

O/0149/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 03449307 BY
ERGOTRON, INC.
TO REGISTER AS A TRADE MARK:**

CHARGEFIT

IN CLASSES 9 & 20

AND

**OPPOSITION THERETO
UNDER NO. 420231 BY
ATARAXIAL, S.L.U.**

Background & Pleadings

1. Ergotron, Inc. (“**the applicant**”) applied to register the trade mark shown on the front page of this decision in the United Kingdom on 5 December 2019 and was accepted and published in the Trade Marks Journal on 14 February 2020. For the purposes of this opposition the relevant goods in the specification are:

Class 9: Battery recharging stations; battery recharging carts; cabinets for computers; Electronic charging devices, namely, portable carts and cabinets with built-in battery chargers specially adapted for use with electronic devices, namely, laptop computers, tablet computers and netbooks; electrical power devices, namely, intelligent electrical systems comprised of sensing, logic, mathematical, control, and display computer hardware and firmware, that sense the power needs of multiple attached electronic or electrical devices to safely and efficiently allocate power to each device without exceeding the total power available; Adjustable computer monitor arms; a flexible pivoting arm designed to hold flat panel displays monitors and screens; desk mounts, wall mounts, and ceiling mounts for use in fixed position, tilting and pivoting mountings specially adapted for audio/visual equipment, namely, audio speakers, microphones, personal stereos, video players, DVD players, audio players, amplifiers, sound mixers, frequency tuners, surround processors, digital sound signal synthesizers, stereos and stereo parts, televisions, liquid crystal display and plasma monitors, loudspeakers, computer peripherals, and projectors; support arm extensions for supporting flat panel monitors and televisions; adjustable platforms specially adapted for supporting computer monitors, computer keyboards, computer keyboard caddies and computer keyboard trays; display stands adapted for audio and video equipment; stands adapted for satellite and surround sound speakers; fixed and adjustable height stands adapted for audio speakers; single and multi-

shelf racks adapted for audio and video equipment; multi-shelf towers specially adapted for audio and video equipment.

2. Ataraxial, S.L.U. ("**the opponent**") opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("**the Act**"). The opponent is the proprietor of the EUTM registration number¹ 18119659 for the following mark:

CHARGEVITE

3. The opponent's mark was filed on 4 September 2019 and registered on 9 January 2020 for the following goods:

Class 9: Apparatus and instruments for accumulating and storing electricity; Apparatus, instruments and cables for electricity; Apparatus and instruments for controlling electricity; Charging stations for electric vehicles; Battery charging devices for motor vehicles; Chargers; Battery chargers; Electric-car chargers; Rechargeable batteries; Batteries for electric vehicles; Cables and wires; Electric and electronic components.

4. In its notice of opposition, the opponent states that all goods covered by its earlier mark are relied upon.
5. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as the registration of the opponent's earlier mark was completed less than five years before the application date

¹ I note that the opposition was launched prior to IP Completion Day, being 31 December 2020, and, thus, the earlier mark will be referred as an EUTM for the purposes of these proceedings. I also note that since 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent's earlier mark was automatically converted into a comparable UK trade mark, namely UK00918119659. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

of the contested mark, proof of use is not relevant in these proceedings, as per Section 6A of the Act.

6. The opponent, in its notice of opposition, claims that the marks “are highly similar” and “[t]he similarity of the marks as a whole should be assessed, taking into account the visual, phonetic and conceptual similarities between the marks.” I will return to this point later in this decision. Further, the opponent contends the respective goods in Class 9 are “identical to those of the earlier mark, including "battery recharging stations battery recharging carts; electronic charging devices; electrical power devices". The remainder of the goods in class 9 are similar to those of the earlier mark.”
7. The applicant filed a defence and counterstatement, denying that “CHARGEFIT and CHARGEVITE are highly similar or confusingly similar to any extent. To the extent the identity of the first parts of the marks have any significance, this is noted to based around the wholly descriptive word CHARGE which carries no weight in terms of indicating origin. The second elements FIT and VITE are readily distinguishable as are the respective totalities, visually, phonetically and conceptually, in particular given the discerning nature of consumers in the relevant market.” (sic) I will return to this point later in this decision. Further, the applicant asserts that the respective goods in Class 9 are not identical or similar.
8. Both parties filed evidence in these proceedings.
9. Both parties filed written submissions, which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
10. In these proceedings, the opponent is represented by Hoffmann Eitle PartmbB and the applicant by Lane IP Limited.

11. 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 Trade Marks Act relied on 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.

Evidence

12. The opponent's evidence consists of a witness statement, dated 19 September 2022, by Debra Louise Lewis, the representative of the opponent. The evidence contains 5 Exhibits (DLL1-5) which are prints from online dictionary entries for the following terms: "chargevite"; "chargefit"; "charge"; "fit"; "vite".
13. The applicant's evidence consists of a witness statement, dated 22 June 2022, by Mark J Hickey, who is the partner of Lane IP Limited, the representative of the applicant, introducing 2 Exhibits (MH1-2). I have considered the applicant's evidence with which demonstrates a selection of trade mark registrations owned by third parties not related to these proceedings, and online dictionary entries for the terms "vite" and "electric charge". Whilst I considered these Exhibits, it must be noted that the exemplified registered trade marks containing the word element "charge" are not relevant to the decision before me. The task before me is simply to compare the competing marks and goods in Class 9 assessing the likelihood of confusion.
14. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

Decision

Section 5(2)(b)

15. Section 5(2)(b) of the Act is as follows:

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

[...]

(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”.

16. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose

attention varies according to the category of goods or services in question;

- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a 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 will wrongly believe that the respective goods or services come from

the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods

17. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

18. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who

of course act for industry, put the goods or services in the same or different sectors.”

19. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

21. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

23. The competing goods to be compared are shown in the following table:

Opponent’s Goods	Applicant’s Goods
Class 9: Apparatus and instruments for accumulating and storing electricity;	Class 9: Battery recharging stations; battery recharging carts; cabinets for computers; Electronic charging devices,

<p>Apparatus, instruments and cables for electricity; Apparatus and instruments for controlling electricity; Charging stations for electric vehicles; Battery charging devices for motor vehicles; Chargers; Battery chargers; Electric-car chargers; Rechargeable batteries; Batteries for electric vehicles; Cables and wires; Electric and electronic components.</p>	<p>namely, portable carts and cabinets with built-in battery chargers specially adapted for use with electronic devices, namely, laptop computers, tablet computers and netbooks; electrical power devices, namely, intelligent electrical systems comprised of sensing, logic, mathematical, control, and display computer hardware and firmware, that sense the power needs of multiple attached electronic or electrical devices to safely and efficiently allocate power to each device without exceeding the total power available; Adjustable computer monitor arms; a flexible pivoting arm designed to hold flat panel displays monitors and screens; desk mounts, wall mounts, and ceiling mounts for use in fixed position, tilting and pivoting mountings specially adapted for audio/visual equipment, namely, audio speakers, microphones, personal stereos, video players, DVD players, audio players, amplifiers, sound mixers, frequency tuners, surround processors, digital sound signal synthesizers, stereos and stereo parts, televisions, liquid crystal display and plasma monitors, loudspeakers, computer peripherals, and projectors; support arm extensions for supporting flat panel monitors and televisions; adjustable platforms specially adapted for supporting computer monitors, computer keyboards, computer keyboard caddies and computer keyboard trays; display stands adapted for audio and video equipment; stands adapted for satellite and surround sound speakers; fixed and adjustable height stands adapted for audio speakers; single and multi-shelf racks adapted for audio and video equipment; multi-shelf towers specially adapted for audio and video equipment.</p>
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24. The opponent made lengthy submissions which I have considered but do not propose to reproduce here.

25. With its submissions, the applicant maintained its initial position that there is no similarity between the competing goods.
26. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.²
27. I note that the contested specification contains the word “*namely*” in more than one instances. Guidance on how to treat this word is contained in the addendum to the Trade Mark Registry’s Classification Guide, which reads as follows:

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.” (emphasis added)

28. The opponent’s specification contains goods in Class 9 that can be defined largely as batteries or similar apparatus/devices that store and release electricity on demand, including other electric components.

Battery recharging stations

29. The contested term is a broad term, and there is no submissions or evidence to guide me. I will interpret the contested term following its literal and ordinary meaning as delineated in *Skykick*. Such goods might be equipment that connects electric vehicles to a source of electricity,

² *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

enabling the recharge of electric cars, or devices that recharge batteries in general, such as cell phone or AAA batteries. Therefore, it is my view that the earlier terms “*Charging stations for electric vehicles; Battery chargers*” are broad terms that will encompass the contested goods. Thus, I find the respective goods to be identical as per *Meric*.

Battery recharging carts; Electronic charging devices, namely, portable carts and cabinets with built-in battery chargers specially adapted for use with electronic devices, namely, laptop computers, tablet computers and netbooks

30. I note that the contested term “*Electronic charging devices, namely, portable carts and cabinets with built-in battery chargers specially adapted for use with electronic devices, namely, laptop computers, tablet computers and netbooks*” (emphasis added) contains a limitation introduced twice by the use of the word ‘namely’. It is my view that such use is not clear, and none of the parties referred me to which goods the word ‘namely’ refers to in this instance. Therefore, I consider that I should adopt a common sense approach and interpret the term, being mindful of the intended purpose and meaning of the words and the scope of the limitation when read as a whole, whilst ensuring that I should not interpret the specification too liberally as to provide a wider scope of protection than that applied for or to result in terms that are less precise or clear. In this regard, I take the view that the obvious and intended meaning of the word “*namely*” followed by the list of terms “*laptop computers, tablet computers and netbooks*” should only apply to “*electronic charging devices*” and not “*portable carts*”.
31. The above contested goods are (mobile) storage carts and containers to charge devices such as laptops, tablets, and netbooks. The opponent’s “*Chargers; Battery chargers*” are broad terms that readily can cover the contested goods. Thus, I find them to be identical based on *Meric*.

Electrical power devices, namely, intelligent electrical systems comprised of sensing, logic, mathematical, control, and display computer hardware and firmware, that sense the power needs of multiple attached electronic or electrical devices to safely and efficiently allocate power to each device without exceeding the total power available

32. The opponent submits that:

“The goods “Electrical power devices, namely, intelligent electrical systems comprised of sensing, logic, mathematical, control, and display computer hardware and firmware, that sense the power needs of multiple attached electronic or electrical devices to safely and efficiently allocate power to each device without exceeding the total power available” of the opposed mark are identical to at least the goods “Apparatus, instruments and cables for electricity; Apparatus and instruments for controlling electricity; Chargers; Battery chargers; Electric and electronic components” of the earlier mark.”

33. I do not have any submissions to guide me in approaching the contested goods. The contested term describes a device, such as a (smart) power strip or a power distribution unit, capable of monitoring, managing, and controlling the power consumption of multiple devices. Against this background, I consider that the earlier term “*Apparatus and instruments for controlling electricity*” is a broad term that would encapsulate the contested term. Thus, I find the goods to be *Merit* identical. If I am wrong, they are highly similar as they share the same nature, purpose, users, method of use, and trade channels and could be in competition.

Cabinets for computers

34. The contested goods are intended for storing a computer within an enclosure with fitted or fixed doors/panels. The opponent submits that the contested goods are similar to its “*Apparatus and instruments for accumulating and storing electricity; Apparatus, instruments and cables for*

electricity; Chargers; Battery chargers; Cables and wires; Electric and electronic components” goods, sharing the same users and trade channels and being complementary. The goods differ in nature, purpose, and method of use. There is no complementarity between the goods 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.”³ While such goods may be sold in the same stores, and to that extent, they may share the same end-users, I do not consider these to be sufficient factors to find similarity. Thus, I find the respective goods to be dissimilar.

Support arm extensions for supporting flat panel monitors and televisions; display stands adapted for audio and video equipment; stands adapted for satellite and surround sound speakers; fixed and adjustable height stands adapted for audio speakers; Adjustable computer monitor arms; a flexible pivoting arm designed to hold flat panel displays monitors and screens; desk mounts, wall mounts, and ceiling mounts for use in fixed position, tilting and pivoting mountings specially adapted for audio/visual equipment, namely, audio speakers, microphones, personal stereos, video players, DVD players, audio players, amplifiers, sound mixers, frequency tuners, surround processors, digital sound signal synthesizers, stereos and stereo parts, televisions, liquid crystal display and plasma monitors, loudspeakers, computer peripherals, and projectors; Adjustable platforms specially adapted for supporting computer monitors, computer keyboards, computer keyboard caddies and computer keyboard trays

35. These are all goods that support or elevate various products, such as monitors, televisions, projectors, and sound speakers. I can see no prominent aspect of similarity between the competing goods in terms of the nature, intended purpose, or method of use, nor are the contested

³ See *Boston Scientific*, Case T-325/06.

goods in competition with or complementary to the opponent's goods. Thus, I find them to be dissimilar.

Single and multi-shelf racks adapted for audio and video equipment; multi-shelf towers specially adapted for audio and video equipment

36. I can see no obvious aspect of similarity between the above contested goods and the opponent's goods. The nature, purpose, and method of use are different. There is no competition or complementarity between the respective goods. Thus, I find them to be dissimilar.
37. The likelihood of confusion does not arise in relation to the application's goods which are dissimilar to the earlier mark's goods.⁴ **The opposition cannot succeed against dissimilar goods and, therefore, is dismissed insofar as it concerns the following terms:**

Class 9: Cabinets for computers; Support arm extensions for supporting flat panel monitors and televisions; display stands adapted for audio and video equipment; stands adapted for satellite and surround sound speakers; fixed and adjustable height stands adapted for audio speakers; Adjustable computer monitor arms; a flexible pivoting arm designed to hold flat panel displays monitors and screens; desk mounts, wall mounts, and ceiling mounts for use in fixed position, tilting and pivoting mountings specially adapted for audio/visual equipment, namely, audio speakers, microphones, personal stereos, video players, DVD players, audio players, amplifiers, sound mixers, frequency tuners, surround processors, digital sound signal synthesizers, stereos and stereo parts, televisions, liquid crystal display and plasma monitors, loudspeakers, computer peripherals, and projectors; Adjustable platforms specially adapted for supporting computer monitors, computer keyboards,

⁴ Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

computer keyboard caddies and computer keyboard trays; Single and multi-shelf racks adapted for audio and video equipment; multi-shelf towers specially adapted for audio and video equipment.

Average Consumer and the Purchasing Act

38. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

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

39. I find that the average consumer of the goods at issue will be a member of the general public without excluding professionals/businesses. Such goods can be selected from stores, including specialist ones, brochures and catalogues, and online. In retail premises, the goods will be displayed on shelves, where they will be viewed and self-selected by consumers. Although I consider this purchasing act to be primarily visual, aural considerations will not be ignored in the assessment. The level of attention paid to the purchase will also vary. For low to medium value goods, such as monitor arm extensions and shelf racks, the average consumer is likely to consider compatibility and other factors, for example, the material of the product, whilst for the more expensive goods, such as battery recharging

stations or carts, the average consumer will closely examine the products to ensure that they are fit for purpose. As a result, depending on the cost of the item, the degree of attention will range from relatively medium to high, with professionals and businesses potentially paying slightly a higher degree of attention.

Comparison of Trade Marks

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

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

41. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

42. The marks to be compared are:

Opponent's Mark	Applicant's Mark
CHARGEVITE	CHARGEFIT

Overall Impression

43. The earlier mark consists of the invented and single word “CHARGEVITE” presented in a standard font and upper case. Registration of a word mark protects the word itself presented in any regular font and irrespective of capitalisation.⁵ The overall impression of the earlier mark lies in the conjoined words, with neither word component dominating the other. Likewise, the same applies to the contested mark “CHARGEFIT”, and with none of these components dominating the other.

Visual Comparison

44. The earlier mark is ten letters long, whereas the contested is nine. The competing marks share the majority of the letters. More specifically, the first six letters, together with the letters in positions eight and nine, are identical, namely CHARGEFIT/CHARGEVITE. Bearing in mind, as a rule of thumb, that the beginnings of words tend to have more impact than the ends,⁶ the first word component, “CHARGE-”, positioned at the beginning of the competing marks, is identical. However, the marks differ in the letter appearing in position seven (CHARGEFIT/CHARGEVITE). Further, the additional letter ‘E’ appears at the end of the earlier mark with no counterpart in the contested mark. Considering all the factors, including the overall impression of the marks, I find them to be visually similar to a high degree.

⁵ See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

⁶ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Aural Comparison

45. The opponent submits that:

“Phonetically, the marks CHARGEFIT and CHARGEVITE are extremely similar. Both words consist of two syllables, with the first syllable being identical. Furthermore, the phonic “f” and “v” sound (fer and ver) are very similar in English. A native English speaker in the UK is likely to pronounce the word CHARGEVITE as “CHARGE-VITT” as many longer English words have the ending “-ite” pronounced as “-it”, for example “hypocrite”, “opposite”, “composite”, “granite”, “favourite” and only a minority of native English speakers in the UK might view the suffix VITE as possibly being a French word pronounced as “VEET”. Furthermore, non-native English speakers in the UK, of which there are many, are also likely to pronounce the words CHARGEFIT and CHARGEVITE in a highly similar manner. For example, in many European languages, such as French and Spanish for example, the letter “i” has only one sound, and not a long form and a short form as in English. So the word “ship” would be pronounced “sheep” by such non-native English speakers who would pronounce “CHARGEFIT” as “CHARGEFEET” and “CHARGEVITE” as “CHARGEVEET”.”

46. Before I proceed to the aural assessment of the competing marks, I note that the opponent made submissions regarding the pronunciation of the marks by non-native English speakers. I disagree with the opponent’s proposed approach. The position here is how the average consumer, namely the “predominantly anglophone public”⁷, will pronounce the marks and not particular consumer groups or sub-groups in the UK.

⁷ In BL O/25/05, *Acqua di Gio*, Mr Geoffrey Hobbs QC (as he then was) sitting as the Appointed Person said at paragraph 29:

“the impact of a word mark on speakers of English should be used to determine whether it is acceptable for registration in the United Kingdom on absolute and

47. The competing marks are two-syllable marks that the average consumer will articulate as “CHAHJ-VEET” and “CHAHJ-FIT”, sharing the same first syllable. However, it is my view that the second and last syllable in the competing marks, namely “-VEET/-FIT”, creates a phonetic similarity but not identity as per the opponent. This is because the word component “-VEET” in the earlier mark will generate a longer sound compared to the word component “-FIT” of the contested mark. Therefore, I consider that the marks are aurally similar to a degree between a medium and high.

Conceptual Comparison

48. The opponent in his submissions contended the following:

“The first part of both of the respective marks consists of the element “CHARGE”. Whilst it is the view of the applicant that this part of the mark is wholly descriptive and should not be taken into account, we disagree and are instead of the view that there is not a distinctive and dominant element in either of the marks and that the marks should be considered in their entirety. This is because neither of the marks consists of an actual word – neither “CHARGEFIT” nor “CHARGEVITE” is an actual word in the English language and both are invented words. Furthermore, the consumer tends to focus on the first part of the mark rather than the end of the mark (El Corte Inglés, SA v OHIM, Cases T-183/02 and T-184/02). The CHARGE element (in both marks) is low in distinctive character in relation to the goods at issue. Both marks combine different suffixes to the element CHARGE, namely VITE in the earlier mark and FIT in the opposed

relative grounds” and at paragraph 41 he said “it is impermissible for the English equivalents of foreign words to be used for the purpose of testing issues relating to the distinctiveness, descriptiveness or deceptiveness of such words in the United Kingdom in the absence of good reason for thinking that a significant proportion of the predominantly anglophone public in the United Kingdom would understand the meaning of the word(s) in question.” In my judgment, the position is that even though many people live in the UK whose native tongue is not English that does not mean that such individuals are to be treated as the relevant “average” consumers for the purpose of deciding what a word means, or how a word would be pronounced, in the United Kingdom. In the absence of special circumstances, the average public is the “predominantly anglophone public.”

mark. The suffix FIT of the opposed mark is also low in distinctive character as it has a meaning in the English language, implying that the goods are able or ready to charge or be charged effectively. The suffix VITE of the earlier mark has no meaning in the English language but will be understood by a significant minority of the UK population as having the meaning “quick” or “fast” in French.

[...]

Conceptually, neither mark has a meaning in English as explained above, but both marks allude to something that can charge or be charged effectively.”

49. In its counterstatement, the applicant asserted that:

“As conceded by the opponent the term CHARGE has low distinctive value so greater attention would be given by the consumer to the suffix part in each mark i.e. VITE and FIT. Consequently, the meaning of VITE must be noted and how it would be perceived by the relevant consumer since it means “quick” in the English language (see Annex 1) which is contrary to the opponents view as stated in their submission dated 21 March 2022. It is therefore submitted that the opponent’s mark means to charge quickly which is highly descriptive and even less distinctive in relation to the respective goods covered in the opponent’s registration. To the contrary, FIT does not have any meaning when used in conjunction with the term CHARGE as it is not possible for a CHARGE to have attributes that are characteristic to humans i.e. being fit and healthy.”

50. The earlier mark consists of the conjoined words “CHARGE” and “VITE”, each of which contributes to the overall impression, and the average consumer will perceive them under their dictionary meaning. In light of the goods in the earlier specification, the word component “CHARGE” will be

understood as “to put electricity into an electrical device such as battery”⁸, and the word component “VITE” as “in a quickened manner”⁹. I note that the applicant with its Exhibit MH1, which consists of a print out of the Merriam-Webster website, provided a different dictionary definition for the term ‘vite’. However, Merriam-Webster is an American-based dictionary website, whereas the definition provided by the opponent is from Collins Online Dictionary website. Therefore, I find the opponent’s definition more apt in the given circumstances and concur with it. Further, although I note that the first word component (CHARGE) is a well-known and ordinary word to the UK average consumer, in the absence of evidence and despite the dictionary reference, I am unwilling to conclude that the entirety of the relevant public in the UK will be aware of the second word component (VITE) and its meaning.¹⁰ Therefore, when considering the earlier mark as a whole, it will convey the concept of fast charging, alluding to the registered goods.

51. The contested mark comprises the conjoined word components “CHARGE” and “FIT”, and the average consumer will immediately understand them. The word component “CHARGE” will be construed as having the same meaning as in the earlier mark. I note that the word component “FIT” has more than one meaning, but, in the case at hand, it is my view that the average consumer will perceive it as something that meets the adequate standards for a purpose. Again, in this instance, there is an allusion to the goods. Notwithstanding the difference created by the divergent second word component of the conjoined words in the competing marks, the same concept of charging will be extracted from the competing marks. To conclude, there is conceptual similarity to a degree between low and medium.

⁸ See Exhibit DLL 3.

⁹ See Exhibit DLL 5.

¹⁰ See *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08.

Distinctive Character of the Earlier Trade Mark

52. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

53. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

54. The opponent has not shown use of its mark and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent

distinctiveness of the earlier mark to consider. The earlier mark consists of the word “CHARGEVITE”, which is an invented word consisting of the conjunction of the ordinary word “CHARGE-” and the dictionary word “-VITE”, conveying the meaning described earlier in this decision. Although I am prepared to accept that the meaning of the latter term (“-VITE”) may not be universally known and that the mark as a whole may be considered “invented”, the conjoining of those words is not highly fanciful. In this regard, while I recognise the level of inventiveness of the mark, I bear in mind that only the common element between the respective marks should be considered to evaluate the relevant (to the question of confusion) distinctiveness,¹¹ a point that I shall return to later in this decision. This is because the word component “CHARGE-” is weaker, conveying a clear meaning to the relevant public in relation to the property of the goods, that of charging, for which it is registered. Consequently, the earlier mark as a whole is inherently distinctive to a below medium degree.

Likelihood of Confusion

55. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.¹² It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater may be the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.¹³

¹¹ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

¹² See *Canon Kabushiki Kaisha*, paragraph 17.

¹³ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

56. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
57. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis K.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask, “in what does the distinctive character of the earlier mark lie?” Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

58. Earlier in this decision I have concluded that:

- the goods at issue range from identical to dissimilar;
- the average consumer of the Class 9 goods will be a member of the general public without excluding professionals/businesses. The

selection process is predominantly visual without discounting aural considerations. Depending on the cost of the item, the degree of attention will range from relatively medium to high, with professionals and businesses potentially paying slightly a higher degree of attention;

- the competing marks are visually similar to a high degree, aurally between a medium and high degree, and conceptually similar to a degree between low and medium;
- the earlier mark has a below medium degree of inherent distinctiveness.

59. Taking into account the above factors and considering the identical goods in play, there is no likelihood of direct confusion. Notwithstanding the principle of imperfect recollection, the consumers will not confuse one mark for the other. This is because the shared common word component “CHARGE-” in the competing marks is too weak for the average consumer to misremember/misrecall as each other, especially in light of the additional and divergent dictionary word components -VITE/-FIT present in the competing marks. In this respect, and according to the rationale in *Kurt Geiger* as quoted above, the likelihood of confusion in this case is reduced. Thus, the various differences between the competing trade marks previously identified are, in my view, sufficient, and, as a result, the marks will not be directly confused.

60. Even if the average consumer recalls the points of similarity between the marks, such as that both contain the common word component “CHARGE-”, I still consider the marks would not be indirectly confused. Sitting as the Appointed Person in *Eden Chocolat*,¹⁴ James Mellor KC stated:

¹⁴ Case BL O/547/17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017).

“81.4 [...] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining¹⁵ in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’” (Emphasis added)

61. Following the rationale above, the conjoined words of the competing marks form a cohesive whole. The overall impression lies within the conjunction of the word components of the marks. In this regard, the average consumer will not consider the respective marks as variants or sub-brands of each other nor that the goods in question are from the same or economically linked undertakings merely on the use of the weak word component “CHARGE-”. I find that the guidance given in *Duebros* applies to this case, namely that an average consumer may merely associate the common word element in the marks but would not confuse the two. Thus, I consider that there is no likelihood of indirect confusion. I, therefore, find there is no likelihood of indirect confusion.

Outcome

62. There is no likelihood of confusion. **The opposition on the basis of the claim under Section 5(2)(b) fails.** Therefore, subject to appeal, the application can proceed to registration.

Costs

63. This opposition has failed in its entirety and the applicant is entitled to a contribution towards its costs of defending its application. Awards of costs

¹⁵ In *L.A. Sugar*.

are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs as follows:

Considering the other side's statement and preparing a counterstatement	£350
Considering and commenting on the other side's evidence	£600
Preparing for and filing submissions-in-lieu	£350
Total	£1,300

64. I, therefore, order, Ataraxial, S.L.U. to pay Ergotron, Inc. the sum of £1,300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 9th day of February 2023

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General