessors; semiconductor devices, diodes, transistors, thyristors, diacs, triacs, resistors, thermistors, potentiometers, capacitors; microprocessors; lasers and laser communication and measurement apparatus; opto-electronic devices; telecommunications apparatus and instruments; radar and navigational aids; oscilloscopes, analytical instruments, electron microscopes; particle accelerators, nuclear resonance spectrometers; metereological instruments, scientific instruments; clock generators; ultrasonic instruments; vacuum devices; apparatus for the recording, acquisition, transmission or reproduction of sound, data or images; records, tapes and discs all bearing sound, data or images; magnetic data carriers; computers; data processing apparatus; electric batteries; traffic control and signalling apparatus; electrical alarm systems; parts and fittings included in Class 9 and cases for all the aforesaid goods; but not including electrical connections or any goods of the same description as electrical connections, and not including electro-inductive devices, magnets or apparatus for generating magnetic fields.

Class 10: Electrical and electronic medical apparatus; radio cardiographic apparatus; ultrasonic apparatus and measuring apparatus, all included in Class 10 for medical use; parts and fittings included in Class 10 for all the aforesaid goods; but not including radiation shielding windows for medical purposes or any goods of the same description as radiation shielding windows.

Class 11: Light bulbs; apparatus included in Class 11 for lighting; parts and fittings included in Class 11 for all the aforesaid goods; but not including parts or fittings incorporating electro-inductive devices, magnets or apparatus for generating magnetic fields.

Annex C

Goods relied upon under trade mark no. 903411923, the opponent's "third earlier mark".

Class 9: Electrochemical current supplies; passive devices, especially resistors, thermal resistors, connectors, other connecting devices, small transformers, choke coils and other inductors; telecommunication relays, namely for military use; switches; protection elements; electric current interrupters; printed wiring, printed circuit cards (electric and printed), circuits (electric, integrated and printed); active devices; screens as components of electronic access control systems; X-ray tubes, other electron tubes, especially photomultiplier tubes, glow-tubes, microwave electron tubes, diodes, transistors; piezoceramic equipment and devices, radio frequency ceramics; transmitting tubes, storage tubes, microwave tubes; microelectronic circuits, especially monolithic integrated circuits (ICs), hybrid ICs, switching ICs, storage ICs; optoelectronic devices and equipment, especially photoelectric devices; microwave components and circuits; magnetic and electromagnetic devices and equipment, various electronic elements, especially filters and microscopes, including electron microscopes, namely protection and filtration modules and electron microscopes; terrestrial, cable and satellite transmission equipment, namely special telephone sets for industrial purposes and antenna units; local and integrated telecommunication network equipment, namely special telephone sets for industrial purposes and antenna units; remote signalling, control and measuring devices, namely radio relays for military use and antenna units; satellite data transmission antennas; receivers and decoders, radio-communication and TV devices and equipment, especially broadcast and TV transmitters, translators, antennas and antenna arrays, radio-relay links, radio link and control devices, namely DVB-T receivers, radio relay for military use and antenna units; CCTV; TV and radio signal receivers and distribution equipment, localisation equipment, measuring and regulation equipment, namely DVB-T receivers, radio relay for military use and antenna; measuring equipment, namely for radioactive emissions; wire-bound communication systems accessories and equipment, intercommunication equipment, communication facilities, videophones, namely videophones, video recording machines, camcorders, video cameras all as components for electronic access systems and security systems; industrial electronics, especially electronic and electric signalling and interlocking systems and monitors, namely special telephone sets for industrial purposes, security systems and

electronic access control systems; voice-controlled systems, namely for electronic access control systems; detectors, sensors, actuators; control units, namely control modules for power tools and motor control modules; electric and electronic vehicle equipment and accessories, namely automotive fuses and ignition leads; electronic and electric instruments, namely apparatus for indication, measuring and control of radioactive emissions, electron microscopes, antenna units, radio relays for military use, DVB-T receivers, security systems, electronic security apparatus against theft, electronic access control systems and their electric and electronic components, scales (for kitchen or personal use), consumer weather stations and special telephone sets for industrial purposes; analyzers, especially electric and electronic recorders, indicating, measuring, monitoring and testing instruments and devices including non-electronic quantity measuring instruments; radioactive emission indicator, measuring and monitoring instruments; meteorological devices, namely consumer weather stations; scientific and laboratory apparatus, namely electron microscopes; weighing equipment, namely scales for kitchen and personal use; vacuum apparatus, especially vacuum interrupters; special electrical technology and electronics materials, especially semiconductors; consumer electronics devices, especially radio and TV sets including the combination thereof with other equipment, monitors, displays and display devices, namely DVB-T receivers, scales for kitchen and personal use, weather stations; video recorders, video cameras, all as components for electronic access systems and security systems; electronic amplifiers, electromechanical, electromagnetic and electro-acoustic converters, amplifiers; all-format sound, video and image recorders, cameras all as components for electronic access systems and security systems; cables, namely ignition leads; interactive set-top boxes for data reception and sending; cables including optical cables and accessories; namely ignition leads; components, parts and accessories of all the above mentioned products.

Class 10: Medical examinational and therapeutic electronic devices and equipment including devices for the stimulation of living bodies functions; accessories to and components of all the previous devices and equipment.

Class 11: Electric light sources, especially bulbs, discharge lamps, fluorescent lamps, lighting installations, lighting fittings and their parts; all types of heat consumers based on both direct and indirect heating systems, especially electric cookers, kettles, hair driers and microwave ovens.

Annex D

Goods relied upon under trade mark no. 916177487, the opponent's "fourth mark".

Class 16: Inking sheets for document reproducing machines; Rollers for typewriters; Inking ribbons and correction tapes for typewriters.