

O/570/21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003476015 AND UK00003476011

BY SHARP GAMING LIMITED

FOR THE FOLLOWING TRADE MARKS:



AND



IN CLASSES 9 AND 42

AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO

UNDER NOS. 421420 AND 421972

BY SHARP KABUSHIKI KAISHA (SHARP CORPORATION)

BACKGROUND AND PLEADINGS

1. On 19 March 2020, Sharp Gaming Limited (“the applicant”) applied to register the following trade marks in the UK:



(“the First Application”)



(“the Second Application”)

2. The First Application was published for opposition purposes on 12 June 2020 and registration is sought for the following goods and services:

Class 9 Computer application software featuring games and gaming; Computer gaming software; Computer software for the administration of on-line games and gaming; Gambling software.

Class 42 Platforms for gaming as software as a service [SaaS]; Software as a service [SaaS] featuring software platforms for electronic gaming.

3. The Second Application was published for opposition purposes on 7 August 2020 and registration is sought for the following goods and services:

Class 9 Gaming software; Gaming software that generates or displays wager outcomes of gaming machines; Computer application software featuring games and gaming; Computer gaming software; Computer software for the administration of on-line games and gaming; Gambling software.

Class 42 Platforms for gaming as software as a service [SaaS]; Software as a service [SaaS] featuring software platforms for electronic gaming.

4. On 9 September 2020 and 5 November 2020 respectively, the First and Second Applications were opposed by Sharp Kabushiki Kaisha (Sharp Corporation) (“the opponent”). The oppositions are based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3), the opponent relies upon the following trade marks:

SHARP

EUTM no. 17502717¹

Filing date 21 November 2017; registration date 3 February 2021
 (“the First Earlier Mark”)

SHARP

EUTM no. 12994737

Filing date 13 June 2014; registration date 6 February 2015
 (“the Second Earlier Mark”)

SHARP

EUTM no. 2398295

Filing date 2 October 2001; registration date 15 December 2009
 (“the Third Earlier Mark”)

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

5. The opponent relies upon those goods and services set out in the Annex to this decision.²

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

7. Under section 5(3), the opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier marks.

8. Under section 5(4)(a), the opponent relies upon the sign **SHARP** which it claims to have used throughout the UK since at least 1990 in relation to "all class 9 goods and class 42 services protected under EUTM nos. 17502717, 12994737 and 2398295, as set out in Annex 2 to the Grounds of Opposition".

9. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of the Second and Third Earlier Marks.

10. Only the opponent filed evidence; the applicant filed written submissions during the evidence rounds. The applicant is represented by Wilson Gunn and the opponent is represented by Maucher Jenkins. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

11. The opponent filed evidence in chief in the form of the witness statement of Mototaka Taneya, Executive Managing Officer of the opponent. Mr Taneya has held this position since November 2016 and has worked for the opponent for approximately 9 years. Mr Taneya's evidence was accompanied by 27 exhibits.

² In its written submissions in lieu, the opponent limited the goods and services relied upon to those underlined in the Annex.

12. As noted above, the applicant filed written submissions during the evidence rounds dated 24 May 2021.

13. Both parties filed written submissions in lieu dated 24 June 2021.

14. I do not propose to summarise the evidence and submissions here. However, I have taken them all into consideration and will refer to them below where necessary.

PRELIMINARY ISSUE

15. In its written submissions in lieu, the applicant states:

“The mark EUTM No: 17502717 was a pending application on the relevant date, but it was not registered until 3 February 2021, which is after the IP completion date of 31 December 2020. The Opponent has not filed an application pursuant to paragraph 25(1) of Schedule 2A of the Act and thus this mark, not being a comparable mark, was not registered in the United Kingdom on 3 February 2021. In consequence, this mark is not an earlier mark as defined by Section 6 and should be disregarded as a valid ground of opposition.”

16. Tribunal Practice Notice 2/2020 (“the TPN”) deals with the transitional provisions for proceedings before this Tribunal following the UK’s departure from the EU. In particular, I note the following:

“Practice for:

All tribunal proceedings launched before IP Completion Day (i.e. before 11pm on 31 December 2020) and,

Oppositions filed on, or after, IP Completion Day against trade mark applications filed before IP Completion Day

3. The transitional provisions provide that these proceedings should continue to be dealt with under the Act as it existed before IP Completion Day (i.e. the old law continues to apply). Users should note the following:

- EUTMs and IR(EU)s will continue to constitute earlier trade marks for the purposes of these proceedings. This applies to both registered and pending marks, although, in the case of the latter, this is subject to the earlier mark subsequently being registered or protected.
- It will not be possible to substitute in, or add, comparable marks or re-filed EUTM/IR(EU)s into these proceedings.
- We are aware that in some UK Tribunal cases, a small number of users have an earlier EU mark pleaded against them which, in turn, is the subject of ongoing proceedings at EU level based on an even earlier UK right. We will issue further guidance in early 2021 setting out how such relevant UK Tribunal proceedings should be managed. In the meantime, the impacted party may request a stay of any relevant UK proceedings until the practice is published.” (my emphasis)

17. These proceedings were launched before IP Completion Day, the oppositions having been launched in September and November 2020 respectively. The TPN makes it clear that EUTMs will continue to constitute earlier trade marks for the purposes of these proceedings; this applies equally to pending marks, provided they are subsequently registered. That is what happened in the case of the First Earlier Mark; although it was pending at the time of IP Completion Day, it was subsequently registered. Consequently, it can continue to constitute an earlier trade mark for the purposes of these proceedings.

DECISION

Section 5(2)(b)

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

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

(a)...

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

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

19. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the First Earlier Mark had not completed its registration process before the application date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act. However, given their registration dates, the Second and Third Earlier Marks are subject to the proof of use provisions and the applicant has requested that the opponent prove use in relation to those goods and services relied upon.

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

Proof of use

21. I will begin by assessing whether there has been genuine use of the Second and Third Earlier Marks. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A(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), (b) 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(5A) [...]

(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.”

22. Section 100 of the Act is also relevant, which 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.”

23. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the Second and Third Earlier Marks is the five-year period ending with the date of the application in issue i.e. 20 March 2015 to 19 March 2020.

24. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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 Bunderversammlung 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], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

25. As the Second and Third Earlier Marks are EUTMs, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down

(see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)".

At paragraphs 57 and 58, the court held that:

"Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

26. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTMs, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them; and

- e. The geographical extent of the use shown.

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

28. Mr Taneya states that the opponent was first established in Japan in 1912 and currently has a presence in the UK and over 20 EU Member States. Mr Taneya gives evidence that the opponent first entered the European market in 1959, when it established a subsidiary in West Germany, and entered the UK market in November 1969, when it incorporated Sharp Electronic (UK) Limited, with a presence in Manchester. It appears that the business originally operated in the metal-work field.³

29. I note that by 2021 (admittedly, after the relevant period), the opponent had premises around the UK including Cardiff, Oxford, Stockport, West Bromwich, Wakefield, Thames Valley, Bristol, Swindon, Dundee, Swanley, Ipswich and Warrington.⁴

30. Mr Taneya gives evidence that the following goods were launched by the opponent:

2015 – vacuum cleaner for bedding; LCD TV; a robot for use in hotel rooms; digital cordless facsimiles and phones; waterless cooker.

2016 - mosquito catching air-purifier; mobile robotic phone; an ultrasonic stain remover; griller/steam oven.

2017 - advanced glycation end-products sensor; cordless vacuum cleaner; LCD TV; camcorder; smart device for wear on the wrist.

³ Exhibit MT1

⁴ Exhibit MT2

2018 – smartphone; cat litter tray with monitor; satellite recorder and tuner; range of cloud-compatible products; hard drive.

2019 – robotic phone; wearable neck speakers; solar cell; cooler bag; OLED display TV; air conditioners.⁵

31. However, I note that none of these product names refer to the word SHARP (or any of the earlier marks). For example, the article uses names such as “Tekion” (for the cooler bag), RACTIVE (for the vacuum cleaner) and AQUOS (for the speakers and TV). I also note that it is not clear when these products were launched in the EU or UK. For example, the smart device for wear on the wrist is described as “for fans of Japanese professional baseball” and the robot for use in hotels is described as having been “installed in rooms at the Henn-na Hotel”, which it states is in Japan.

32. Mr Taneya has provided figures for net sales generated in thousands of euros for the opponent’s subsidiaries in the UK, France and Italy.⁶ Some of the figures provided show minus figures and so it is not clear to me that any sales have been generated in relation to these columns. However, by way of example, I note the following:

July 2015 to September 2015 (France and UK)

€10,000 in relation to DVD and audio players

€1,298,000 in relation to calculators

€88,000 in relation to telephones and fax machines

€148,000 in relation to refrigerators

€8,000 in relation to kitchen appliances

€1,142,000 in relation to air-conditioning

€7,000 in relation to air purifiers and humidifiers

€4,296,000 in relation to electronic cash registers and point of sale equipment

€7,026,000 in relation to solar panels

€83,780,000 in relation to multi-functional printers

⁵ Exhibit MT3

⁶ Exhibits MT4 and MT5

April 2016 to September 2016 (France and UK)

€107,000 in relation to telephones and fax machines

€115,000 in relation to refrigerators

€16,000 in relation to air-conditioning

€10,549,000 in relation to solar panels

€147,987,000 in relation to printers

€10,525,000 in relation to electronic cash registers and point of sale equipment

April 2017 to September 2017 (France and UK)

€79,000 in relation to telephones and fax machines

€24,245,000 in relation to solar panels

€174,377,000 in relation to multi-functional printers

€9,586,000 in relation to electronic cash registers and point of sale equipment

October 2018 to March 2019 (France and UK)

€48,000 in relation to telephones and fax machines

€42,622,000 in relation to solar panels

€163,672,000 in relation to multi-functional printers

€6,491,000 in relation to electronic cash registers and point of sale equipment

July 2015 to September 2015 (Italy)

€254,000 in relation to LCD TVs

€140,000 in relation to DVD and audio players

€300,000 in relation to calculators

€1,000 in relation to telephones and fax machines

€1,822,000 in relation to refrigerators

€257,000 in relation to kitchen appliances

€2,618,000 in relation to air-conditioning

€2,000 in relation to air purifiers and humidifiers

€22,000 in relation to solar panels

€7,317,000 in relation to multi-functional printers

October 2015 to March 2016 (Italy)

€432,000 in relation to LCD TVs

€1,000 in relation to DVD and audio players

€640,000 in relation to calculators

€4,000 in relation to telephones and fax machines

€3,124,000 in relation to refrigerators

€1,073,000 in relation to kitchen appliances

€4,053,000 in relation to air-conditioning

€110,000 in relation to laundry

€16,000 in relation to air purifiers and humidifiers

€16,464,000 in relation to multi-functional printers

April 2018 to September 2018 (Italy)

€453,000 in relation to calculators

€1,615,000 in relation to refrigerators

€767,000 in relation to kitchen appliances

€806,000 in relation to air-conditioning

€16,244,000 in relation to multi-functional printers

33. Mr Taneya has provided information about the number of visitors to the opponent's websites during the relevant period.⁷ By way of example, I note the following:

November 2015	Sharp.fr (France)	29,300 visitors
April 2016	Sharp.at (Austria)	11,224 visitors
January 2017	Sharp.de (Germany)	67,195 visitors
February 2018	Sharp.it (Italy)	36,329 visitors
August 2019	Sharp.co.uk (United Kingdom)	40,696 visitors
February 2020	Sharp.es (Spain)	18,600 visitors

34. Invoices displaying the word SHARP as well as the following marks are in evidence:⁸

⁷ Exhibit MT6

⁸ Exhibit MT7

35. The invoices can be summarised as follows:

Jurisdiction	Date	Goods	Net Value (EUR)
Lithuania	6 December 2019	Printers and accessories	12,890
Sweden	3 June 2019	Retail services	33,220
Hungary	26 March 2019	Printers and printer toner	34,386
France	23 November 2018	Printer toner	10,816
France	2 March 2018	Printer toner	21,908
Denmark	10 January 2018	Interactive whiteboard display monitor	28,110
France	11 December 2017	Printer toner	30,654.19
Spain	14 November 2017	Printer toner and accessories	9,979.14
Hungary	18 January 2017	Printer toner	641,301
Denmark	19 December 2016	Printers and printer toner	28,251
Germany	29 February 2016	Printers	228,763.91
Spain	18 November 2015	Printer toner and accessories	14,850.74
Germany	30 June 2015	Printers and accessories	96,179.45
Finland	23 June 2015	Printer and accessories	4,700
Finland	30 December 2015	Printer and accessories	21,862.70

36. Mr Taneya states that the opponent also provides a range of computer software solutions including output management, document capture, mobile applications, document management and workflow, device management and product solutions.

37. Mr Taneya states that the opponent's Sharpdesk mobile app software has been available for sale in the UK since April 2012 and throughout the EU since June 2012. The app has been downloaded from the Google Play store over 100,000 times.⁹ Over 80 reviews are visible which date back to 2012, and the majority appear to be in English. It is clear that there have been downloads of both of the app during the relevant period from customers located in the EU and the UK.¹⁰ The app is described as:

"Sharpdesk Mobile can receive, preview and store scanned documents from your scanner to your mobile device connected to your wi-fi network.

[It] can also print the documents stored in your mobile device to your printer, attach the scanned documents stored in this application to e-mail, and send documents to other application in your mobile device to utilize them."

38. Mr Taneya states that the opponent has offered its Sharp Print Service Plugin app software in the UK and EU since April 2016. This has also been downloaded over 100,000 times on the Google Play store.¹¹ The software enables the printing of documents and images on Android mobile devices. It is clear that there have been downloads of both of the app during the relevant period from customers located in the EU and the UK.¹²

39. Mr Taneya explains that the opponent provided professional IT support services to its business clients. I note that the opponent's website describes this as "our managed IT services takes care of your IT, so you can take care of your business". It goes on to state: "nothing kills productivity as fast as a computer failure [...] rely on Sharp's Optimised Hardware Maintenance services. Phone support, prompt on-site repairs and loan equipment all feature in this comprehensive break-fix services" and "with Sharp's optimised Data Protection service we'll back up all your data and store it securely on remote servers in our state-of-the-art data centres, refreshing it with

⁹ Exhibit MT10

¹⁰ Exhibit MT12

¹¹ Exhibit M11

¹² Exhibit MT13

regular updates”.¹³ I note that equivalent website pages are provided for Denmark, France and Poland.

40. The opponent’s computer software, IT services, LCD monitors, printers and tablets have been advertised during the relevant period in the UK, France and Germany.¹⁴ These adverts display the following mark:

SHARP
Be Original.

41. The opponent also sponsors the German Bundesliga football teams, VfB Stuttgart, FC Köln and SC Paderborn 07. The opponent’s mark has appeared in the club’s stadiums.¹⁵ Mr Taneya confirms that this was the case during the relevant period. For example, Mr Taneya has provided the following images:



¹³ Exhibit MT15

¹⁴ Exhibits MT17, MT18 and MT19

¹⁵ Exhibit MT21 and MT22



42. I also note the following advertisements:

- Adverts for wearable neck speakers, smartphone, air purifiers, LCD TV (UK);
- Adverts for LCD TV, speaker (France);
- Adverts for LED TV (Germany);
- Adverts for speakers, radios, TVs (Italy).¹⁶

43. Mr Taneya confirms that these were distributed during the relevant period and I note that they all contain the word only mark SHARP or the word in red as displayed above.

¹⁶ Exhibit MT23

44. I note that the opponent has advertised in a number of EU countries, although it is not always clear what products the adverts relate to.¹⁷ I note that the opponent has won a number of awards during the relevant period.¹⁸ However, it is not always clear what goods these relate to. However, I note that these do include the opponent's display monitors and printers/copying machines.

45. For the avoidance of doubt, I consider use of the word only SHARP or the same mark in red (and with accompanying slogans 'be original' or 'business systems') to be acceptable use of the marks relied upon.

46. I bear in mind that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹⁹

47. Clearly, the opponent's evidence shows long-standing use in the UK and EU. Total sales figures as well as invoices have been provided to prove sales made. These are supported by evidence of use on the opponent's website and advertisements. There is clearly a reasonable amount of web traffic visiting each of the opponent's websites in different EU member states throughout the relevant period. Taking all of this into account, I am satisfied that the opponent has shown genuine use in relation to LCD monitors, LED monitors, DVD players, audio players, speakers, calculators, computer software relating to the printing and management of documents, cash registers, telephones, printing machines, solar panels and computer services relating to business support in the EU during the relevant period.

48. I must now consider whether, or the extent to which, the evidence shows use of the earlier marks in relation to the goods and services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

¹⁷ Exhibit MT24

¹⁸ Exhibit MT27

¹⁹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

49. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

50. The specification for the Second Earlier Mark includes the term “LCD monitors”. The opponent can clearly retain this term. It also includes the term “monitors”. Given that the opponent has shown use for a range of different monitors, I also consider that this term can be retained.

51. Whilst I note that the opponent has shown use in relation to DVD players, it has elected not to rely upon this term, as set out in its written submissions in lieu.

52. As the opponent has shown use for audio players and there is no suggestion that these are anything other than digital, I consider that it should be able to retain the term “digital audio players”.

53. Although the opponent has shown use in relation to speakers, it has elected not to rely upon this term, as set out in its written submissions in lieu.

54. Although the opponent has shown use for calculators, it has elected not to rely upon this term, as set out in its written submission in lieu.

55. The opponent has shown some use of computer software. The applicant submits that the use shown by the opponent is not sufficient to justify retention of the term computer software per se. I agree. I consider that the term “computer software relating to the management and printing of documents” is a suitable sub-category.

56. Although the opponent has shown use of “cash registers” it has elected not to rely upon this term, as set out in its written submissions in lieu.

57. The terms “printers” and “telephones” can clearly be retained. Similarly, given the use shown, I also consider that “mobile phones” and “facsimile machines” should be retained.

58. My understanding is that “solar cell modules” is another name for solar panels. Consequently, given the use shown, I consider that the opponent should be able to retain this term.

59. I note that the opponent has shown use in relation to some computer services. However, these are limited to the field of business support only. Given the breadth of this term, I do not consider it appropriate for the opponent to retain use of the broader term. Consequently, I consider the term “computer services relating to business support” to be an appropriate sub-category.

60. Taking all of this into account, I consider a fair specification for the Second Earlier Mark to be:

Class 9 LCD monitors; monitors; digital audio players; computer software relating to the management and printing of documents; telephones, mobile phones; printers; facsimile machines; solar cell modules.

61. I consider a fair specification for the Third Earlier Mark to be:

Class 42 Computer services relating to business support.

Section 5(2)(b) – case law

62. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

63. The competing goods and services are as follows:

Opponent's goods and services	Applicant's goods and services
<p>The First Earlier Mark</p> <p><u>Class 9</u></p> <p>Nautical, weighing, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; computers; computer software; mobile phones; tablet computers; portable digital assistants; integrated white boards; interactive white boards, application software for smart telephones and tablet style digital</p>	<p>The First Application</p> <p><u>Class 9</u></p> <p>Computer application software featuring games and gaming; Computer gaming software; Computer software for the administration of on-line games and gaming; Gambling software.</p> <p><u>Class 42</u></p> <p>Platforms for gaming as software as a service [SaaS]; Software as a service [SaaS] featuring software platforms for electronic gaming.</p>

assistants; other application software; apparatus for recording computer data; data processing apparatus; computer programs downloadable via the Internet; computer programs (downloadable software); computer and computer software; computer application software for portable digital assistants; computer software for cloud computing; application software; application programs for smartphones utilizing wireless Local Area Network for controlling home electrical appliance; downloadable game programs for mobile phones; computer games programs downloaded via the internet; programs for portable games with liquid crystal displays downloaded via the internet; downloadable computer software; downloadable ring tones for mobile phones; downloadable electronic publications; electronic publications.

The Second Earlier Mark

Class 9

LCD monitors; monitors; digital audio players; computer software relating to the management and printing of documents; telephones, mobile phones; printers; facsimile machines; solar cell modules.

The Third Earlier Mark

Class 42

The Second Application

Class 9

Gaming software; Gaming software that generates or displays wager outcomes of gaming machines; Computer application software featuring games and gaming; Computer gaming software; Computer software for the administration of on-line games and gaming; Gambling software.

Class 42

Platforms for gaming as software as a service [SaaS]; Software as a service [SaaS] featuring software platforms for electronic gaming.

Computer services relating to business support.	
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64. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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.”

65. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

- (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.

The First Application

Computer application software featuring games and gaming; Computer gaming software; Computer software for the administration of on-line games and gaming; Gambling software

66. These terms in the applicant's specification are identical on the principle outlined in *Meric* to "computer software" and "computer games programs downloaded via the internet" in the specification of the First Earlier Mark. These goods are, therefore, identical on the principle outlined in *Meric*.

67. I note that the specification of the Second Earlier Mark contains the term "computer software relating to the management and printing of documents". I recognise that both terms are types of computer software and that this will inevitably result in an overlap in nature. However, I consider that the method of use, purpose and trade channels for the goods are entirely different. I recognise that both may be used by members of the public. The goods are neither in competition nor complementary.²⁰ Taking all of this into account, I consider these goods to be dissimilar. I can see no other point of similarity with the specification of the Second Earlier Mark which would put the opponent in a stronger position.

68. I consider these terms to be dissimilar to the specification of the Third Earlier Mark. The nature of the goods and services will clearly differ, as will the purpose, method of use and trade channels. I recognise that there may be some overlap in user, but I do not consider this sufficient for a finding of similarity.

Platforms for gaming as software as a service [SaaS]; Software as a service [SaaS] featuring software platforms for electronic gaming.

²⁰ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

69. There will be some similarity between these terms and the term “computer software” in the specification of the First Earlier Mark. The opponent’s term could include computer software for gaming and, consequently, there may be overlap in terms of purpose and user. I recognise that the goods and services will differ in nature and that there may be some difference in method of use. There may be overlap in trade channels and there may be some competition between the goods and services. Consequently, I consider the goods and services to be similar to a medium degree.

70. In my view, in relation to the specification of the Second Earlier Mark, the same findings will apply as set out in paragraph 67 above. However, there is the additional difference in the nature of the goods and services. Consequently, for the same reasons, I consider the goods and services to be dissimilar to the specification of the Second Earlier Mark.

71. I can see no point in overlap in trade channels, nature, method of use or purpose with the services in the Third Earlier Mark’s specification. Even if there is overlap in user, this is not enough on its own for a finding of similarity. Consequently, I consider the services to be dissimilar.

The Second Application

Gaming software; Gaming software that generates or displays wager outcomes of gaming machines; Computer application software featuring games and gaming; Computer gaming software; Computer software for the administration of on-line games and gaming; Gambling software.

72. These terms are broadly similar to the terms in class 9 of the First Application. Consequently, I consider that the same findings will apply.

Platforms for gaming as software as a service [SaaS]; Software as a service [SaaS] featuring software platforms for electronic gaming.

736. These terms are broadly similar to the terms in class 42 of the First Application. Consequently, I consider that the same findings will apply.

74. As I have found there to be no similarity between the specifications of the Second and Third Earlier Marks and the applications, the oppositions based upon those marks must fail.

The average consumer and the nature of the purchasing act

75. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

76. The average consumer for the goods and services will be a member of the general public or a business user. In terms of the level of attention paid during the purchasing process, the opponent submits:

“Computer software goods and computer services, including software as a service, particularly those relating to computer games and gambling, are commonplace in the marketplace; are relatively inexpensive; and are purchased by the general public on a regular basis. For example, most gaming or gambling apps can be downloaded for free. The general public buying the parties' goods and services will therefore only pay a low to medium degree of

attention. [...] Therefore, while the professional public will pay a higher degree of attention, the Hearing Officer must focus their assessment based on the general public, who will only pay a low to medium degree of attention when purchasing the parties' goods and services."

77. The price of the goods and services is likely to vary. However, I recognise that some of the purchases may be of low (or no) cost, such as gaming software downloaded on to mobile phones. However, even in those circumstances, the average consumer is likely to take various factors into consideration, such as the type of software offered, functionality and ease of use. Consequently, I consider that a medium degree of attention is likely to be paid. However, I recognise that the level of attention paid may be higher than medium in some cases, where the cost is higher or the goods and services are particularly technical in nature.

78. The goods are likely to be self-selected from the shelves of a retail outlet or their online equivalent. The services are likely to be selected following perusal of premises frontages, websites or advertisements. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase, given that advice may be sought from retail assistants and word-of-mouth recommendations may play a part.

Comparison of trade marks



79. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

"... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight

in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

80. 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.

81. The respective trade marks are shown below:

Opponent’s trade marks	Applicant’s trade marks
<p style="text-align: center;">SHARP</p> <p style="text-align: center;">(the First Earlier Mark)</p>	<div style="text-align: center;">  <p>(the First Application)</p>  <p>(the Second Application)</p> </div>

82. The First Earlier Mark consists of the word SHARP in an unremarkable font. The overall impression lies in the word itself. The First Application consists of the words SHARP GAMING. The word SHARP is presented in a white font and the word GAMING is presented in a graduated font from green to purple. These words are presented alongside a geometric device on a dark rectangular background. As noted by the opponent, given the goods and services for which the First Application is applied-for, the word GAMING is likely to be seen as descriptive. However, I accept that it makes more than a negligible contribution to the mark, although the word SHARP and device will be the dominant and distinctive elements, with the use of colour playing a lesser role. The background will be perceived by the average consumer for what it is – a background – and will be attributed little significance. The same applies to the Second Application, which is the same as the First, save for the

absent background and use of colour which are different to those in the Second Application.

83. Visually, the marks all overlap to the extent that they all contain the word SHARP. They differ in the use of stylisation, device, colour and the word GAMING which are absent from the First Earlier Mark. There is also the addition of the background in the First Application, although I recognise that this will be attributed little significance. Taking all of this into consideration, I consider the marks to be visually similar to a medium degree.

84. Aurally, the word SHARP will be pronounced identically in all of the marks. The word GAMING in the First and Second Application will act as a point of aural difference. Taking all of this into account, I consider the marks to be aurally similar to between a medium and high degree.

85. Conceptually, the word SHARP will be identified as an ordinary dictionary word or relatively common English name. The same meaning will be attributed to all of the marks. The word GAMING conveys its dictionary meaning, which has no counterpart in the First Earlier Mark. I do not consider that the geometric device will convey any meaning. Consequently, the marks are conceptually similar to between a medium and high degree.

Distinctive character of the earlier mark

86. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, paragraph 49).

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

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

88. I will begin by assessing the inherent distinctiveness of the First Earlier Mark. The word SHARP, as noted above, is an ordinary dictionary word or relatively common English surname. Consequently, I consider it will be distinctive to no more than a medium degree. It is presented in an unremarkable font, which adds nothing to its distinctiveness.

89. The opponent has filed evidence of use. I have summarised its use above. However, the goods that I have found to be similar to the applicant’s goods and services is the term “computer software” at large and “computer games programs downloaded via the internet”. Although the opponent’s evidence does show use in relation to computer software, this relates to an entirely different type of computer software which, for the reasons set out above, is dissimilar to the applicant’s goods and services. Consequently, I do not consider that any enhanced distinctiveness in this regard could be of assistance and I need deal with it no further.

Likelihood of confusion

90. 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 and services 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 marks may be offset by a greater degree of similarity between the goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the First Earlier Mark, the average consumer for the goods and services 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 he has retained in his mind.

91. I have found the marks to be visually similar to a medium degree and aurally and conceptually similar to between a medium and high degree. I have found the earlier mark to be inherently distinctive to no more than a medium degree. I have identified the average consumer to be a member of the general public or a business user who will pay at least a medium degree of attention during the purchasing process (although I recognise that the level of attention may be higher than medium for some of the goods and services). I have found the purchasing process to be predominantly visual, although I do not discount an aural component. I have found the goods and services to vary from being identical to similar to a medium degree.

92. I do not consider that the additional word GAMING, device and use of stylisation/colour in the First and Second Applications will be overlooked by the average consumer, particularly given that at least a medium degree of attention will be paid (and in some cases the level of attention will be higher). Consequently, I do not consider that there is a likelihood of direct confusion. However, I consider that the common element SHARP, which is the only element (other than minimal stylisation)

in the First Earlier Mark and one of the dominant and distinctive elements of the First and Second Applications will lead the average consumer to conclude that they originate from the same or economically linked undertakings. The similarity of the goods and services (being medium or higher) is another factor in favour of the opponent. In my view, the average consumer will view the marks as alternative marks, possibly indicating a sub-brand specialising in the gaming sector, originating from the same business. Consequently, I consider there to be a likelihood of indirect confusion.

93. The opposition based upon section 5(2)(b) succeeds in its entirety.

Final remarks

94. For the avoidance of doubt, even if I had found some similarity between the goods and services in the specifications of the Second and Third Earlier Marks and the applicant's marks, this would have been at only a low level. My findings regarding the level of similarity and distinctiveness of these marks would have been very similar to those outlined above. I would not have found enhanced distinctiveness due to the lack of information regarding advertising expenditure in the UK and the lack of information directed specifically at the UK market. Taking this into account, even if I had found some low degree of similarity between the goods and services, I would have found no likelihood of confusion. This is because the distance between the respective goods and services would have been sufficient to offset the similarity of the marks, thus avoiding direct or indirect confusion.

Section 5(3)

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

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (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.”

96. I can deal with this ground relatively swiftly. Even if I had found a reputation for all of those goods and services for which it has demonstrated proof of use, I do not consider that this ground puts it in any stronger position. Those goods and services are, for the reasons set out above, dissimilar to the applicant’s goods and services. I recognise that similarity of goods and services is not essential for a successful opposition under section 5(3), but it is one of the factors to be considered. In my view, when used on goods and services that are dissimilar, the distance between those goods and services would be sufficient to offset the similarity between the marks and the strength of the opponent’s reputation, with the result that no link would be made. If any link was made, it would be too fleeting to result in damage.

97. The opposition based upon section 5(3) is dismissed.

Section 5(4)(a)

98. 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”.

99. 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.”

100. I can also deal with this ground swiftly. Even assuming that the opponent had established goodwill for all of those goods and services for which it has shown genuine use, the distance between the parties’ respective fields of activity would, in my view, result in no misrepresentation arising and, consequently, no damage.

101. The opposition based upon section 5(4)(a) is dismissed.

CONCLUSION

102. The opposition is successful and the First and Second Applications are refused.

COSTS

103. The opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Whilst I note that the opponent has been successful under section 5(2)(b), it has been unsuccessful under sections 5(3) and 5(4)(a). As reliance upon the latter two ground attracted a higher official fee (£200 as opposed to £100), I will make an award for the lower fee only to reflect that those grounds did not improve the opponent’s position. With that in mind, I award the opponent the sum of **£1,750**, calculated as follows:

Filing Notices of opposition and considering the applicant’s counterstatements	£400
Filing evidence and considering the applicant’s submissions	£800

Written submissions in lieu	£350
Official fee of £100 (x2)	£200
Total	£1,750

104. I therefore order Sharp Gaming Limited to pay Sharp Kabushiki Kaisha (Sharp Corporation) the sum of £1,750. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 29th day of July 2021

S WILSON

For the Registrar

ANNEX

EUTM no. 17502717

Relying on some goods for which the mark is registered, namely:

Class 9 Nautical, weighing, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; robot-shaped smart phones; other smart phones; mobile phones; other telephones; parts and fittings for telephones; tablet computers; tablet style portable digital assistants; wristwatch style portable digital assistants; portable digital assistants; integrated white boards; interactive white boards, integrated white board with touch panels; interactive white boards with touch panels; application software for smart telephones and tablet style digital assistants; other application software; other telecommunication apparatus; electronic-applied apparatus and parts thereof; batteries; electric wire and cables; electric distribution and/or control machinery and apparatus; self-propelled monitoring security robots; self-propelled monitoring robots for security purposes; monitoring robots for security purposes; automatic control machines and instruments by temperature and motion monitoring for air-conditioning or freezing purposes; light dimmers for luminaires; power controllers for luminaires; measuring or testing machines and instruments for temperature, humidity and atmosphere pressure; automatic controllers and remote controllers for measuring, monitoring and controlling purposes for air-conditionings; anti-theft and fire warning apparatus; motion sensors; data recorders for transmission and storage between electronic memory devices via wireless or cable; warning apparatus with monitoring motion of babies by camcorders or sensors; electronic translators by sound; electronic translators; pre-recorded data

carriers for voice recognition systems; apparatus for recording computer data; data processing apparatus; computer programs downloadable via the Internet; computer programs (downloadable software); computer and computer software; photovoltaic cell modules; solar batteries; photovoltaic apparatus and installations; security anti-intrusion alarms for doors; gas alarms; smoke alarms; water leak alarms; anti-theft alarms; electronic locking mechanisms for safes; remote monitoring power controls; wattmeters; electric power converters; measuring power apparatus; microbe detectors; microbe sensors; measuring or testing machines and instruments; pedometers; counters; vibration sensors; computer application software for portable digital assistants; computer software for cloud computing; application software; application programs for smartphones utilizing wireless Local Area Network for controlling home electrical appliance; downloadable game programs for mobile phones; computer games programs downloaded via the internet; programs for portable games with liquid crystal displays downloaded via the internet; downloadable computer software; downloadable ring tones for mobile phones; downloadable electronic publications; electronic publications; AGEs (Advanced Glycation End Products) sensors; protein analysis apparatus; electrophoresis apparatus; blotting apparatus; fluorescence imaging apparatus; soil analysis apparatus; bathroom scales.

EUTM no. 12994737

Relying on some goods for which the mark is registered, namely:

Class 9 LCD television receivers; television receivers; mounting frames and metal parts for fixing of LCD television receivers; tuners for satellite broadcasting; USB memories; Hard Disc Drives; set-top boxes; power cables; digital audio/video transmission interface cables; antenna cables; LCD monitors; monitors; DVD players; DVD recorders; optical disc players; optical disc recorders; Combined LCD televisions and/or monitors with optical disc recorders and optical disc players; video

cassette recorders; video cameras; video camcorders; digital cameras; digital audio players/recorders; compact disc players; mini disc players; mini disc recorders; speakers; amplifiers; sub woofers; radio cassette tape recorders, radio cassette tape recorders with a compact disc player; home theater systems consisting of disc players/recorders, amplifiers, sub woofers, speakers and remote controllers; stereo component systems consisting of disc players/recorders, tuners, cassette tape players/recorders, speakers and remote controllers; channel systems and music stereo systems for smart phones and digital audio players/recorders playback; sound bar systems consisting of subwoofers, speakers and amplifiers; remote controllers; sound rack systems consisting of disc players, recorders, tuners, speakers, amplifiers and a rack; karaoke machines; navigational instruments; electronic dictionaries; electronic organizers; personal digital assistants; electronic calculators; computers; notebook computers; tablet computers; tablet personal computers; PHS (Personal Handy-phone Systems) phones; computer software; cash registers; POS systems; telephones, mobile phones; copying machines; printers; facsimile machines; scanners; copying machines having functions of printers, facsimile machines and scanners; solar cell modules; power conditioners; photovoltaic power generating systems consisting of solar cell modules, power conditioners, interconnecting cables, mounting frame and hardware of which fix the solar cell modules on roofs of houses and buildings; accumulators; controllers; electronic components; integrated circuits; light emitting diodes; light emitting diodes modules; LCD panels; LCD modules; Electro-luminescence display modules; Complementary “MOSFET” (metal–oxide–semiconductor field-effect transistor) image sensors; Complementary “MOSFET”(metal–oxide–semiconductor field-effect transistor) camera modules; camera modules for mobile phones; Charge Coupled Devices modules; Large scale integrations circuits; flash memories; combination memories; memories; laser diodes; power devices; optical pickups; radio frequency components; IC card reader/writers; one-segment tuner modules; printed circuit boards; switching power supplies; photocouplers;

phototriac couplers; photointerrupters; phototransistors; photodiodes; Infrared Emitting Diodes; Optical-Electric Sensors; fiber optics; Infrared Data devices; ion generating devices, low noise block converters; digital television tuners; television tuners; multi-channel triacs; satellite data modems; satellite data modem modules; AC adapters; power transistor units; light detectors; printed wiring boards; magneto-optical disks; DAT memory drive units; magneto-optical disk drive units; infrared detecting unit for remote controls; infrared data communication devices; three dimension eye glasses for television receivers; electronic publications (downloadable); electronic book readers; digital photo frames; integrated white boards; interactive white boards, integrated white board with touch panels; interactive white boards with touch panels; liquid crystal display monitors with touch panels; liquid crystal display monitors for video conferences systems; liquid crystal display monitors and multi monitor system for news, advertising and entertainment; batteries; dry batteries; batteries for mobile phones and smart phones; battery-based back-up power supply apparatus having accumulators; liquid crystal display projectors, data projectors, theater projectors; dual function boards; OPC (Organic Photo Conduction) drums for copying machines and copying machines having functions of printers; drums for facsimile machines; finishers for copying machines and copying machines having functions of printers, facsimile machines and scanners; trays for copying machines and copying machines having functions of printers, facsimile machines and scanners; ion generating devices and units; monitoring and alarming apparatus for security and emergency purposes; camcorders for monitoring purposes; memory cards; electronic notebooks; electronic memos; liquid crystal display touch panels; monitoring apparatus for environmental monitoring apparatus; sensor modules for environmental monitoring apparatus; microbe sensors; bacteriological sensors.

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Relying on some services for which the mark is registered, namely:

Class 42 Computer services; providing access to and leasing access time to computer database connected with local and global computer information networks, providing access to local and global computer information networks for the transfer and dissemination of a wide range of information; provision of computer programs via local and global computer information networks; providing on-line books and magazines on a wide range of topics; providing access to an electronic bulletin board in a wide range of fields; providing on-line facilities for real time information with computer users concerning a wide range of topics in the nature of chat rooms; technical services and technical consulting services for creating, designing and maintaining web sites for others; technical services and technical consultation for computer programming and computer hardware; services relating to the technical supervision and inspection of electronic apparatus and instruments including electronic computers; rental of electric and electronic apparatus and instruments; provision of food and beverages; providing temporary accommodation.