

O/0221/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003679108

BY NINGBO NANYANG VEHICLE CO., LTD

TO REGISTER THE TRADE MARK:

yoyo sister

IN CLASS 12

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 429706 BY

BABYZEN

BACKGROUND AND PLEADINGS

1. On 9 August 2021, NINGBO NANYANG VEHICLE CO., LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 19 November 2021 and registration is sought for the following goods:

Class 12 Bicycles; Bicycle frames; Electric bicycles; Tricycles; Trolleys; Safety seats for children, for vehicles; Electric vehicles; Delivery bicycles; Baskets adapted for bicycles; Push scooters [vehicles].¹

2. On 22 December 2021, the application was opposed by BABYZEN (“the opponent”) based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under both sections, the opponent relies upon the following trade mark:

YOYO

UKTM no. 909857061

Filing date 31 March 2011; registration date 5 September 2011

Relying on all goods for which the mark is registered, namely:

Class 12 Buggies; Pushchair hoods; Strollers; Perambulators; Carrycots.

3. Under section 5(2)(b), the opponent claims that the marks are similar and the goods are identical or similar, meaning that there is a likelihood of confusion.

4. Under section 5(3), the opponent claims a reputation in relation to all of the goods listed above. The opponent claims that use of the applicant’s mark would, without due cause, be detrimental to the reputation of the earlier mark.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark.

¹ On 28 March 2022, the applicant filed a Form TM21B to amend their application to remove “pushchairs” and “pushchair covers” from their specification.

6. The applicant is represented by Pawel Wowra and the opponent is represented by Dehns.

7. Only the opponent filed evidence. Neither party requested a hearing, and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

8. The opponent filed evidence in the form of the witness statements of Sebastian Blanc dated 3 August 2022 and Philip Dean Towler dated 23 August 2022. Mr Blanc is the Product Development Manager for the opponent, a position he has held since 2015. His statement is accompanied by 21 exhibits. Mr Towler is a Chartered Trade Mark Attorney acting on behalf of the opponent in these proceedings. His statement was accompanied by 5 exhibits.

9. The opponent filed written submissions in lieu dated 12 December 2022.

10. I have taken the evidence and submissions into account in reaching this decision.

RELEVANCE OF EU LAW

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

DECISION

Section 5(2)(b)

12. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

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

13. Section 5A of the Act is as follows:

“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.”

14. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. The earlier mark had completed its registration process more than 5 years before the application date of the mark in issue and, consequently, is subject to proof of use.

Proof of use

15. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“(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.”

16. Section 100 of the Act states that:

“100. 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.”

17. As the earlier mark is a comparable mark, 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. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date of the application in issue i.e. 10 August 2016 to 9 August 2021.

19. 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 Bunderversammlung 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 Marken 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].”

20. 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 or services protected by the mark” is, therefore, not genuine use.

21. I note the following from the opponent’s evidence:

- a) The following are displayed on the opponent’s website during the relevant period:²

² Exhibit SB1



YOYO+ board it all becomes easy...



YOYO², now strolling with its bassinet.

- b) The word YOYO has appeared on prams and hoods for prams during the relevant period.³
- c) The opponent's YOYO goods have been sold through retailers including Harrods, John Lewis, JoJo Maman Bebe, Mamas & Papas and Boots during the relevant period. Mr Blanc confirms that 150 retailers have stocked their goods during the relevant period.

[REDACTED]

[REDACTED]

[REDACTED]

e) UK specific sales are as follows:

Year	No. of Products Sold	Sales Revenue (EUR)
2016	25,152	1,297,459
2017	53,777	3,143,466
2018	80,251	4,310,783
2019	106,138	5,420,509
2020	107,228	4,870,022
2021	42,825	1,852,550
TOTAL	415,371	20,894,789

³ Exhibit SB4

This includes bassinets as well as strollers and prams.

- f) The bassinet provided by the opponent under the YOYO mark appears to be a form of carrycot.⁴
- g) Invoices dated between 2013 and 2018 are addressed to recipients in the UK and across the EU (for example, in Spain, France and Belgium).⁵ These support the sales figures set out above and display the YOYO mark. They include goods such as car seats, strollers and attachments.
- h) The opponent has advertised its goods in various UK publications.⁶
- i) The opponent's advertising expenditure for goods bearing the earlier mark in the EU is as follows:

Year	Advertising Expenditure (EUR)
2015	118,788
2016	171,361
2017	189,525
2018	157,974
TOTAL	637,648

22. I am satisfied that there has been use of the opponent's mark as registered. Clearly, there have been significant sales in the UK and EU during the relevant period. There has been clear investment in advertising the mark, and goods have been advertised in UK publications. Use of the mark has been geographically widespread, with sales made in the UK and across various EU countries. I note that there has been use of the opponent's mark in relation to car seats. However, these goods are not covered by its specification. In my view, there has clearly been genuine use in relation to prams, carrycots and buggies, including hoods for those goods.

⁴ Exhibit SB10

⁵ Exhibit SB11

⁶ Exhibit SB12

23. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

24. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

25. The earlier mark is registered for "Buggies; Pushchair hoods; Strollers; Perambulators; Carrycots". The opponent has used the mark for all of the goods identified above and can, therefore, retain those terms.

Section 5(2)(b) – case law

26. 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 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 greater 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

27. The competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 12</u> Buggies; Pushchair hoods; Strollers; Perambulators; Carrycots.	<u>Class 12</u> Bicycles; Bicycle frames; Electric bicycles; Tricycles; Trolleys; Safety seats for children, for vehicles; Electric vehicles; Delivery bicycles; Baskets adapted for bicycles; Push scooters [vehicles].

28. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 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."

29. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

30. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

31. I note that the opponent has referred to various decisions of the EUIPO in its written submissions. These decisions are not binding upon me, but I have taken them into consideration in reaching my decision.

Safety seats for children, for vehicles

32. The opponent submits as follows:

“9. Turning to the comparison of goods, the Applicant’s “*Safety seats for children, for vehicles*” are identical to the Opponent’s goods, for the simple reason that that [sic] prams, strollers and carrycots are often designed so as to be convertible into an infant’s car seat.” (original emphasis)

33. I disagree. Whilst I accept that the goods may be sold together and that one may have an attachment for the other, this does not make the goods themselves identical. I note that travel systems often include pram frames which can be adapted to fit a car seat attachment, but this means that they are usable together, rather than that they are the same goods. I agree with the opponent that the goods are likely to be sold through the same trade channels as the opponent’s “buggies”. In my experience, it is common for these goods to be sold as a package and are often sold by the same businesses. My view on this is fortified by the opponent’s evidence. The users will clearly be the same i.e. members of the public with young children. The nature of the goods overlaps to the extent that both typically take the form of seats, although they will differ in that a buggy is typically on a frame with wheels, whereas a car seat has a fitting for being attached to the seat of a car. The purpose of the goods will overlap at a high level i.e. to carry a child from one place to another, but the specific purposes will differ as the car seat has a safety aspect for ensuring a child is protected in the case of a road traffic accident. The method of use will overlap, in that children are typically seated and strapped into both, although, again, the fact that one is on wheels and the other is for use in the car will result in a difference here. These goods are not in competition and I do not consider them to be complementary. Taking this into account, I consider the goods to be similar to between a medium and high degree.

Bicycles; tricycles; push scooters [vehicles]

34. The opponent submits as follows:

“12. In respect of “*Bicycles*”, “*Tricycles*” and “*Push scooters [vehicles]*”, it is submitted that these goods can be considered identical to the Opponent’s prams/strollers, in accordance with the principle established in *Meric*, on the basis that many models of strollers include pulley, cycle and/or scooter elements for infants, and are convertible into such goods as the child grows.”

35. I note that the opponent’s evidence shows a tricycle that converts from being pushed by a parent when the child is young, to being capable of being ridden by the child independently when they are older and, subsequently, converts to a bicycle.⁷ However, this is not, in my view, a stroller that converts to a tricycle, it is a tricycle that is capable of being pushed or rode independently. I also note the following products:



The first is a buggy board which converts into a scooter. This is a board that attaches to a buggy for older children to stand on. The second is, essentially, a three wheeled pushchair with handlebars for the child to hold onto. Whilst I recognise that there may be products such as this on the market, which cross boundaries from one product to another, I have to assess the terms in the parties’ specifications on their ordinary

⁷ Exhibit PDT3

meaning. The evidence before me does not go far enough, to persuade me that these are anything other than unusual examples. I do not consider that these goods can be considered identical on the ordinary meaning of the terms. The opponent continues:

“13. In the event that [these goods] are not considered identical to the Opponent’s goods, the alternative submission is that they are highly similar because:

- i. For those strollers/buggies that include pulley, cycle and/or scooter elements, the manufacturer is the same, there is a common nature, purpose and method of use between these goods, and they are to that extent complementary, and
- ii. Even for strollers/buggies which do not have these features, they are nevertheless still similar to bicycles, tricycles and scooters because all of these goods are means of transport fitted with wheels that are used for transporting people and/or goods. As well as sharing a common nature and purpose, all of these goods are for use by children and infants, and so have the same target public (parents/guardians) and trade channels (baby and nursery shops, as well as shops selling travel/transportation articles and toys). [...].”

I also note that the opponent has provided evidence of two retailers (Halfords and Smyths) which sell both bicycles and prams.⁸

36. I accept that there may be some (limited) overlap in trade channels where the applicant’s goods are specifically aimed at children, as some businesses which sell a range of goods may sell children’s bicycles and scooters, as well as prams. However, the businesses referred to by the opponent are businesses which tend to sell the products of others, and I consider it unlikely that the specific businesses that produce these goods will overlap. The nature of the goods will overlap to the extent that both have wheels. However, they otherwise differ, with one being a seat or carrycot style

⁸ Exhibit PDT4

attachment to a frame with wheels and the other having a seat or standing platform and handlebars. The method of use of the goods will differ, as the applicant's goods are intended to be ridden by a (typically older) child, whereas the opponent's goods are for a child to sit/lie in and be pushed by an adult. The purpose of the goods will overlap to the extent that both are means of transport, but they differ to the extent that the applicant's goods are typically intended for the entertainment/exercise of children, whereas the opponent's goods are purely functional. The user of the goods will overlap to the extent that both may be purchased by parents/guardians of children. I do not consider these goods to be in competition or complementary. Taking all of this into account, I consider the goods to be similar to a low degree.

Electric bicycles; Delivery bicycles

37. The opponent submits as follows:

“15. By extension of the above arguments [...] [these goods] are also similar to the Opponent's strollers/buggies, since these are both a sub-set of bicycles, and could again be for use by children. Further, page 6 of PDT4 shows that Halfords sells electric bikes, thus proving that the trade channels for these goods are the same as those for strollers (shown on page 1 of Exhibit PDT4) – on the one hand, the Opponent and the Applicant's goods are all in the field of transportation and so will be sold via shops in this commercial field; and on the other hand, insofar as the Opponent and the Applicant's goods could all be for use by children/infants, they are sold via shops specialising in these types of products.”

38. In my view, “delivery bicycles” are not goods which would be used by children. They are clearly bicycles intended for carrying out deliveries, and so I think it unlikely that they will be aimed at the children's market. Similarly, I am not convinced that children would use “electric bicycles”. Consequently, any overlap in trade channels is likely to be even more distant than identified above. I note the opponent's submission regarding Halfords selling prams and electrical bicycles, but Halfords are a retailer that sell a range of goods and services. For example, they also provide MOT services; the mere fact that Halfords sell these services and prams does not make the goods and

services similar. I accept that both goods could be purchased by members of the general public. The method of use and purpose of the goods will differ, and in the case of electric bicycles, there will be the additional difference in nature of one being electric and the other not. The goods are not in competition nor complementary. Taking all of this into account, I consider the goods to be dissimilar.

Bicycle frames; Baskets adapted for bicycles

39. The opponent submits as follows:

“The above is also true of the Applicant’s related accessories [...] which it is submitted are also similar to the Opponent’s goods. As above, these goods have the same target public, can all be for use by children, and have the same trade channels – page 5 of Exhibit PDT4 shows that bicycle accessories such as baskets are sold by Halfords, which also sells strollers (per page 1 of Exhibit PDT4). Moreover, just as bicycles can be sold in the form of frames, seats, and accessories, so too are strollers – for instance, the sales revenue information provided at Paragraph 11 of the Witness Statement of Sebastian Blanc and the accompanying images in Exhibit SB9 illustrate that, when buying a stroller, consumers purchase a frame, a seat/bassinet compatible therewith, as well as related accessories (such as carry bags, covers, and so on). Accordingly, a ‘stroller’ which includes a stroller frame, which has a similar nature, purpose and method of use (as well as common trade channels, as above) to a bicycle frame. Bicycle baskets can also be fixed on to other transportation devices, such as strollers and buggies, in order to carry different goods. There is therefore some complementarity between these products.”

40. In my view, the same findings regarding trade channels apply as set out above. I accept that there could be an overlap in user as both could be purchased by members of the general public (specifically those with young children, to the extent that the applicant’s goods could be aimed at the children’s market). These are parts or accessories for bicycles. Consequently, there is no overlap in nature, purpose or method of use. The goods are not in competition. I note that the opponent submits that they are complementary, because one could be used with another. However,

complementarity arises where goods are important or indispensable for each other. I do not consider that the fact that a user might attach a basket intended for use with a bicycle to another item (i.e. a pram) gives rise to complementarity. In my view, the goods are dissimilar.

Electric vehicles

41. In relation to these goods, the opponent makes the same submissions as set out above in relation to electric bicycles. For the same reasons, I consider the goods to be dissimilar on that basis. I have also considered the opponent's submission that:

“[...] Further, it should be noted that ‘vehicles’ is a broad term, being something used to transport people or goods. Accordingly, insofar as strollers/buggies are goods used for the transportation of children and infants, electric vehicles include (and so are identical to) e-strollers (i.e. electric strollers and buggies), which in turn are a sub-set of the Opponent's goods.”

42. I have no evidence before me as to the existence of e-strollers but, in any event, I do not consider that strollers and buggies would be considered ‘vehicles’ on the ordinary meaning of the terms. Taking all of this into account, I consider the goods to be dissimilar.

Trolleys

43. The opponent submits as follows:

“17. Trolleys are frames on wheels used for transportation purposes, and thus have a common nature, purpose and method of use as strollers/pushchairs (which also consist of a chassis/frame on wheels, used for the transport of infants and babies).”

44. In my view, these goods clearly differ in purpose (one is typically used to carry goods, and the other infants). There will be some overlap in nature, only to the extent that they both have wheels. They can both be pushed, but that is where any similarity

in method of use ends. The user will be the same i.e. members of the general public. The trade channels will, in my view, be different. There is no competition or complementarity. Taking all of this into account, I consider the goods to be dissimilar.

The average consumer and the nature of the purchasing process

45. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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*, [2014] EWHC 439 (Ch), Birss J 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

46. The average consumer for the goods will be a member of the general public, with young children. The goods will be reasonably costly and relatively infrequent purchases. For bicycles and prams, the user might consider the weight, aesthetics and durability of the goods. For car seats, the safety of the baby is likely to be a key consideration meaning that a high degree of attention will be paid during the purchasing process. For the other goods, the level of attention paid will be at least medium, although it may be higher.

47. The goods are likely to be selected from physical retail premises or their online equivalents. Consequently, the marks are likely to be encountered on signage and packaging. The purchasing process will, therefore, be predominantly visual. However, given that advice may be sought from retail assistants, I do not discount an aural component.

Comparison of trade marks

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

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

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

50. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
YOYO	yoyo sister

51. The opponent's mark consists of the word YOYO. There are no other elements to contribute to the overall impression of the mark, which lies in the word itself. The

applicant's mark consists of the words YOYO SISTER, presented in a lower case font. The overall impression of the mark lies in the words themselves.

52. Visually, the marks coincide to the extent that the opponent's mark appears as the first word in the applicant's mark. The addition of the word SISTER to the end of the applicant's mark is a point of visual difference. I do not consider that the font used in the applicant's mark will be a point of difference, because the opponent's mark could be used in any standard typeface. Taking all of this into account, I consider the marks to be visually similar to between a medium and high degree.

53. Aurally, the word YOYO will be pronounced identically in both marks. The word SISTER in the applicant's mark will be given its ordinary English pronunciation and will act as a point of aural difference. Taking this into account, I consider the marks to be aurally similar to between a medium and high degree.

54. Conceptually, the word YOYO is likely to be seen as referring to the popular toy. The meaning will be the same in both marks. The word SISTER has a number of different meanings in the English language. Whichever meaning is attributed to it, it will act as a point of conceptual difference. Consequently, I consider the marks to be conceptually similar to between a medium and high degree.

Distinctive character of the earlier trade mark

55. 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 Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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).”

56. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

57. The earlier mark consists of the word YOYO. This is an ordinary dictionary word which have no link with the goods in issue. Consequently, I consider the earlier mark to be inherently distinctive to a medium degree.

58. The relevant market for assessing enhanced distinctive character is the UK market. In addition to the evidence above which relates to the UK market, I note the following:

- a) The website naturalbabyshower.co.uk from 2017 states “the YoYo is the most incredible stroller ever imagined. It’s worldwide famous for its record-breaking compactness, its magic folding and sleek design [...]”.⁹
- b) An article on a3babybarn.co.uk from 2016 states “If there is one thing all my mummy friends are raving about this summer, it’s the Babyzen YOYO. I can’t

⁹ Exhibit SB8

seem to go to a playgroup or coffee morning without someone declaring their undying love for the lightweight stroller”.¹⁰

- c) The opponent engaged in a promotional give away in 2018 through UK magazine “B”.¹¹
- d) The YOYO stroller has won various awards including Best Buggy/Pushchair in October 2021 (as voted for by 90,000 people), GOLD award for the Lightweight Buggy category at the Made For Mums Awards 2019 (a UK-based award), Shortlisted for Most Compact Pushchair in the Made For Mums Awards 2018, GOLD for Best Travel Pram in the Project Baby Magazine Awards 2017, GOLD for Best Innovative Stroller at the Loved By Parents Awards 2017 and GOLD for Best Luxury Stroller in the 2016 Best Baby & Toddler Gear Awards by Mumii UK.¹²

59. I recognise that the opponent’s advertising expenditure is not particularly high. However, there are reasonable sales figures and a number of awards have been won. Consequently, I consider the distinctive character of the mark has been enhanced to between a medium and high degree through use in relation to prams.

Likelihood of confusion

60. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertaking being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is 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 goods and vice versa. As I mentioned

¹⁰ Exhibit SB8

¹¹¹¹ Exhibit SB13

¹² Exhibit SB14

above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

61. I have found as follows:

- a) The goods vary from being similar to between a medium and high degree to similar to a low degree (except where I have found them to be dissimilar).
- b) The average consumer for the goods is a member of the general public who will pay at least a medium degree of attention during the purchasing process (although for some of the goods the level of attention will be higher).
- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The marks are visually, aurally and conceptually similar to between a medium and high degree.
- e) The earlier mark is inherently distinctive to a medium degree, which has been enhanced through use to between a medium and high degree.

62. I do not consider it likely that the average consumer will overlook the additional word SISTER in the applicant's trade mark. Consequently, I do not consider that the marks will be mistakenly recalled or misremembered as each other. However, given that one of the meanings of the word SISTER is something that is connected in some way to something else, I consider it likely that the marks will be viewed as indicating a connected product range sold under the YOYO brand. This will result in a likelihood of indirect confusion. In my view, this will apply to those goods that I have found to be similar to between a medium and high degree. Where the goods are similar to only a

low degree, I consider that the differences between the goods will offset the similarity of the marks and avoid confusion arising.

63. The opposition based upon section 5(2)(b) succeeds in relation to “safety seats for children, for vehicles” only.

Section 5(3)

64. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

65. Section 5(3A) of the Act states:

“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.”

66. As the earlier trade mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union”.

67. 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’Oreal v Bellure and 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 Saloman, 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'Oreal 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'Oreal v Bellure*).

68. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark and the applicant's mark are similar. Secondly, the opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a

significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Finally, and assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be 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.

69. I can deal with this ground relatively swiftly. I consider that the opponent's evidence shows a modest reputation for prams for the same reasons set out above. However, I do not consider that the opponent's section 5(3) claim would put it in any stronger position than it is under section 5(2)(b). That is because, even if it could establish the requisite link, it has only pleaded two heads of damage i.e.:

- a) That the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks; and
- b) "The Applicant's use of a sign containing 'YOYO' as a distinctive part thereof for the goods of the opposed application could damage the reputation enjoyed by the Opponent in its trade mark if those goods are of inferior quality. This is particularly relevant for products aimed at babies, infants and children, since the safety requirements for such goods are high. The Opponent would not have any control over the quality of the Applicant's goods, and its reputation would be harmed if consumers came to associate the sign 'YOYO' with low quality products."

70. I note that in its written submissions in lieu, the opponent has referred to other categories of damage, but as these have not been pleaded, it is not open to me to consider them.

71. Given the distance between the goods for which I have found no likelihood of confusion, I do not consider there to be a risk of the relevant public believing that there is an economic connection between the users of the marks. Consequently, I do not consider that the first head of damage pleaded takes the opponent's case any further than its section 5(2)(b) ground.

72. The second head of damage pleaded is ill-conceived. I am mindful of the decision of Ms Anna Carboni, sitting as the Appointed Person in *United The Union v The Unite Group Plc*, Case BL O/219/13, in which she considered whether a link between an earlier mark with a reputation and a later mark with the mere potential to create a negative association because of the identity of the applicant or the potential quality of its goods/services was sufficient to found an opposition based on detriment to reputation. She stated:

“46. Indeed, having reviewed these and other opposition cases, I have not found any in which the identity or activities of the trade mark applicant have been considered in coming to a conclusion on the existence of detriment to repute of an earlier trade mark. I can understand how these matters would form part of the relevant context in an infringement case, but I have difficulty with the notion that it should do so in an opposition. After all, many, if not most, trade mark applications are for trade marks which have not yet been used by the proprietor; some are applied for by a person or entity that intends to license them to a third party rather than use them him/itself; and others are applied for by an entity that has only just come into existence.

47. I do not exclude the possibility that, where an established trading entity applies to register a mark that it has already been using for the goods or services to be covered by the mark, in such a way that the mark and thus the trader have already acquired some associated negative reputation, perhaps for poor quality goods or services, this fact might be taken into account as relevant “context” in assessing the risk of detriment to repute of an earlier trade mark. Another scenario might be if, for example, a trade mark applicant who was a known Fascist had advertised the fact prior to the application that he was launching a new line of Nazi memorabilia under his name: I can see how that

might be relevant context on which the opponent could rely if the goods and services covered by the application appeared to match the advertised activities. But I would hesitate to decide an opposition on that basis without having had confirmation from a higher tribunal that it would be correct to take such matters into account.”

73. Consequently, I do not consider that this line of argument can succeed. In any event, there is no evidence before me that the applicant has been trading prior to the relevant date, nor is there evidence to suggest that its goods are of inferior quality or have acquired a negative reputation. Consequently, I do not consider that this head of damage could take the opponent’s case any further.

CONCLUSION

74. The opposition is successful in relation to the following goods for which the application is refused:

Class 12 Safety seats for children, for vehicles.

75. The opposition is unsuccessful in relation to the following goods for which the application may proceed to registration:

Class 12 Bicycles; Bicycle frames; Electric bicycles; Tricycles; Trolleys; Electric vehicles; Delivery bicycles; Baskets adapted for bicycles; Push scooters [vehicles].

COSTS

76. The applicant has enjoyed the greater degree of success and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I have applied what I consider to be an appropriate reduction for the only partial success. In the circumstances, I award the applicant the sum of **£725**, calculated as follows:

Preparing a Counterstatement and considering the Notice of Opposition	£275
Considering the opponent's evidence	£450
Total	£725

77. I therefore order BABYZEN to pay NINGBO NANYANG VEHICLE CO., LTD the sum of £725. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 1st day of March 2023

S WILSON
For the Registrar