

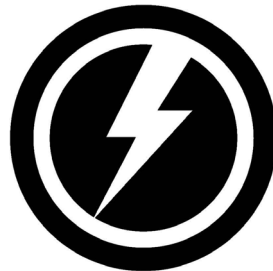
O-1123-22

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3605470  
BY REDDE NORTHGATE PLC, FOR A SERIES OF TWO TRADE MARKS:



AND



AND

THE OPPOSITION THERETO UNDER NO 427080 BY  
BREDENOORD HOLDING B.V.

## Background and pleadings

1. On 5 March 2021, Redde Northgate Plc (the applicant) applied to register the above series of two trade marks in classes 35 and 39, as follows:<sup>1</sup>

### **Class 35**

Business management of a transportation fleet; business management of a vehicle fleet; database management; data management; provision of business management assistance; office functions; provision of business management information; the bringing together, for the benefit of others, of direction and location finding apparatus and instruments, apparatus for displaying the path followed by a vehicle, apparatus for displaying the position of vehicles, fleet management software, computer programs relating to management of fleets of vehicles, battery charging stations and apparatus, battery chargers, electric battery chargers, power supply devices for battery chargers, electric battery systems, equipment for the storage and supply of electricity to electric vehicles, computer software for electric battery systems, computer software for electric vehicles, application software for use in remote meter monitoring, application software for use with electricity distribution apparatus and instruments, electricity metering apparatus, electricity terminals, apparatus and instruments for regulating or controlling electricity, measuring equipment, cables, wires, apparatus for reading encoded cards, apparatus for reading electronic cards containing information. enabling customers to conveniently view and purchase those goods; online retail services connected with the sale of battery charging stations and apparatus, battery chargers, electric battery chargers, power supply devices for battery chargers, electric battery systems, equipment for the storage and supply of electricity to electric vehicles, computer software for electric battery systems, computer software for electric vehicles, application software for use in remote meter monitoring, application software for use with electricity distribution apparatus and instruments,

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<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*


electricity metering apparatus, electricity terminals, apparatus and instruments for regulating or controlling electricity, measuring equipment, cables, wires, apparatus for reading encoded cards, apparatus for reading electronic cards containing information, enabling customers to conveniently view and purchase those goods in a retail motor vehicle store or by means of the Internet; the bringing together, for the benefit of others, of apparatus for use with computers relating to the management of fleet vehicles, commercial vehicles, goods vehicles and land vehicles, enabling customers to conveniently view and purchase those goods in a retail motor vehicle store or by means of the Internet; advertising services relating to the sale of motor vehicles; retail services connected with the sale of vehicles, commercial vehicles and automotive goods enabling customers to conveniently view and purchase vehicles, commercial vehicles and automotive goods from a retail or a wholesale outlet or from a catalogue or by means of telecommunications or from an Internet website; information, advice and consultancy services in relation to the aforesaid services.

### **Class 39**

Arrangement of vehicle rental; booking of vehicle rental; contract rental of vehicles; rental of commercial vehicles, goods vehicles, land vehicles, motor land vehicles, motor road vehicles, motor vehicles, road vehicles, sports equipment (vehicles), transport vehicles, transportation vehicles, vehicle roof racks, vehicles, vehicles equipped with lifting platforms, vehicles for transportation; vehicle rental; arranging vehicle rental by means of the Internet; leasing, rental and hire services for motor vehicles; storage facilities for motor vehicles, parts and apparatus; vehicle breakdown recovery services; arranging vehicle breakdown recovery; commercial vehicle breakdown recovery; leasing, rental and hire of parts and fittings for vehicles; leasing, rental and hire of vehicle tracking equipment; information, advice and consultancy services in relation to the aforesaid services.

2. The applicant's mark was published on 9 July 2021, following which it was opposed by Bredenoord Holding B.V. (the opponent).

3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies upon the following Trade Mark:

<b>Mark details and relevant dates</b>	<b>Goods and services relied upon</b>
<p><b>TM:</b> 916252918</p>  <p><b>Filed:</b> 13 January 2017</p> <p><b>Registered:</b> 25 August 2017</p> <p><b>Colour claimed:</b> Red; Yellow; White</p>	<p><b>Class 7</b></p> <p>Machine tools; Motors and engines (except for land vehicles); Machine coupling and transmission components (except for land vehicles); Apparatus for generating electricity, Emergency power generators and Generators; Solar power generators; Wind-powered electricity generators; Hydroelectric installations for generating electricity; Hydro-pneumatic accumulators; Emergency power generators, included in this class; Energy conversion apparatus; Filters being parts of engines or machines; Filters for cleaning cooling air, for engines; Parts and components for the aforesaid goods, included in this class.</p> <p><b>Class 9</b></p> <p>Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Data processing equipment/apparatus and computers; Computer software; Accumulator batteries; Uninterruptible power supply apparatus [battery]; Solar batteries; Chargers for electric batteries; Accumulators for photovoltaic power; Photovoltaic apparatus and modules; Photovoltaic installations for generating electricity [photovoltaic power plants]; Photovoltaic inverters; Solar batteries; Solar panels; Energy control devices; Batteries; Electricity transformers; Parts and components for the aforesaid goods included in this class.</p>

**Class 35**

Advertising; Advertising; Business management; Business administration; Office functions; Marketing services; Market canvassing, market research and market analysis; Business mediation in the purchase and sale, import and export, and wholesaling and retailing of power units, generators, emergency power generators, machine tools, motors, engines, machine coupling and transmission components, energy conversion apparatus, filters, energy-saving apparatus, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, computer software, batteries, chargers for electric batteries, accumulators, photovoltaic apparatus and modules, apparatus for energy control, batteries, distribution boxes, storage tanks, lampposts, start-up units, synchronous boxes, control boxes, transformers, cables, distribution devices, water purification apparatus, water purification installations, parts and fittings; Arranging of events for publicity and commercial purposes; Consultancy and information regarding the aforesaid services; The aforesaid services also provided via electronic networks, such as the Internet.

**Class 37**

Installation, repair, overhaul and maintenance of power units, generators, emergency power generators, machines, machine tools, motors, engines, machine coupling and transmission components, energy conversion apparatus, filters, energy-saving apparatus, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, accumulators, chargers for electric batteries, photovoltaic apparatus and modules, apparatus for energy control,

batteries, distribution boxes, storage tanks, lampposts, start-up units, synchronous boxes, control boxes, transformers, cables, distribution devices, water purification apparatus, water purification installations, parts and fittings for the aforesaid goods; Installation and maintenance in the field of energy management; Recharging of batteries and accumulators; Replacement of batteries; Consultancy and information regarding the aforesaid services; The aforesaid services also provided via electronic networks, such as the internet.

**Class 40**

Rental and leasing of power units, generators, emergency power generators, energy generating installations, machine tools, motors, engines, machine coupling and transmission components, energy conversion apparatus, filters, energy-saving apparatus, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, accumulators, chargers for electric batteries, photovoltaic apparatus and modules, apparatus for energy control, batteries, distribution boxes, tanks, lampposts, start-up units, synchronous boxes, control boxes, transformers, cables, distribution devices, water purification apparatus, water purification installations, parts and fittings for the aforesaid goods; Generation of power; Generation, production and conversion of energy; Consultancy and information regarding the aforesaid services; The aforesaid services also provided via electronic networks, such as the Internet.

**Class 42**

Technological services and research and design; Design and development of computer hardware and software;

	<p>Engineering services; Energy auditing; Development of energy and power management systems; Providing technical advice relating to energy-saving measures; Technological consultancy in the fields of energy production and use; Technological analysis relating to energy and power needs of others; Measurement and analysis of generator emissions; Installation, repair, overhaul and maintenance of computer software; Rental and leasing of computer software; Consultancy and information regarding the aforesaid services; The aforesaid services also provided via electronic networks, such as the Internet.</p>
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4. The opponent claims that the respective marks are similar and that the applied for services in classes 35 and 39 are 'identical, similar and complementary to the goods and services protected by the registration'. It concludes that, 'as a result, there is a likelihood of confusion, including a likelihood of association with the opponent's mark'.

5. The applicant filed a counterstatement in which it denied the ground raised by the opponent.

6. Both parties filed evidence. The applicant filed a skeleton argument and was represented by Alan Fiddes of Murgitroyd & Company at a hearing, which took place by video conference. The opponent filed submissions in lieu of attendance at the hearing. The opponent has been represented by Withers & Rogers LLP throughout these proceedings.

7. 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 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

### Applicant's evidence

8. The applicant's evidence is provided by a witness statement of Julia Robinson with attached exhibits JR1-JR7. Ms Robinson is the applicant's head of marketing and has been employed by them since January 2018. Her evidence relates to the nature of the applicant's business and the use of its trade marks for different sectors of its business. She also provides examples of lightning bolts used by several companies in the electric vehicle sector.

### Opponent's evidence in reply

9. The opponent's reply to the applicant's evidence is provided by a witness statement of Mark James Caddle and exhibit MJC1. Mr Caddle is a partner at the opponent's representative. His evidence is intended to show that all of the evidence provided by the applicant relates to companies based outside the UK. His statement is dated 8 August 2022.

10. I do not intend to itemize the evidence here. I have taken note of it and will refer to it throughout this decision where necessary.

## DECISION

11. Under Section 6(1) of the Act, the opponent's trade mark qualifies as an earlier trade mark. However, proof of use is not relevant in these proceedings because registration of the opponent's earlier mark was completed less than five years before the application date of the contested mark.<sup>2</sup>

12. Section 5(2)(b) of the Act states:

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

(a)...

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<sup>2</sup> See section 6A of the Act.



(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,

or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

13. 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 Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 they have kept in their 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**

14. The goods and services to be compared are as follows:

<b>The opponent's goods and services</b>	<b>The applicant's services</b>
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**Class 7**

Machine tools; Motors and engines (except for land vehicles); Machine coupling and transmission components (except for land vehicles); Apparatus for generating electricity, Emergency power generators and Generators; Solar power generators; Wind-powered electricity generators; Hydroelectric installations for generating electricity; Hydro-pneumatic accumulators; Emergency power generators, included in this class; Energy conversion apparatus; Filters being parts of engines or machines; Filters for cleaning cooling air, for engines; Parts and components for the aforesaid goods, included in this class.

**Class 9**

Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Data processing equipment/apparatus and computers; Computer software; Accumulator batteries; Uninterruptible power supply apparatus [battery]; Solar batteries; Chargers for electric batteries; Accumulators for photovoltaic power; Photovoltaic apparatus and modules; Photovoltaic installations for generating electricity [photovoltaic power plants]; Photovoltaic inverters; Solar batteries;

<p>Solar panels; Energy control devices; Batteries; Electricity transformers; Parts and components for the aforesaid goods included in this class.</p>	
<p><b>Class 35</b>  Advertising; Advertising; Business management; Business administration; Office functions; Marketing services; Market canvassing, market research and market analysis; Business mediation in the purchase and sale, import and export, and wholesaling and retailing of power units, generators, emergency power generators, machine tools, motors, engines, machine coupling and transmission components, energy conversion apparatus, filters, energy-saving apparatus, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, computer software, batteries, chargers for electric batteries, accumulators, photovoltaic apparatus and modules, apparatus for energy control, batteries, distribution boxes, storage tanks, lampposts, start-up units, synchronous boxes, control boxes, transformers, cables, distribution devices, water purification apparatus, water purification installations, parts and fittings; Arranging of events for publicity and commercial purposes; Consultancy</p>	<p><b>Class 35</b>  Business management of a transportation fleet; business management of a vehicle fleet; database management; data management; provision of business management assistance; office functions; provision of business management information; the bringing together, for the benefit of others, of direction and location finding apparatus and instruments, apparatus for displaying the path followed by a vehicle, apparatus for displaying the position of vehicles, fleet management software, computer programs relating to management of fleets of vehicles, battery charging stations and apparatus, battery chargers, electric battery chargers, power supply devices for battery chargers, electric battery systems, equipment for the storage and supply of electricity to electric vehicles, computer software for electric battery systems, computer software for electric vehicles, application software for use in remote meter monitoring, application software for use with electricity distribution apparatus and instruments,</p>

and information regarding the aforesaid services; The aforesaid services also provided via electronic networks, such as the Internet.

electricity metering apparatus, electricity terminals, apparatus and instruments for regulating or controlling electricity, measuring equipment, cables, wires, apparatus for reading encoded cards, apparatus for reading electronic cards containing information. enabling customers to conveniently view and purchase those goods; online retail services connected with the sale of battery charging stations and apparatus, battery chargers, electric battery chargers, power supply devices for battery chargers, electric battery systems, equipment for the storage and supply of electricity to electric vehicles, computer software for electric battery systems, computer software for electric vehicles, application software for use in remote meter monitoring, application software for use with electricity distribution apparatus and instruments, electricity metering apparatus, electricity terminals, apparatus and instruments for regulating or controlling electricity, measuring equipment, cables, wires, apparatus for reading encoded cards, apparatus for reading electronic cards containing information, enabling customers to conveniently view and purchase those goods in a retail motor vehicle store or by means of the Internet; the bringing together, for the benefit of

	<p>others, of apparatus for use with computers relating to the management of fleet vehicles, commercial vehicles, goods vehicles and land vehicles, enabling customers to conveniently view and purchase those goods in a retail motor vehicle store or by means of the Internet; advertising services relating to the sale of motor vehicles; retail services connected with the sale of vehicles, commercial vehicles and automotive goods enabling customers to conveniently view and purchase vehicles, commercial vehicles and automotive goods from a retail or a wholesale outlet or from a catalogue or by means of telecommunications or from an Internet website; information, advice and consultancy services in relation to the aforesaid services.</p>
<p><b>Class 37</b>  Installation, repair, overhaul and maintenance of power units, generators, emergency power generators, machines, machine tools, motors, engines, machine coupling and transmission components, energy conversion apparatus, filters, energy-saving apparatus, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, accumulators,</p>	

<p>chargers for electric batteries, photovoltaic apparatus and modules, apparatus for energy control, batteries, distribution boxes, storage tanks, lampposts, start-up units, synchronous boxes, control boxes, transformers, cables, distribution devices, water purification apparatus, water purification installations, parts and fittings for the aforesaid goods; Installation and maintenance in the field of energy management; Recharging of batteries and accumulators; Replacement of batteries; Consultancy and information regarding the aforesaid services; The aforesaid services also provided via electronic networks, such as the internet.</p>	
	<p><b>Class 39</b>  Arrangement of vehicle rental; booking of vehicle rental; contract rental of vehicles; rental of commercial vehicles, goods vehicles, land vehicles, motor land vehicles, motor road vehicles, motor vehicles, road vehicles, sports equipment (vehicles), transport vehicles, transportation vehicles, vehicle roof racks, vehicles, vehicles equipped with lifting platforms, vehicles for transportation; vehicle rental; arranging vehicle rental by means of the Internet; leasing, rental and hire services for motor vehicles; storage facilities for</p>

	<p>motor vehicles, parts and apparatus;  vehicle breakdown recovery services;  arranging vehicle breakdown recovery;  commercial vehicle breakdown recovery;  leasing, rental and hire of parts and fittings for vehicles; leasing, rental and hire of vehicle tracking equipment;  information, advice and consultancy services in relation to the aforesaid services.</p>
<p><b>Class 40</b>  Rental and leasing of power units, generators, emergency power generators, energy generating installations, machine tools, motors, engines, machine coupling and transmission components, energy conversion apparatus, filters, energy-saving apparatus, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, accumulators, chargers for electric batteries, photovoltaic apparatus and modules, apparatus for energy control, batteries, distribution boxes, tanks, lampposts, start-up units, synchronous boxes, control boxes, transformers, cables, distribution devices, water purification apparatus, water purification installations, parts and fittings for the aforesaid goods; Generation of power;</p>	



<p>Generation, production and conversion of energy; Consultancy and information regarding the aforesaid services; The aforesaid services also provided via electronic networks, such as the Internet.</p>	
<p><b>Class 42</b>          Technological services and research and design; Design and development of computer hardware and software; Engineering services; Energy auditing; Development of energy and power management systems; Providing technical advice relating to energy-saving measures; Technological consultancy in the fields of energy production and use; Technological analysis relating to energy and power needs of others; Measurement and analysis of generator emissions; Installation, repair, overhaul and maintenance of computer software; Rental and leasing of computer software; Consultancy and information regarding the aforesaid services; The aforesaid services also provided via electronic networks, such as the Internet.</p>	

15. In *Gérard Meric v OHIM*,<sup>3</sup> the General Court (GC) stated that:

“29...goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by

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<sup>3</sup> Case T-133/05.

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”.

16. In *Canon*,<sup>4</sup> 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, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

17. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 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;

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<sup>4</sup> Case C-39/97.

(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.”

18. Terms in the respective specifications should be given their ordinary and natural meanings. In *YouView Ltd v Total Ltd*,<sup>5</sup> Floyd J stated:

“...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”.

19. I also bear in mind the comments of Jacob, J in *Avnet Incorporated v Isoact Limited*,<sup>6</sup> in which he stated:

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

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<sup>5</sup> [2012] EWHC 3158 (Ch) at [12].

<sup>6</sup> [1998] F.S.R. 16.

20. With regard to broad terms in specifications, I bear in mind *Sky v Skykick*,<sup>7</sup> in which 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. On the matter of complementarity, 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 GC 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”.

22. Moreover, in *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in

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<sup>7</sup> [2020] EWHC 990 (Ch).

circumstances where the nature and purpose of the respective goods and services are very different, e.g. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public is liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL-O-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

23. Whilst on the other hand:

“...it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

24. The opponent submits:<sup>8</sup>

“19. The Class 35 and 39 services applied for by the Applicant are either identical, similar or complimentary [sic] to the goods and services in respect of which the Opponent's Mark is registered.

20. For example, per the *Meric* principle, Class 35 services relating to ‘business management of a transportation fleet’ and ‘business management of a vehicle fleet’ in the Application are identical to the Opponent's Class 35 services relating to ‘business management’. This will result in a clear likelihood of confusion between the respective marks.

21. The remaining services in the Application are all either similar or complimentary [sic] to the goods and services for which the Opponent's

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<sup>8</sup> See the opponent's submissions in lieu of attendance at the hearing - filed 20 October 2022.

Mark is registered. This is because the respective goods and services all relate to the industrial provision and installation of energy, related machinery and/or apparatus, energy related research and analysis, and general business management and/or advertising in relation to these goods and services. Accordingly, the respective uses and users of the relevant goods and services, their physical nature and the trade channels through which they reach the market are either identical or similar to a high degree.”

25. The opponent has commented on the issue of similarity in broad terms and has only singled out one term in class 35 where it sees an example of similarity/identity, between the respective specifications. Other than that, it is silent on the comparison between goods and services, despite the bald assertion that all of the applicant's services are similar to the opponent's goods and services. I do not find these submissions helpful.

26. The applicant does not accept that the services covered by its application are similar to the goods and services contained in the opponent's specification, though Mr Fiddes accepted at the hearing that there are some notional areas in class 35 where there is similarity, for example, the business management services in class 35.

### **The application in class 39**

27. I will deal first with the application in class 39 which is for the following:

Arrangement of vehicle rental; booking of vehicle rental; contract rental of vehicles; rental of commercial vehicles, goods vehicles, land vehicles, motor land vehicles, motor road vehicles, motor vehicles, road vehicles, sports equipment (vehicles), transport vehicles, transportation vehicles, vehicle roof racks, vehicles, vehicles equipped with lifting platforms, vehicles for transportation; vehicle rental; arranging vehicle rental by means of the Internet; leasing, rental and hire services for motor vehicles; storage facilities for motor vehicles, parts and apparatus; vehicle breakdown recovery services; arranging vehicle breakdown recovery; commercial vehicle breakdown recovery; leasing, rental and hire of parts and fittings for

vehicles; leasing, rental and hire of vehicle tracking equipment; information, advice and consultancy services in relation to the aforesaid services.

28. In short, these services relate to rental of vehicles and vehicle parts, such as roof racks, as well as storage for motor vehicles and related parts. The specification also includes arranging vehicle breakdown recovery.

#### The opponent's goods in class 7

29. The opponent's goods in class 7 are machine tools, motors, transmissions and generators, specifically not for vehicles. I can see no area of similarity between these goods and the applicant's services in class 39. The rental of vehicles is a rental service, which is not similar to goods unrelated to the provision of that service. The applicant's goods neither enable the performance of the applicant's service, nor are they the subject of it, in a way which may give rise to a complementary relationship. I have considered the users, uses, nature and trade channels, which, coupled with the fact that these goods and services are not in competition nor complementary, leads to my finding these goods and services dissimilar to class 39 of the application.

#### The opponent's goods in class 9

30. The opponent's goods in this class are broadly solar and photovoltaic goods, power supplies, electrical control apparatus and software and data processing goods. The application in class 39 is for vehicle rental services, arranging breakdown cover and providing storage facilities for vehicles and their parts. Taking, for example, 'chargers for electric batteries' in the opponent's class 9 specification, the user will be someone wanting to charge an electrical item. The nature of the goods will be a cable or pack which plugs into an electrical source, with a plug or dock or other connecting element which attaches to the item to be charged. The users, use and nature of these goods is not similar in any way to the opponent's class 39 services of vehicle rental, storage services and arranging breakdown cover. These goods and services are not in competition, nor complementary, nor likely to share any trade channels. These goods are clearly dissimilar.

31. Having considered all of the relevant factors for all of the other goods in the opponent's class 9 specification, and in the absence of any helpful submissions on the

point, I can see no areas of similarity between the applied for services and the opponent's goods in class 9.

#### The opponent's services in class 35

32. The opponent's services in this class are for advertising, business management, business administration, business mediation services, office functions, marketing, arranging publicity events, consultancy and the provision of information about the aforementioned services. The opponent's services aim to enable the running of a business or the promotion of an undertaking, individual, service or product. In addition the opponent has business mediation services which are services which aim to settle disputes or foster agreement between businesses. These services have no obvious areas of similarity with the applicant's vehicle rental, arranging breakdown cover and storage services in class 39. I have considered all of relevant factors and find the opponent's services in class 35 dissimilar to the applicant's services in class 39.

#### The opponent's services in class 37

33. The opponent's services in this class are, put simply, installation, repair, overhaul and maintenance services for generators, batteries and other devices such as water purification systems. The applicant's services in class 39 are vehicle rental, storage services for vehicles and their parts and arranging breakdown cover. I have considered the core purpose of these services and having applied all of the relevant factors I find no areas of similarity between the opponent's services in class 37 and those of the applicant.

#### The opponent's services in class 40

34. The opponent's services in this class are broadly the rental and leasing of power units, generators, machine tools and a number of other items including, inter alia, lamp posts. Services in this class do not include rental of vehicles which is proper to class 39. The applicant has the rental of vehicles in its class 39 specification, along with vehicle and vehicle part storage and the arranging of breakdown cover. Whilst both parties' services include rental services, they relate to completely different types of goods. The user of the applicant's services will be a person wanting to hire a vehicle, for domestic or commercial purposes. The trade channels for such a hire are usually distinct, relating to vehicles and related parts. They would not normally include the



option to rent machine tools from the same undertaking as that providing a vehicle lease. It may be possible that a type of commercial vehicle (rented by the applicant), such as a towing vehicle, may use a type of machine tool rented by the opponent. But in the absence of any submissions from the opponent I am not prepared to find such a scenario to be likely enough that the average consumer would have been educated to expect both the rental of vehicles and the rental of machine tools to be provided by the same undertaking. The services are not in competition and given my comments above, are not complementary. I have considered the core purpose of these services and having applied all of the relevant factors I find no areas of similarity between the opponent's services and those of the applicant.

#### The opponent's services in class 42

35. The opponent's services in this class are technological services, research and design services, engineering services and include energy auditing and advice, the design and development of computer hardware and software, along with the rental, installation, repair, overhaul and maintenance of the same. The applicant's services in class 39 are vehicle rental, storage services for vehicles and their parts and arranging breakdown cover. I have considered the core purpose of these services and having considered all of the relevant factors I find no areas of similarity between the opponent's services and those of the applicant.

36. As some similarity of goods and services is an essential requirement of section 5(2)(b) of the Act, it follows that the opposition under 5(2)(b) must fail for the services listed in class 39 of the application.

#### **The application in class 35**

37. With regard to the application in class 35, Mr Fiddes, for the applicant, accepted some notional similarity between business management services in class 35 of the parties' specifications. In that class the applicant has the terms 'business management of a transportation fleet', 'business management of a vehicle fleet', 'provision of business management assistance' and 'provision of business management information'. The opponent has the broader term 'business management'. Clearly, the

applicant's terms are included within the opponent's broader term and in accordance with the principle in *Meric*, these are identical services.

38. Both parties also have the term 'office functions' in their specifications, which are also clearly identical.

39. The applicant's 'advertising services relating to the sale of motor vehicles' is clearly included within the opponent's broad term 'advertising' and is identical on the *Meric* principle.

40. The applicant's 'database management' and 'data management' services are services which can enable a business to organise its operation, for example, inter alia, keeping track of customers, stock, employees and running payment systems. Accordingly, it can be considered part of the broader business management term in the parties' specifications and is therefore identical in accordance with *Meric*.

41. The remainder of the terms in the application are retail services provided via the internet, a catalogue or in store. These include, broadly, the retail of vehicles, their parts and accessories. Many parts are listed and include, inter alia, vehicle charging devices and batteries as well as instruments, cables, encoded cards and card reading apparatus. The opponent's class 35 specification includes a term that covers a list of goods which includes some of the same items. However, the opponent's services are for business mediation<sup>9</sup> in the purchase and sale, import and export and wholesaling and retailing of, inter alia, batteries, motors and engines.

42. Business mediation services aim to settle disputes between parties. The list of items in the opponent's specification which follow that term simply reflect the subject matter for which such business mediation services are available. The applicant's services, on the other hand, are retail services which bring together a range of products from which the customer can select. The users of these services are different, one being a business seeking resolution of a dispute and the other being a customer wishing to use a retailer in order to purchase goods, in this case vehicles and related

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<sup>9</sup> My emphasis.

goods. The nature and purpose of the services is different. They are unlikely to reach the consumer by the same trade channels and are unlikely to be provided by the same undertaking, nor is one necessary for the other. In addition, they are not in competition. I find these services to be different.

43. I find it convenient, at this point in the decision, to proceed on the basis of the following services in class 35 of the application, which I have found to be identical to terms in the specification for the opponent's earlier mark. These are:

'Business management of a transportation fleet; business management of a vehicle fleet; database management; data management; provision of business management assistance; office functions; provision of business management information; advertising services relating to the sale of motor vehicles.'

#### **The average consumer and the nature of the purchasing act**

44. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade.

45. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*<sup>10</sup>, Birss J. (as he then was) described the average consumer in these terms:

"60. 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."

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<sup>10</sup> [2014] EWHC 439 (Ch)

46. The services in class 35 for which this opposition is proceeding are ‘Business management of a transportation fleet; business management of a vehicle fleet; database management; data management; provision of business management assistance; office functions; provision of business management information; advertising services relating to the sale of motor vehicles’. These services may be selected via a website or brochure or may involve a tendering process or at least a selection process when entering a contract for their provision. The purchasing process is likely to be primarily visual as first contact will likely be via a website or brochure. I do not discount the fact that there may be an aural element given that some of these services may be purchased as a result of recommendation.

47. Purchasers are more likely to be businesses and the purchase is more likely to be infrequent with a reasonable cost attached. Overall, in respect of the identical services, I find that the average consumer is more likely to be a business or professional than a member of the general public and will pay a higher than average level of attention to the purchase, though not the highest level.

### **Comparison of marks**

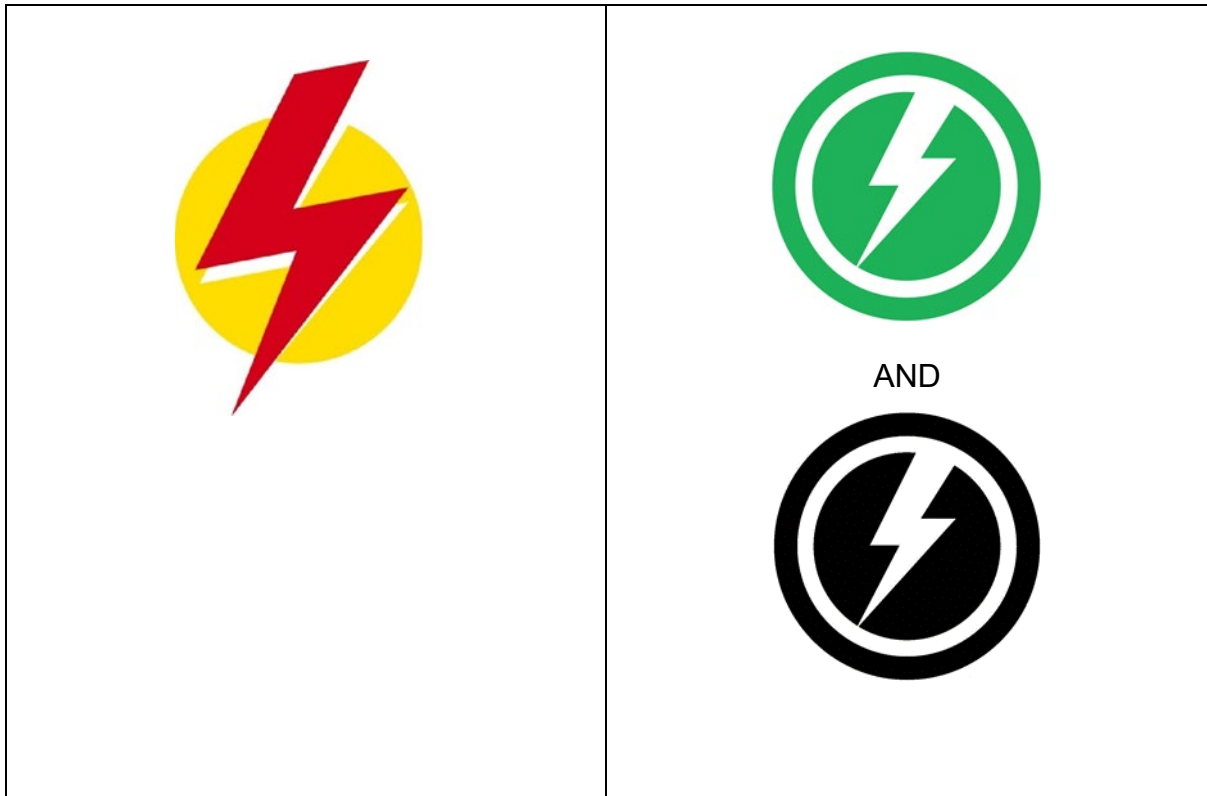
48. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components<sup>11</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

49. The marks to be compared are:

<b>Opponent</b>	<b>Applicant</b>
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<sup>11</sup> *Sabel v Puma AG*, para.23



50. I note that in its submissions the opponent says that “[t]he fact that the respective marks are different in colour is of no relevance, since it is common for a brand to use its marks in a variety of colours.”<sup>12</sup>

51. This is not strictly true in this case as the opponent has claimed the colours red, white and yellow when it applied for its trade mark and it is therefore limited to those colours.

52. It is the case that registration of a mark in black and white (such as the second mark in the applicant’s series) covers use of the mark in colour. However, given the nature of the mark (being one colour and white), fair and notional use of that mark would only allow use in one colour plus the white circle and flash/spark element. It is unlikely that it would extend to a three colour combination such as the red, yellow and white used for the opponent’s mark. However, this is not material to my decision, as I must assess the marks before me, including the potential range of fair and notional uses of those marks.

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<sup>12</sup> See the opponent’s submissions dated 20 October 2022, paragraph 12.

53. I will refer to the applicant's mark in the singular for the remainder of this decision. By this, I mean to include both marks in the series.

### **Overall impression**

54. The application is a series of two marks (hereinafter 'the applicant's mark'). Both are circular devices. The first is a green circle, inside which is a white circular line which sits equidistant from the outside edge of the circular mark. A flash or spark or lightning bolt emanates from the top of the white internal line and finishes at the bottom of that line. The black version of the mark appears in identical form to the green version with all of the green elements being shown in black in the second mark in the series. There are no word elements in the mark. The overall impression rests in the whole mark.

55. The opponent's mark is a red spark or lightening flash, edged in white on its right side and underneath the central horizontal line of the 'flash'. The white part takes the form of a dropped highlight. The flash device sits on top of a yellow circle which is considerably smaller than the flash part of the mark, with a quarter of the top of the flash extending above the circle and the bottom quarter of the flash extending below the circle. The 'crossbar' of the flash reaches from the left side of the circle across to the right side. The overall impression rests in the whole mark, but with the red lightning bolt playing a slightly larger role than the background yellow circle.

### **Visual comparison**

56. Visual similarity rests in the fact that both marks contain a circle and a spark/flash element. However, the configuration of those elements is different. In the application the flash or spark is smaller and is contained within the circular part of the mark, resulting in the whole mark being circular in form. The earlier mark has a considerably larger flash/spark element which extends beyond the circle on which it sits. The circle plays a smaller role in the whole than is the case with the application. Put simply, the application is a circular mark with a flash or spark contained within it. The earlier mark is a large flash/spark with a small circular background. I find the marks visually similar to a slightly lower than medium degree.

57. I make no aural comparison as there are no elements in either mark which would be articulated by the average consumer.

58. With regard to the conceptual comparison, both marks contain an image of a spark or flash and it is this which will provide the average consumer with the concept. To that extent, the marks are conceptually identical.

### **Distinctive character of the earlier mark**

59. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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* [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).”

60. The applicant in this case has provided submissions regarding the low level of distinctive character of a flash or spark trade mark for goods related to electricity, charging devices, batteries and so on. However, I must give a registered trade mark a degree of distinctive character, in accordance with the decision in *Formula One Licensing BV v OHIM*.<sup>13</sup> Furthermore, this part of the decision is made in respect of some of the applicant’s services in class 35. The opponent’s identical services are ‘business management, advertising and office functions’. For these services the opponent’s mark is a normal trade mark possessed of a medium degree of inherent distinctive character.

### **Likelihood of confusion**

61. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>14</sup> I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.

62. I have made the following findings:

- The average consumer is more likely to be a business or professional than a member of the general public and will pay a higher than average level of attention to the purchase, though not the highest level.
- The services are identical.
- The purchase will be primarily a visual one, though I do not rule out an aural element.

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<sup>13</sup> C-196/11P

<sup>14</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27



- The opponent's mark is visually similar to the applicant's mark to a lower than medium degree. An aural comparison cannot be made, due to both marks having no elements within them which will be articulated by the average consumer. The marks are conceptually identical.
- The earlier mark has a medium of inherent distinctive character for the relevant services in class 35.

63. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).

64. The high point of this case which may give rise to a likelihood of confusion is the fact that the parties' respective marks share a concept. However, I do not find that this is sufficient for an overall finding of a likelihood of confusion. The average consumer for the identical class 35 services is more likely to be a business than a member of the general public and is also likely to pay a higher than average degree of attention to the purchase of these services. The purchases are likely to have a primarily visual nature, as least at the outset when a business is selecting potential providers of these services, and, bearing in mind the visual differences between the respective marks which are not negligible, I find that the average consumer is not likely to be confused by mistaking one mark for the other. Furthermore, there is nothing about these trade marks which leads me to conclude that there would be indirect confusion. If that were the case I would expect to see some evidence of a common element which would lead the average consumer to believe there is relationship between the respective marks. Both marks contain a flash type device and a circle, but the exact configuration of these elements is somewhat different. They are presented in ways different from one another and not in a way that would suggest some sort of brand extension or development. In my view, an average consumer encountering one mark would, on encountering the other mark at some later point, simply conclude that two different undertakings are using circles and flashes in their respective brands.

65. Having found no likelihood of confusion for identical services in class 35 then it stands to reason that there will be no likelihood of confusion for services which possess a lower degree of similarity.

66. I have already found that the opposition against class 39 of the application failed due to there being no similarity between the applicant's services and any services contained in the specification of the earlier mark. However, even if I am found to be wrong on this point, any similarity can only be at a very low level and would not, for all of the reasons already provided, result in a finding of a likelihood of confusion.

## **CONCLUSION**

67. The opposition fails under section 5(2)(b) of the Act.

## **COSTS**

68. The opposition having failed, the applicant is entitled to a contribution towards its costs according to the scale of costs provided by Tribunal Practice Notice 2/2016. I have borne in mind that the applicant did not file evidence but did file submissions.

69. The award is as follows:

Preparing a counterstatement and considering the other side's statement:	£400
Considering the other side's evidence:	£500
Preparation for and attending a hearing	£800
Total:	£1800

70. I order Bredenoord Holding B.V. to pay Redde Northgate Plc the sum of £1800. This sum is to be paid within 21 days of the expiry of the appeal period or within 21

days of the final determination of this case if any appeal against this decision is unsuccessful.

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

**Al Skilton**

**For the Registrar,**

**The Comptroller-General**