

O/0681/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003975035
BY DONGGUAN EDIFIER ESPORTS TECHNOLOGY CO., LTD.
TO REGISTER:**



AS A TRADE MARK IN CLASSES 9 & 28

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 446419 BY
ROBERT BOSCH GMBH**

BACKGROUND AND PLEADINGS

1. On 2 November 2023, Dongguan Edifier Esports Technology Co., Ltd. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published on 15 December 2023 and registration is sought for the following goods:

Class 9: Computer keyboards; Joysticks for use with computers, other than for video games; Computer peripheral devices; Mouse [computer peripheral]; Devices for the projection of virtual keyboards; Sound card; Mouse pads; Keyboard for smartphone; Headset; Wireless speakers; Telephone receiver; Earbuds; Headset used with a computer; Music headphones; Wireless headset for smartphones; Virtual reality games with headphones; Noise-canceling headphone; Double channel stereo recording microphone; Megaphones; Microphones; Headphones; Portable media players; Cabinets for loudspeakers; Diaphragms [acoustics]; Loudspeakers; Bar speaker; Subwoofers; Earpieces for remote communication; Personal headsets for voice transmission devices; Earphone for telephone; Virtual reality glasses; Virtual reality headsets; Head-mounted video display; USB cables; Mobile power (rechargeable battery); Stabilized voltage supply; Uninterruptible power supply; Low voltage power supply; High voltage power supply.

Class 28: Hand-held consoles for playing video games; Joysticks for video games; Controllers for game consoles; Mouse for games; Keypad for games; Special packages for handheld video game consoles; Video game machines; Interactive gaming chairs for video games; Board game equipment.

2. On 14 March 2024, the applicant's mark was opposed by Robert Bosch GmbH ("the opponent"). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under the section 5(2)(b) and 5(3) grounds, the opponent relies on the following trade marks:



UK registration no. 910359958¹

Filing date 21 October 2011; registration date 1 March 2012

Relying on some goods only, namely:

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Automatic vending machines and mechanisms for coin-operated apparatus; Cash registers, calculating machines and data-processing equipment; Fire-extinguishing apparatus; Lift operating apparatus; Decorative magnets; Electronic publications, downloadable; Welding apparatus (electric arc -); Hair-curlers, electrically heated; Magnets; Electric welding apparatus; Sealing plastics (electrical apparatus for -) [packaging]; Electric door openers; Electric door closers; Cigar lighters for automobiles; Asbestos

¹ The opponent's first and second marks are comparable marks based on earlier EUTMs. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

clothing for protection against fire; Asbestos gloves for protection against accidents; Speaker enclosures; Clothing especially made for laboratories; Clothing for protection against accidents, irradiation and fire; Coin-operated gates ' for car parks or parking lots; Computer keyboards; Computer operating programs, recorded; Peripherals adapted for use with computers; Recorded computer programs; Computer programs [downloadable software]; Recorded computer software; Covers for electric outlets; Electric arc cutting apparatus; Electric installations for the remote control of industrial operations; Lift operating apparatus; Electrified fences; Filters for respiratory masks; Clothing for protection against fire; Electrical irons; Furniture especially made for laboratories; Gates for car parks (coin-operated -); Holders for electric coils; Hands free kits for phones; Electronic locks; Protective masks; Masts for wireless aerials; Monitors [computer programs]; Protection devices for personal use against accidents; Push buttons for bells; Railway traffic safety appliances; Safety restraints, other than for vehicle seats and sports equipment; Shoes for protection against accidents, irradiation and fire; Solderers' helmets; Spark-guards; Steering apparatus, automatic, for vehicles; Theft prevention installations, electric; Camera tripods; Turnstiles, automatic; Vehicle breakdown warning triangles; Electrodes for welding; Workmen's protective face-shields.

Class 28: Games and playthings.
("the opponent's first mark");



UK registration no. 905047238

Filing date 10 April 2006; registration date 16 April 2007

Relying on some goods only, namely:

Class 9: Electric apparatus and instruments, namely electric irons, kitchen scales, personal scales; electric welding devices for wrapping; remote control devices, signalling devices, controlling (supervision) devices and monitoring devices for household and kitchen machines and equipment; recorded and not recorded machine readable data carriers such as magnetic data carriers for household appliances; electric apparatus for dispensing beverage or food, vending machines; data processing devices and data processing programmes for controlling and operating household appliances.

("the opponent's second mark"); and



UK registration no. 2111946

Filing date 3 October 1996; registration date 13 June 1997

Relying on some goods only, namely:

Class 9: Computers adapted for use in agricultural, horticultural and gardening apparatus and implements; computer devices for controlling water supplies.

("the opponent's third mark").

3. The opponent's position under section 5(2)(b) is that the marks at issue are highly similar and that the goods at issue are identical. As a result, the opponent claims that there exists a likelihood of confusion on the part of the average consumer.
4. Turning to the section 5(3) ground, the opponent claims that its marks enjoy a reputation for the goods relied upon. Further, the high similarity of the marks is such that it is likely that the relevant public would believe that the marks were used by the same or an economically connected undertaking. Consequently, the opponent claims that use of the applicant's mark would take unfair advantage of and be detrimental to the distinctive character and/or reputation of the opponent's marks.
5. Lastly, under the section 5(4)(a) ground, the opponent relies on the following sign:



("the opponent's sign")

6. The opponent claims to have used its sign across the UK since 1914 in respect of the following goods:

"Game motion sensors; game environmental sensors; game smart sensors; keyboards with joystick; speakers; headphones and headsets; batteries and battery chargers; machines and machine tools; power tools; automotive components; household electricals; electrical parts and components; electrical appliances."

7. Under this ground, the opponent claims to have acquired considerable goodwill and that its sign is immediately associated with the opponent. Given the high similarity of the marks and the identity/similarity of the goods at issue, there is a risk that use of the applicant's mark would result in a misrepresentation that is likely to deceive the public as to the existence of an association between the parties. As a result, it is claimed that this would cause damage to the opponent because consumers will lose confidence in the opponent's sign and its goodwill, ultimately reducing their purchasing intention.
8. The applicant filed a counterstatement wherein it denied all of the claims against it. In addition, the applicant requested that the opponent provide proof of use for the marks relied upon.
9. The opponent is represented by WP Thompson and the applicant is represented by HGF Limited. Both parties filed evidence in chief. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
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.

EVIDENCE

11. The opponent's evidence in chief was provided in the form of two witness statements. The first statement is that of Mr Joachim Bee dated 12 August 2024. Mr Bee is the Vice President of the opponent and his statement is accompanied by 11 exhibits, being those labelled RB1 to RB11. His evidence was adduced in

order to prove genuine use and the existence of a reputation in the marks relied upon and the existence of goodwill in the sign relied upon. The opponent's second witness statement is that of Mr Matthew Bush dated 19 September 2024. Mr Bush is a Trainee Trade Mark Attorney at the opponent's representative firm. His evidence is accompanied by two exhibits, being MB1 and MB2, and was adduced in order to provide further evidence of use of the opponent's marks.

12. The applicant's evidence came in the form of the witness statement of Zhang Jian dated 7 February 2025. Zhang Jian is the Vice General Manager of the applicant, a position they had held for six years as at the date of the statement. Zhang Jian's evidence is accompanied by nine exhibits, being those labelled ZJ1 to ZJ9, and was adduced to demonstrate the applicant's own use of the applied for mark.

13. I do not intend to summarise the parties' evidence (or the opponent's submissions, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

14. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

15. Section 6A is also relevant. It reads:

“(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(aa) or (ba) in relation to which the conditions set out in section 5(1),
(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. Section 100 of the Act is also relevant. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

17. As the opponent’s first and second marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

18. Given the filing dates of the opponent's marks, they all qualify as earlier trade marks under the above provisions. The opponent's marks all completed their registration processes more than five years prior to the filing date of the applicant's mark. As above, the applicant requested proof of use meaning that the opponent's marks are subject to the use provisions.

19. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer*

Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

20. Section 6A of the Act (cited above) sets out that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant's mark, being 2 November 2023. The relevant period is, therefore, 3 November 2018 to 2 November 2023 ("the relevant period"). For the avoidance of doubt, the relevant territory for genuine use for the first two marks prior to 31 December 2020 ("IP Completion Day") includes the EU at large but, thereafter, it is the UK only. The relevant territory for the opponent's third mark is the UK only.

21. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"² because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

Evidence of use

22. I will begin my summary by discussing the opponent's sales revenue. This is provided via a table covering European and UK figures for the years 2018 to 2023. This revenue is confirmed as covering the opponent's four main business sectors, being 'mobility solutions', 'consumer goods', 'energy and building technology' and 'industrial technology'. Whilst 2018 figures are provided, I remind myself that the relevant period commenced in November 2018. As such, I am of the view that the overwhelming majority of sales for this year would have fallen prior to the relevant period beginning. As I have no way to calculate how much turnover is attributed to the relevant period for that year, I will discount it altogether. As for the 2023 figures, I will include these in their entirety for the same reasons, i.e. because it is likely that the overwhelming majority of the sales took place prior to November 2023.

23. The opponent's revenue figures are as follows:

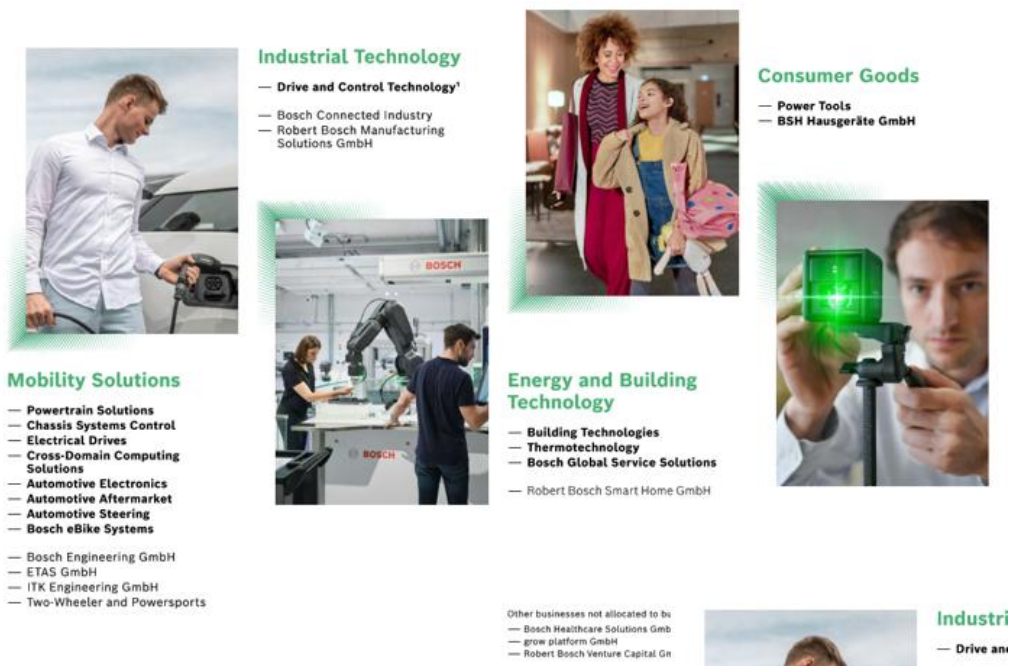
² *Jumpman* BL O/222/16

Year	Europe (inc. UK) (Billions of €)	UK (Billions of €)
2019	40.8	3.57
2020	38.0	3.16
2021	41.3	3.44
2022	44.3	3.56
2023	46.8	3.87
Total	211.2	17.6

24. Clearly, the above represents a staggering level of use across both the EU at large and the UK. However, the problem in the present case is that the opponent has offered no breakdown as to how the above sales can be attributed to the goods relied upon. This is a significant issue here because, as above, the revenue relates to the opponent's four business sectors. Mr Bee's narrative evidence sets out that these business sectors are identified in annual reports and he provides what he refers to as 'the relevant pages'.³ Having considered these reports, I note that the sectors are broken down to briefly describe what sort of offerings they cover. As an example, and for illustrative purposes, I reproduce the following screenshot taken from the 2022 report:⁴

³ RB1

⁴ Page 49 at RB1



25. Even with the above breakdown of the sectors, the categories discussed are all, themselves, fairly sizeable endeavours that are all likely to cover a wide range of disparate goods. For example, an eBike is clearly a product that is very far removed from products under the thermo-technology category. I appreciate that ‘consumer goods’ are mentioned but this appears to relate to power tools and goods offered by ‘BSH Hausgeräte GmbH’ (“BSH”). The report goes on to explain that BSH offers a range of home appliances such as washing machines, tumble dryers and a range of other kitchen or household appliances.⁵ The goods are described as being sold under the brands Bosch, Siemens, Gaggenau and Neff. Such use, therefore, clearly covers use by brands other than that which is relied upon here.

26. In light of the above, I fail to see how I can determine what proportion of the sales figures relate to any of the goods actually relied upon by the opponent. For example, it is not possible for me to assess how much use can be attributed to goods such as hair curlers, fire extinguishers or cigar lighters for cars, being just a few examples of the goods relied upon.

⁵ See page 54 of RB1

27. It is noted that in addition to the above, the opponent has sought to provide some specificity to its use by way of the witness statement of Mr Bush. This statement is simply a vehicle for introducing a range of screenshots of goods listed for sale on Amazon.co.uk⁶ and mouser.co.uk⁷ that bear the opponent's marks. This includes a home relay switch, a battery charger starter set, a moisture meter, a universal switch, an iron, a coffee machine, a stand mixer, a radiator thermostat, an outdoor camera and a sensor node. This evidence is noted but there is no attempt to provide any actual evidence as to the level of sales achieved by such goods during the relevant period. Further, there is nothing before me relating to any advertising or marketing efforts for such goods.

28. In my view, the way in which the opponent has filed its evidence has caused significant problems as, save for reference to sensors and toys (which I will discuss below), it has made no effort to correlate its massive turnover to the goods actually relied upon. On this point, I remind myself of the comments of Professor Johnson, sitting as the Appointed Person, in the case of *Eros Bodyglide* (O/0984/25), namely paragraphs 26 and 27, wherein he set out that where global sales figures are provided for multiple goods sold under one trade mark, this is not going to be evidence of use for any of those goods. This is precisely what has occurred here in that the opponent has simply adduced evidence of a significant turnover without any breakdown of products and with very little supporting evidence as to what has actually been used and then expected a finding of use to follow.

29. As above, the opponent has at least made some attempt to correlate its evidence with 'sensors'. While this term is expressly relied upon under the section 5(4)(a) ground, it is not relied upon in the specifications of the marks relied upon. On this point, it is not clear to me what goods in the specifications can be said to cover 'sensors'. Therefore, my primary view is that these goods are not relied upon here.

⁶ MB1

⁷ MB2

That being said, I will assess the evidence on this point on the basis that I am wrong and this point can it could be said that some of the technical class 9 goods of the opponent do encompass sensor goods.

30. In his narrative evidence, Mr Bee refers to page 71 of RB1 which is a page of the opponent's 2023 report which sets out that the opponent uses its proven expertise in 'sensor technology'. Mr Bee goes on to state that the opponent's key use of 'sensors' is in the gaming and toy industry, such as game motion sensors, game environmental sensors and game smart sensors that relate to both virtual and augmented reality. Of the evidence relating to sensors, I note the following:

- a. A range of screenshots dated 5 August 2024 taken from the opponent's 'bosch-sensortec.com' website showing various sensors are provided.⁸ It is noted that each product shown displays the opponent's marks;
- b. A product catalogue regarding sensors with a publication date of January 2024.⁹ The sensors shown do not simply pertain to gaming or toys but for use on wearables such as fitness trackers, virtual reality glasses, smart home equipment, robots, telematics and cameras;
- c. Screenshots dated 5 August 2024 of the opponent's list of distributors for sensor goods, which includes said goods listed for sale on a third party website, being 'Future Electronics' which is shown as being a UK distributor.¹⁰ The sensors listed for sale appear to be analog semi-conductors, 'combo' sensors, sensors for development tools, humidity sensors and air quality sensors; and
- d. Screenshots obtained from the internet archive facility, the Wayback Machine, which show the community forum for the Bosch Sensortec Community¹¹. One screenshot is from the relevant period, being 22 July 2023, but the second is from after its conclusion.

⁸ RB4

⁹ RB5. The reference to January 2024 as the publication date is shown on page 18 of this document.

¹⁰ RB6

¹¹ RB7

31. While on the topic of 'sensors', the opponent has also provided evidence that it has been identified as one of the market leaders in the field of 'MEMS Sensors'.¹² This article relates to the statistics for 2023 and 2024 and whilst 2024 is not relevant here, 2023 is. Further, the printout confirms that in April 2022, the opponent released its first 'capacitive barometric pressure sensor'.

32. Turning to the evidence insofar as it pertains to toys, the evidence explains that such goods are sold under licence by Theo Klein GmbH. On this point, I remind myself of section 6A(3)(a) of the Act (reproduced above) which states that use of a mark may be suitable if it is with the proprietor's consent. As the use in the present case is subject to a licencing agreement, it is clearly with the opponent's consent and, therefore, is capable of being relied upon here.

33. I note that the opponent has provided specific UK sales figures in respect of the toys it sells. These are as follows:

Year	Units Sold	Turnover (US \$)
2019	205,774	2,308,500.29
2020	155,659	2,138,237.76
2021	185,056	2,080,127.21
2022	132,473	1,681,761.33
2023	128,021	1,624,694.85
Total	806,983	9,833,321.44

34. In support of the toys sold, the opponent has provided a range of invoices covering goods sold during the relevant period.¹³ The narrative evidence explains this evidence as being UK invoices, but it is noted that some are from EU countries prior to IP Completion Day. This is not particularly an issue here because the above

¹² RB10 at pages 10 and 11

¹³ RB2

turnover is confirmed as being UK only so this does not make a difference in terms of the overall turnover.

35. Staying with the toys sold, it is noted that a range of screenshots taken from Amazon.co.uk are provided that show a range of the opponent's toys listed for sale.¹⁴ These show goods such as toy helmets, toy tool sets, toy vehicles and toy work benches. While the printouts appear to have been obtained after the relevant period, a number of UK based reviews from during the relevant period are shown in the printouts. On this point, I note that the narrative evidence sets out that the marks relied upon (being what it refers to as the 'Bosch logo') are omnipresent in the company's branding and that it appears on all goods sold by the opponent. I take this to extend to the toy goods and I have no reason to doubt the narrative evidence of the opponent. As such, I see no reason to doubt why the marks at issue would not have appeared on the toys during the relevant period.

36. Lastly, I note that evidence is provided attempting to demonstrate the size of the opponent's business operation in respect of automotive goods, power tools and household appliances. This evidence comes via screenshots showing that, in 2020, the opponent was the world's largest automotive supplier,¹⁵ a top 10 global appliance manufacturer¹⁶ and the leading power tool brand in the world.¹⁷ This is noted but such goods are not relevant here. I say this because the opponent relies only on goods in class 9 and 28 and even if it was to be argued that the broad wording of some of its terms covers such goods, this is not the case. This is on the basis that the goods subject to these global rankings are not proper to class 9 or 28. Instead, power tools are proper to class 7, automotive goods are either proper to class 7 or 12 (whether that be parts of motor engines or vehicles themselves) and household appliances are proper to class 7 (insofar as it covers washing machines) or, 11 or 21 (insofar as it covers large or handheld kitchen appliances).

¹⁴ RB3

¹⁵ RB11 at page 1

¹⁶ RB11 at pages 3 to 5

¹⁷ RB11 at page 7 and 8

Assessment of the evidence

37. It is clear from the evidence that the opponent is an extraordinarily large company that conducts a significant business operation. However, insofar as it pertains to anything other than toys, it is severely lacking any real precision. I remind myself that while the turnover provided is very large, the opponent has made no attempt to break it down to enable me to appropriately apportion it to the goods actually relied upon. Even where some attempt has been made to discuss goods further (being 'sensors'), the opponent has still failed to provide any actual turnover (or explain how the large turnover can be apportioned to them) and the majority of the evidence pertaining to such goods stems from either after the end of the relevant period or very close to it. Further, the technical nature of the various sensors shown raises some questions as to how much use can be attributed to the various types of gaming sensors that the opponent claims to have used. On this point, given the technical nature of such goods, I am of the view that it is reasonable to expect evidence to be provided as to what such goods actually cover and how they can be said to be sub-categories of the goods actually relied upon.

38. I also remind myself that the opponent has attempted to supplement its vague and imprecise primary evidence by furnishing further evidence under the cover of its attorney who simply provides a number of screenshots of goods listed for sale without any further explanation as to how this shows genuine use. Put simply, such evidence fails to escape the fact that there is no way for me to determine what level of use there is for such goods. Simply filing evidence of a massive turnover with various and singular examples of sales listings for a disparate range of goods that fall within significantly different categories is not a suitable way to accurately demonstrate use. Further, the opponent has not made any effort to show use for goods such as solderers' helmets, lift operating apparatus, electric door openers and closers, asbestos clothing for protection against first, decorative magnets or electric fences, to name just a few examples of the disparate terms relied upon.

39. In respect of the opponent's evidence insofar as it pertains to class 9 goods, I remind myself of the comments of Mr Iain Purvis KC, sitting as the Appointed Person, at paragraphs 36 and 37 in the case of *LACD* (BL O/0725/25) that a Hearing Officer before the Tribunal is entitled to draw limited conclusions from the evidence and it is not the role of the Tribunal to fill in gaps in the evidence by conducting a 'deep dive' of the evidence filed. Lastly in respect of this point, I am of the view that in order for me to reach a conclusion of genuine use for such goods, I would need to make a series of inferences that, in my view, are simply unreasonable to make in the circumstances.

40. Overall, I accept that the opponent is a large business with a significant turnover. However, taking all of my above criticisms into account, I do not consider that the opponent has provided sufficiently solid evidence to allow me to conclude that it has genuinely used its mark for the range of class 9 goods relied upon in these proceedings. The consequence of this is that the opponent's second and third marks are not permitted to be relied upon in these proceedings at all as they cover class 9 goods only. As for the opponent's first mark, this is not permitted to be relied upon in respect of its class 9 goods but given that it stands registered for goods in class 28, I will now turn to consider the evidence insofar as it relates to the same.

41. In respect of toys, I appreciate that the evidence does come with a degree of specificity for such goods. Firstly, I consider it necessary to discuss the way in which the mark is shown on such goods. As above, the opponent has provided a range of Amazon printouts relating to these goods. Further, Mr Bee confirmed that the 'Bosch logo' has appeared on all of its goods. It is noted that the toy goods are shown bearing the following signs:



42. Briefly, I remind myself that, as per *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, use of a registered mark as part of a composite mark is acceptable so long as the registered mark continues to be perceived as indicative of the origin of the goods. In the present case, whilst the addition of 'BOSCH' (in both examples above) and 'mini' (in the second) is noted, I consider that the device element remains an independent indicator of origin for the goods. As a result, the above examples are acceptable uses of the opponent's first mark as registered.
43. The total turnover attributed to sales of various toys amounted to approximately \$9.8 million. While presented in US dollars, the evidence expressly states that the sales relate to the UK and, as such, I see no issue with the fact that the turnover is not provided in British pounds. Further, the use covers over 800,000 toys sold during the relevant period. Such use is, in my view, sufficient for me to conclude that the opponent has genuinely used its first mark on goods that fall within the category of goods relied upon under class 28.
44. The above being said, I am of the view that the term "games and playthings" is too broad in light of the use before me. All the opponent has shown use for is a range of toys, namely toy helmets, toy tool sets, toy vehicles and toy work benches. Toys are not necessarily games and to allow use for such a term would mean that the opponent was protected for video games or board games, which are clearly not covered in its evidence. Further, when it comes to playthings, I consider that this can also be construed as covering items such as video games, video game consoles or other goods relating to video games which are, again, not suitably covered in the evidence. In accordance with the principle set out in *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834, I accept that it is not

necessary for a proprietor of a mark to show use for all possible variations of a term. However, I am of the view that “toys” is a suitable subcategory of “playthings” and that it is an appropriate category of goods in the present circumstances. On this point, I will say that I do not consider that limiting “playthings” to “toys” strips the opponent of protection for the goods it has actually demonstrated use for. As a result, I am content for the reliance upon the opponent’s first mark to proceed but only in respect of “toys”, as a suitable subcategory of “games and playthings” in class 28.

Section 5(2)(b): legislation and case law

45. Section 5(2)(b) states that:

“(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.”

46. Section 5A of the Act states as follows:

“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.”

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

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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; and

(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

48. The competing goods are as follows:

The opponent's goods	The applicant's goods
<u>Class 28</u> Toys.	<u>Class 9</u> Computer keyboards; Joysticks for use with computers, other than for video games; Computer peripheral devices; Mouse [computer peripheral]; Devices for the

	projection of virtual keyboards; Sound card; Mouse pads; Keyboard for smartphone; Headset; Wireless speakers; Telephone receiver; Earbuds; Headset used with a computer; Music headphones; Wireless headset for smartphones; Virtual reality games with headphones; Noise-canceling headphone; Double channel stereo recording microphone; Megaphones; Microphones; Headphones; Portable media players; Cabinets for loudspeakers; Diaphragms [acoustics]; Loudspeakers; Bar speaker; Subwoofers; Earpieces for remote communication; Personal headsets for voice transmission devices; Earphone for telephone; Virtual reality glasses; Virtual reality headsets; Head-mounted video display; USB cables; Mobile power (rechargeable battery); Stabilized voltage supply; Uninterruptible power supply; Low voltage power supply; High voltage power supply. <u>Class 28</u> Hand-held consoles for playing video games; Joysticks for video games; Controllers for game consoles; Mouse for games; Keypad for games; Special packages for handheld video game consoles; Video game machines;
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	Interactive gaming chairs for video games; Board game equipment.
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49. 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:

“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”.

50. 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.

51. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

Class 9

Computer keyboards; Computer peripheral devices; Mouse [computer peripheral]; Keyboard for smartphone; Virtual reality games with headphones; Virtual reality headsets; Virtual reality glasses; Head-mounted video display.

52. The above goods can all, in my view, be types of goods used to allow the user to play a video game. While these goods clearly differ in nature and method of use, I am of the view that in the context of video games, there is a degree of overlap in purpose with the opponent's “toys”. That being said, any overlap is not particularly compelling because the applicant's goods are used as periphery devices to facilitate the playing of a game whereas a toy is actually a product that is directly played with. Further, I have nothing before me to suggest that it is common in the trade for the provider of a toy in class 28 to also produce a range of computer peripheral devices. On this point, I accept that the goods may be sold via the same stores but are not likely to be found in close proximity to one another. As for users, I accept that there is an overlap here, but this is due to the broad user base of both parties' goods. Lastly, the goods are not complementary and neither do I consider

that they share any actual competitive relationship. Taking all of this into account, any overlaps are fleeting and are, in my view, insufficient to give rise to a finding that they are similar to any degree. They are, therefore, dissimilar.

Joysticks for use with computers, other than for video games; Devices for the projection of virtual keyboards; Sound card; Mouse pads; Headset; Wireless speakers; Telephone receiver; Earbuds; Headset used with a computer; Music headphones; Wireless headset for smartphones; Noise-canceling headphone; Double channel stereo recording microphone; Megaphones; Microphones; Headphones; Portable media players; Cabinets for loudspeakers; Diaphragms [acoustics]; Loudspeakers; Bar speaker; Subwoofers; Earpieces for remote communication; Personal headsets for voice transmission devices; Earphone for telephone; USB cables; Mobile power (rechargeable battery); Stabilized voltage supply; Uninterruptible power supply; Low voltage power supply; High voltage power supply.

53. Even where the above goods can be said to relate to goods used to play video games (such as a power supply to a computer used for playing games or a USB connecting a keyboard to a computer), I do not consider that they are similar to the opponent's "toys". Plainly, the natures, method of use and purpose of these goods differ. Further, I do not consider it to be common in the trade for such goods to overlap in trade channels. The goods are not complementary or competitive in nature. Lastly, users may overlap but this alone is insufficient to give rise to a finding of material similarity between them. They are, therefore, dissimilar.

Class 28

Hand-held consoles for playing video games; Joysticks for video games; Controllers for game consoles; Mouse for games; Keypad for games; Special packages for handheld video game consoles; Video game machines; Interactive gaming chairs for video games.

54. The above goods are not toys, therefore, they are not the same as the opponent's term that remains in its specification. They clearly differ in nature and method of use. Further, following similar reasoning to that given at paragraph 52 above, I do not consider that any overlap in purpose is compelling. Further, I have nothing to suggest that producers of toys would commonly produce video games, or vice versa.¹⁸ The goods may be sold via the same stores but are not likely to be found in close proximity to one another. The goods may overlap in users, but this is not overly pronounced due to the broad user base for both parties' goods. Lastly, the goods are not competitive or complementary. As a result, I find that these goods are dissimilar.

Board game equipment.

55. The above term is, in my view, different in nature and method of use with the opponent's term of "toys". The purpose overlaps but only on a limited basis for similar reasons to those discussed in other comparisons above. In terms of trade channels, I have nothing before me to suggest that it is common in the trade for the provider of toys to also provide equipment for board games. Without such evidence, I am not willing to make such a finding. Further, the users overlap on the basis that someone looking to play with toys may also wish to play board games, thereby seeking the above equipment. The goods are not complementary, and neither are they competitive in nature. In respect of the latter point, I accept that a user may choose to play a board game or with a toy, or vice versa. However, this is not the relevant comparison as here, I am required to focus on equipment for a board game as opposed to the board game itself. Overall, I consider that the aforementioned overlaps are sufficient to give rise to a finding that these goods are similar to a low degree.

¹⁸ I appreciate that some undertakings may licence third parties to make toys of video game characters. However, I am not convinced that this is common in the trade but, even so, the third party production of the toys would not mean that there is a sufficient overlap.

Conclusion of the goods comparison.

56. Under the present ground, a likelihood of confusion can only exist where there is at least some similarity between the parties' goods.¹⁹ This means that as a result of my findings above, the present ground proceeds only against "board game equipment". It fails, however, in respect of all the remaining goods.

The average consumer and the nature of the purchasing act

57. 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.

58. In *Iconix Luxembourg Holdings*, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule

¹⁹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

59. The goods at issue will be selected by members of the general public at large. The goods will be available via general physical retailers where they will be placed on shelves and self-selected by the consumer. Alternatively, the goods will be available online where they will be viewed on webpages. As such, the purchasing process will be primarily visual, although I do not discount an aural component playing a part.

60. The goods at issue will range in price but are, for the most part, likely to be fairly inexpensive. As for the frequency at which the goods will be purchased, I am of the view that, for the most part, they will be selected on a regular basis. The average consumer is likely to consider factors such as materials, suitability, purpose and compatibility (for example, whether the equipment is suitable for the board game the consumer wishes to play). These factors are fairly ordinary and I, therefore,

find that the average consumer will pay a medium degree of attention during the selection process for the goods.

Comparison of the marks

61. It is clear from *Sabel 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 trade marks, bearing in mind their distinctive and dominant components.

62. 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.”

63. 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.

64. As the opponent is only permitted to rely on its first mark, I will refer to it for the remainder of my assessment under the present ground as “the opponent’s mark”.

65. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
	

66. I have submissions from the opponent regarding the similarity of the marks. While these are noted, I do not intend to reproduce them here but will, where necessary, discuss them below.

Overall impression

67. In discussing the comparison of the marks, the opponent sets out that the applicant's own claim in its evidence is that its mark is a letter 'H'.²⁰ The opponent then refers to a screenshot of the website 'LOGOS WORLD' in its own evidence where its mark is referred to as a "mysterious symbol in the shape of a letter H".²¹ While this is noted, I am not convinced that one printout from 'logos-world.net' is a compelling point in favour of the opponent's mark being viewed in this way. Whilst I accept that some consumers may see the mark this way, I do not consider that this constitutes a significant proportion. I say this because the letter H is not ordinarily presented in a such a way as to have two horizontal lines or hollow semi-circle shapes on its sides. Instead, I find that the opponent's mark will simply be viewed as a device shape that sits within a circular border. The overall impression of this mark will lie in a combination of its elements.

68. As for the applicant's mark, I am of the view that a majority of consumers will see its central element as a letter 'H'.²² This is because it only has one horizontal line

²⁰ See paragraph 9 of the witness statement of Zhang Jian

²¹ See page 13 at RB9

²² While some consumers may not necessarily see the mark as a letter 'H', I do not consider that this constitutes a significant proportion. As such, those consumers do not factor into the assessments I must make throughout my decision.

and while its side elements are curved, they are represented by thick black lines of relatively the same thickness as its horizontal element. As for the outer circular element, this is merely a dashed border. As such, I find that because the central element can technically be read and because consumers tend to be drawn to such elements, the overall impression of the mark lies in the letter 'H', with the outer element playing a lesser role due to its purpose solely as a banal border.

Visual comparison

69. Visually, the marks share a degree of similarity insofar as they are figurative marks with a central element and a circular border. The consumers will note the similarity in shape of the central elements but due to one being viewed as a letter and the other not, any similarity is limited. Further, the difference in the dashed border in the applicant's mark and the full circle in the opponent's mark will also be noticed. Overall, taking into account the overall impression of the marks, I am of the view that the marks are visually similar to only a low degree.

Aural comparison

70. Aurally, the applicant's mark will be pronounced as the letter 'H'. As for the opponent's mark, this contains no aural element. As such, the marks at issue are not capable of being compared aurally.

Conceptual comparison

71. Given that the opponent's mark has no meaning, it is not capable of carrying any concept. As for the applicant's mark, this will be associated with the letter 'H' which, despite being a single known letter, is not capable of carrying any actual concept. As such, these marks are not capable of being compared conceptually.

Distinctive character of the opponent's mark

72. 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 I-0000, paragraph 49).

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

73. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the opponent has filed evidence of use. I will, therefore, consider whether the

opponent's evidence is sufficient to give rise to a finding that the distinctiveness of its mark has been enhanced through use. Before doing so, I will consider the inherent position.

74. The opponent's mark is a simple figurative device. It has no obvious meaning to consumers so cannot, therefore, be said to be descriptive or allusive in relation to the goods relied upon. That being said, it is fairly banal in its design and, therefore, is not particularly compelling from a trade mark perspective. In my view, the banal nature of the design is such that its inherent distinctiveness sits somewhere just below medium.

75. I have summarised the evidence of the opponent above. Insofar as it relates to the relevant goods, I refer to paragraphs 32 to 35. This covers a turnover of almost \$10 million worth of toys prior to the relevant date, stemming from over 800,000 goods sold. This covers five years' worth of use so is not particularly long standing, but it is not short-term use either. The opponent has not provided any market share evidence for such goods, but it is my view, that the relevant market is likely to be very large, with turnover exceeding billions of pounds per annum. As such, whilst almost \$10 million worth of turnover over five years is not insignificant, it is not particularly compelling in the context of the market at issue. Further, it is noted that no marketing evidence has been provided, and neither is there any press coverage pointing to a wide level of knowledge of the opponent's mark in respect of toys. Overall, despite my issues with the lack of any advertising or market share evidence, I am of the view that the use is at a level that can warrant a finding that the distinctiveness of the mark has been enhanced, but only to a slight degree. Given the inherent position, I find that the mark has been enhanced to a medium degree of distinctiveness.

Likelihood of confusion

76. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

77. I found the goods at issue to be similar to a low degree. The average consumer base for the goods at issue will be members of the general public who will select the goods via primarily visual means (though I do not discount an aural component) whilst paying a medium degree of attention. I have found the marks at issue to be visually similar to a low degree but incapable of being compared aurally and conceptually. Lastly, I concluded that the opponent's mark enjoys a slightly below medium degree of inherent distinctive character but that this has been enhanced to a medium degree due to the use made of it.

78. Taking all of the above factors into account, I do not consider that the marks at issue will be misremembered or inaccurately recalled for one another, even bearing in mind the principle of imperfect recollection. Whilst the overall shared shapes of the elements within the marks will be noticed, one will be viewed as a

representation of a letter 'H' whereas the other will not. This will create a different impression of the marks in the mind of the consumer and, as such, I consider that they will readily be able to distinguish between the marks by pinning their recollection of them on this point of difference. Further, I remind myself that the goods at issue are similar to a low degree and, in my view, the similarity of the marks at issue are insufficient to overcome the distance between the goods. Lastly, I make this finding whilst bearing in mind what I have said above in that consumers rarely have the opportunity to make direct comparisons between marks. Consequently, I do not consider that there exists a likelihood of direct confusion.

79. I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

80. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances whereby indirect confusion occurs.

81. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

82. Taking all of the above into account, I do not consider that consumers would be indirectly confused by the marks at issue. In short, the differences between the

marks are that one will be viewed as a letter 'H' whereas the other would not. In such circumstances, I see no reason why consumers would believe that an undertaking that uses a 'H' device would alter its mark so that the device no longer looks like a 'H', or vice versa. Therefore, I see no reason why consumers would believe that these marks shared the same or economically connected undertakings. Consequently, I find that there exists no likelihood of confusion between the marks at issue.

Final remarks under section 5(2)(b)

83. I am of the view that even if I was wrong to limit the opponent's specification to just "toys", I do not consider that this would have advanced the opponent's position. If it was the case that use was granted for additional terms that shared a higher degree of similarity with the applicant's goods, the above conclusion would not have changed. This is on the basis that, as above, the applicant's mark would be viewed as a figurative letter 'H' whereas the opponent's would not. Regardless of the similarity of the goods at issue, it is this point that consumers will affix their recollection of the marks on (thereby avoiding direct confusion) and I envisage no scenario where the consumer would believe that the marks originated from the same or connected undertakings (thereby avoiding indirect confusion).

84. The section 5(2)(b) ground fails and I will now proceed to consider the section 5(3) ground.

Section 5(3)

85. 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.”

86. 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; *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 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*).

87. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks at issue are similar. Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the pleaded types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or 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.

88. The issue of genuine use is as equally relevant to section 5(3) as it is to section 5(2)(b). Therefore, my findings under genuine use made above are applicable here. This means that the present ground may only proceed on the basis of the term "toys" in the opponent's first mark. As was the case above, I will refer to this mark as simply "the opponent's mark".

Reputation

89. I can deal with the issue of reputation swiftly. This is on the basis that, as set out above, there exists an enhanced of the distinctive character of the opponent's mark, albeit only slightly. I appreciate that the test for reputation is not the same as that for enhanced distinctive character. However, the same factors are to be taken into account in both assessments. As above, the present ground proceeds in

reliance upon the same mark and goods that were relevant to the section 5(2)(b) ground. While the relevant territory is broader for the present assessment (in that use in the EU prior to IP Completion Day can be taken into account), the evidence in respect of the relevant goods focuses solely on UK use.²³ As such, I consider that a similar finding to that reached above can be made here, namely that the opponent's mark enjoys a reputation. That being said, for the same reasons set out at paragraph 75 above, the level of use is limited and, in my view, is only sufficient to give rise to a reputation that is, at best, moderate.

Link

90. As noted above, my assessment of 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:

The degree of similarity between the conflicting marks.

91. The marks are visually similar to a low degree but are incapable of being compared aurally and conceptually.

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.

92. The comparison of the goods I conducted under the section 5(2)(b) ground above was based solely on the opponent's "toys". As such, those findings apply here,

²³ As per *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, an EUTM may be considered to have a reputation if it is known by a substantial part of the territory of the European Community and that the territory of a single Member State alone may be considered as satisfying that requirement. Further, in *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), Geoffrey Hobbs K.C. confirmed that when assessing reputation in the EU, the UK is a substantial part of the same. As such, use in the UK alone is still capable of satisfying the test for a reputation.

namely that they are dissimilar to all of the applicant's goods, save for "equipment for board games", which are similar to a low degree.

93. As set out above, it is not necessary for goods to be similar in order for the present ground to succeed. In considering the dissimilar goods, I note that they are those that will be selected by the same section of the relevant public. Given the size of the relevant public for such goods, I find that any degree of closeness can only be at a general level.

The strength of the earlier mark's reputation

94. The opponent's mark enjoys, at best, a moderate reputation.

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

95. The opponent's mark is inherently distinctive to a slightly below medium degree. However, this has been enhanced to a medium degree.

Whether there is a likelihood of confusion

96. I have found there to be no likelihood of confusion between the marks.

Conclusion on link

97. When considering link, I remind myself that the opponent's pleaded basis for its existence was that "the relevant public will believe that the trade marks concerned are used by the same undertaking or that the parties are economically connected."²⁴ This sets a higher threshold for a link as opposed to a situation

²⁴ See Question 3 of Section B of the opponent's TM7

where, for example, the relevant public was caused to wonder if the marks were linked.

98. Taking all of the above into account, I do not consider that members of the relevant public would believe that the marks at issue were linked. Whilst the opponent does enjoy a reputation in its toys, this is not a strong reputation and is, in my view, insufficient to overcome the differences between the marks at issue and the lowly similar or outright dissimilar goods (even where those goods may share a general degree of closeness). In short, the applicant's mark will be viewed as a representation of a letter 'H', whereas the opponent's mark would not. As such, I do not consider that members of the relevant public (who are aware of the opponent's reputed mark) would, upon viewing the applicant's mark, believe that it was a mark used by the opponent or that the parties were economically connected. Even if the issue of link was pleaded in an alternative way so as to argue the fact that the applicant's mark brought to mind the opponent's mark, I do not consider that the reputation is at a high enough level to overcome the differences between the marks and the distance between the goods at issue.

99. Without a link, there can be no damage and, as such, the opponent's section 5(3) ground fails.

Section 5(4)(a)

100. 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”.

101. 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.”

102. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

103. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant Date

104. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

105. The applicant's mark does not have a priority date. While the applicant has sought to provide evidence of use of its own mark, this is mostly undated or aimed at the Chinese market. That being said, there is one screenshot from Amazon.co.uk showing a listed for gaming headset with a first available date of 3 April 2020.²⁵ This constitutes the first offering of goods that is capable of being the start of the behaviour complained about. Therefore, I will consider the position of goodwill at both 3 April 2020 and the filing date of the applicant's mark, being 3 November 2023.

Goodwill

106. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

107. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The

²⁵ See page 37 at ZJ4

requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the *prima facie* case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

108. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least *prima facie*, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

109. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

110. Under the present ground, the opponent relies on a sign pretty much identical to the marks relied on under the above grounds. In terms of the goods relied upon, I remind myself that these are as follows:

“Game motion sensors; game environmental sensors; game smart sensors; keyboards with joystick; speakers; headphones and headsets; batteries and battery chargers; machines and machine tools; power tools; automotive components; household electricals; electrical parts and components; electrical appliances.”

111. Where the goods relied upon here cover the same goods that were relevant to the issue of genuine use above (such as the sensor good, for example), I make similar findings here in that the evidence is far too vague and imprecise in order to lead to a finding that the opponent enjoys a goodwill in such goods. In short, even taking into account the subsequent attempt to flesh out its evidence via the witness

statement of Mr Bush, the opponent has failed to offer any guidance as to how its vast turnover can be appropriately apportioned to such a wide range of goods. As the burden falls squarely on the opponent, the failure to do so has rendered it impossible for me to make any sort of accurate determination.

112. The above being said, the present ground relies on “power tools”, “automotive components” and “household electricals”. Those categories of goods (albeit household electricals being referred to as household appliances) are specifically mentioned in the opponent’s evidence as to its market share for such goods. On this point, I remind myself that in 2020, the opponent was the world’s largest automotive supplier, a top 10 global appliance manufacturer and the leading power tool brand in the world. While there is no evidence as to how the turnover of the opponent can be attributed to such goods, I am content to conclude that such evidence clearly demonstrates that the opponent, as at 3 April 2020 and 3 November 2023, conducted a very large business operation when it comes to such goods. I will, therefore, proceed on the basis that it enjoys a strong goodwill for the same and that the sign relied upon is distinctive of and/or associated with said goodwill. That being said, “household electricals” is, in my view, too broad in light of the actual evidence filed. I say this because it can be said to cover any electrical product used in a household and, instead, I remind myself that the evidence on this point focuses on household appliances (such as washing machines, for example). Therefore, it is the term “household appliances” with which I associate the opponent’s goodwill (as above, this is along with “power tools” and “automotive components”).

Misrepresentation

113. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

114. And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

115. The problem for the opponent here is that while it may have a strong goodwill in power tools, household appliances and automotive components, the fields of activity covering such goods are disparate from the field of activity of the applicant, which relates to video games and board games. On this point, I remind myself that whilst there can be passing off where businesses operate in different fields of activity, the burden for overcoming this difference is, as per *Harrods Limited v*

Harroddian School Limited [1996] RPC 697 (CA) and *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501, a heavy one. In accordance with this case law, the opponent is required to provide clear and cogent proof that there is (1) an actual or a possible confusion, (2) actual damage or (3), a real likelihood of damage to the opponent's goodwill in order to overcome said burden. The opponent has failed to even attempt to discharge this burden and, as such, I am not willing to find that there exists a misrepresentation in the present case. Further, even if such an attempt was made, I am of the view that the differences between the marks is such to avoid any risk of a misrepresentation. I say this because, to repeat what I have said above, the applicant's mark will be viewed as a figurative letter 'H' whereas the opponent's mark would not so I fail to see how members of the relevant public would believe that there was an association between the parties.

116. Without a misrepresentation, there can be no damage, meaning that the present ground fails in its entirety.

CONCLUSION

117. The opposition fails and, subject to any successful appeal against my decision, the applicant's mark may proceed to registration for all of the goods applied for.

COSTS

118. The applicant has successfully defended its mark 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 appreciate that the applicant's evidence did not assist me in my decision. However, I am of the view that it would have incurred costs associated with reviewing the opponent's evidence and, therefore, is entitled to costs in respect of the same.

119. I award the applicant the sum of £900 as a contribution towards its costs. The sum is calculated as follows:

Considering a notice of opposition and preparing the counterstatement:	£300
Reviewing evidence:	£600
Total:	£900

120. I hereby order Robert Bosch GmbH to pay Dongguan Edifier Esports Technology Co., Ltd. the sum of £900. The above 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 30th day of July 2026

A COOPER

For the Registrar