

O/194/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2555627
BY GREENERGY SOLAR LIMITED FOR THE TRADE MARK:**



AND

**OPPOSITION THERETO (NO 101263) BY GREENERGY INTERNATIONAL
LIMITED**

THE BACKGROUND AND THE PLEADINGS

1) Application 2555627 was filed by Greenergy Solar Limited (the “applicant”) on 11 August 2010 and was published for opposition purposes on 3 September 2010. The mark and the services for which registration is sought are:



Class 37: Installation, maintenance and repair of solar panels and of other energy-saving products.

Class 42: Design of solar panels and other energy-saving products; surveying services.

2) Greenergy International Limited (the “opponent”) opposes the registration of the above application. Its opposition was filed on 2 December 2010 and is based on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Three earlier marks are relied upon under sections 5(2)(b) and 5(3), namely:

i) Community Trade Mark (“CTM”) registration 1869353 which was filed on 22 September 2000 and registered on 29 November 2001 for the mark:



in respect of:

Class 04:

Fuel; fuel gas; fuel oil; fuel mixtures; charcoal, coal, coke, combustible oils, diesel, kerosene, lignite, mineral fuel, motor fuel, motor fuel additives, paraffin, peat, petrol, wood.

Class 35:

Advertising; business management; business administration; business management services, public relation services, publicity services.

Class 42:

Scientific and industrial research; scientific, industrial and consultation services relating to fuels, emissions and environmental issues; assessment of companies CO₂ emissions, determination of such

emissions, the recommendation of courses of action to reduce emissions in a cost effective manner; provision of advice on potential fuel sources and their constituents; accurate measurement and control of emissions and fuel supplies; technical work concerning companies' fuel purchasing and consumption policies, emission policies and general environmental issues; management of carbon offset programs; energy advice; energy conservation services

iii) CTM 586750 which was filed on 3 June 1997 and registered on 19 March 1999 for the mark:

Greenergy

in respect of:

Class 04:

Fuel; fuel gas; fuel oil; fuel mixtures; charcoal, coal, coke, combustible oils, diesel, kerosine, lignite, mineral fuel, motor fuel, motor fuel additives, paraffin, peat, petrol, wood.

iii) UK registration 2118567 which was filed on 13 December 1996 and registered on 21 November 1997 for the series of marks:

GREENERGY

Greenergy

in respect of:

Class 04:

Fuel; fuel gas; fuel oil; fuel mixtures; charcoal, coal, coke, combustible oils, diesel, kerosine, lignite, mineral fuel, motor fuel, motor fuel additives, paraffin, peat, petrol, wood

3) All three marks constitute earlier marks as defined by section 6 of the Act. All three of the marks completed their registration procedures before the five year period ending on the date of publication of the opposed mark; the consequence of this is that the use conditions apply to the marks, as per section 6A of the Act. Under section 5(4)(a) the opponent relies on the use it has made of the sign GREENERGY since 1992.

4) The applicant filed a counterstatement denying the grounds of opposition. The applicant asked the opponent to provide proof of use in respect of its earlier

marks. Both sides filed evidence. A hearing took place before me on 12 April 2012 at which the opponent was represented by Ms Alison Wilson of Murgitroyd & Company and the applicant by Mr Mark Armitage of Withers & Rogers LLP.

THE EVIDENCE

Witness statement of Richard Clifton on behalf of the opponent

5) Mr Clifton is General Counsel for the opponent. He provides various details about the business operated by the opponent. The opponent was founded in 1992 to “create and supply environmental fuels and has grown into one of the UK’s largest independent fuel companies”. Exhibit RC1 contains extracts from the opponent’s website which detail its history. The mark used on these extracts is a plain version of “Greenergy”. The business appears to be focused on petrol, diesel and bio-fuel in the road fuel market. Exhibit RC2 shows the Whois record for the website (www.GreEnergy.com) with the opponent recorded as its owner.

6) Turnover figures have ranged between £1000 million to £4000 million between 2006/7 to 2010/11. The figures are not broken down by product or service type. Invoices are provided in Exhibit RC3 for dates in 2006,7,8,9 & 10 in respect of “Greenergy” petrol and diesel. The first CTM is depicted on them. The customers identified on these invoices are: Morrisons’ Supermarket, Airport Energy Ltd, Shelford Energy, Jones Distribution Limited, Thames Petroleum (Scotland) Ltd, Highland Fuels Ltd, BWOC Ltd, Sainsburys’ Supermarket, Watson Petroleum and Arriva Southern Counties.

7) Mr Clifton states that the opponent has been a key sponsor of the World Bio-fuels Markets Conference for the last few years (initially in Belgium and later in the Netherlands). This is described as the largest bio-fuels exhibition in Europe. Exhibit RC4 consists of website prints relating to this exhibition. Exhibit RC5 contains a photograph of the opponent’s stand at the exhibition but it is barely legible. It is explained that attendance at this exhibition (and being a sponsor and providing speakers) is undertaken to win prospective clients, strengthen existing relationships and enhance the profile of the company.

8) Mr Clifton provides market share information which is predominantly by way of UK sales. He estimates that in the road fuels market the opponent has a 17% share (based on volume) or a 23% share (if in-land product trade is taken into account). Some supporting graphs are provided in Exhibit RC6.

9) Exhibit RC7 consists of an article taken from National Geographic in Autumn 2010. It is an article about the opponent and its work in relation to bio-fuel production; the article features all three of the opponent’s marks. Exhibit RC8 consists of a brochure which the opponent issues at exhibitions and at other events. Its two CTMs are featured throughout the brochure. “Greenergy” is most often presented as “Greenergy” but it is used without italics in web addresses.

10) Exhibit RC9 is a newsletter called *Field to Forecourt News* which Mr Clifton states “was sent to petrol station forecourts”. It is dated 2005, so it is not clear if it was published during the relevant period (which commenced on 4 September 2005). It refers to various achievements of the opponent including supplying (in 2005) 150 Tesco forecourts in the South of England. As well as providing other facts and figures, the newsletter carries an article about the opponent sponsoring the BTRDA Rally Series and that a Greenergy car took part. The rallies took place on 9 July, 3 September, 15-18 September, 24 September and 5 November 2005.

11) Exhibit RC10 contains annual reports to the renewable fuels agency for the periods 2008/09 and 2009/10. They explain what the opponent has been doing during the relevant year and which focuses, mainly, on bio-fuel production. The two CTMs are carried in these documents.

12) Mr Clifton refers to the opponent as being “an active “seed” investor in various joint ventures for the furtherance of scientific and industrial research and consultation services relating to fuels, emission and environmental issues”. Reference is made to Scarab Distributed Energy Limited (“Scarab”) which is said to be a venture formed between the opponent and other industry participants. The opponent is said to be a lead proponent in the initial stage of its development. It is stated that the Greenergy brand and reputation enhances and supports the position of Scarab. Company details are listed for Scarab which shows that the opponent is an investor in its share capital (with a shareholding of 23%).

Witness statement of Gavin Andrew Kilvington Rose on behalf of the applicant

13) Mr Rose is a director of the applicant. It is stated that the name GREENERGY was chosen as it combined Mr Rose’s initials (GR) with the word ENERGY. He states that it was not chosen as a play on words with GREEN ENERGY.

14) It is stated that the applicant’s mark has been used since February 2010 in relation to the services covered by the application. To date, it has installed 150 solar panel systems and has spent £20,000 on direct marketing. Mr Rose refers to seminars that the applicant has run to educate the public about its services; 15 such seminars are listed in Exhibit GAKR1. An invoice from August 2011 is provided (which shows the applied for mark) relating to the installation of a solar PV system in a school. Mr Rose refers to the colouring of the trade mark which he says separates out the GR element from the word ENERGY so that it will be pronounced either as GR ENERGY or GREENERGY and not as GREENENERGY or GREEN ENERGY.

15) Mr Rose provides a sample letter and quotation to what appears to be a private individual from May 2011 which, again, features the applied for trade mark. Exhibit GAKR4 is an information document produced by the applicant (and

featuring its mark) about solar panels and the government's feed in tariff scheme. Other similar business material used in the applicant's business is provided in GAKR5. Mr Rose states that it is clear from the documents that the customer knows who they are dealing with, namely the applicant.

16) Mr Rose provides a dictionary reference for the word FUEL and highlights that fuels are burnt to provide energy whereas solar panels convert energy from the sun into electricity. He refers to fuels typically being used to power vehicles. He considers the goods to be different to his services and notes a different purpose and end customer. He also provides a definition for "bio-fuel" which is derived from bio-mass, it is often made from renewable, biological materials.

THE PROOF OF USE PROVISIONS

17) As stated earlier, the proof of use provisions apply to the opponent's earlier marks. The use conditions are set out in section 6A(3) of the Act as follows:

"...The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application 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."

18) Section 100 is also relevant which reads:

"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."

19) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the Court of Justice of the European Union ("CJEU") in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 ("*Ansul*") and *Laboratoire de la Mer Trade Marks C-259/02* ("*La Mer*"). The position¹ was helpfully summarized by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

"42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the "legal learning" that flows from them, adding in references to *Silberquelle* where relevant:

¹ Which also took into account the guidance set out in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28.

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

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

20) The relevant period for my assessment is the five year period ending on the date of publication of the applicant's mark, namely: **4 September 2005 to 3 September 2010**. At the hearing there was no real dispute that the earlier marks had been genuinely used. The arguments and submissions focused more on what the earlier marks had been used for and what a fair specification was for such use. This is a sensible approach as, without going into detail, it is clear that during the relevant period the opponent operated a business of significant size and that the three trade marks it relies upon have been used in association with such a business. Mr Armitage had no real concerns over use in relation to petrol and diesel but was not satisfied that use in relation to bio-fuel had been proven. He also made various suggestions as to what a fair specification should be for such use, submissions which I will come on to. Ms Wilson had her own views on what a fair specification should be (which I will, again, come on to) and submitted that use had been proven in respect of bio-fuels. She also submitted that use had been proven in respect of the services of the first CTM particularly those involving research; Mr Armitage disputed this.

21) Before deciding on a fair specification, I need to make a finding of fact as to what goods/services the marks have been used in relation to. There is no doubt that the mark has been used in relation to petrol and diesel as evidenced not only by the documents which relate to the opponent's business in a general sense, but also by the invoices that have been provided which explicitly detail petrol and diesel. In relation to bio-fuel, such goods are not specifically detailed in the invoices. However, from the various pieces of evidence taken as a whole (including the annual reports, the references in the newsletter, the narrative of the witness), I am satisfied that bio-fuel was still part and parcel of what the opponent supplied during the relevant period. Greater focus may have been placed on bio-fuel when the business first started, but the evidence does not suggest that this has been abandoned with the focus now being based purely on petrol and diesel. The marks have been genuinely used in relation to petrol, diesel and bio-fuel. I should add that, from the context of the evidence as a whole, the business relating to such goods is for fuels sold for the purposes of powering the internal combustion engines of car, lorries and other vehicles. Whilst some of the references refer to bio-fuel in a general sense, there is no evidence that sales have been made for any other purpose. In any event, it is not clear whether the goods have any real purpose beyond those for powering the internal combustion engine. I should add that having considered the evidence in detail I could find no use in relation to any other goods than these, Ms Wilson highlighted nothing else during the hearing.

22) In relation to services, Mr Armitage was adamant that no use had been made. I agree. There is scant evidence in relation to any service. There is evidence about joint venture research initiatives, however, this is undertaken through a company called Scarab. The fact that the opponent may be a shareholder does not mean that it has genuinely used its marks in relation to research of any type. Genuine use relates to the creation or maintenance of a

market. There is no evidence that this has been undertaken in relation to any of the services that form part of the CTM's specification.

23) In terms of deciding upon a fair description, the description must not be over pedantic². It is necessary to consider how the relevant public would likely describe the goods³. The General Court ("GC") in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

"43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

² See *Animal Trade Mark* [2004] FSR 19.

³ See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

24) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed Page 23 of 68 in a number of previous decisions. 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."

25) The goods in class 4 read:

"Fuel; fuel gas; fuel oil; fuel mixtures; charcoal, coal, coke, combustible oils, diesel, kerosene, lignite, mineral fuel, motor fuel, motor fuel additives, paraffin, peat, petrol, wood."

26) Many of the specifically listed terms (such as charcoal, coal etc) have not been used so can form no part of a fair specification. Ms Wilson argued that the term "fuel" should be retained as part of any fair specification. However, this

strikes me as too wide a term as it would cover not just the goods upon which the marks have been used but, also, other goods (such as coal, wood, peat etc) which may have quite different purposes and which would fall into a different types or categories of fuel. Mr Armitage suggests in his skeleton argument “fuels for road vehicles”. Whilst I note that this accords with a categorization used by Mr Clifton in his evidence (he refers to the opponent’s market share in the road fuel market), such a description strikes me as a little pernickety as petrol, diesel and bio-fuel could be used for other vehicles which are not used on the road or, indeed, for other motors. There is an argument that the terms petrol, diesel and bio-fuel are, effectively, self-limiting as their only purpose may be in fuelling motors. **However, in case such terms may have wider application than that, I consider a fair description to be “motor fuels including petrol, diesel and bio-fuel”. The earlier marks will be considered on this basis.**

SECTION 5(2)(B)

27) Section 5(2)(b) of the Act reads:

“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.”

28) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

29) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

30) In terms of the applicant’s services, they all strike me as ones where a good deal of care and consideration will be deployed when considering the choice of service provider. The average consumer of the class 37 services will be members of the public who wish to have solar panels (or other energy saving devices) installed or, indeed, business and other organisations who wish to have them installed in their business premises. In relation to the class 42 services, these strike me as specialist services likely to be provided on a business to business basis.

31) In terms of the opponent’s motor fuels, the average consumer will, predominantly, be a member of the general public purchasing fuel for his or her motor vehicle. However, I will also take into account that businesses may also purchase fuel for their fleet etc. The latter will pay more attention in the purchasing process than the former.

Comparison of goods/services

32) The earlier mark is to be considered on the basis of:

Class 4: Motor fuels including petrol, diesel and bio-fuel.

33) This is to be compared with:

Class 37: Installation, maintenance and repair of solar panels and of other energy-saving products.

Class 42: Design of solar panels and other energy-saving products; surveying services.

34) When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

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

35) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (a) 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.”

36) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

37) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark

specification, one is concerned with how the product/service is, as a practical matter, regarded for the purposes of the trade”⁴ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁵. However, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

38) There is, of course, a self-evident difference between the nature and the methods of use of a good and a service. Despite this, the purpose of a good and a service could, nevertheless, be similar. In this case they are not. The purpose of motor fuel is to enable a motor to operate and so to facilitate the motor’s purpose such as to drive a vehicle. The purpose of the installation service is simply to have a solar panel installed to produce electricity. The purposes are thus different. The goods and the services are not competitive. The average consumer is unlikely to make a choice between buying fuel or having solar panels installed. Neither do I see any complementary relationship between fuel and the installation services. I bear in mind that vehicles can now be powered by electricity rather than fuel, but the competition there would be between fuel and electricity not fuel and solar panel installation services. An argument was put forward that there was similarity on the basis that bio-fuel and solar panel installation have “green” issues at their heart. However, I agree with Mr Armitage that this is a too superficial an approach. **I come to the view that the goods and the installation services are not similar.** This also applies to the installation of other energy saving products, the installation of which strikes me as having no closer relationship with fuel than solar panels do.

39) In relation to the class 42 services I see no real basis for similarity at all. The questions of nature, intended purpose, methods of use, competition and complementary are even further away than that assessed already. **The goods are not similar to the services in Class 42.**

40) Without the goods and services being similar then there can be no likelihood of confusion under section 5(2)(b). However, if I am wrong on my assessment above then I will give my view on the likelihood of confusion but will do so on the basis that if there is any similarity between the goods and services then it is of a very minimal level.

⁴ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁵ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

Comparison of the marks

41) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. I will make a comparison on the basis of the opponent's word only mark as this is likely to represent its best prospect for success. The marks to be compared are:



and

GREENERGY

42) The applicant's mark is likely to be more dominated by the words GREENERGY SOLAR than by the device element. The SOLAR element is descriptive and, so, more focus will be placed on GREENERGY. However, the device element is far from negligible and must be fully considered in the comparison. The opponent's mark has only one element, GREENERGY, which forms its dominant component, although, I think it likely that the average consumer will realise that it is a coalescence of the words GREEN and ENERGY. In terms of the visual comparison, the dominant components are quite similar differing in only one letter. The colour in the applied for mark is to be drained⁶ but it is fair to bear in mind that the letters GR and ENERGY have different colour scaling, although, the word will still be seen as the single word GREENERGY; whilst it is possible that some consumers will separate the elements (as the letters GR and the word ENERGY), the majority will still read through. The difference created by the device element also needs to be borne in mind. Weighing up the differences and similarities, I consider there to be a reasonable degree of visual similarity.

43) In terms of aural similarity then the differences in presentation and the device element are not relevant. The GREENERGY mark will be pronounced as GREEN-ER-GY. The GREENERGY SOLAR mark will be pronounced as GREN-ER-GY SOLAR or GRE-NER-GY SOLAR; as above, whilst it is possible that the mark may be pronounced as G-R-ENERGY this is the least likely outcome. I do not consider that GREENERGY will be pronounced as GREE-ENERGY as

⁶ See to that effect the judgment of Mr Justice Mann in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch).

submitted by Ms Wilson. I consider the respective pronunciations I have indicated to equate to there being a reasonably high degree of aural similarity.

44) In terms of concept, I have already stated that the GREENERGY mark will be perceived as a coalescence of GREEN and ENERGY. Green (environmentally friendly) energy will, therefore, constitute that mark's concept. In terms of the GREENERGY mark, I agree with Ms Wilson that Mr Rose's explanation of why the mark was coined has no bearing. It is the perception of the average consumer that matters and such a person will not know of Mr Rose's motive. However, for a concept to be relevant it must be one capable of immediate grasp. In my view, the combination of GR and ENERGY together with the other elements of the mark, will send to the consumer a message of GREEN ENERGY. It may not be as obvious as GREENERGY but obvious enough for an evocative meaning to be immediately grasped. The marks are conceptually identical. Overall, there is a good deal of similarity between the marks.

The distinctiveness of the earlier mark

45) As a coalescence of the words GREEN ENERGY, the earlier mark is not, from an inherent perspective, highly distinctive. It has an average degree of inherent distinctiveness at best, its distinctiveness residing in the way in which the words have been combined. Use of the mark has been presented which may enhance its distinctive character, but such enhancement will only exist in relation to trade consumers and not the general public. I say this because there is very little evidence that the earlier mark has been exposed to the general public. The strongest evidence of exposure to the general public lies in an article in National Geographic, the sponsorship of a rally and a newsletter "sent to petrol station forecourts". The latter is not helpful because it is not clear whether the newsletter was made available to the public or just to people who work in the forecourt. The other evidence does little to establish the level of use necessary to enhance a mark's distinctive character. Based on the evidence filed, the earlier mark's distinctiveness is enhanced from the perspective of trade consumers of fuel, but not from the perspective of the general public.

Likelihood of confusion

46) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

47) I come to the clear view that the general public average consumer will not be confused as to the economic origin of the goods/services sold under the

respective marks. The level of goods/service similarity is so low that this, when combined with the various other factors (including the more considered nature of the purchase of the services) means that the similarity between the marks will be put down simply to different undertakings, doing different things, who have happened upon a similar name. The similarity will be put down to coincidence and not connection. I come to the same view with regard to trade average consumers, notwithstanding that the earlier mark's distinctiveness will be enhanced. A coincidence not connection view will be taken. **There is no likelihood of confusion and the opposition under section 5(2)(b) is dismissed.**

SECTION 5(4)(A)

48) Ms Wilson conceded at the hearing that the opponent's case was no stronger under section 5(4)(a) than under section 5(2)(b). I confirm that have I given consideration as to whether the opponent is better off, I can see no reason for coming to that view and, therefore, even though I accept that the opponent will have established a goodwill, it would have failed to establish a misrepresentation for similar reasons to that already given above. **The opposition under section 5(4)(a) is dismissed.**

SECTION 5(3)

49) Section 5(3)⁷ of the Act reads:

"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 Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

50) In order to succeed under this ground the earlier mark(s) must have a reputation. In *General Motors Corp v Yplon SA* (Chevy) [1999] ETMR 122 and [2000] RPC 572 Chevy the CJEU stated:

"The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark."

⁷ Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the ECJ in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* ("Addidas-Salomon") (C-408/01)).

51) The applicant's mark was filed on 11 August 2010. The earlier mark(s) must have had a reputation at this point. My comments in relation to enhanced distinctiveness demonstrates that there will be no reputation with members of the general public. However, on the basis of the evidence put forward, including the significant turnover and market share, it is accepted that there is a reputation with trade buyers.

52) In addition to having a reputation, a link must be made between the respective marks. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

53) In *Intel Corporation Inc v CPM (UK) Ltd (C-252-07)* (“*Intel*”), the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

54) Having assessed the matter against the above criteria, I come to the view that a link will not be made. Despite the degree of similarity between the marks

and the strong reputation with trade buyers of motor fuel, such trade buyers are not to be taken as the relevant public for the applicant's services. There could be a theoretical overlap but not one which, in my view, should be taken as establishing a link between the reputed goods and the applied for services.

55) Even if I am wrong on the above then there are further problems with the opponent's claim. The primary argument is based on the taking of an unfair advantage. In Case C-487/07, *L'Oreal SA and others v Bellure NV and others* the CJEU defined what is meant by "unfair advantage":

"41 As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.

50 In the light of the above, the answer to the fifth question is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

56) The opponent has to establish not only that there would be an advantage, but also that it is unfairly taken. It is to be noted that the CJEU refers to the third party seeking to take advantage, ie a conscious decision being made. The question of the unfair aspect was considered by Lloyd LJ in *Whirlpool Corporations and others v Kenwood Limited* [2009] EWCA Civ 753:

"136. I do not consider that Kenwood's design involves anything like a transfer of the image of the KitchenAid mark, or of the characteristics which it projects, to the goods identified by Kenwood's sign (see *L'Oréal v Bellure* paragraph 41). Of course, as a newcomer in a specialist market of which KitchenAid had a monopoly, and being (necessarily) in the basic C-shape of a stand mixer, the kMix would remind relevant average

consumers, who are design-aware, of the KitchenAid Artisan. That, however, is a very different phenomenon, in very different commercial circumstances, from the situation considered in *L'Oréal v Bellure*. I find the Court's judgment instructive, but it does not seem to me to lead to the conclusion in favour of Whirlpool for which Mr Mellor contends. On the contrary, having rejected his radical submission that the word "unfair" could just as well have been left out of the article, it seems to me that the decision points away from, rather than towards, liability under the article on the facts of the present case. It is not sufficient to show (even if Whirlpool could) that Kenwood has obtained an advantage. There must be an added factor of some kind for that advantage to be categorised as unfair. It may be that, in a case in which advantage can be proved, the unfairness of that advantage can be demonstrated by something other than intention, which was what was shown in *L'Oréal v Bellure*. No additional factor has been identified in this case other than intention."

57) This matter was also considered by Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch):

"160. Thus something more than mere advantage is required. It must be an unfair advantage. Lloyd LJ seems to state that an advantage is rendered unfair if it is intended. He also leaves open the possibility that unintended advantage may have a sufficient quality of unfairness about it to qualify."

58) There is no evidence that the applicant was seeking to take an advantage. Indeed, Mr Rose explains in his evidence that the mark was coined by combining his initials GR with the word ENERGY. This evidence has not been challenged. Whilst an unfair advantage may be assumed in some cases, this is not the position here. Furthermore, I do not see how the installer or designer of solar panels will gain a leg-up due to a reputation by another company in relation to motor fuels provided to the motor fuel trade. **The ground of opposition under section 5(3) is dismissed.**

COSTS

59) The applicant has been successful and is entitled to a contribution towards its costs. I hereby order Greenergy International Limited to pay Greenergy Solar Limited the sum of £1500. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£300

Considering and filing evidence
£700

Attending the hearing
£500

60) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 11th day of May 2012

**Oliver Morris
For the Registrar,
The Comptroller-General**