

O/1142/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003768398  
BY SHENZHEN COOSHARK INNOVATION TECHNOLOGY CO., LTD  
TO REGISTER THE TRADE MARK:

***Cooshark***

IN CLASSES 7 AND 11

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 434811  
BY SHARK NINJA OPERATING LLC

## BACKGROUND AND PLEADINGS

1. On 22 March 2022, Shenzhen Cooshark Innovation Technology Co., Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 8 April 2022 and registration is sought for the following goods:

Class 7      Electric cordless sweepers; Rechargeable sweepers; Electric window cleaning machines; Carpet cleaning machines; Automatic floor scrubbers; Floor cleaning machines; Machines for cleaning surfaces using high pressure water; Vacuum cleaners; Dust removing installations for cleaning purposes; Steam cleaning machines; Swimming pool cleaning machines; Electric sweepers.

Class 11     Hair dryers; Electric hair dryers; Portable electric warm air dryer; Air cleaning apparatus; Air cleaning instruments; Air fryers; Humidifiers; Electric kettles for household purposes; Coffee machines, electric; Electric toasters; Gas purification apparatus; Gas purification machines; Water purification installations.

2. On 6 July 2022, the application was opposed by Shark Ninja Operating LLC (“the opponent”) based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade marks:

SHARK

UKTM no. 3371049

Filing date 29 January 2019; registration date 14 June 2019

Priority date: 20 December 2018 (United States of America)

Class 11      Electric Hair Dryers and parts and fittings therefore; Air Purifying units; Portable electric heaters for domestic use; Humidifiers.

(“the First Earlier Mark”)

SHARK

UKTM no. 918015640<sup>1</sup>

Filing date 29 January 2019; registration date 12 June 2019

Priority date: 20 December 2018 (United States of America)

Class 11 Electric Hair Dryers and parts and fittings therefore; Air Purifying units; Portable electric heaters for domestic use; Humidifiers.

("the Second Earlier Mark")

SHARK

UKTM no. 903223062

Filing date 12 June 2003; registration date 24 September 2004

Class 3 Detergents, cleaning preparations, cleaners for household use, carpet shampoo, preparations for cleaning carpets, floor wax, furniture and floor polish, soaps for household use.

Class 21 Mops, brooms, dustbins, mechanical carpet brushes (non-electric), brushes, cleaning cloths, dust cloths, polishing cloths.

("the Third Earlier Mark")

SHARK

UKTM no. 902718419

Filing date 31 May 2002; registration date 2 October 2003

Class 7 Vacuum cleaners; multi-purpose steam cleaning machines; kitchen electrics, namely, food blenders for domestic use, mixers, choppers, citrus juicers and juice extractors, food processors; sewing machines.

Class 9 Steam irons for domestic use, electric irons for domestic use.

Class 21 Cookware, namely, frying pans, metal cooking pans, pots and pot lids; grills for cooking; bakeware; ironing boards.

("the Fourth Earlier Mark")

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<sup>1</sup> 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 rights holders with an existing EUTM. As a result of the opponent having EUTMs being protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable trade marks shown here are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

3. Under section 5(2)(b) of the Act, the opponent claims that the marks are similar and the goods are identical or similar, resulting in a likelihood of confusion.

4. Under section 5(3) of the Act, the opponent claims that it has a reputation for all goods for which the earlier marks are registered and that use of the applicant's mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character or repute of the earlier marks.

5. Under section 5(4)(a) of the Act, the opponent relies upon the sign SHARK which it claims to have used throughout the UK since December 2017 in relation to:

“electric hair dryers an parts and fittings therefore; air purifying units; portable electric heaters for domestic use; humidifiers; vacuum cleaners; multi-purpose steam cleaning machines; kitchen electrics, namely, food blenders for domestic use, mixers, choppers, citrus juicers and juice extractors, food processors; sewing machines; steam irons for domestic use, electric irons for domestic use; cookware, namely, frying pans, metal cooking pans, pots and pot lids; grills for cooking; bakeware; ironing boards; detergents, cleaning preparations, cleaners for household use, carpet shampoo, preparations for cleaning carpets, floor wax, furniture and floor polish, soaps for household use; mops, brooms, dustbins, mechanical carpet brushes (non-electric), brushes, cleaning cloths, dust cloths, polishing cloths.”

6. The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

7. The applicant filed a counterstatement denying the claims made.

8. The applicant is represented by Gloria Qsing and the opponent is represented by Taylor Wessing LLP.

9. Both parties filed evidence in chief. The opponent did not file evidence in reply. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

10. The opponent filed evidence in chief in the form of the witness statement of William Seymour dated 28 October 2022, which is accompanied by 11 exhibits. Mr Seymour is the Associate General Counsel – Global Marketing and Robotics for the opponent.

11. The applicant filed evidence in chief in the form of a statement of use and witness statement given by Zhiming Le dated 30 December 2022, which is accompanied by 5 exhibits. Zhiming Le is the CEO of the applicant.

12. The opponent filed written submissions in lieu dated 7 June 2023.

13. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

## **RELEVANCE OF EU LAW**

14. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **DECISION**

### **The applicant's evidence**

15. I have reviewed the applicant's evidence. It relates to the use that has been made of the application, by the applicant, in the UK since August 2022. That evidence is

after the date of the application in issue and is, consequently, not of assistance to the applicant in relation to any of the grounds of opposition.

### **My approach**

16. I will begin by considering the section 5(3) ground of opposition. In my view, this ground represents the opponent's best case.

### **Section 5(3)**

17. Section 5(3) of the Act states:

“5(3) A trade mark which -

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

18. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

19. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. Although the Third and Fourth Earlier Marks had completed their registration process more than 5 years prior to the filing date of the application in issue and so are subject to the use provisions of section 6A of the Act, the applicant did not request that the opponent prove use. Consequently, the opponent can rely upon all of the earlier marks identified.

20. The relevant case law can be found in the following judgments of the Court of Justice of the European Union (“CJEU”): *Case C-375/97, General Motors, Case 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 C383/12P, 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; *General 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) 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.*

(g) 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.*

(h) 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.*

(i) 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*).

21. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the applicant's mark are similar. Secondly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier marks being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section

5(3) of the Act that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

## **Reputation**

22. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

23. In determining whether the opponent has demonstrated a reputation for the goods relied upon, it is necessary for me to consider whether the earlier marks will be known by a significant part of the public concerned with those goods. In reaching this decision, I must take all of the evidence into account including: “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it”.

24. The relevant jurisdiction for assessing reputation is the UK only for the First Earlier Mark and the UK and/or EU for the Second, Third and Fourth Earlier Marks (being comparable marks). However, for reasons that will become clear, I need only consider the opponent's reputation in the UK. With that in mind, I note the following from the opponent's evidence:

- a) Mr Seymour explains that the opponent sells goods under two brands: "Shark, which mainly produces vacuum cleaners and hairdryers; and Ninja, which focuses on kitchen appliances".
- b) The opponent has made the following sales of shark branded products in the UK (approximate figures only):

2017	£38million
2018	£87million
2019	£156million
2020	£272million
2021	£291million

- c) The opponent has sold its goods through UK national retailers including Costco and John Lewis.<sup>2</sup>
- d) The opponent has invested over £142million in marketing its products in Europe (including the UK). I note that no breakdown is provided for the UK market specifically.
- e) The opponent's UK dedicated social media channels include Facebook (with more than 75,000 followers), Instagram (with more than 100,000 followers), Twitter (with more than 6,500 followers) and YouTube (with more than 3,500 followers). I note that these figures are correct as of the date of Mr Seymour's statement, and so I will proceed on the basis that the figures at the relevant date would have been lower.

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<sup>2</sup> Exhibit WS1 and WS2

25. The opponent has clearly achieved significant sales in the UK and has sold through national retailers, suggesting a broad geographical spread. However, the sales figures provided are not broken down by product. I note Mr Seymour's evidence that sales under the SHARK brand "mainly" relate to vacuum cleaners and hair dryers. Based upon that, I am prepared to infer that the majority of the sales figures provided would have related to these products. I note that the advertising and marketing figures provided have not been broken down by jurisdiction, but I note that UK-specific social media accounts have amassed a significant following (albeit it is likely to have been lower at the relevant date). I bear in mind that the opponent also claims to have a reputation for goods such as cooking appliances. Whilst I can see from the invoices provided that the opponent has made sales in relation to these goods, they appear to have been made under the NINJA brand; this is supported by Mr Seymour's narrative evidence. In the absence of any further detail about how the SHARK brand has been applied to these goods (if at all), I am not prepared to conclude that the opponent had a reputation for those goods at the relevant date. I find that the opponent had a strong reputation for vacuum cleaners and hair dryers at the relevant date.

## **Link**

26. Whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are (i) the degree of similarity between the conflicting marks; (ii) the nature of the goods for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods, and the relevant section of the public; (iii) the strength of the earlier mark's reputation; (iv) the degree of the earlier mark's distinctive character, whether inherent or acquired through use and (v) whether there is a likelihood of confusion.

### The degree of similarity between the conflicting marks

27. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and

conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

28. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

29. The marks to be compared are as follows:

The opponent's marks	The applicant's mark
SHARK	<b><i>Cooshark</i></b>

30. The opponent's marks consists of the word SHARK, in which the overall impression resides. The applicant's mark consists of the invented word COOSHARK, presented in a slightly stylised, title case, grey font. It is the word itself which plays the greater role in the overall impression, with the font playing a lesser role.

31. Visually, the marks coincide in that the opponent's marks appear at the end of the applicant's mark. However, the letters COO- at the beginning of the applicant's mark

represent a point of visual difference. I bear in mind that the beginning of marks tend to make more of an impact than the ends.<sup>3</sup> I note that the applicant's mark is presented in title case, whereas the opponent's marks are presented in upper case. However, as the opponent's marks are word only, they can be used in any font. I consider the marks to be visually similar to a medium degree.

32. Aurally, the word SHARK in the opponent's marks will be given its ordinary English pronunciation. The letters -SHARK at the end of the applicant's mark will be pronounced identically. However, the letters COO- at the beginning of the applicant's mark will act as a point of aural difference. I consider the marks to be aurally similar to a medium degree.

33. Conceptually, the opponent's marks will be attributed their ordinary dictionary meaning i.e. a large predatory fish. The applicant's mark is an invented word. However, a significant proportion of average consumers are likely to recognise the dictionary word at the end of the applicant's mark. They may perceive the mark as a whole as being a reference to a particular type of shark. In those circumstances, the marks are conceptually similar to at least a medium degree. However, for those average consumers who view the applicant's mark as an invented word with no meaning, the marks are conceptually dissimilar.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

34. The following terms in the applicant's specification are identical to the goods for which the opponent has a reputation (either self-evidently or because one falls within the broader category of the other):

Class 7      Electric cordless sweepers; Electric sweepers; Rechargeable sweepers;  
Carpet cleaning machines; Floor cleaning machines; Vacuum cleaners;  
Dust removing installations for cleaning purposes.

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<sup>3</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Class 11 Hair dryers; Electric hair dryers; Portable electric warm air dryer.

35. The remaining goods in class 7 of the application are all domestic cleaning products:

Electric window cleaning machines; Automatic floor scrubbers; Machines for cleaning surfaces using high pressure water; Steam cleaning machines; Swimming pool cleaning machines.

36. They are likely to be sold through the same trade channels to the same users as the opponent's "vacuum cleaners". There may be some limited overlap in nature (such as where they are all electric goods) and method of use. The specific purpose of the goods will differ, although they all have the general purpose of cleaning. They are not in competition or complementary. In my view, they are similar to at least between a low and medium degree.

37. The following goods in class 11 of the application are all (or could include) electronic domestic goods:

Air cleaning apparatus; Air cleaning instruments; Air fryers; Humidifiers; Electric kettles for household purposes; Coffee machines, electric; Electric toasters.

38. They are likely to be sold through the same retailers as other electronics for domestic use and will be sold to the same users. There will be some limited overlap in nature to the extent that they are all electric products. The method of use and purpose of the goods clearly differ and they are neither in competition, nor complementary. I consider there to be a low degree of similarity between the goods.

39. That leaves the following goods in the applicant's specification:

Gas purification apparatus; Gas purification machines; Water purification installations.

40. These appear to me to be specialist goods that are unlikely to be sold through the same retailers as the opponent's goods. I have been provided with no evidence to support such a finding. If there is any overlap in user then it is not likely to be frequent and, in any event, that alone is not enough for a finding of similarity. There is no overlap in method of use, nature or purpose. They are neither in competition nor complementary. I consider the goods to be dissimilar.

41. The relevant public includes members of the general public at large and professional users. The purchasing process for the goods is likely to be predominantly visual, as the goods are likely to be purchased following sight of the packaging, and branding on retail premises or on websites/advertisements. However, I do not discount an aural component given that advice may be sought from retail assistants. I bear in mind that these goods are likely to be reasonably costly purchases, which will be purchased relatively infrequently. They are likely to attract a slightly higher than medium degree of attention.

#### The strength of the earlier mark's reputation

42. I have found the opponent to have a strong reputation for vacuum cleaners and hair dryers in the UK.

#### The degree of the earlier mark's distinctive character, whether inherent or acquired through use

43. 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

44. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

45. The word SHARK is an ordinary dictionary word which has no connection to the goods in issue. In my view, it is inherently distinctive to a medium degree. For the same reasons given above, I consider that the distinctiveness of the earlier marks has been enhanced through use to a high degree for vacuum cleaners and hair dryers.

#### Whether there is a likelihood of confusion

46. For those goods that I have found to be similar to the goods for which the opponent has a reputation, I consider that there would be a likelihood of indirect confusion. This is on the basis that the earlier marks have become so distinctive through use that the relevant public would expect only one undertaking to be using it (even as part of another mark) in relation to similar goods. Where I have found the goods to be dissimilar, the distance between the goods would be sufficient to avoid confusion arising.

### Conclusion on Link

47. Bearing in mind all of the above factors, I am satisfied that a link would be made in the mind of the relevant public where the goods share some degree of similarity. Where the goods are dissimilar, I do not consider it likely that a link would be made. Consequently, the opposition based upon this ground must fail in respect of:

Class 11      Gas purification apparatus; Gas purification machines; Water purification installations.

### **Damage**

48. I must now consider whether any of the types of damage pleaded will arise.

### Unfair Advantage

49. In its Form TM7, the opponent stated as follows:

“18. Use of the Applicant’s Mark in relation to any and all of the goods covered by the Application, being without due cause, would take unfair advantage of the Opponent’s Mark by free-riding on its distinctiveness and reputation. The Applicant will gain an advantage from the substantial reputation of the Opponent’s Mark because its mark will gain attention and marketability for the services covered by the Application by riding on the coat-tails of the Opponent’s Mark and benefitting from the Opponent’s promotional and marketing efforts.

19. Furthermore, the strong reputation of the Opponent’s Mark will be transposed to the Applicant’s mark, meaning that the provision of goods will become easier for the Applicant. The advantage resulting from the use of a similar trade mark must be considered to be an advantage unfairly gained from the distinctive character and repute of the Opponent’s Mark.”

50. I bear in mind that unfair advantage has no effect on the consumers of the earlier mark's goods. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the goods of the later mark than they would otherwise have been if they had not been reminded of the earlier mark.

51. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

52. To the extent that the relevant public believes that the goods of the applicant originate from the opponent, there will clearly be unfair advantage. However, even if they do not consider that the goods originate from the same undertaking, I consider that the applicant will still gain an unfair advantage. Mr Seymour's unchallenged evidence is that the opponent has a reputation for quality. In my view, there is clear potential for this image to transfer to the applicant's goods. Consequently, I consider that damage is made out.

53. As damage is made out on the basis of unfair advantage, I do not need to consider the other pleaded heads of damage.

54. The opposition based upon section 5(3) of the Act succeeds in relation to the following goods:

Class 7      Electric cordless sweepers; Rechargeable sweepers; Electric window cleaning machines; Carpet cleaning machines; Automatic floor scrubbers; Floor cleaning machines; Machines for cleaning surfaces using high pressure water; Vacuum cleaners; Dust removing installations for cleaning purposes; Steam cleaning machines; Swimming pool cleaning machines; Electric sweepers.

Class 11     Hair dryers; Electric hair dryers; Portable electric warm air dryer; Air cleaning apparatus; Air cleaning instruments; Air fryers; Humidifiers; Electric kettles for household purposes; Coffee machines, electric; Electric toasters.

55. It fails in relation to the following goods:

Class 11     Gas purification apparatus; Gas purification machines; Water purification installations.

**Section 5(2)(b)**

56. Section 5(2)(b) of the Act reads as follows:

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

(a)...

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

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

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

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

58. 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:

(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 greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

59. As noted above, where I have found the goods to be similar to some degree, there would plainly be a likelihood of confusion. However, I do not consider that this ground of opposition puts the opponent in any stronger position than it is under the section 5(3) ground. This is because the only term in the opponent's specifications that is similar to the surviving goods is the term "air purifying units". I accept that there would be a low degree of similarity between these goods due to the general overlap in nature

and purpose by virtue of them being purification goods. However, the specific purpose/nature would differ due to them relating to water/gas/air. There is no evidence before me of an overlap in trade channels and any overlap in user is likely to be limited. There is no competition or complementarity. Whilst the opponent has established enhanced distinctiveness for vacuum cleaners and hair dryers, it cannot benefit from that enhancement in relation to “air purifying units”. Consequently, the earlier marks are inherently distinctive to only a medium (or average) degree.

60. Given the differences between the marks and the goods, there is no likelihood of direct confusion; they are simply too far apart. In relation to indirect confusion, given that the common element is only distinctive to a medium (or average) degree for the goods in issue, it cannot be said to be so strikingly distinctive that the average consumer would assume that no-one else but the opponent could be using it. The addition of the letters COO- to the beginning of the applicant’s mark cannot be described as a non-distinctive addition; it is also not consistent with a sub-brand or brand extension. The opponent suggests that the applicant’s mark will be read as COOL-SHARK referring to a “cool” sub-brand of the SHARK product. However, given that the additional letters added to the start of the application are COO (not COOL), I can see no basis for this. I have considered whether there is any other basis for indirect confusion to arise and I am unable to identify any.

61. Consequently, the opposition based upon section 5(2)(b) of the Act does not put the opponent in any stronger position than it is under section 5(3).

#### **Section 5(4)(a)**

62. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

63. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

64. I can deal with this ground relatively swiftly. Clearly, the opponent has goodwill for vacuum cleaners and hair dryers and the sign relied upon was distinctive of that goodwill at the relevant date. However, bearing in mind the distance between these goods and the goods that have survived the section 5(3) ground of opposition, I do not consider it likely that misrepresentation or damage would occur. I am not satisfied that a substantial number of members of the relevant public will be misled into thinking that the goods of the applicant are those of the opponent. Consequently, this ground of opposition does not put the opponent in any stronger position than it is under the section 5(3) ground of opposition.

## **CONCLUSION**

65. The opposition is successful in relation to the following goods for which the application is refused:

Class 7      Electric cordless sweepers; Rechargeable sweepers; Electric window cleaning machines; Carpet cleaning machines; Automatic floor scrubbers; Floor cleaning machines; Machines for cleaning surfaces using high pressure water; Vacuum cleaners; Dust removing

installations for cleaning purposes; Steam cleaning machines; Swimming pool cleaning machines; Electric sweepers.

Class 11 Hair dryers; Electric hair dryers; Portable electric warm air dryer; Air cleaning apparatus; Air cleaning instruments; Air fryers; Humidifiers; Electric kettles for household purposes; Coffee machines, electric; Electric toasters.

66. The opposition is unsuccessful in relation to the following goods for which the application may proceed to registration:

Class 11 Gas purification apparatus; Gas purification machines; Water purification installations.

## **COSTS**

67. The opponent has enjoyed the greater degree of success and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I have applied a reduction for the only partial success. In the circumstances, I award the opponent the sum of **£1,700**, calculated as follows:

Preparing a Notice of opposition and considering the counterstatement	£350
Preparing and filing evidence	£800
Written submissions in lieu	£350
Official fee	£200
<b>Total</b>	<b>£1,700</b>

68. I therefore order Shenzhen Cooshark Innovation Technology Co., Ltd to pay Shark Ninja Operating LLC the sum of **£1,700**. This sum should be paid within 21 days of the

expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 30<sup>th</sup> day of December 2023**

**S WILSON**

**For the Registrar**