O/0255/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003854948
BY BRIGHTEVER CO., LTD.
TO REGISTER:

Brightever

AS A TRADE MARK IN CLASSES 7, 8 AND 9

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 439564
BY KUANG XINQIAO

BACKGROUND AND PLEADINGS

1. On 01 December 2022, BRIGHTEVER CO., LTD. ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 10 February 2023 in respect of the following goods:[1]

> **Class 7:** *Abrasive disks for power-operated grinders; Air brushes for applying paint; Air compressors; Ratchet wrenches [machines]; Electric drills; Grinders [machines]; Orbital sanders [machines]; Band saws; Bits for power drills; Blades for power tools; Car washing machines; Cemented carbide cutting tools; Electric hoists; Pneumatic hoists; Electric arc welding machines; Electricity generators; Impact wrenches; Power tools; Winches; Electric pumps; Electric soldering irons; Power-operated staple guns; Electrical welding machines.*
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> **Class 8:** *Hand tools, hand-operated; Hand-operated tools for repair of vehicles; Tire irons; Oil filter wrenches; Manually-operated grease guns; Manually operated motorcycle lifts; Hand-operated tools for bending pipes; Ratchet wrenches [hand tools];Socket wrenches [hand tools].*
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> **Class 9:** *Measuring instruments; Scanners; Apparatus for testing vehicle brakes; Batteries; Battery chargers; Battery jump starters; Diesel injector testers; Digital multimeters; Magnifying glasses; Measuring rulers; Micrometers; Solar-powered battery chargers; Solar-powered rechargeable batteries; Welding helmets; Inverters for power supply; Surveying instruments; Measuring apparatus and instruments; Distance measuring apparatus; Levels [instruments for determining the horizontal].*

2. On 06 March 2023, the application was opposed by Kuang Xinqiao ("the opponent") based upon Sections 5(2)(a) and 5(3) of the Trade Marks Act 1994 ("the Act").

[1] The application initially included goods in class 11, however, they were subsequently removed following a request filed by the applicant on 23 August 2023 to remove class 11 from the application.

3. The opponent relies on the following trade mark and all of the goods covered by the same, as shown below:

UK00003430994 Brightever Filing date: 24 September 2019 Registration date: 20 December 2019 **Class 11:** *Ceiling light fittings; Desk lamps; Downlights; Fairy lights for festive decoration; Flood lights; Floor lamps; Hanging lamps; Lamps; LED light bulbs; Decorative lights; Wall lamps; Outdoor lighting; Pendant fluorescent lighting fixtures; Portable headlamps; Solar powered lamps; String lights for festive decoration; Ultraviolet ray lamps, not for medical purposes; LED flashlights; Chandeliers.*

4. By virtue of its earlier filing date, the trade mark relied upon by the opponent is an "earlier mark" in accordance with Section 6 of the Act. As the opponent's earlier mark had not been registered for five years or more at the filing date of the applied-for mark, it is not subject to the use conditions under Section 6A of the Act. Consequently, the opponent may rely on all of the goods it has identified without demonstrating that it has used the mark.

5. Under Section 5(2)(a), the opponent claims there is a likelihood of confusion because the marks are identical, and the goods are identical or similar.

6. Under Section 5(3), the opponent claims that it has a reputation in respect of the registered goods and that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier mark.

7. The applicant filed a counterstatement, denying the claims made and claiming that the trade mark applied-for is the name of the applicant's company which has been in existence for 22 years and enjoys a strong reputation.

8. The opponent is not professionally represented albeit their case was conducted by Qinbin Li. The applicant is represented by Bayview IP.

9. Both parties filed evidence which was accompanied, in both cases, by written submissions. Neither party requested a hearing, nor did they file written submissions in lieu. I make this decision having taken full account of all the papers, referring to them as necessary.

THE EVIDENCE

10. Both parties have filed evidence about their use of the mark 'Brightever'.

11. The opponent filed evidence in the form of the witness statement of Kuang Xinqiao, (i.e. the opponent themselves), dated 20 December 2023. The opponent's statement is very brief, consisting of only six paragraphs, and is accompanied by three exhibits being those labelled Exhibit A-C. Along with this evidence, the opponent also filed written submissions dated 11 December 2023.

12. The applicant filed evidence in the form of the witness statement of Chen Peijian, who describe themselves as the owner of the applicant's company. The applicant's statement is also very brief, consisting of only eight paragraphs, and is accompanied by seven exhibits being those labelled CP1-CP7. Along with this evidence, the applicant also filed written submissions dated 1 April 2024.

RELEVANCE OF EU LAW

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

PRELIMINARY ISSUE

14. In its counterstatement, the applicant states that their use of the applied-for mark predates the opponent's use of the earlier mark. It also filed evidence showing that it owns an international trade mark registration designating the UK (no. WO0000000825220) for the mark 'BRIGHTEVER' in class 7 which has an international registration date of 24 February 2004 (which is earlier than the filing date of the opponent's earlier mark).[2] The applicant also states that it is the opponent that it is attempting to trade on the applicant's long-established reputation and goodwill in the brand 'Brightever' rather than the contrary. The points raised by the applicant have no bearing on this matter. Tribunal Practice Notice 4/2009 makes clear that there is no basis in law for a defence to succeed purely because the applicant for registration owns another mark which is earlier still compared to the opponent's mark, or has used the trade mark before the opponent used or registered its mark. In those circumstances, the proper course of action is to seek to invalidate the earlier mark, based on the earlier registered (or unregistered) right. In this case, since there is no record of the opponent's mark being subject to any invalidation action, I will proceed on the basis that the validity of the earlier mark is not in question.

DECISION

Section 5(2)(a)

15. Section 5(2)(a) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or…
> (b) …
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

[2] CP4

16. 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."

17. 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

18. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be

taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

19. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

"[…] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

21. In *Sanco SA v OHIM,* Case T-249/11, the General Court ("GC") indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

22. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

23. The competing goods are as follows:

The applicant's goods	**The opponent's goods**
Class 7: *Abrasive disks for power-operated grinders; Air brushes for applying paint; Air compressors; Ratchet wrenches [machines]; Electric drills; Grinders [machines]; Orbital sanders [machines]; Band saws; Bits for power drills; Blades for power tools; Car washing machines; Cemented carbide cutting tools; Electric hoists; Pneumatic hoists; Electric arc welding machines; Electricity generators; Impact wrenches;*	

Power tools; Winches; Electric pumps; Electric soldering irons; Power-operated staple guns; Electrical welding machines.	
Class 8: *Hand tools, hand-operated; Hand-operated tools for repair of vehicles; Tire irons; Oil filter wrenches; Manually-operated grease guns; Manually operated motorcycle lifts; Hand-operated tools for bending pipes; Ratchet wrenches [hand tools]; Socket wrenches [hand tools].*	
Class 9: *Measuring instruments; Scanners; Apparatus for testing vehicle brakes; Batteries; Battery chargers; Battery jump starters; Diesel injector testers; Digital multimeters; Magnifying glasses; Measuring rulers; Micrometers; Solar-powered battery chargers; Solar-powered rechargeable batteries; Welding helmets; Inverters for power supply; Surveying instruments; Measuring apparatus and instruments; Distance measuring apparatus; Levels [instruments for determining the horizontal].*	
	Class 11: *Ceiling light fittings; Desk lamps; Downlights; Fairy lights for festive decoration; Flood lights; Floor lamps; Hanging lamps; Lamps; LED light bulbs; Decorative lights; Wall lamps; Outdoor lighting; Pendant fluorescent lighting fixtures; Portable headlamps; Solar*

	powered lamps; String lights for festive decoration; Ultraviolet ray lamps, not for medical purposes; LED flashlights; Chandeliers.

24. Apart from the general claims and denials about the similarity of the goods at issues, neither party has made any submissions as to why the competing goods should be regarded as being similar or dissimilar. The only submission which can remotely be said to relate to the similarity of the goods is contained in the opponent's written submissions in which the opponent states:

> *"Although [the] Applicant have deleted class 11 and its goods from their application, there is still related goods used in the United Kingdom by the opponent as attached hereto as Exhibit B, for the products sell in class 7 , 8 and 9 which is sold on Amazon platform with the back-store sales data."*

25. Exhibit B to the opponent's witness statement contains undated images of three products featuring the mark 'Brightever', namely a drill bit, a spanner and a magnifying glass, along with undated screen shots from the Amazon website showing these products available for sale. Since (a) the goods shown in Exhibit B are not covered by the specification of the earlier mark and (b) the opponent did not rely on unregistered trade mark rights deriving from its use of the mark 'Brightever' in relation to the goods shown in Exhibit B, the fact that the opponent might have used the earlier mark in relation to the goods shown in Exhibit B (and that those goods might be more similar to the applied-for goods than the registered goods), is wholly irrelevant because the opponent cannot rely on such use.

26. Normally, in circumstances where it is not self-evident why the goods and services covered by an earlier mark are claimed to be identical, or similar, to the opposed goods and services for the purposes of Sections 5(1) or 5(2), the casework examiner might demand further particularisation of the claim about the identity/similarity of the goods and services (see Tribunal Practice Note 1/2018). In this case, the fact that this was not done does not exonerate the opponent from the burden of pleading its case. This leaves me with an unparticularised claim that the goods are similar. I bear in mind that

it is not my job to go beyond the bare and unexplained assertion of similarity; further, unless the goods are self-evidently similar, it is not for me to find points of similarity which the opponent has neither pleaded nor argued.[3] Nevertheless, I can rely on dictionary definitions for the purpose of determining the natural, ordinary and core meaning of the terms listed in the specifications. With this in mind, I now turn to the goods.

Class 7: *Abrasive disks for power-operated grinders; Air brushes for applying paint; Air compressors; Ratchet wrenches [machines]; Electric drills; Grinders [machines]; Orbital sanders [machines]; Band saws; Bits for power drills; Blades for power tools; Car washing machines; Cemented carbide cutting tools; Electric hoists; Pneumatic hoists; Electric arc welding machines; Electricity generators; Impact wrenches; Power tools; Winches; Electric pumps; Electric soldering irons; Power-operated staple guns; Electrical welding machines.*

27. The applied-for goods in class 7 include machines, machine tools and power-operated tools for various purposes including for applying paint, for grinding (a grinder is defined as "*a machine used to rub or press something until it becomes a powder*", e.g. coffee grinders), for sanding (a sander is defined as *"an electrical machine to which a sheet or disc of rough paper is fastened to rub other surfaces in order to make them smoother*", e.g. floor sander), for cutting, for drilling (a drill is defined as *"a tool or machine that makes holes*"), and for welding and soldering metal (welding and soldering consisting of joining metal parts together). They also include ratchet wrenches (I understand ratchet wrenches to be a hand tool used for locking, disassembling, and fastening bolts and nuts), air compressors (an air compressor is defined as *"a piece of equipment that presses air into a smaller space so that it can be used under high pressure, for example for filling a tyre*"), electric generators for the production of electrical power, electric pumps (I understand an electric pump to be a device that uses electricity to move fluids, such as chemicals, oil, or water), electric and pneumatic hoists and winches (I understand those goods to be types of lifting equipment).

[3] BL-O/0911/24

28. The opponent's goods in class 11 include light fittings, lights, lamps, light bulbs and chandeliers which are all goods, apparatus and installations for the purpose of lighting.

29. The nature, intended purpose and use of the opponent's goods is that of illuminating a space or decorating it with lights which is very different from that of the applied-for goods in class 7 which are used for applying paint, grinding, sanding, cutting, drilling, welding and soldering, cleaning, generating electricity, pressing air, locking and unlocking bolts, and lifting. In addition, the goods have different methods of use, and are neither interchangeable, not complementary. Whilst the competing goods might all be sold in the same DIY shops which might sell tools, paint, and other equipment needed for DIY as well as light fittings, lamps and bulbs, the mere fact that there may be some similarity of trade channels, does not mean that there is overall similarity given the other differences between the goods. As Amanda Michaels, sitting as the Appointed Person, stated in BL-O/1078/24:

> "Taking the trade channels point to extremes would mean that one would risk making a finding of similarity between orange juice and peanuts simply because both might be sold in supermarkets or in pubs. Plainly that cannot be right, when the reason for examining the similarity of the parties' goods is to consider to what extent the two kinds of goods are liable to be perceived as "related" by the average consumer. As Mr Hobbs KC said in Burn trade mark O/074/19 at p 14:
>
> "for the purposes of an objection to registration under section 5(2)(b) [the factors] must be sufficient to establish a basis for maintaining that the goods in issue are what may be termed "kindred goods", the nature or characteristics of which or the nature or characteristics of commerce in which are such that a single economic undertaking would naturally be regarded as directly or indirectly responsible for providing goods of the kind in question."

30. In addition, the goods target different users, as the opponent's lighting goods are likely to be purchased by homeowners, whereas the applied-for goods are likely to be purchased by garages, builders and tradesmen as well as those who do DIY. Insofar the opponent's lighting goods can also be purchased by an electrician or a DIY

enthusiast who might also purchase some of the applicant's goods (e.g. Electric drills, Bits for power drills) and use them when fitting the opponent's goods, (a) the coincidence in users is too general a factor and is not sufficient to establish that the goods are similar and (b) although the goods might be used together they are not, on any normal view, complementary in a sense that customers may think that the responsibility for those goods lies with the same undertaking. These goods are dissimilar.

Class 8: *Hand tools, hand-operated; Hand-operated tools for repair of vehicles; Tire irons; Oil filter wrenches; Manually-operated grease guns; Manually operated motorcycle lifts; Hand-operated tools for bending pipes; Ratchet wrenches [hand tools]; Socket wrenches [hand tools].*

31. Similar considerations apply to the above goods in class 8, which include hand-operated tools and implements for performing tasks, such as repairing vehicles, changing oil filters in cars, lifting motorcycles, bending pipes and locking and unlocking nuts and bolts, and would be purchased, primarily, by garages. The goods have a different nature, intended purpose, use, users and method of use and are not complementary, the coincidence in trade channels (if it exists) not being sufficient to establish that the goods are similar. Admittedly, the applied-for *Hand tools, hand-operated* cover hand-operated tools at large, and include tools which would be used by electricians or DIY enthusiasts, when, for examples, fitting the opponent's lighting goods. However, as I have said above, (a) the coincidence in users is too general a factor and is not sufficient to establish that the goods are similar and (b) although the goods might be used together, they are not, on any normal view, complementary in a sense that customers may think that the responsibility for those goods lies with the same undertaking. These goods are dissimilar

Class 9: *Measuring instruments; Scanners; Apparatus for testing vehicle brakes; Batteries; Battery chargers; Battery jump starters; Diesel injector testers; Digital multimeters; Magnifying glasses; Measuring rulers; Micrometers; Solar-powered battery chargers; Solar-powered rechargeable batteries; Welding helmets; Inverters for power supply; Surveying instruments; Measuring apparatus and instruments; Distance measuring apparatus; Levels [instruments for determining the horizontal].*

32. Similar considerations apply to the above goods in class 9, which include measuring instruments (e.g. rulers, gasometers), surveying instruments (for example, tools used by surveyors to measure and map the land and physical environment), protective helmets for welding metal, scanners, batteries and battery chargers, as well as tools for testing vehicle brakes and evaluate the health of engine components. The goods have a different nature, intended purpose, use, users and method of use and are not complementary, the coincidence in trade channels (if it exists) not being sufficient to establish that the goods are similar. Admittedly, the applied-for *measuring instruments* cover electric measuring instruments which would be used by electricians or DIY enthusiasts, when, for examples, fitting the opponent's lighting goods. However, as I have said above, (a) the coincidence in users is too general a factor and is not sufficient to establish that the goods are similar and (b) although the goods might be used together, they are not, on any normal view, complementary in a sense that customers may think that the responsibility for those goods lies with the same undertaking. These goods are dissimilar

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

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

34. Some similarity of goods is therefore essential for a likelihood of confusion to be established. Since I have concluded that there is no meaningful similarity between the competing goods, the opposition based on Section 5(2)(a) fails, regardless of the identity of the marks.

Section 5(3)

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

> "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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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."

36. The relevant case law can be found in the following judgments of the 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,* Case C-323/09, *Marks and Spencer v Interflora,* 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; 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 Salomon, 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 holder 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).

37. The conditions of Section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark and the applicant's mark are similar. Secondly, the opponent must show that the earlier mark has 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 mark 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) that the goods and services 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.

38. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 01 December 2022.

Reputation

39. 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."

40. The opponent's evidence is in an extraordinarily truncated format. It consists of five brief paragraphs, the first and last of which contains no narrative evidence, providing information about who made the witness statement and a statement of truth, respectively. The body of the opponent's witness statement is short, and it is convenient merely to reproduce it in full:

"2. Opponent's trademark Brigherever UK00003892285 Print-outs from the Intellectual Property Office records showing the current status of these registrations are attached hereto as Exhibit A.

3. Although Applicant have deleted class 11 and its goods from their application, there is still related goods used in the United Kingdom by the opponent as attached hereto as Exhibit B, for the products sell in class 7, 8 and 9 which is sold on Amazon platform with the back-store sales data.

4. Opponent's trademark has been used all over the world for years and registered in the local countries as well, hereto as Exhibit C."

41. As it can be seen, paragraph 2 (and exhibit A) does not refer to the earlier mark UK00003430994 but to a different trade mark which is not pertinent in these proceedings. The records show that UK00003892285 corresponds to a trade mark registration for 'Brightever' in classes 9 and 28 which was filed by the opponent after the contested application was filed, on 23 March 2023, and was registered on 16 June 2023. This evidence does not show use of the earlier mark on the goods for which it is registered and for which reputation is claimed.

42. Turning to paragraph 3 and exhibit B, as it will be recalled, I have dealt with this evidence above at [25-26], but I will repeat briefly that it consists of undated images of three products featuring the mark 'Brightever', namely a drill bit, a spanner and a magnifying glass, along with undated screen shots from the Amazon website showing these products available for sale. Since none of the goods shown in Exhibit B are covered by the specification of the earlier mark, this evidence does not show use of the earlier mark on the goods for which it is registered and for which reputation is claimed.

43. Lastly, Mr Xinqiao's statement that *"the opponent's trade mark has been used all over the world for years and registered in the local countries as well"* is nothing more than a vague general assertion, and fails to provide any information as to whether the mark has been use in the UK, for how long and to what extent, exhibit C only providing copy of USA trade mark registration for the mark 'Brightever' in the opponent's name.

44. Since the opponent has failed to establish that, by the relevant date, the earlier mark had been used in the UK, it has also failed to establish the higher hurdle that it had a reputation in relation to the relevant section of the public as regards the goods for which the mark is registered. Accordingly, the opposition based on Section 5(3) also fails.

OUTCOME

45. The opposition has failed. Subject to any successful appeal against my decision, the application will proceed to registration.

COSTS

46. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £850, calculated as follows:

Preparing a statement and considering the other side's statement: £350
Considering the other party's evidence

And preparing evidence and written submissions: £500
Total: £850

47. I therefore order Kuang Xinqiao to pay BRIGHTEVER CO., LTD. the sum of £850. This sum is to 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 19th day of March 2025

TERESA PERKS
For the Registrar