

O/0540/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3583813
BY EMPIRE ONLINE SHOPPING LTD
TO REGISTER THE FOLLOWING TRADE MARK:**



IN CLASS 20

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 426542
BY E.ON SE**

Background and pleadings

1. On 23 January 2021, Empire Online Shopping LTD (“the applicant”) applied to register the trade mark displayed on the cover page of this decision in the UK, under number 3583813 (“the contested mark”). Details of the application were published for opposition purposes on 28 May 2021. Registration is sought for ‘*non-metal garden stakes; castors; cable ties*’ in class 20.
2. On 31 August 2021, E.ON SE (“the opponent”) opposed the application in full under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).
3. For the purposes of its claim under section 5(2)(b), the opponent relies upon the following trade marks:

E.ON

Comparable UK registration no. 911560232

Filing date: 8 February 2013

Registration date: 24 July 2013

(“the first earlier mark”)



Comparable UK registration no. 908700536

Filing date: 20 November 2009

Registration date: 24 May 2010

(“the second earlier mark”)

E.ON

Comparable UK registration no. 800924530

Filing date: 22 February 2007

Priority date: 25 September 2006 (Germany)

Registration date: 03 May 2010

(“the third earlier mark”)

4. The first, second and third earlier marks stand registered in respect of a wide range of goods and services, all of which are relied upon by the opponent. These are set out in full in the annex to this decision. The opponent contends that the contested mark is similar to each of its earlier marks and that the parties' goods and services are identical and/or similar. On this basis, the opponent submits that there is a likelihood of confusion, including the likelihood of association.

5. As for its claim under section 5(3), the opponent relies upon the third earlier mark, as well as the following trade marks:



UK registration no. 2363119

Filing date: 12 May 2004

Registration date: 27 January 2006

("the fourth earlier mark")



Comparable UK registration no. 902361608

Filing date: 3 September 2001

Registration date: 19 December 2002

Priority date: 3 July 2000 (UK)

("the fifth earlier mark")

e.on

Comparable UK registration no. 906296529

Filing date: 20 September 2007

Registration date: 27 June 2008

("the sixth earlier mark")

6. The fourth, fifth and sixth earlier marks are also registered in respect of a wide range of goods and services, as set out in the annex. The opponent claims that each of its earlier marks relied upon under this ground have a reputation for all the goods and services for which they are registered. It argues that the similarity between the parties' marks and goods and services would cause the relevant public to believe there is an economic connection between them, when there is not, leading to a change in economic behaviour. Moreover, the opponent argues that use of the contested mark would take unfair advantage of the reputation and distinctiveness of its earlier marks; the applicant would benefit from the same, thus gaining an unfair commercial advantage. In addition, the opponent submits that use of the contested mark would be detrimental to the reputation and distinctiveness of its earlier marks. In this regard, it contends that if the applicant's goods are of lower quality than those of the opponent, there is a risk that its reputation will suffer damage. Furthermore, it submits that the applicant's adoption of a highly similar mark to those of the opponent would reduce the ability of the latter to identify the commercial origin of its goods and services.

7. The opponent's marks qualify as "earlier trade marks" in accordance with section 6 of the Act, as their filing/priority dates are earlier than the filing date of the contested mark.¹ As they had all completed their registration processes more than five years before the filing date of the contested mark, they are subject to the use provisions specified in section 6A of the Act. In its notice of opposition, the opponent made a statement of use in respect of all its goods and services across all six earlier marks.

8. The applicant filed a counterstatement, denying the grounds of opposition. The applicant disputes that the contested mark is similar to the opponent's marks. Moreover, the applicant denies that the parties' goods and services are identical or similar. Based upon these factors, it denies that there is a likelihood of confusion. Further, the applicant denies that use of the contested mark would take unfair

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM or IREU. As a result of the opponent's EUTM numbers 11560232, 8700536, 2361608 and 6296529, and IREU number 924530, being registered/protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The 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 retain their original filing/priority dates.

advantage of, or be detrimental to, the reputation or distinctive character of the earlier marks. Finally, the applicant indicated that it would require the opponent to provide proof of use of all its earlier marks, though only insofar as they are registered in relation to '*casters for trolleys [vehicles]*' in class 12 and '*non-metal garden stakes; castors; cable ties*' in class 20.²

9. The opponent is professionally represented by Sipara Limited, whereas the applicant is not professionally represented. Only the opponent filed evidence. Neither party requested a hearing, nor did they elect to file written submissions in lieu of attendance. This decision is taken following careful consideration of all the papers before me.

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

Evidence

11. The opponent's evidence is given in the witness statement of Scott Somerville, dated 14 October 2022, and one accompanying exhibit (SS1). Mr Somerville is the Head of Brand & Marketing of E.ON UK plc, a wholly owned UK subsidiary of the opponent.

12. His statement serves as a vehicle for introducing into the evidence a witness statement he previously prepared for other opposition proceedings. That witness

² Following the filing of the Form TM8, the Registry wrote to the applicant on 29 November 2021 to seek further clarification regarding its proof of use request. An amended Form TM8 was duly filed on 17 December 2021. However, due to deficiencies in this section of the amended form, the Registry wrote to the applicant again on 17 February 2022, inviting it to make further amendments. No response was forthcoming. On 6 July 2022, the Registry wrote to the applicant to reiterate the deficiencies in the proof of use section of its Form TM8. It set a final period in which the applicant could file an amended form. Again, no response was forthcoming. Thereafter, the applicant's Form TM8 was admitted into the proceedings and served upon the opponent on 15 August 2022. Within its serving letter, the Registry indicated that the opponent would only be required to provide proof of use for the cited terms which were applicable to its earlier marks.

statement is dated 21 September 2022 and is accompanied by eighteen exhibits (SS1 to SS18).

13. For the avoidance of doubt, references to Mr Somerville's witness statement throughout this decision are to be taken as references to that dated 21 September 2022, unless otherwise indicated. Moreover, I shall use the original labelling system for the documents exhibited thereto, despite them all being contained in Exhibit SS1 to Mr Somerville's later witness statement.

14. Mr Somerville's statement goes to the background of the opponent and its use of the earlier marks.

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

Proof of use

16. The relevant statutory provisions are as follows:

“6A – (1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

17. As all but the fourth earlier mark are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7. - (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

- (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
- (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—

- (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and
- (b) the references in section 6A to the United Kingdom include the European Union.”

18. Moreover, section 100 of the Act states that:

“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. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the filing date of the application at issue, i.e. 24 January 2016 to 23 January 2021.

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

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a

label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

21. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark” is not, therefore, genuine use.³

22. Mr Somerville states that the opponent is a prominent member of the “big five” energy providers in the UK.⁴ He says that it is one of Europe’s largest operators of energy networks and infrastructure; at the date of his statement, the opponent was said to have been providing energy to over 51million customers around Europe and 10.3million in the UK.⁵ According to data from Ofgem, it had the second most electricity customer accounts in Great Britain as at 1 April 2022.⁶

23. Mr Somerville explains that the opponent was founded under the ‘E.ON’ mark in 2002 and entered the UK market that year, following an acquisition of UK power company Powergen.⁷ The rebranding of the UK business from Powergen to ‘E.ON’

³ *Intermar Simanto Nahmias v Nike Innovate C.V.*, Case BL O/222/16

⁴ Witness statement of Scott Somerville, §2

⁵ Somerville, §3

⁶ Exhibit SS1

⁷ Somerville, §5

was completed in 2007.⁸ The opponent also acquired Npower in 2019, with all customers transferred to a subsidiary business under an ‘E.ON’ mark.⁹

24. He also says that, aside from E.ON UK plc (“the UK subsidiary”), the opponent has a number of other subsidiaries, including, *inter alia*, E.ON Next Energy Limited; he confirms that all the subsidiaries have used the earlier marks with the opponent’s consent.¹⁰

25. The following unchallenged turnover figures relating to “all UK activities” have been provided:¹¹

| Financial year | Opponent’s turnover | UK subsidiary’s turnover |
|-----------------------|----------------------------|---------------------------------|
| 2018 | €30,084,000 | £2,286,000 |
| 2019 | €41,284,000 | £2,307,000 |
| 2020 | €60,944,000 | £3,917,000 |
| 2021 | €77,358,000 | £6,392,000 |
| Total | €209,670,000 | £14,902,000 |

26. A copy of the opponent’s annual report from 2021 has been exhibited.¹² This corroborates some of Mr Somerville’s narrative evidence regarding numbers of customer accounts in Europe and the opponent’s turnover.

27. Printouts from the UK subsidiary’s website at eonenergy.com are in evidence.¹³ The printouts, themselves, are undated. However, Mr Somerville has labelled each with a date between 9 May 2008 and the date of his statement. These appear consistent with the website addresses from web.archive.org (for example, 9 May 2008 reflecting “[...] 20080509 [...]” within the website address). The printouts confirm that the opponent is a provider of gas and electricity. Indeed, the UK subsidiary describes

⁸ Somerville, §5; Exhibit SS2

⁹ Somerville, §6; Exhibit SS2

¹⁰ Somerville, §4

¹¹ Somerville, §8

¹² Exhibit SS4

¹³ Exhibit SS3

itself as an energy supplier. ‘E.ON’ can be seen in normal font throughout the printouts, as can the following figurative signs:



28. Mr Somerville says that the opponent promotes itself in a number of ways. The marketing and advertising budget for the UK subsidiary is over £10million per year.¹⁴ The following figures relating to marketing and advertising investment have been provided:¹⁵

| Financial year | Approximate investment |
|----------------|------------------------|
| 2018 | £11,000,000 |
| 2019 | £6,000,000 |
| 2020 | £8,000,000 |
| 2021 | £10,000,000 |
| Total | £35,000,000 |

29. He provides printouts from the opponent’s website at eon.com, as well as those of the UK subsidiary at eonenergy.com and eonnexx.com.¹⁶ The websites, again, confirm that the opponent is a supplier of gas and electricity. Although ‘E.ON’ in normal font and the figurative signs displayed above are clearly visible on the websites, the printouts are all undated and Mr Somerville has not indicated when they were obtained. He does say, however, that the UK-facing sites had 20million visitors in September 2020, and that they achieve approximately 4-5million visits per week.¹⁷

30. Furthermore, Mr Somerville states that the UK subsidiary has entered into sponsorship arrangements, including with the Birmingham Commonwealth Games in 2022.¹⁸ This sponsorship resulted in ‘E.ON’ being made visible to an approximate

¹⁴ Somerville, §20

¹⁵ Somerville, §20

¹⁶ Exhibit SS5

¹⁷ Somerville, §11

¹⁸ Somerville, §12

global television audience of 1.5billion.¹⁹ Further examples of partnerships include Nottingham Forest FC (2022), the FA Cup (2006 to 2011), Ipswich Town FC (2006 to 2008), Veloce Extreme E racing (dates unknown), *Marie Claire* (dates unknown), *Wallpaper* (2022) and Sky Cinema (commencing July 2016).²⁰

31. The UK subsidiary is also said to invest heavily in television advertising.²¹ Printouts from Campaign's website at campaignlive.co.uk have been exhibited,²² which provide an overview of "the best E.ON creative work". The article shows still images of 'E.ON' advertisements dated 6 June 2017, 13 March 2018 and 7 September 2021, as well as November 2010, October 2013 and October 2015. Further, the evidence includes printouts from the 'E.ON Energy UK' YouTube page.²³ These show still images of promotional 'E.ON' videos dated between 12 October 2013 and 6 September 2021. One dated 14 October 2020 had over 6.8million views, whereas one dated 26 May 2017 had over 2.2million views.

32. Printouts from the UK subsidiary's social media accounts are in evidence.²⁴ From these, I note it operates YouTube, Facebook, Instagram, LinkedIn and Twitter pages. The YouTube account was created on 7 August 2009 and, at the date of Mr Somerville's statement, had 712,000 subscribers and nearly 30million views. The Facebook page was created on 20 April 2012 and has over 760,000 likes and followers. Whilst I cannot ascertain when the Instagram page was created, it had 9,182 followers at the time of Mr Somerville's statement. The Twitter page was created in May 2010 and has 427,000 followers. In addition to social media, Mr Somerville says that the UK subsidiary uses software applications to engage with customers and help them access information about its services.²⁵ These are available on Android and Apple mobile phones; the Android 'E.ON' application has had more than 1million downloads, while the Android 'E.ON Next' application has had more than 100,000 downloads since September 2021.²⁶

¹⁹ Somerville, §12

²⁰ Somerville, §12; Exhibit SS6

²¹ Somerville, §13

²² Exhibit SS7

²³ Exhibit SS7

²⁴ Exhibit SS8

²⁵ Somerville, §19

²⁶ Somerville, §19; Exhibit SS12

33. The UK subsidiary engages in community activities, which Mr Somerville says raises its profile and brand awareness.²⁷ Printouts from its website, which describe such activities, have been provided.²⁸ For example, the UK subsidiary has partnered with the charities Mind and Alzheimer's Society. However, none of the printouts are dated. The UK subsidiary is also said to engage in public relations activities.²⁹ Examples of media releases have been provided;³⁰ although many are from 2022, I note that some are from November and December 2020.

34. Mr Somerville says that 'E.ON' is regularly featured in major UK media outlets, such as the BBC, *The Guardian*, *The Sun*, *Daily Mail* and ITV News.³¹ It is his unchallenged narrative evidence that the UK subsidiary's analysis shows that the mark is mentioned in around 20,000 articles a year.³² This analysis is only retained for one year, though he provides some from September 2021.³³ This confirms that 'E.ON' was referred to in over 28,000 articles. The vast majority of this activity was conducted by online news outlets and broadcast media. Mr Somerville confirms that this media coverage is specific to the UK.³⁴

35. A brand awareness review relating to energy companies in the UK was conducted in 2019.³⁵ The review examined consumer awareness of these companies within the UK between January 2017 and February 2019. In this period, 'E.ON' ranked second in unaided brand awareness with 55%. A brand awareness review was also conducted in 2021.³⁶ In that year, 'E.ON' ranked second in unaided brand awareness with 46.9%. There is no specific information as to how many individuals from the UK were involved in the reviews. A YouGov survey from 2022 suggests a 93% awareness,³⁷ though does not indicate how many individuals were surveyed or whether this was aided or

²⁷ Somerville, §15

²⁸ Exhibit SS9

²⁹ Somerville, §16

³⁰ Exhibit SS10

³¹ Somerville, §16

³² Somerville, §16

³³ Exhibit SS11

³⁴ Somerville, §17

³⁵ Somerville, §22; Exhibits SS14

³⁶ Somerville, §25; Exhibit SS15

³⁷ Somerville, §26; Exhibit SS16

unaided. The Brand Finance ‘Europe 500’ Brand Directory placed ‘E.ON’ at 111th and 110th in 2021 and 2022, respectively.³⁸

36. Taking all of the above into account, I am satisfied that the earlier marks have been used. That is clear from the turnover figures, website printouts, amounts expended on marketing and advertising, sponsorship arrangements, television advertising, social media presence, downloads of the opponent’s software application, media releases, third-party references to the mark, and indications of brand awareness in the UK. However, I remind myself that the opponent is only required to provide proof of use of its earlier marks to the extent that they are registered in relation to ‘*casters for trolleys [vehicles]*’ in class 12 and ‘*non-metal garden stakes; castors; cable ties*’ in class 20. The evidence summarised above indicates that the marks have been used in relation to the opponent’s (and its subsidiaries’) activities as an energy supplier. There is simply no evidence that any of the relevant goods have been provided. Therefore, the opponent has not demonstrated genuine use of them and, consequently, it may not rely upon them to support its claims. I should add that this only applies to ‘*casters for trolleys [vehicles] [carts (Am)]*’ in class 12 of the first earlier mark, since none of the other earlier marks stand registered in respect of the goods for which proof of use was requested.

Section 5(2)(b)

The law

37. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

³⁸ Somerville, §27; Exhibit SS17

(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.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

38. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijzen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

39. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] 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”.

40. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ('Treat')* [1996] RPC 281 for assessing similarity were:

- (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.

41. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court stated that “complementary” means:

“[...] 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”.

42. I note that, upon the serving of the notice of opposition, the Registry indicated that, in light of the requirement for there to be some similarity between goods and/or services, there were aspects to the opponent’s pleaded case which did not appear to have any prospect of success under this ground. Whilst this did not prevent the notice of opposition being served, the opponent was directed under rule 62 of the Trade Mark Rules 2008 to indicate its best case upon the filing of its evidence, making clear submissions as to which particular goods or services in each class were similar to the applied-for terms.

43. No such submissions were forthcoming. Particularly in the absence of a clear explanation from the opponent, I do not consider there to be any obvious similarity between the goods and services relied upon and the applied-for goods. Accordingly, I shall confine my assessment to the arguments made in the opponent’s pleadings which are relevant to the issue of whether the parties’ goods and services are identical or similar.

44. The opponent’s pleaded case is that the following goods and services (taking my findings at paragraph 36 into account) are identical or highly similar to the applied-for goods:

First earlier mark

Class 12: Vehicle wheels.

Class 35: Presentation of goods on communication media, for retail purposes; advertising; procurement services for others [purchasing goods and services for other businesses.

Second earlier mark

Class 12: Vehicles; apparatus for locomotion by land, air, or water.

Third earlier mark

Class 35: Procurement services for others in the field of energy supply and energy transportation.

'Non-metal garden stakes; cable ties'

45. '*Non-metal garden stakes*' describe pointed sticks, often made from wood or plastic, that are used to support growing plants. '*Cable ties*' are a type of fastener which are designed to securely hold together wires and electrical cables. In this class, they may be interpreted as referring to clips, clamps or straps which are typically used in the home for, for example, keeping multiple cables extruding from electrical devices neat and tidy. There is no overlap in nature, intended purpose or method of use when considering these goods and '*vehicle wheels*' in class 12 of the first earlier mark and '*vehicles; apparatus for locomotion by land, air, or water*' in class 12 of the second earlier mark. The respective goods may share users to the extent that they may be purchased by the general public. Nevertheless, that is insufficient for a finding of overall similarity since it is at too broad a level. The respective goods do not typically share trade channels. There is no competition between them; for example, a consumer seeking to purchase a vehicle would clearly not purchase a garden stake instead, or vice versa. The respective goods are not important or indispensable to one another and consumers are unlikely to believe that the responsibility for them lies with the same undertakings; they are ordinarily offered by distinct undertakings. In this regard, they are not complementary. In light of the above, I find that there is no similarity between them; they are dissimilar.

46. To my mind, the opponent's services in class 35 of the first earlier mark do not improve its position. The nature, intended purpose and method of use of these services differs entirely from the applied-for goods. The only overlap is that, theoretically, the applicant's goods could be the subject of the opponent's services. For example, purchasing cable ties on behalf of other businesses or providing advertising services in relation to them. However, that is insufficient to engage any similarity; the relationship between them is tenuous. There is no material overlap in users. Moreover, the respective goods and services reach the market through distinct channels of trade. The respective goods and services are not important to one another in such a way that consumers will believe that the responsibility for them lies with the same undertaking. They are not, therefore, complementary. Neither are they in competition. Taking all of this into account, I find that the respective goods and services are dissimilar.

47. As for '*procurement services for others in the field of energy supply and energy transportation*' in class 35 of the third earlier mark, I do not consider there to be any overlap with the applied-for goods in terms of nature, intended purpose or method of use. The respective goods and services have different users and reach the market through different channels of trade. The respective goods and services are not in competition, and they are not complementary. Overall, I find that they are dissimilar.

'Castors'

48. I understand these goods to be small sets of swivelling wheels, which are fixed to the base or legs of items of furniture to enable movement. I accept that there is an overlap in nature, method of use and intended purpose between these goods and '*vehicle wheels*' in class 12 of the first earlier mark. However, this overlap is on an extremely general level, and rests, in my view, solely on the fact that they are both technically wheels which allow things to move. There are also clear differences between them in that one is typically for furniture and the other for vehicles, they are ordinarily made from different materials, they have different technical capabilities/functions and are usually different in size. The respective goods reach the market through entirely different trade channels and do not share users to any material extent. There is no competition between them; a consumer seeking a wheel for a

vehicle would not purchase a castor instead, or vice versa. The respective goods are not important or indispensable to one another and are not, therefore, complementary. Overall, notwithstanding the superficial overlap identified above, I find that the respective goods are dissimilar.

49. In my view, '*vehicles; apparatus for locomotion by land, air, or water*' in class 12 of the second earlier mark are even further removed from 'castors'. Clearly, the nature, method of use and intended purpose of the respective goods is different. I acknowledge that they both allow movement, though that is far too general to engage any similarity between them. Again, the goods do not share trade channels. They may both be purchased by the general public. However, such an overlap is far too broad to engage similarity. The respective goods are not in competition. Neither are they complementary. In light of all this, I find that the respective goods are dissimilar.

50. The opponent's services in class 35 of the first and third earlier marks do not improve its position in respect of 'castors'. For the same reasons as outlined at paragraphs 46 and 47 above, I find that the respective goods and services are dissimilar.

51. Some degree of similarity between goods or services is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of confusion to be considered.³⁹ As I have found all the applicant's goods to be dissimilar to the opponent's goods and services, the opposition under this ground must fail.

52. The opponent's claim under section 5(2)(b) is dismissed.

³⁹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

Section 5(3)

The law

53. Sections 5(3) and 5(3A) of the Act state:

“(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 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.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

54. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oréal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas-Salomon*, paragraph 29 and *Intel*, paragraph 63.

- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV*, paragraph 40.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails

of the senior mark 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. This 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 (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure*).

55. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its earlier marks are similar to the contested mark.⁴⁰ Secondly, the opponent must show that the marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier marks being brought to mind by the contested mark. Fourthly, assuming the foregoing conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is not necessary for the purposes of section 5(3) that the goods or services are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

56. The relevant date for the assessment under this ground is the filing date of the contested application, that being 23 January 2021.

Reputation

57. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

⁴⁰ As I will come on to discuss below, the opponent has satisfied this first requirement.

26. 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.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

58. The evidence (summarised above at paragraphs 22 to 35) suggests that the opponent is a major player in the UK energy market; the opponent provides energy to a significant number of individuals in Europe and the UK and, in recent times, had the second most electricity accounts in Great Britain. Whilst the opponent has not provided any specific details as to the size of the relevant market, or its share in the same, the unchallenged evidence shows that it generated a substantial turnover in the UK for several years leading up to the relevant date. Even in the context of what I understand to be an extremely large market, the figures are significant. The opponent has provided printouts from its website, which demonstrate relatively longstanding use of the earlier marks (either as registered or in acceptable variant forms). The opponent has spent significant sums in the marketing and advertising of its services under the earlier marks. The evidence suggests that the earlier marks achieved a significant degree of exposure to consumers in the UK prior to the relevant date. Its UK-facing websites appear to have had a large amount of traffic, albeit that it is not possible to ascertain where the users were based. The earlier marks have been used through sponsorship arrangements prior to the relevant date, some of which are likely to have generated large-scale exposure. Moreover, there is evidence of television advertising conducted prior to the relevant date. The earlier marks also feature on the opponent’s social

media channels; its accounts have a significant number of follows, likes and views. However, I am mindful that it has not been possible to ascertain what proportion of these were from before the relevant date, nor where the users are based. There is evidence of media releases carried out by the opponent prior to the relevant date. In addition, Mr Somerville's unchallenged narrative evidence confirms that the brand is referred to in UK media outlets around 20,000 times per year. Finally, although I place little weight on the brand awareness reviews due to a lack of information regarding the individuals involved, they are at least indicative that 'E.ON' was well-known to those surveyed prior to the relevant date. On the balance of the evidence as a whole, I am satisfied that the opponent has demonstrated that the earlier marks had a strong reputation in the UK at the relevant date.

59. In my view, the evidence clearly demonstrates that the opponent is an energy supplier, i.e. it provides gas and electricity. The opponent has claimed a reputation in respect of a wide range of goods and services, many of which do not specifically appear in the evidence at all. I certainly have reservations regarding the sufficiency of the evidence to establish a reputation in respect of any other goods and services. However, at least some of the other goods and services are closely related to the supply of energy, such as, for example, '*fuels*' and '*generation of power and electricity*'. To my mind, the relevant public may believe that an energy supplier is the undertaking responsible for such goods and services. With this in mind, and given that it represents the opponent's best case, I will proceed on the basis that my finding as to reputation extends to all goods and services covered by all earlier marks relied upon under this ground, returning to consider the matter further should it become necessary to do so.

Link

60. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take into account all relevant factors. The factors are identified in *Intel* at paragraph 42. I will take these in turn.

The degree of similarity between the conflicting marks

61. The third and sixth earlier marks are in word-only format and comprise the words ‘E.ON’ and ‘e.on’, respectively. As there are no other elements in the marks, their overall impressions are dominated by this word.

62. The fourth and fifth earlier marks are figurative and consist of the word ‘e.on’ in a slightly stylised font, the former in black and the latter in red. The word ‘e.on’ dominates the overall impressions of the marks. The stylisation, whilst still contributing, plays a much lesser role.

63. The contested mark is figurative and comprises two elements. At the beginning of the mark appears an incomplete, circular device, which is presented in red and white. Following the device element appears the word ‘EOS’ in a standard, red font. Although the eye is naturally drawn to elements of marks which can be read,⁴¹ due to the size and positioning of the device element, it is my view that both elements dominate the overall impression of the mark in roughly equal measure.

64. Visually, all the competing marks are similar in that they share two letters, i.e. ‘E’ and ‘O’. The difference in letter case between the sixth earlier mark and the contested mark is not significant, since the registration of word-only marks provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case.⁴² Further, the difference in letter case between the fourth and fifth earlier marks and the contested mark is, in my view, likely to be overlooked by consumers. The competing marks are visually different in that they end with different letters, i.e. ‘S’ and ‘N’. Moreover, the letters in the earlier marks are separated by a full stop, a feature which is not replicated by the contested mark. In addition, the contested mark contains a circular device. This element co-dominates the overall impression of the contested mark and has no counterpart in the earlier marks. The difference created by the device also appears at the beginning of the competing marks, a position which is generally considered to have more impact.⁴³ The stylisation in the fourth and fifth

⁴¹ *Wassen International Ltd v OHIM*, Case T-312/03

⁴² *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

⁴³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

earlier marks creates a further point of visual difference, although it plays a lesser role in their overall impressions and the impact of this difference is minimal. Overall, I find that there is a low degree of visual similarity between the fourth and fifth earlier marks and the contested mark. As the third and sixth earlier marks are not presented in the stylised font, I find that the degree of visual similarity between them and the contested mark is slightly higher. However, overall, I still consider this to be at a fairly low level.

65. The contested mark comprises a two-syllable word, i.e. "EE-OSS". Consumers will make no attempt to articulate the circular device. The earlier marks will all be pronounced as two syllables, i.e. "EE-ON". Aurally, the competing marks coincide in their respective first syllables, as well as the common sound created by the letter 'O'. Verbally, the only difference between the marks comes at their respective endings. Overall, I find that there is a high degree of aural similarity between the competing marks.

66. The contested mark is likely to be perceived as an invented word with no clear meaning. The circular device does not convey any particular concept. The mark is, therefore, conceptually neutral. Due to the separation of the letters in the earlier marks, consumers are likely to identify the word 'ON'. This word will be understood in accordance with its ordinary dictionary meaning. In relation to energy-related goods and services, it is somewhat allusive. The letter 'e'/'E' will be perceived as such and does not provide any obvious meaning other than its existence as a letter in the English alphabet. The earlier marks convey a concept which is not replicated by the contested mark. As such, insofar as the competing marks convey any meanings, they are conceptually dissimilar.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

67. I have already found that the applied-for goods are dissimilar to the goods and services of the first, second and third earlier marks. Whilst I acknowledge that the fourth, fifth and sixth earlier marks stand registered for different goods and services, having considered the relevant factors identified in *Treat*, I conclude that they are also

dissimilar. The parties' goods and services differ in nature, intended purpose and method of use. None are likely to reach the market through shared channels of trade and there is no meaningful competition between them. The respective goods and services are not important or indispensable to one another in such a way that consumers would assume they are provided by the same undertakings. In the absence of any evidence or submissions to the contrary, I do not consider it typical for any of the opponent's goods and services to be provided by undertakings which offer the applied-for goods, or vice versa. Some of the respective goods and services may share users on a broad level in that they may be purchased by the general public. However, that does not result in any overall similarity, not least because the specific users of those goods and services are unlikely to be the same. I accept that dissimilarity is a relative concept. Nevertheless, the parties' goods and services are provided in entirely distinct industries with no obvious overlap. It is my view that the distance between them is considerable.

68. As noted above, the majority of the goods and services at issue are likely to have different users. For example, the opponent's '*construction and repair of power stations*' and '*assignment of temporary workers*' are likely to be purchased by businesses, whereas the applied-for goods are likely to be purchased by members of the general public. To my mind, the only (and, therefore, relevant) section of the public who will purchase both parties' goods and services is the general public. For instance, a member of the public interested in gardening is also likely to be a consumer of household energy. In respect of the applicant's goods, the purchasing process is likely to be fairly casual, with the relevant public only considering factors such as cost and suitability when making their selection. In light of this, the general public is likely to demonstrate between a low and medium level of attention during the purchasing process. Conversely, the opponent's goods and services will constitute more considered purchases, since they will generally attract much higher outlays and selection will be more important. Whilst I acknowledge that the level of attention paid by the general public would vary (for example, it is likely to be lower for '*recycling services*' than '*energy supply services*'), overall, I find that it would be between a medium and high level.

The strength of the earlier mark's reputation

69. I have found that the earlier marks have a strong reputation in the UK.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

70. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

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

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

71. The third and sixth earlier marks are in word-only format and comprise the words ‘E.ON’ and ‘e.on’, respectively. As there are no other elements in the marks, their distinctive character rests in this word. The fourth and fifth earlier marks are figurative and consist of the word ‘e.on’ in a slightly stylised font, the former in black and the latter in red. The distinctive character of these marks lies predominantly in the word

'e.on'. The stylisation provides a minimal contribution to the distinctive character of the marks. The marks all consist of an ordinary letter from the English alphabet and the common dictionary word 'ON'/'on', separated by a full stop. As outlined previously, the word 'ON'/'on' is somewhat allusive of energy related goods and services. Overall, I find that the earlier marks have no more than a medium level of inherent distinctive character.

72. I have already assessed the evidence filed by the opponent. For the same reasons as given at paragraph 58, it is my view that the evidence supports a finding that the inherent distinctiveness of the earlier marks has been enhanced through use to a high level. For the purposes of this decision, I shall proceed on the basis that this applies across the specifications of the earlier marks.

Whether there is a likelihood of confusion

73. As outlined above, some degree of similarity between goods or services is necessary to engage the test for likelihood of confusion. Given that I have found the parties' respective goods and services to be dissimilar, I conclude that there would be no confusion. I acknowledge that the provisions of section 5(3) offer additional protection which takes into account the repute and distinctiveness of earlier trade marks. However, in the circumstances, I do not believe that the relevant public would be caused to believe that the user of the contested mark for dissimilar goods is economically connected to the user of the earlier marks.

Conclusions on link

74. I accept that the opponent has demonstrated that the earlier marks enjoy a strong reputation. I also acknowledge that the earlier marks are factually distinctive to a high level. Nevertheless, I have found that the parties' goods and services are dissimilar, and that there is a considerable distance between them. Although the competing marks share two letters, which appear in their dominant (or co-dominant) elements, there is a relatively low level of visual similarity between them overall. Despite there being no special test for 'short' marks, the competing marks comprise only three characters and, therefore, the differences between them have a greater impact and

are more likely to be noticed by the relevant public.⁴⁴ Moreover, the competing marks are conceptually dissimilar and, therefore, there is no common meaning which would be retained in the minds of members of the relevant public. To my mind, neither the reputation nor distinctive character enjoyed by the earlier marks, nor a combination of the two, are sufficient to counteract the differences between the marks and the distance between the goods and services, even considering the high degree of aural similarity between them. Taking all the above factors into account, it is my view that the mere presence of two shared letters is not sufficient to cause the relevant public to make a link between the competing marks, even where a lower level of attention is paid during the purchasing process. I consider it highly unlikely that the earlier marks would be brought to mind by the contested mark. If any link is made, it is my view that this will be too fleeting to result in any damage arising; given that the parties' goods and services are dissimilar, there will be no material change in economic behaviour.

75. The opponent's claim under section 5(3) is dismissed.

Conclusion

76. The opposition under sections 5(2)(b) and 5(3) has failed. Subject to any appeal against my decision, the application will proceed to registration in the UK.

Costs

77. The opposition having failed, ordinarily the applicant would be entitled to an award of costs. As the applicant has not instructed professional representatives, it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings.

⁴⁴ *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20, paragraph 38; Case T-274/09 *Deutsche Bahn v OHIM*, paragraph 78; Case T-304/10 *dm-drogerie markt v OHIM*, paragraph 42

78. It was made clear by letter dated 17 February 2023 that if the pro-forma was not completed, no costs would be awarded. The applicant did not return a completed pro-forma to the Tribunal and, on this basis, no costs are awarded.

Dated this 9th day of June 2023

James Hopkins

For the Registrar

Annex

Goods and services of the first earlier mark

Class 7: Machines for processing metal, timber and plastics, machines for the chemical industry, agriculture, mining, textile machines, machines for the drinks industry, construction equipment, packing machines; Wind power installations, machines and parts therefor for generating and distributing energy, in particular electrical and thermal energy and steam; all of the aforesaid goods with the exception of spark plugs.

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording and transmission of data; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; Computer software; Fire-extinguishing apparatus, batteries and Chargers for electric vehicles; none of the aforesaid goods being for recording, transmission oder reproduction of sound or images.

Class 12: Vehicles; Apparatus for locomotion by land, air or water; Vehicle covers [shaped]; Axle journals; Air bags [safety devices for automobiles]; Amphibious airplanes; Trailers [vehicles]; Trailer hitches for vehicles; Transmission chains for land vehicles; Driving motors for land vehicles; Transmission shafts for land vehicles; Aeronautical apparatus, machines and appliances; Motor buses; Automobile tires [tyres]; Dredgers [boats]; Air balloons; Concrete mixing vehicles; Sleeping berths for vehicles; Rolling stock for funicular railways; Saddle covers for bicycles or motorcycles; Covers for vehicle steering wheels; Balance weights for vehicle wheels; Anti-glare devices for vehicles; Boats; Davits for boats; Boat hooks; Masts for boats; Brake segments for vehicles; Brake pads for automobiles; Brake linings for vehicles; Brake discs for vehicles; Brake shoes for vehicles; Dining cars [carriages]; Portholes; Motor homes; Vehicle chassis; Automobile chassis; Anti-theft devices for vehicles;

Anti-theft alarms for vehicles; Funiculars; Cable transport apparatus and installations; Trolleys; Bogies for railway cars; Torque converters for land vehicles; Tricycles; Jet engines for land vehicles; Shopping trolleys [carts (Am)]; Rolling stock for railways; Electric vehicles; Motors, electric, for land vehicles; Ferry boats; Bicycle stands; Cycle brakes; Cycles; Cycle rims; Cycle bells; Cycle chains; Baskets adapted for cycles; Cycle handle bars; Cycle hubs; Dress guards for bicycles, cycles; Pedals for cycles; Cycle pumps; Wheels for bicycles, cycles; Cycle frames; Tires for bicycles, cycles; Cycle saddles; Inner tubes for bicycles, cycles; Cycle spokes; Direction indicators for bicycles; Turn signals for vehicles; Brakes for vehicles; Vehicles for locomotion by land, air, water or rail; Windows for vehicles; Bodies for vehicles; Vehicle wheels; Vehicle wheel spokes; Vehicle wheel tires [tyres]; Vehicle seats; Doors for vehicles; Hoods for vehicles; Parachutes; Vehicle wheel rims; Remote control vehicles, other than toys; Repair outfits for inner tubes; Air vehicles; Aeroplanes; Mine cart wheels; Freewheels for land vehicles; Crankcases for land vehicle components, other than for engines; Luggage nets for vehicles; Panniers adapted for cycles; Luggage carriers for vehicles; Gear boxes for land vehicles; Ladle cars; Hydroplanes; Casters for trolleys [vehicles] [carts (Am)]; Non-skid devices for vehicle tires; Golf carts; Fork lift trucks; Horns for vehicles; Hydraulic circuits for vehicles; Upholstery for vehicles; Yachts; Cars for cable transport installations; Automobile bodies; Carts; Caissons [vehicles]; Automobile chains; Strollers; Pushchair hoods; Tilting-carts; Tilt trucks; Cycle cars; Head-rests for vehicle seats; Automobiles; Ambulances; Refrigerated vehicles; Refrigerated wagons [railroad vehicles]; Couplings for land vehicles; Cranks for cycles; Tailboard lifts [parts of land vehicles]; Barges; Vans [vehicles]; Trucks; Tipping bodies for lorries [trucks]; Treads for retreading tires [tyres]; Casings for pneumatic tires [tyres]; Traction engines; Locomotives; Wagons; Aircraft; Air cushion vehicles; Air pumps [vehicle accessories]; Cable cars; Military vehicles for transport; Mopeds; Motors for land vehicles; Hoods for vehicle engines; Automobile hoods; Motorcycles; Vehicle wheel hubs; Bands for wheel hubs; Omnibuses; Paddles for canoes; Pushchair covers; Connecting rods for land vehicles, other than parts of motors and engines; Pontoons; Screw-propellers; Buffers for railway rolling stock; Axles for vehicles; Gearing for land vehicles; Hub caps; Space vehicles; Treads for vehicles [roller belts]; Tires for vehicle wheels; Tires, solid, for vehicle wheels; Motor coaches; Spare tire covers; Scooters [vehicles]; Wheelchairs; Reversing alarms for vehicles; Rearview mirrors; Oars; Oarlocks; Ships' hulls; Sack-barrows; Saddles for bicycles,

cycles or motorcycles; Saddlebags adapted for bicycles; Clutches for land vehicles; Launches; Windscreen wipers; Headlight wipers; Ships; Fenders for ships; Cleats [nautical]; Funnels for ships; Screw-propellers for boats; Screws [propellers] for ships; Spars for ships; Ships' steering gears; Sleeping cars; Inner tubes for pneumatic tires [tyres]; Tubeless tires [tyres] for bicycles, cycles; Hose carts; Ejector seats for aircraft; Sleighs [vehicles]; Mudguards; Anti-skid chains; Snowmobiles; Seat covers for vehicles; Funnels for locomotives; Inclined ways for boats; Wheelbarrows; Kick sledges; Cycle mudguards; Side cars; Adhesive rubber patches for repairing inner tubes; Chairlifts; Security harness for vehicle seats; Safety belts for vehicle seats; Safety seats for children, for vehicles; Ski lifts; Ski carriers for cars; Sun-blinds adapted for automobiles; Timbers [frames] for ships; Spoke clips for wheels; Dining cars; Studs for tires [tyres]; Spoilers for vehicles; Sports cars; Sprinkling trucks; Flanges of railway wheel tires; Airships; Steering wheels for vehicles; Rudders; Suspension shock absorbers for vehicles; Shock absorbers for automobiles; Shock absorbing springs for vehicles; Vehicle bumpers; Bumpers for automobiles; Tramcars; Caps for vehicle petrol [gas] tanks; Torsion bars for vehicles; Vehicle suspension springs; Tractors; Carrier tricycles; Aerial conveyors; Handling carts; Cleaning trolleys; Driving chains for land vehicles; Propulsion mechanisms for land vehicles; Vehicle running boards; Turbines for land vehicles; Transmissions, for land vehicles; Reduction gears for land vehicles; Valves for vehicle tires [tyres]; Disengaging gear for boats; Cars; Undercarriages for vehicles; Tipping apparatus, parts of trucks and waggons; Railway couplings; Carriages [railways]; Water vehicles; Seaplanes; Windscreens; Caravans; Sculls; Gears for cycles; Cigar lighters for automobiles; Motors for cycles; Cycle stands.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioka, sago, artificial coffee; Flour and preparations made from cereals; Bread, pastry and confectionery, ices; Honey, treacles; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces, condiments; Spices; Ice, cereal bars, glucose for food.

Class 35: Advertising; Business management; Business administration; Office functions; Updating of advertising material; Cost price analysis; Business inquiries; Business management and organization consultancy; Business management consultancy; Personnel management consultancy; Advisory services for business

management; Procurement services for others [purchasing goods and services for other businesses]; Import-export agencies; Professional business consultancy; Accounting; Computerized file management; Publicity agencies; Auctioneering; Transcription; Relocation services for businesses; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Business investigations; Compilation of statistics; Business efficiency expert services; Drawing up of statements of accounts; Tax preparation; Economic forecasting; Commercial information agencies; Commercial information and advice for consumers [consumer advice shop]; Invoicing; Television advertising; Photocopying services; Business management of performing artists; Business management of sports people; Business management of hotels; Publication of publicity texts; Commercial or industrial management assistance; Business information; Commercial administration of the licensing of the goods and services of others; Layout services for advertising purposes; Payroll preparation; Modelling for advertising or sales promotion; Marketing; Marketing research; Marketing studies; Opinion polling; Data search in computer files for others; Business research; Public relations; On-line advertising on a computer network; Organization of exhibitions for commercial or advertising purposes; Organization of fashion shows for promotional purposes; Business organization consultancy; Outsourcing services [business assistance]; Employment agencies; Personnel recruitment; Psychological testing for the selection of personnel; Bill-posting; Business management assistance; Presentation of goods on communication media, for retail purposes; Price comparison services; Production of advertising films; Radio advertising; News clipping services; Shop window dressing; Word processing; Typing; Secretarial services; Sponsorship search; Shorthand; Systemization of information into computer databases; Telephone answering for unavailable subscribers; Telemarketing services; Organization of trade fairs for commercial or advertising purposes; Dissemination of advertising matter; Writing of publicity texts; Sales promotion for others; Office machines and equipment rental; Rental of photocopying machines; Rental of vending machines; Rental of advertising space; Publicity material rental; Rental of advertising time on communication media; Arranging subscriptions to telecommunication services for others; Arranging newspaper subscriptions for others; Advertising by mail order; Distribution of samples; Direct mail advertising; Document reproduction; Administrative processing of purchase orders; Demonstration of goods; Advertising; Publicity columns preparation;

Business appraisals; Business auditing; Compilation of information into computer databases.

Class 41: Education; Providing of training; Entertainment; Sporting and cultural activities, publication of printed matter, other than for advertising purposes, providing electronic, non-downloadable publications online.

Goods of the second earlier mark

Class 9: Measuring, signalling, checking (supervision) apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; counters for electric and thermal energy, gas and water; checking (supervision) apparatus for electricity consumption; equipment for central control and switching of consumer units for electrical and thermal energy, gas and water; apparatus for recording, processing, storage and transmission of measurements, in particular devices for central data transmission; wireless-operated apparatus for reading data from meters; electric accumulators for vehicles; chargers for electric batteries; computer software; electric cables; transformers; electric display apparatus; connectors (electricity), electrical fittings; electric junction boxes; limiters (electricity); anti-interference devices (electricity).

Class 12: Vehicles; apparatus for locomotion by land, air or water; Electric vehicles.

Class 16: Printed matter; photographs; stationery; instructional and teaching material (except apparatus).

Goods and services of the third earlier mark

Class 9: Measurement, control and regulating instruments and apparatus for the generation of electrical and thermal energy and for the transportation, distribution and supply of electrical and thermal energy, gas and water; measurement instruments for use in environmental technology and for metering the consumption of electrical and thermal energy, gas and water; instruments for the analysis of exhaust gases from fuel-fired power stations; instruments for the determination of physical and

thermodynamic properties of gas, in particular natural gas; integrated circuit cards, in particular customer account cards.

Class 11: Industrial fuel firing installations for power stations; regulating and safety equipment for gas lines.

Class 35: Employment agencies; personnel recruitment; assignment of temporary workers; procurement services for others in the field of energy supply and energy transportation.

Goods and services of the fourth earlier mark

Class 4: Fuels, benzene, charcoal, coal, fuel gas; mineral fuels; gas oil; paraffin, peat fuel oils; natural gas; bitumen and/or water emulsions for fuel; non-chemical additives for fuels; all included in this class and none for automotive use.

Class 9: Electrical and electronic apparatus and instruments, all for use in generating or distributing electricity or for use with electrical generating or distributing apparatus and installations; scientific, weighing, measuring, signalling, checking (supervision) apparatus and instruments, all for use in generating or distributing electricity or for use with electrical generating or distributing apparatus and installations; computer programs for use in or in connection with generation of power or electricity, provision and distribution of gas and water; electrostatic precipitators; safety equipment.

Class 37: Construction and repair of power stations, power generating apparatus and machinery; installation of electrical and generating machinery.

Class 39: Transport by ship, barge and heavy goods vehicle of fuel, ash, chemicals, generating apparatus and machinery and heavy engineering plant; transportation of waste to disposal sites; hire and rental of goods vehicles, railways trucks and coal-moving machinery.

Class 40: Disposal and treatment of waste water from industrial processes and generating operations; demineralization and desalination of water; disposal of waste

from water treatment installations; waste and water treatment by electrolysis; ash disposal; disposal of solid residues; extraction of elements contained in waste residues; generation of power and electricity.

Class 42: Project studies and professional consultancy services, all relating to power generation, supply and distribution; geological, chemical, technical and scientific research services; geological surveys; industrial design services; engineering drawing; computer programming; computer consultancy and advisory services, all relating to computer software for use in or in connection with the generation of power and electricity or the provision and distribution of gas and water; consultancy services relating to environmental matters; materials evaluation and testing.

Services of the fifth earlier mark

Class 35: Arranging and concluding of contracts for supplying electricity, gas and water.

Class 39: Energy supply services, namely the supply and distribution of electricity, gas and water.

Class 40: Generation of electricity, gas and water.

Goods and services of the sixth earlier mark

Class 7: Machines for use in energy, gas, environmental and air conditioning technology, turbo engines; machines and machine parts for generating gas, including gas compressors and valves and pumps; machines and parts therefor, for generating and distributing energy, in particular electrical energy and steam, in particular using renewable energy sources and biomass; parts of the aforesaid goods.

Class 36: Financing and monetary affairs in the field of energy, gas, environmental and air conditioning technology; consultancy with regard to investment, subsidy and financing of installations and businesses in the field of energy, gas, environmental and air conditioning technology; contracting, namely financial transactions and leasing

transactions in connection with operating emission-reducing, decentral installations for energy generation.

Class 37: Building construction; installation services; civil engineering construction; mechanical engineering and construction in the field of energy, gas, environmental and air conditioning technology and process engineering; installation, assembly, maintenance and repair of power stations, gas generators, pipelines and installations for generating electrical and thermal energy from renewable energy sources, in particular from wind energy, water energy, solar energy, geothermal heat and biomass, and installations for generating gas from biomass and valuable materials, in particular from renewable raw materials; electricity, gas and water installation.

Class 40: Treatment of materials; generating energy, in particular electrical energy, thermal energy and steam; generating electrical, thermal energy and steam from renewable energy sources, in particular from wind energy, water energy, solar energy, geothermal heat and biomass; generating gas from biomass and valuable materials, in particular renewable raw materials; generating of bio natural gas; recycling services; water treatment; incineration of waste and valuable materials.