

O/0430/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003595403

BY POWER INTEGRATIONS, INC.

FOR THE FOLLOWING TRADE MARK:

PI

IN CLASS 9

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 426373

BY NEBRA LIMITED

BACKGROUND AND PLEADINGS

1. On 15 February 2021, Power Integrations, Inc. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was made pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union. Under the terms of that agreement, the applicant is entitled to rely upon its earlier EU filing date i.e. 17 November 2014 for the purpose of establishing priority vis-a-vis third party trade marks. The application was published for opposition purposes on 21 May 2021 and registration is sought for the following goods:

Class 9 Apparatus and instruments for conducting, switching, transforming, commutating, accumulating, regulating or controlling electricity; apparatus for recharging electrical accumulators; electric power converters; integrated circuits; semiconductors; computer software; semiconductor devices and integrated circuits for smart power operations and power conversion.

2. On 23 August 2021, Nebra Ltd (“the opponent”) opposed the application based upon section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent claims to have used the sign PI SUPPLY throughout the UK since February 2013 in relation to the goods and services set out in the Annex to this decision. The opponent claims that use of the application would cause a misrepresentation, leading consumers to believe that the goods marketed by the applicant originate from the opponent and that damage would arise due to loss of custom and detriment to reputation.

3. The applicant filed a counterstatement putting the opponent to proof of its goodwill in the sign relied upon and denying that use of its application would give rise to a misrepresentation or damage. The applicant also claimed to have been trading under the applied-for mark in the UK since 1998.

4. Both parties filed evidence in chief. The opponent did not file evidence in reply.

5. The applicant is represented by AA Thornton IP LLP and the opponent is represented by Trade Mark Wizards Limited.

6. 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

7. The opponent filed evidence in the form of the witness statement of Aaron Shaw dated 14 February 2022. Mr Shaw is a director of the opponent, a position he has held since its incorporation on 24 October 2008. Mr Shaw's statement is accompanied by 20 exhibits.

8. The applicant filed evidence in the form of the witness statement of Clifford J. Walker dated 13 April 2022. Mr Walker is Vice President of Corporate Development for the applicant, a position he has held since June 1995. Mr Walker's statement is accompanied by 16 exhibits. Exhibits 13 and 14 (excluding the summaries of those exhibits) are subject to a confidentiality order.

9. Both parties filed written submissions in lieu dated 12 January 2023.

RELEVANCE OF EU LAW

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

DECISION

11. Section 5(4)(a) states:

“(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.”

12. Subsection (4A) of Section 5 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.”

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

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

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per

Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”

The Relevant Date

14. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander KC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

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

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

15. The prima facie relevant date is the priority date for the application i.e. 17 November 2014. However, I must also consider whether there is an earlier relevant date as a result of the applicant’s use of the contested mark prior to the application for registration.

16. I note that there are various examples of logo marks in the applicant’s evidence. For example:



In my view, this logo mark is so highly stylised that it is unlikely to be recognised as the letters PI. Consequently, I do not consider that the applicant can rely upon use of this sign to establish an earlier relevant date.

17. The only example of the sign, PI, being applied to any products appears in the applicant's 1998 Annual Report. It appears as follows, on what Mr Walker describes as an "integrated circuit".¹



However, this appears to be a graphic of a product (rather than a product itself) and this appears to be an internal document: it is not clear whether, or to what extent, it would have been visible to the relevant public.

18. Various documents in the applicant's evidence do not refer to the mark PI at all, but rather refer to the applicant's company name (Power Integrations), which is where Mr Walker states that the acronym came from. For example, items listed for sale on various websites described the manufacturer as Power Integrations.²

19. Where the mark PI (solus) does appear in the evidence, it appears to me to be used as shorthand for the applicant's company name. For example, the applicant uses PI in social media posts to refer to its company name, such as:³

"PI Launches LED Design Selector" (2011)

"Visit the PI Booth at LED Expo India" (2011)

"PI Reports First-Quarter Financial Results" (2012)

¹ Exhibit CW1

² Exhibits CW6 and CW7

³ Exhibit CW3

“PI’s New Led Driver Design Delivers Long Lifetime and High Efficiency” (2012)

“New Dimmable High-Line LED Design Using PI’s LYTSwitch-4” (2014)

20. Similarly, in Product Selector Guides which Mr Walker states were issued to customers and distributors (including in the UK) references to PI appear to be shorthand for the company name.⁴ For example, products are referred to by names such as DPA-Switch, the LinkSwitch-TN and the TOPSwitch-GX. Examples of the use of PI as shorthand for the company name in these documents include:

“Tested by the University of New Hampshire’s Interoperability Consortium (UNH-IOC), PI solutions have been shown to work with all available Power Sourcing Equipment (PSE). The results of the UNH-IOC testing are shown on the PI website.”

and:

“Contact local PI Sales office”

21. Taking all of the evidence into account, I am not satisfied that there has been use of the applied-for mark (on its own) to indicate origin of the goods prior to the prima facie relevant date.

22. There is, however, use of the word PI as part of composite signs. Firstly, an article from 2009 states that the applicant has launched PI University, “an online technical learning center featuring practical instructional videos that build to form a complete how-to tutorial in power supply circuit design”.⁵ It is not clear whether this service was launched in the UK (or elsewhere, specifically the US) because the article makes reference to California and the publication does not appear to be specifically targeted

⁴ Exhibit CW8

⁵ Exhibit CW16

at the UK. In any event, this does not appear to be use in relation to the goods covered by the applicant's specification.

23. Secondly, a document from September 2004 refers to something called PI FACTS.⁶ It states:

"PI Facts identifies and displays the product information and reference designs that match your application specs. Try it now at: www.powerint.com/facts."

Whilst this appear to be use to indicate origin (albeit as part of a composite mark), it is not clear what goods/services the use relates to. It appears to be some sort of online software or perhaps software service, but it is not sufficiently clear for me to be able to make a finding on this.

24. Thirdly, the Product Selector Guides referenced above refer to PI Forums. These appear to be references to a technical information service. However, as these services are not covered by the applied-for specification this does not assist the applicant in establishing an earlier relevant date.

25. Lastly, there is reference to PI Expert throughout the applicant's evidence. The Product Selector Guides referred to above describe PI Expert as:

"A powerful software program that takes a designer's switching power supply requirements and determines the critical components needed to generate a working switch mode power supply. Auto design or manual control options. Design can be optimized for efficiency or cost."

And:

"With PI Expert Suite, you're only "mouse-clicks" away from determining the key components in your next switching power supply design, including the best

⁶ Exhibit CW9

Power Integrations power IC and detailed instructions for building the transformer! It's fast & easy... and best of all, FREE!"

26. Mr Walker gives narrative evidence that the applicant's software was available in the UK from March 2004. Although PI appears as part of the composite sign PI Expert, PI is clearly the dominant and distinctive element. The word EXPERT is laudatory in relation to these goods and would not be given any trade mark significance. The opponent's evidence relates predominantly to electronic components for computers and retail services relating to those goods. Clearly, there is overlap between the software goods used by the applicant and the goods and services sold by the opponent. They are in similar fields of activity. In my view, it was in March 2004 that the behaviour complained about commenced. Consequently, I consider that use in relation to PI EXPERT demonstrates an earlier relevant date of March 2004 in relation to software for designing power supplies.

27. In reaching this finding I have borne in mind the opponent's submission that the application to register PI solus is different to use of PI in combination with an additional word (such as Expert) which assists consumers in distinguishing it from the goods of other businesses (such as the opponent's PI Supply). However, I do not consider that this argument has any merit given that the dominant and distinctive element of the mark previously used by the applicant is PI.

Goodwill

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

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

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

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

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

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

application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

31. There is no claim by the opponent that they had used the sign relied upon prior to the earlier relevant date; the opponent’s pleaded case was that they did not start using the sign until 2013. There is also no evidence to suggest that they were using the sign prior to March 2004. For the opposition to succeed, the opponent would need to be able to demonstrate that they had goodwill at both relevant dates. Plainly, it has not done so.

32. The opposition based upon section 5(4)(a) falls at the first hurdle.

CONCLUSION

33. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

34. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,500**, calculated as follows:

Considering the Notice of opposition and filing a counterstatement	£300
Filing evidence and considering the opponent’s evidence	£850
Written submissions in lieu	£350
Total	£1,500

35. I therefore order Nebra Ltd to pay Power Integrations, Inc. to the sum of £1,500. 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 9th day of May 2023

S WILSON

For the Registrar

ANNEX

The opponent claims to have used the sign in relation to the following goods and services:

Class 9

Computer software; computer hardware; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; power supplies; electronic components; semiconductors; transistors; network boards; distribution boards; pc boards; digital boards; memory boards; circuit boards; electronic copy boards; electrical circuit boards; connection boards [electric]; memo boards [electronic]; panel boards [electricity]; flexible circuit boards; camera boards; computer circuit boards; printed circuit boards; electrical switch boards; computer interface boards; add-on circuit boards; computer add-on boards; system boards (mother cards); printed wiring boards; integrated circuit boards; distribution panel boards [electricity]; test adapters for testing printed circuit boards; add-on circuit boards for connecting computers to networking software; circuit distributors; circuit fuses; circuit testers; circuit closers; circuit breakers; circuit cards; decision circuits; focusing circuits; analogue circuits; logic circuits; hybrid circuits; printed circuits; electrical circuit testers; integrated circuit chips; integrated circuit modules; electronic circuit cards; electrical circuit breakers; integrated circuit memories; electric circuit interrupters; hybrid integrated circuits; printed electric circuits; computer network switches; high frequency switches; electric current switches; electronic touch sensitive switches; rotary cam limit switches; push button switches (electrical -); push leaf switches (electrical -); temperature control apparatus [electric switches]; change-over switches [for telecommunication apparatus]; temperature control apparatus [electric switches] for machines; temperature control apparatus [electric switches] for vehicles; battery adapters; power adapters; ethernet adapters; electric plug adapters; electric extension leads and extension outlet sockets; electric conductor wires and cables; electric couplings; electric connections; electric switchboxes; electric fuses; electric sensors; electric contacts; electric cells; electric batteries; electric convertors; electric rectifiers; electric plugs; electric oscillators; electric buzzers; electric cords; electric wire; electrical sockets; electrical inductors; electrical terminators; electrical

armatures; electrical capacitors; electrical receivers; electrical coils; electric leads; electrical ducts; electrical meters; electrical conduits; electrical amplifiers; electric switching apparatus; connection plugs (electric -); electric current rectifiers; electric circuit interrupters; metallic cables [electric]; switch panels [electric]; heat resistant electric cables; plastic covered electric wires; data storage devices; memory storage devices; electricity storage apparatus; junction boxes [electricity]; branch boxes [electricity]; connection boxes [electricity]; wire connectors [electricity]; computer network adapters; flash card adapters; test adapters for testing printed circuit boards; high-frequency switching power supplies; wireless computer peripherals.

Class 35

Retail and online retail services in relation to the sale of computer software, computer hardware, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, power supplies, electronic components, semiconductors, transistors, network boards, distribution boards, pc boards, digital boards, memory boards, circuit boards, electronic copy boards, electrical circuit boards, connection boards [electric], memo boards [electronic], panel boards [electricity], flexible circuit boards, camera boards, computer circuit boards, printed circuit boards, electrical switch boards, computer interface boards, add-on circuit boards, computer add-on boards, system boards (mother cards), printed wiring boards, integrated circuit boards, distribution panel boards [electricity], test adapters for testing printed circuit boards, add-on circuit boards for connecting computers to networking software, circuit distributors, circuit fuses, circuit testers, circuit closers, circuit breakers, circuit cards, decision circuits, focusing circuits, analogue circuits, logic circuits, hybrid circuits, printed circuits, electrical circuit testers, integrated circuit chips, integrated circuit modules, electronic circuit cards, electrical circuit breakers, integrated circuit memories, electric circuit interrupters, hybrid integrated circuits, printed electric circuits, computer network switches, high frequency switches, electric current switches, electronic touch sensitive switches, rotary cam limit switches, push button switches (electrical -), push leaf switches (electrical), temperature control apparatus [electric switches], change-over switches [for telecommunication apparatus], temperature control apparatus [electric switches] for machines, temperature control apparatus [electric switches] for vehicles, battery adapters, power adapters, ethernet adapters, electric plug adapters, electric extension leads and

extension outlet sockets, electric conductor wires and cables, electric couplings, electric connections, electric switchboxes, electric fuses, electric sensors, electric contacts, electric cells, electric batteries, electric convertors, electric rectifiers, electric plugs, electric oscillators, electric buzzers, electric cords, electric wire, electrical sockets, electrical inductors, electrical terminators, electrical armatures, electrical capacitors, electrical receivers, electrical coils, electric leads, electrical ducts, electrical meters, electrical conduits, electrical amplifiers, electric switching apparatus, connection plugs (electric -), electric current rectifiers, electric circuit interrupters, metallic cables [electric], switch panels [electric], heat resistant electric cables, plastic covered electric wires, data storage devices, memory storage devices, electricity storage apparatus, junction boxes [electricity], branch boxes [electricity], connection boxes [electricity], wire connectors [electricity], computer network adapters, flash card adapters, test adapters for testing printed circuit boards, high-frequency switching power supplies, wireless computer peripherals.

Class 41

Education; education services relating to electronic components; providing of training; training services relating to the installation of computer controlled test systems; training courses relating to the study and installation of electronic components; training related to computer programmes; training in electrical engineering; training in electronics; publication services.

Class 42

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design services; designing of electronic components; designing of electronic systems; development of electronic systems; engineering services relating to the design of electronic systems; calibration services relating to electronic apparatus; advisory services relating to electronic components.