

O809/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. 3471446, 3471477 & 3519251

BY PHOTO-IMAGE LTD

TO REGISTER THE FOLLOWING TRADE MARKS:

**Pentax 6x7**

**Pentax6x7**

AND

**Pentax 67**

**Pentax67**

AND

**Asahi Pentax 6x7**

IN CLASS 9

AND

IN THE MATTER OF OPPOSITIONS THERETO

UNDER NOS. 420574, 420575 & 422493

BY HOYA CORPORATION

## **Background and pleadings**

1. On 2 March 2020, Photo-Image Ltd (“the applicant”) applied to register **Pentax 6x7** and **Pentax6x7** as a series of trade marks in the UK, under number 3471446. As the only difference between the marks which comprise the series is the spacing, I will refer to them in the singular (i.e. “the first contested mark”), unless it becomes necessary to distinguish between them. Registration is sought for the following goods:

Class 9: Camera cases; camera covers; camera filters; camera flashes; camera hoods; camera lens adapters; camera lens mounts; camera lenses; camera mounts; camera straps; cameras; cameras [photography].

2. On 2 March 2020, the applicant also applied to register **Pentax 67** and **Pentax67** as a series of trade marks in the UK, under number 3471477. Again, I shall refer to the marks which comprise the series in the singular (i.e. “the second contested mark”), unless it becomes necessary to distinguish between them. Registration is sought for the following goods:

Class 9: Camera cases; camera covers; camera filters; camera flashes; camera hoods; camera lens adapters; camera lens mounts; camera lenses; camera mounts; camera straps; cameras; cameras [photography]; image capturing and developing devices; image processing apparatus; image processing equipment; image processing instruments; image recording apparatus; imaging apparatus.

3. Details of the first and second contested marks were published for opposition purposes on 20 March 2020.

4. On 4 August 2020, the applicant applied to register the trade mark **Asahi Pentax 6x7** in the UK, under number 3519251 (“the third contested mark”). The third contested mark was published for opposition purposes on 19 September 2020. Registration is sought for the following goods:

Class 9: Camera cases; camera covers; camera filters; camera hoods; camera lens adapters; camera lens mounts; camera lenses; camera shutters; camera stands; camera straps; cameras; cameras (bags adapted or shaped to contain -); cameras [photography]; image processing apparatus; image processing equipment; image processing instruments; image recording apparatus; image reproducing apparatus; imaging apparatus; lens; lens caps; lens cases; lens covers; lens filters [for cameras]; lens hoods; lens hoods [for cameras]; lens shutters; lenses for cameras; lenses for photographic apparatus; lenses (optical -).

5. Hoya Corporation (“the opponent”) opposes all three applications under section 5(2)(b) of the Trade Marks Act 1994 (“the Act) on the basis of the following trade marks:

**PENTAX**

International Registration Designating the UK (“IRUK”) No. 751039

International Registration date: 26 September 2000

UK designation date: 26 September 2000

Protection granted date: 10 August 2001

(“the first earlier mark”)

**PENTAX**

IRUK No. 793800

International Registration date: 27 November 2002<sup>1</sup>

UK designation date: 27 November 2002

Protection granted date: 21 September 2003

(“the second earlier mark”)

---

<sup>1</sup> I note that the IRUK claims a priority filing date of 30 May 2002 from the Benelux Office for Intellectual Property.

## **PENTAX**

European Union Trade Mark (“EUTM”) No. 340349

Filing date: 5 August 1996<sup>2</sup>

Registration date: 9 March 1999

(“the third earlier mark”)

## **PENTAX**

UK Trade Mark (“UKTM”) No. 1259043

Filing date: 28 January 1986

Registration date: 28 January 1986

(“the fourth earlier mark”)

6. The goods and services relied upon by the opponent are outlined in the annex to this decision.

7. Given the respective filing dates, the opponent’s marks are earlier marks in accordance with section 6 of the Act.<sup>3</sup> As they had been registered for more than five years at the filing dates of the applications, they are subject to the proof of use requirements specified within section 6A of the Act.

8. In its notices of opposition, the opponent contends that the parties’ respective goods are identical or similar and that the competing trade marks are similar, giving rise to a likelihood of confusion. The opponent also made statements of use in respect of the goods underlined in the annex to this decision.

9. The applicant filed counterstatements denying the grounds of opposition. It also indicated that it would require the opponent to provide proof of use of its earlier marks.

10. On 19 October 2020 and 7 May 2021, the proceedings were consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008 (“the Rules”).

---

<sup>2</sup> I note that the EUTM claims seniority from multiple national trade marks, with the earliest registration date being 22 September 1952 (Germany).

<sup>3</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, such as the third earlier mark, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

11. Both parties filed evidence in these proceedings. A hearing was requested and held before me, in person, on 1 July 2022. The applicant represented itself through Raj Pal Senna. The opponent has been professionally represented throughout these proceedings by Lewis Silkin LLP, though elected not to attend the hearing or to file written submissions in lieu.

12. 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 and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

### **Evidence**

13. The opponent's evidence in chief consists of the witness statement of Miho Ikenishi, dated 23 December 2020, together with Exhibits HC1 to HC16, and the witness statement of Helene Whelbourn, dated 2 July 2021, together with Exhibits HC17 to HC27. Ms Ikenishi is the Leader of Corporate IP Office of the opponent, a position she has held since 2016. Ms Whelbourn is a Senior Trade Mark Attorney with the opponent's professional representatives. The witnesses both give evidence as to the background and use of the earlier marks.

14. The applicant's evidence is given in the witness statement of Raj Pal Senna, dated 2 December 2021, and Exhibit Senna 2. Mr Senna is the Director and shareholder of the applicant company. A significant proportion of his statement consists of submissions, which will be treated as such. Broadly speaking, and insofar as it contains evidence of fact, the purpose of his statement is to provide details of the applicant's use of the contested marks and apparent differences between the actual goods provided by the parties.

15. The opponent filed evidence in reply in the form of the witness statement of James Brown, dated 1 February 2022. Mr Brown is the Group Legal Director (EMEA) of Ricoh Europe PLC, a position he has held since 2018. Mr Brown has been employed by the

company since 2011. He confirms that the company sells 'PENTAX' branded products but that the earlier marks are owned by the opponent.

16. I have read all of the evidence and will return to it to the extent I consider necessary in the course of this decision.

### **Preliminary remarks**

17. At the hearing, Mr Senna brought a range of physical products and packaging with him. At various stages of the hearing, he used the products and packaging to demonstrate points about respective branding, functions and features. Clearly, Mr Senna sought to rely upon the products and packaging, and it is my understanding that he considered them relevant particularly to the issues of proof of use of the earlier marks, perceived differences between the parties' respective goods and alleged differences between their consumers.

18. Bearing in mind that Mr Senna is an unrepresented party, I did not prevent him from commenting upon the physical products and packaging at the hearing. However, I informed him at the outset that, whilst I would generally not interrupt him when giving his submissions, I could not take any new evidence into account. The items produced by Mr Senna had not been admitted into the evidence prior to the hearing and no request has been made to file additional evidence. As such, this evidence cannot form part of the decision and I am not able to take his comments on it into consideration. As I confirmed at the hearing, the only evidence I can consider is that detailed above.

19. Further, Mr Senna indicated that he was challenging whether the opponent's representatives were properly authorised to file the opposition on behalf of the opponent. He said that no Board Resolution from the opponent to that effect had been filed and argued that, without one, the opponent's representatives have "no locus".<sup>4</sup> As a result, according to Mr Senna, the Registrar must disregard everything that has been filed in support of the opponent's claims.

---

<sup>4</sup> Which I take to be a reference to *locus standi*, being the right or capacity to bring an action or to appear in a court.

20. There is nothing in the Act or the Rules which states that the opponent must adduce evidence to demonstrate that its recorded representatives have authority to act on its behalf (such as a Board Resolution). Section 82 of the Act provides that “any act required or authorised by this Act to be done by or to a person in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may be done by or to an agent authorised by that person orally or in writing”. Rule 60(5) of the Rules states that the Registrar “may by notice in writing require an agent to produce evidence of his authority under section 82”. As can be seen from the wording of that rule, it is a matter of discretion.

21. Lewis Silkin LLP are the opponent’s recorded representatives for these proceedings. They filed the opponent’s notices of opposition on its behalf. I note that Ms Whelbourn of Lewis Silkin LLP gives evidence that she had been instructed to file the evidence on behalf of the opponent.<sup>5</sup> The witness statement included a signed statement of truth. Mr Senna has not sought to cross-examine the veracity of this evidence. Moreover, the opponent’s representatives filed the signed witness statement of Ms Ikenishi. As noted above, Ms Ikenishi is the Leader of Corporate IP Office of the opponent. The witness statement appears to have been prepared for the purposes of these oppositions and also included a signed statement of truth. In light of all of this, I have no reason to doubt that the opponent’s representatives have authority to act on the opponent’s behalf.

22. Mr Senna also made submissions regarding how he intends to use the contested marks. For reasons which I will now explain, his comments about the claimed differences in the actual goods and services he may provide will, as a matter of law, have no bearing on the outcome of this decision.

23. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. Once a trade mark has been

---

<sup>5</sup> Witness statement of Helene Whelbourn, §1

registered for five years, section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. As noted above, the marks relied upon by the opponent had been registered for more than five years at the date on which the contested applications were filed and, therefore, the opponent has been required to provide evidence of use. Subsequent to a proof of use assessment and the construction of a fair specification, the earlier marks are entitled to protection against a likelihood of confusion with the contested marks based on the 'notional' use of the earlier marks for any goods in its specifications which survive that assessment. The concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

24. So far as the applicant's claimed use of its applied-for marks is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union stated (at paragraph 66 of its judgment) that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, even though the applicant has suggested the ways in which the contested marks will be used, my assessment later in this decision must take into account only the applied-for marks – and their specifications – and any potential conflict with the opponent's earlier marks. Any



perceived differences between the actual goods provided by the parties are not relevant unless those differences are apparent from the applied-for and registered marks. As I explained at the hearing, my comparison between the parties' goods would be between the goods contained in the applicant's specifications and the goods of the earlier marks, subject to a proof of use assessment.

25. Finally, Mr Senna referred to an objection raised during the examination of the third contested mark under section 41(2) of the Act. He highlighted that the examination report issued on 5 September 2020 stated that the applied-for marks 'Asahi Pentax' and 'Asahi Pentax 6x7' could not constitute a series on one application because they differ in their material particulars, the additional element '6x7' rendering the marks visually, aurally and conceptually different. Mr Senna feels that the reasoning of this objection is a sufficient basis for rejecting the present oppositions.

26. Whilst I acknowledge that such an objection was raised during the examination of the third contested mark, I must clarify that this alone is not a proper basis for dismissing the opponent's claims. Firstly, I am not bound by decisions taken during the examination of a trade mark application. Secondly, whether two or more marks are able to function as a series on one application requires a different assessment to whether there is a likelihood of confusion.

27. Section 41(2) of the Act states that a "series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark". In *LOGICA*, Case BL O/068/03, Professor Ruth Annand, sitting as the Appointed Person, stated that section 41(2) contains three conditions, namely, a) the marks in the series must resemble each other in their material particulars, b) the differences between the trade marks must not comprise matter which, when considered as a separate element of the trade mark, would be regarded as having distinctive character, and c) the differences between the trade marks must not comprise matter, which when considered in the context of the trade mark as a whole, substantially affects the identity of the trade mark. The test is not whether the marks in the series would be regarded as being confusingly similar to each other. Rather, the

Registrar will consider whether the marks comply with the aforementioned requirements and whether a single examination can be done.

28. In contrast, whether there is a likelihood of confusion is an assessment carried out under section 5(2)(b) of the Act, which states “a trade mark shall not be registered if because [...] 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”. In making that assessment, the Registrar will be guided by, *inter alia*, the following principles:<sup>6</sup>

(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;

---

<sup>6</sup> These 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.

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

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

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

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

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

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

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

29. The relevant factors to be considered in a likelihood of confusion assessment do not include whether the marks could function as a series on one application. Moreover, series considerations are not based upon whether the marks would be regarded as confusingly similar. In other words, they are different tests: a series objection cannot be used to show that marks are not confusingly similar. Consequently, I do not consider it appropriate to derive my findings in this decision from the objection to which Mr Senna referred.

## **Decision**

### **Proof of use**

30. The relevant statutory provisions are as follows:

“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), (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.

[...]

(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.”

31. Section 100 of the Act is also relevant, which states:

“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.”

32. Pursuant to section 6A of the Act, the relevant periods for assessing whether there has been genuine use of the earlier marks are the five-year periods ending with the filing dates of the applications at issue, i.e. 3 March 2015 to 2 March 2020 and 5 August 2015 to 4 August 2020.

33. 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 Kameradschaft '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].”

34. 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 and services protected by the mark” is not, therefore, genuine use.<sup>7</sup>

35. I am also guided by *Awareness Limited v Plymouth City Council*, Case BL O/236/13, in which Mr Daniel Alexander K.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

---

<sup>7</sup> *Intermar Simanto Nahmias v Nike Innovate C.V.*, Case BL O/222/16



[...]

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

36. Furthermore, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs K.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or

her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

37. Ms Ikenishi gives evidence that the trade mark ‘PENTAX’ has been used since the 1950s in relation to cameras and camera lenses.<sup>8</sup> Ricoh Imaging Europe S.A.S. (“Ricoh”) has been an authorised user of the mark in the UK since 2011.<sup>9</sup> Printouts from Ricoh’s website at [www.ricoh-imaging.co.jp](http://www.ricoh-imaging.co.jp) have been provided,<sup>10</sup> which show the history of the brand. I note that Asahi Pentax Corporation was established in Japan in 1955 and that the first camera bearing the ‘PENTAX’ mark (that being the ‘ASAHI PENTAX’) was launched in 1957. In the decades since, other cameras bearing the ‘PENTAX’ mark have been regularly launched. Ms Whelbourn also provides printouts from Ricoh’s website,<sup>11</sup> showing that cameras bearing the ‘PENTAX’ mark have been released each decade since the 1960s.

38. Ms Ikenishi explains that Ricoh has sold digital single lens reflex cameras, camera lenses, compact cameras and binoculars throughout the UK before and during the five

---

<sup>8</sup> Witness statement of Miho Ikenishi, §2

<sup>9</sup> Ikenishi, §1 and §15; Exhibit HC16

<sup>10</sup> Exhibit HC1

<sup>11</sup> Exhibit HC27

years preceding her statement.<sup>12</sup> She says that the products sold under the mark in the UK have been promoted in a variety of ways, including press releases, product catalogues, exhibitions and through Ricoh’s website at [www.ricoh-imaging.eu.uk](http://www.ricoh-imaging.eu.uk).<sup>13</sup> Ms Whelbourn gives the following overview of ‘PENTAX’ products which are said to have been sold in the UK:<sup>14</sup>

<b>Product</b>	<b>Years sold</b>
Pentax 645z camera	2014 – 2020
Pentax K-1 camera	2014 – 2020
Pentax KP camera	2016 – 2020
Pentax K-3 camera	2015 – 2017
Pentax K-70 camera	2016 – 2020
Pentax K-S2 camera	2015 – 2017
Pentax K mount lens	2015 – 2020
Pentax MF lens	2015 – 2020

39. Ms Whelbourn also provides Ricoh catalogues and news releases relating to these products.<sup>15</sup> From the same I note that the 645z was launched in April 2014; K-1 cameras were launched in April 2016 and February 2018; the KP was launched in January 2017; the K-3 was launched in October 2013; the K-70 was launched in June 2016; the K-S2 was launched in February 2015; and the K mount lens was launched in June 2016.

40. According to Ms Ikenishi, ‘PENTAX’ products are sold in a variety of stores in the UK.<sup>16</sup> She provides photographs of in-store displays, which are said to show products bearing the ‘PENTAX’ mark in UK stores between 2015 and 2019.<sup>17</sup> ‘PENTAX’ cameras and lenses can be seen in the same. The photographs are labelled “Park London” (said to be from 2015-2016), “Peter Rogers Stafford” (said to be from 2017-2018) and “WEX Whitechapel” (said to be from 2017-2018). The photograph of a store

---

<sup>12</sup> Ikenishi, §§3-4

<sup>13</sup> Ikenishi, §5

<sup>14</sup> Whelbourn, §§3-10

<sup>15</sup> Exhibits HC17-24

<sup>16</sup> Ikenishi, §10

<sup>17</sup> Exhibits HC8-10

front labelled “SRS Watford” (said to be from 2018-2019) is adorned with ‘PENTAX’ branding. A plan for ‘PENTAX’ in-store merchandising at Park Cameras London (2015) can also be seen in the evidence. In addition, ‘PENTAX’ products are said to be sold on the Amazon UK shopping website.<sup>18</sup> A printout from amazon.co.uk has been provided,<sup>19</sup> which shows ‘PENTAX’ branded cameras offered for sale. The printout is dated 10 December 2020.

41. Ms Ikenishi says that products bearing the ‘PENTAX’ mark have featured prominently on Ricoh’s UK website.<sup>20</sup> Printouts from the same have been exhibited.<sup>21</sup> ‘PENTAX’ cameras and lenses are clearly visible in the first printout. The printout is dated 16 December 2020, i.e. after the relevant dates. The remaining printouts, obtained using Internet Archive, are dated 5 February 2015, 7 March 2016, 25 April 2017, 23 June 2018 and 10 May 2019. They show links from the Ricoh website to features about ‘PENTAX’ cameras and lenses. They also show that, from 2017 onwards, full banners showing ‘PENTAX’ products were displayed at the top of the website. Further, Ms Ikenishi says that ‘PENTAX’ products are promoted by Ricoh in brochures.<sup>22</sup> Brochures from 2017 and 2018 are in evidence.<sup>23</sup> The former is entitled “PENTAX K-mount Lenses and Accessories”; a range of ‘PENTAX’ lenses and details of their features can be seen within, as can accessories (such as, for example, mounting adapters, conversion lenses, lens magnifier and auto flashes). The latter is entitled “PENTAX K-mount [...] SINGLE FOCUS LENS”; the brochure gives details of a ‘PENTAX’ lens which was due to be launched in July 2018.

42. According to Ms Ikenishi, products bearing the ‘PENTAX’ mark have been promoted at a number of events in 2015, 2018 and 2020.<sup>24</sup> From the information provided, I note that some took place in North Wales, Chester, Chiswick and Manchester. The majority of the events occurred in 2018. A report from Ricoh regarding its attendance at the Photography Show 2015 has been exhibited.<sup>25</sup> The

---

<sup>18</sup> Ikenishi, §14

<sup>19</sup> Exhibit HC15

<sup>20</sup> Ikenishi, §11

<sup>21</sup> Exhibits HC11 and HC12

<sup>22</sup> Ikenishi, §13

<sup>23</sup> Exhibits HC13 and HC14

<sup>24</sup> Ikenishi, §6

<sup>25</sup> Exhibit HC2

event took place in Birmingham and was said to have been attended by thousands of photography enthusiasts, professionals and trade visitors. Photographs show displays of 'PENTAX' branded cameras and (to a lesser extent) lenses. The report says that "a number of cameras" were sold as a result of a 'demo'. Photographs, said to be from the Photography Show 2017, have also been provided.<sup>26</sup> The 'PENTAX' mark can be seen adorning a camera display. A further presentation – from Ricoh, regarding its attendance at the Photography Show 2018 – is in evidence.<sup>27</sup> According to the report, the event was attended by over 30,000 photographers. 'PENTAX' branded cameras and lenses can be seen in photographs of the event. The total cost of the stand was said to have been £20,000. A photograph, said to be from the Wilkinsons Digital Splash Exhibition in 2016/2017, has been exhibited.<sup>28</sup> A display of 'PENTAX' branded cameras can be seen in the same.

43. Articles from *Digital Camera World* and *Digital SLR Photography* magazines have been provided.<sup>29</sup> The first from *Digital Camera World* is from January 2017 and details a product comparison between the 'PENTAX K-1' camera and that of a competitor. The second from *Digital Camera World* is from February 2017 and is a product review of the 'Pentax K-70' camera. Another article from *Digital Camera World* is from June 2017 and is a review of the 'Pentax KP' camera. The authors of all three articles refer to 'PENTAX' branded camera lenses. The article from *Digital SLR Photography* is from June 2017. It is a review of the 'PENTAX KP' camera. The author says that there has been "a revival for Pentax over the last couple of years" and describes it as an "historic camera brand".

44. Ms Whelbourn says that various 'PENTAX' products have received awards from the Technical Image Press Association ("TIPA"),<sup>30</sup> which she describes as an international association advocating the interests of the photography and imaging magazine-publishing industry.<sup>31</sup> Printouts from TIPA's website are in evidence.<sup>32</sup> From

---

<sup>26</sup> Exhibit HC3

<sup>27</sup> Exhibit HC4

<sup>28</sup> Exhibit HC5

<sup>29</sup> Exhibits HC6 and HC7

<sup>30</sup> For the sake of completeness, I note that Ms Whelbourn refers to this entity as the "Technology Image Press Association", while it is described on TIPA's website as the "Technical Image Press Association" (see Exhibit HC25). This appears to be a typographical error and nothing in this decision turns on it.

<sup>31</sup> Whelbourn, §11

<sup>32</sup> Exhibit HC25

the same, I note that 'PENTAX' cameras have won a number of TIPA awards dating back to 1993, one being within the relevant periods (2015). An article from *Photography News* is also in evidence.<sup>33</sup> A 'PENTAX' camera is the front-page feature. However, the article is dated 20 May to 16 June 2014, i.e. before the relevant periods. According to information from TIPA,<sup>34</sup> *Photography News* is aimed at camera club members and photo enthusiasts; it is circulated to 850 camera clubs and is also available in several leading national photographic retailers. As the copyright notice is dated 2021, and the printout is otherwise undated, I infer that these figures reflected the position at the time of Ms Whelbourn's statement, i.e. after the relevant periods.

45. I remind myself that an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>35</sup> Taking all of the above into account, the evidential picture suggests that the opponent (and its predecessors in title) have produced cameras and camera lenses under the 'PENTAX' mark since the late 1950s, with Ricoh being an authorised user of the mark since 2011. News releases suggest that such products were launched during the relevant periods. Cameras and lenses can be seen in photographs of 'PENTAX' displays in stores, said to be in the UK and dated within the relevant periods. 'PENTAX' products featured on the Ricoh website within the relevant periods, as well as within product brochures. Products bearing the mark were also promoted at events, such as the Photography Show, during these time periods. Moreover, 'PENTAX' cameras featured in magazine articles during the relevant periods and won an award at the beginning of the same.

46. Nevertheless, as indicated in the case law above, not every commercial use of a mark may automatically be deemed to constitute genuine use. I note that the opponent has not provided any turnover figures connected with its activities in the UK. Further, the opponent has not provided any details as to the size of the relevant market(s), or its share in the same. It is my impression that the market for photography equipment in the UK is remarkably large, numbering in the many millions of pounds per annum. In the absence of any financial information from the opponent, I am unable to

---

<sup>33</sup> Exhibit HC25

<sup>34</sup> *Ibid.*

<sup>35</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

determine how significant any sales were (if, indeed, there were any) during the relevant periods. I consider that evidence and information of this nature would have been readily available to the opponent.

47. Although the opponent's witnesses say that 'PENTAX' products have been sold in the UK and there is evidence that products have been launched, there is no specific evidence of any products being sold, or any business having been conducted, in the UK. For example, no invoices, order confirmations or financial reports have been provided. Again, it is my view that such documentation would have been readily available to the opponent.

48. There is nothing in the evidence which would enable me to conclude with any degree of certainty that the cameras and lenses had been launched in the UK; the press releases appear to concern the launch of these products globally, i.e. there is nothing specific to the UK market. Whilst I am prepared to accept the opponent's commentary that the undated photographs of in-store displays were taken during the relevant periods, I do not find this compelling evidence that products have been sold in the UK. It is true that 'PENTAX' displays of cameras and lenses can be seen in the photographs. Nevertheless, particularly in the absence of any documentary evidence showing that 'PENTAX' products have been sold by these outlets, the photographs add little to the evidential picture; they do not appear to actually show any 'PENTAX' products available to purchase and they are from a very limited number of stores.

49. Similarly, although images of 'PENTAX' cameras, lenses and links to features thereof were displayed on the Ricoh website during the relevant periods, the printouts do not unequivocally show that any products were available to purchase through the website. Particularly in the absence of turnover figures or sales reports from Ricoh, I am unable to conclude that any products were sold through the website. In addition, no information regarding website visits from consumers in the UK has been provided. As such, it is not possible to gauge to what extent relevant consumers had been exposed to the earlier marks by visiting the website. I also accept that 'PENTAX' cameras and lenses can be seen within product brochures. However, there is no information regarding the circulation of these brochures such as, for example, where they have been circulated and when. Moreover, the brochures do not appear to be

catalogues in the sense that they are informative, rather than commercial, i.e. they provide details of product features but do not indicate how the products can be purchased. I also note that the printouts of the Amazon UK listings postdate the filing dates of the contested marks and, as such, cannot be relied upon as showing the position during the relevant periods.

50. Moreover, the evidence of promotional or advertising activities conducted during the relevant periods is limited. Although I do not doubt that 'PENTAX' products were displayed at a number of events during the relevant periods, such as the Photography Show, no information has been provided as to how many individuals visited the 'PENTAX' stands at these events. I also note that the opponent has not provided any specific detail as to whether any business was generated as a result of the brand being represented at the events. In my view, a comment suggesting that "a number of cameras" were sold is far too ambiguous for me to determine how quantitatively significant any such sales were. In addition, whilst I note that the stand at the Photography Show 2018 was said to have cost Ricoh approximately £20,000, the opponent has not provided details of any other amounts spent during the relevant periods in promoting its marks in the UK. Across the five-year periods, I consider £20,000 to be modest at best. Furthermore, I accept that 'PENTAX' products were referred to by third party publications during the relevant periods. However, no details have been provided as to the publications' respective readership or circulation. Neither do they establish that any 'PENTAX' products were sold in the UK during the relevant periods. Finally, whilst I note that a 'PENTAX' product received an award from TIPA at the beginning of the relevant periods (that being the 'Pentax 645Z' in 2015), this is not sufficient to demonstrate that the opponent has attempted to create or maintain a market for products bearing the mark in the UK; the evidence from TIPA suggests that they are "world" awards, i.e. not specific to the UK, and appear to be given on the basis of the camera features, rather than, for example, financial performance in the relevant market. To my mind, receiving such awards does not establish the extent to which the mark has been used in the UK.

51. Although it appears that there has been some commercial activity, namely, that cameras and lenses have been produced in connection with the 'PENTAX' mark, it is my view that the evidence provided is insufficiently solid or specific to meet the



requisite standard of proof. On the balance of the opponent's evidence, it has not been possible to assess the true scale and extent of the use of the earlier marks, or how geographically widespread any such use has been. Due to the aforementioned evidential deficiencies, I have been unable to properly ascertain whether the opponent's use of the earlier marks is warranted in the economic sectors concerned to maintain or create a share in the market for the goods protected by the marks. Following a careful consideration of the evidence in its entirety, I am not satisfied that the opponent has demonstrated genuine use of its marks in the UK for any of the goods for which the opponent made statements of use. As a consequence, the earlier marks may not be relied upon to support the opponent's claims and the oppositions must inevitably fail.

### **Conclusion**

52. The oppositions under section 5(2)(b) of the Act have failed. Subject to any successful appeal, the contested marks will proceed to registration in the UK for all the specified goods.

### **Costs**

53. As the oppositions have been unsuccessful, ordinarily the applicant would be entitled to an award of costs. At the hearing, Mr Senna indicated that he seeks costs on an indemnity basis because he feels that the oppositions were "mischievous", "misconceived" and "totally without merit".<sup>36</sup> He said that this was because the opponent does not own the contested marks and were not entitled to register the earlier marks. He invited me to make such an award of costs as, in his view, the Registrar has a "moral and ethical obligation to stop and discourage mischievous" oppositions. He added that the oppositions have caused him alarm, distress and aggravation.

---

<sup>36</sup> Although during the course of his submissions, Mr Senna stated that he had informed the opponent that he "will not seek costs", this did not strike me as his position at the hearing. In the context of all the submissions that were made, it is clear that costs are sought on an indemnity basis.

54. Rule 67 of the Rules provides that:

“The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid.”

55. Moreover, Tribunal Practice Notice (“TPN”) 4/2007 indicates that the Tribunal has a wide discretion when it comes to the issue of costs, including making awards above or below the published scale where the circumstances warrant it. It also stipulates that costs off the scale are available “to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour”. There has been no suggestion that the opponent has breached any rules or utilised delaying tactics in the course of these proceedings. Accordingly, the matter at issue appears to be whether the action of the opponent bringing its claims should, itself, be considered unreasonable behaviour.

56. Having considered the conduct of proceedings, it is my view that off-scale costs are not appropriate in this instance. Whilst I have sympathy with Mr Senna having experienced alarm, distress and aggravation as a result of being involved in these proceedings, I do not consider the conduct of the opponent in this case to be demonstrative of unreasonable behaviour. I accept that the opponent did not rely upon marks which are identical to the contested marks. However, under section 5(2)(b) of the Act, the competing marks are only required to be similar. The word ‘PENTAX’ forms the entirety of the earlier marks and is identically reproduced within the contested marks. Therefore, although the opponent’s claims, ultimately, failed (as a result of failing to demonstrate genuine use of the earlier marks), there was at least an arguable case to be determined.<sup>37</sup> Moreover, Mr Senna’s assertion that the opponent was not entitled to register the earlier marks does not warrant an award of costs off the scale, or on an indemnity basis. The opponent is the recorded owner of the earlier marks and was duly named as the opponent in its notices of opposition. Section 72 of the Act provides that registration shall be taken as *prima facie* evidence of the validity

---

<sup>37</sup> For the sake of clarity, I should add that I have not determined any of the factors relevant to a likelihood of confusion assessment (such as, for example, the levels of similarity between the competing marks) and make no finding as to what the outcome of the oppositions would have been had the opponent successfully demonstrated genuine use. In the circumstances, I have not been required to do so.

of a registered mark. The applicant has not sought to invalidate or revoke the earlier marks. Consequently, the opponent's earlier marks must be regarded as validly registered marks. In light of all of this, the manner in which the opponent brought its claims does not strike me as an abuse of process or otherwise unreasonable behaviour.

57. At the hearing, I explained to Mr Senna that costs in Registry proceedings are ordinarily based upon the scale published in TPN 2/2016. However, upon reflection, I recognise that the applicant has not instructed professional representatives. As is common practice in proceedings involving unrepresented parties, I note that it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. It was made clear in the official letters dated 28 March, 20 April and 8 June 2022 that, if the pro-forma was not completed, no costs would be awarded. The applicant did not return a completed pro-forma to the Tribunal and, on this basis, no costs are awarded.

**Dated this 20<sup>th</sup> day of September 2022**

**James Hopkins**  
**For the Registrar**

## **ANNEX**

### **Goods of the first earlier mark (IRUK No. 751039)**

Class 9: Laboratory apparatus and instruments, measuring or testing machines and instruments, power distribution or control machines and apparatus, batteries and cells, electric or magnetic meters and testers, electric wires and cables, photographic machines and apparatus, cinematographic machines and apparatus, optical apparatus and instruments, spectacles (eyeglasses and goggles), processed glass (not for building), life saving apparatus and devices, telecommunication machines and apparatus, phonograph records, electronic machines and apparatus and their parts, ozonisers (ozonators), electrolyzers (electrolytic cells), satellites for scientific purposes, amusement machines and apparatus for use in amusement parks, rotary converters, phase modifiers, electric flat irons, electric hair-curlers, electric buzzers, railway signals, vehicle breakdown warning triangles, luminous or mechanical road signs, fire alarms, gloves for protection against accidents, fire extinguishers, fire hydrants, fire hose nozzles, fire engines, anti-theft warning apparatus, protective helmets, fireproof garments, dust masks, gas masks, magnetic cores, cigar lighters for automobiles, resistance wires, electrodes, welding masks, exposed cinematographic films, exposed slide films, slide film mounts, recorded video discs and tapes, vending machines, coin-operated gates for car parking facilities, cash registers, slide-rules, coin counting or sorting machines, electric sign boards for displaying target figures or current outputs or the like, photocopying machines, manually operated computing apparatus, drawing or drafting machines and apparatus, time and date stamping machines, time recorders, electric computing machines, punched card office machines, voting machines, billing machines, postage stamp checking apparatus, weight belts (for scuba diving), wetsuits (for scuba diving), inflatable swimming floats, air tanks (for scuba diving), swimming flutter boards, diving machines and apparatus (not for sports), regulators (for scuba diving), electric arc welding machines, consumer video games, metal cutting machines (by arc, gas or

plasma), egg-candlers, electric welding apparatus, electric door openers, metronomes.

**Goods of the second earlier mark (IRUK No. 793800)**

Class 9: Digital cameras (photography); parts and accessories thereof not included in other classes.

**Goods and services of the third earlier mark (EUTM No. 340349)**

Class 3: Soaps, deodorants for personal use.

Class 5: Deodorants other than for personal use; plasters, materials for dressings, material for stopping teeth, dental wax.

Class 9: Surveying, photographic, cinematographic, optical, electric apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, magnetic data media, recording discs, data processing equipment and computers, spectacles.

Class 10: Surgical, medical, dental apparatus and instruments, artificial teeth, special materials for medical purposes, retentive bandages.

Class 37: Repair of photographic apparatus and instruments, repair of surgical, medical and dental apparatus and instruments, repair of optical apparatus and instruments.

**Goods of the fourth earlier mark (UKTM No. 1259043)**

Class 9: Photographic, cinematographic, surveying, measuring, electrical, electronic, scientific and optical apparatus and instruments; lenses; binoculars; light meters; television cameras; video cameras; tape recorders for use with sound or video; computers; electronic apparatus for the processing of data; input and output; devices, all for use with the aforesaid computers or apparatus for the processing of data;

computer programs; tapes, discs, cards, wires, drums and filaments, all being magnetic, and optical discs, all for the storage of data or computer programs; cases adapted for use with all the aforesaid goods; parts and fittings included in Class 9 for all the aforesaid goods; but not including switching apparatus or instruments.