

O/0627/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003663442

BY ZERO PLASTIC LTD

TO REGISTER THE FOLLOWING TRADE MARK:

ZerØ

IN CLASSES 5, 8, 16, 21, 35 AND 39

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 430220

BY CUPCLUB LIMITED

BACKGROUND AND PLEADINGS

1. On 2 July 2021, Zero Plastic 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 15 October 2021, and registration is sought for the goods and services set out in Annex 1 to this decision.¹

2. On 14 January 2022, the application was partially opposed by Cupclub Limited (“the opponent”) based upon section 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at those goods and services underlined in Annex 1 to this decision. The opponent relies upon trade mark no. 3571101 for the sign **ZERØ**, which was filed on 22 December 2020 and registered on 4 June 2021. The opponent relies upon some of the goods and services for which the earlier mark is registered, as set out in Annex 2 to this decision.

3. The opponent claims that the marks are identical and that the goods and services are similar or identical, with the result that there is a likelihood of confusion.

4. The applicant filed a counterstatement denying the claims made.

5. The applicant is unrepresented and the opponent is represented by Bird & Bird.

6. Neither party filed evidence. The opponent filed written submissions during the evidence rounds dated 28 November 2022. Neither party requested a hearing, and neither filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

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 upon

¹ The applicant’s specification has been restricted following the filing of multiple TM21Bs.

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.

PRELIMINARY ISSUE

8. The applicant points to the differing target markets/strategies of the respective parties, and submits that this will prevent a likelihood of confusion. For the avoidance of doubt, I must carry out a notional assessment based upon the parties' respective marks and their specifications. The actual activities carried out by the parties are not relevant to my assessment.

DECISION

9. Section 5(2)(a) of the Act states:

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

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

(b) [...]

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

10. 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.”

11. 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. As the earlier mark had not completed its registration process more than 5 years before the date of the application in question, it is not subject to proof of use pursuant to section 6A of the Act.

12. 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.

Identity of the marks

13. The marks to be compared are as follows:

Opponent's mark	Applicant's mark
ZERØ	ZerØ

14. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

15. The applicant denies that the marks are identical, submitting as follows:

“a. Different spelling.

Zero Plastic Ltd’s application is for “ZerØ”, that is, spelt with the ‘Empty-Set Symbol’ from mathematics (Unicode U+2205), in place of the English letter ‘o’. Whereas the Opponent uses the vowel “Ø” from the Dano-Norwegian alphabet (Unicode U+00D8). These are two distinct symbols. Hence, the marks are spelt with distinct symbols. (The Opponent misrepresented the Applicant’s mark, in their answer to Q5, of their TM7 form).

b. Conceptually different.

The empty-set, from mathematics, is the only set containing no elements and thus is the only set with a cardinality of zero. Whereas the Dano-Norwegian alphabet vowel is a close-mid front rounded vowel with pronunciation “OE”. These symbols are clearly conceptually distinct and are from very different origins. The use of conceptually distinct symbols imparts a difference in meaning to the marks. Further difference also arises from the referencing of two very different origins of the respective symbols, and subsequent associations with set-theory (Applicant’s mark) and the Dano-Norwegian cultures, their languages and pronunciations (the Opponent’s mark).

c. Aurally different.

The Dano-Norwegian vowel has a distinct, well-defined and well-accepted pronunciation, [...]

Thus, from its spelling, the opponent's mark is pronounced "ZerOE", which is clearly phonetically and aurally distinct to the mark Zero Plastic Ltd is applying for, which has no such phonetic definition."

16. I disagree that the average consumer will view these as different symbols. The differences between them are so insignificant that they would, in my view, go unnoticed by the average consumer. In any event, I do not consider that the average consumer would identify either of the meanings set out by the applicant. The average consumer may recognise that the parties have swapped the letter O for a letter from another language or may simply view the strike through as stylisation. At best, the marks will be seen as differing in their casing; the earlier mark is presented all in upper case, whereas the applicant's mark is presented with the first and last letters in capitals, and the middle letters in lower case. In my view, the differences in casing are so insignificant that they would go unnoticed by the average consumer and the marks are identical.

Comparison of goods and services

17. I have included only those goods and services identified by the opponent as their best case in the table below. With that in mind, the competing goods and services are as follows:

Opponent's goods and services	Applicant's goods and services
<u>Class 21</u> Reusable containers.	<u>Class 21</u> Tooth brush cases.
<u>Class 35</u> Customer services for commercial, promotional and/or advertising purposes; assistance in product	<u>Class 35</u> Online ordering services; Providing online marketplaces for sellers of goods and or services; none of the

<p>commercialization, within the framework of a distribution arrangement.</p>	<p>aforementioned services being in connection with or relating to cosmetics, beauty preparations, beauty kits, cosmetic wipes, cosmetic bags, make up, make up utensils, make up applicators, toilet preparations, skin care preparations, nail care preparations, hair care preparations, hair care preparations or related goods.</p>
<p><u>Class 39</u> Delivery and distribution of reusable consumer packaging; packaging services.</p>	<p><u>Class 39</u> Warehouse storage; Warehouse storage services; Storage of goods in warehouses; Goods warehousing; Goods (Delivery of -); Delivery of goods; Warehousing of goods; Shipping of goods; Transport of goods; Storage of goods; Warehousing of finished goods; Arranging transportation of goods; Delivery [distribution] of goods; Wrapping and packaging of goods; Packaging and storage of goods; Distribution [transport] of retail goods; Delivery of goods by mail order; Arranging and conducting of mail order delivery services.</p>

18. When making the comparison, all relevant factors relating to the goods and 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.”

19. 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.

20. 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.”

Class 21

21. Collins Dictionary describes a ‘case’ as “a container that is specially designed to hold or protect something”.² Consequently, I agree with the opponent that the applicant’s “tooth brush cases” is identical on the principle outlined in *Meric* to “reusable containers” in the opponent’s specification.

Class 35

22. In relation to the applicant’s class 35 services, the opponent identifies “customer services for commercial, promotional and/or advertising purposes” and “assistance in product commercialization” as its best case. It submits:

“[These services] are equivalent and similar to those covered by the Application: customer services for commercial purposes are provided as part of an online marketplace for sellers of goods, and also in connection with online ordering services. Marketplaces also operate as a means by which seller can commercialise their products, coinciding with the second underlined term.”

23. The opponent’s customer services are services that are provided by a company to its customers. Product commercialization is the process of bringing a product to the market. I do not consider either of these to be the same as “online ordering services” or “providing online marketplaces for sellers of goods and or services”. I accept that there may be some overlap in user. However, the nature, purpose and method of use of the services differ. I accept that there may be an overlap in trade channels. Consequently, I consider the services to be similar to a low degree.

²² <https://www.collinsdictionary.com/dictionary/english/case>

Class 39

24. The applicant's "goods (delivery of -)", "delivery of goods", "shipping of goods", "transport of goods", "arranging transportation of goods", "delivery [distribution] of goods", "distribution [transport] of retail goods", "delivery of goods by mail order" and "arranging and conducting of mail order delivery services" in the applicant's specification are all identical on the principle outlined in *Meric* to "delivery and distribution of reusable consumer packaging" in the opponent's specification.

25. "Warehouse storage", "Warehouse storage services", "Storage of goods in warehouses", "Goods warehousing", "Warehousing of goods", "Storage of goods" and "Warehousing of finished goods" in the applicant's specification overlap in trade channels with "delivery and distribution of reusable consumer packaging" and "packaging services" because the same businesses that offer packaging and delivery services may also offer businesses the option to store their goods whilst waiting for them to be purchased and packed/shipped. There will clearly be an overlap in user. The method of use, nature and purpose of the services differ. However, they may be complementary. Taking all of this into account, I consider the services to be similar to a medium degree.

26. In reaching this finding I have borne in mind the applicant's submission that the inclusion of the words "finished goods" in some of the terms listed above is sufficient to draw a distinction. I disagree; the opponent's services are not limited and, in any event, the same overlap would exist as set out above. Consequently, I dismiss this line of argument.

27. The applicant's "wrapping and packaging of goods" and "packaging and storage of goods" will either be identical on the principle outlined in *Meric* or similar to a medium degree to "packaging services", because even where the applicant's services are storage/wrapping services (rather than packaging services) they will overlap for the same reasons set out above.

Average consumer and the nature of the purchasing act

28. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services 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 (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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

29. The average consumer for the goods and services will be a member of the general public or a business user. The frequency of purchase is likely to vary, but the goods will not be particularly expensive. The services may attract a higher cost, but would not be at the highest end of the scale. Various factors will be taken into account such as materials, aesthetics and functionality for the goods and suitability for particular requirements and efficiency for the services. Consequently, I consider that a medium degree of attention will be paid during the purchasing process, although I recognise that it may be slightly higher for the services (particularly where they are purchased in the course of the user's business).

30. The goods and services are likely to be purchased following perusal of signage on websites, on advertisements and physical premises. Consequently, I consider the purchasing process to be predominantly visual. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants and word-of-mouth recommendations may be made.

Distinctive character of the earlier mark

31. 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).”

32. 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 and services, 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.

33. The opponent has not pleaded that the distinctiveness of the earlier mark has been enhanced through use, nor has it filed any evidence to support such a claim. Consequently, I have only the inherent position to consider. The opponent’s mark

consists of the word ZERØ, which is an ordinary dictionary word, albeit the O has a diagonal strikethrough which some may recognise as a letter used in other languages, but most will just view as stylisation. In relation to goods and services with an emphasis on reusable materials/goods, this is likely to be seen as a reference to zero waste. In those circumstances, the earlier mark will have a low degree of inherent distinctive character. In relation to other goods/services, which are not related to reusability/zero waste, it will have a medium degree of inherent distinctive character.

Likelihood of confusion

34. 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 and services down to the responsible undertakings 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 goods and services may be offset by a greater degree of similarity between the marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services 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.

35. I have found as follows:

- a) The goods vary from being similar to a low degree to identical.
- b) The average consumer is a member of the general public or a business user, who will pay at least a medium degree of attention during the purchasing process (although it may be slightly higher for some of the services).

- c) The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.
- d) The marks are identical.
- e) The earlier mark is inherently distinctive to a low degree or a medium degree, depending upon the goods and services.

36. Taking all of the above factors into account, I consider that the marks are likely to be mistakenly recalled or misremembered as each other. Consequently, there is a likelihood of direct confusion in relation to all of the goods and services that I have found to be similar.

37. Consequently, the opposition succeeds in its entirety.

CONCLUSION

38. The opposition is successful and the application is refused for the following goods and services:

Class 21 Tooth brush cases.

Class 35 Online ordering services; Providing online marketplaces for sellers of goods and or services; none of the aforementioned services being in connection with or relating to cosmetics, beauty preparations, beauty kits, cosmetic wipes, cosmetic bags, make up, make up utensils, make up applicators, toilet preparations, skin care preparations, nail care preparations, hair care preparations, hair care preparations or related goods; retail services connected with stationary.

Class 39 Warehouse storage; Warehouse storage services; Storage of goods in warehouses; Goods warehousing; Goods (Delivery of -); Delivery of goods; Warehousing of goods; Shipping of goods; Transport of goods; Storage of goods; Warehousing of finished goods; Arranging

transportation of goods; Delivery [distribution] of goods; Wrapping and packaging of goods; Packaging and storage of goods; Distribution [transport] of retail goods; Delivery of goods by mail order; Arranging and conducting of mail order delivery services.

39. The application may proceed to registration for those services against which the opposition was not directed:

Class 5 Sanitising wipes; Antibacterial wipes; Sanitizing wipes; Disposable sanitizing wipes; Disposable sanitising wipes; Sanitary towels; Sanitary tampons; Sanitary pads.

Class 8 Disposable razors.

Class 16 Greetings cards; Cards; Post cards; Blank cards; Printed cards; Note cards; Blank note cards; Birthday cards; Occasion cards; Christmas cards; Thank you cards; Posters; Envelopes; Paper; Paper tapes; Paper carton sealing tape; Sticky tape; Tapes (adhesive -) [stationery]; Adhesive packaging tapes; Gummed tape [stationery]; Paper stock [printing paper]; Gift tags; Gift paper; Adhesive labels; Adhesive stickers; Self-adhesive paper for notes; Toilet paper; Toilet rolls; Paper wipes; Waxed paper; Paper bags; Recycled paper; Giftwrapping paper; Packing cardboard containers; Disposable napkins; Stationery; Packing paper; Packing cardboard; Packing [cushioning, stuffing] materials of paper or cardboard; Packaging materials; Gift packaging; Cardboard packaging; Packaging cartons of cardboard; Gift boxes; Stationery boxes.

Class 21 Tooth brushes.

COSTS

40. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I award the opponent the sum of **£650**, calculated as follows:

Preparing a Notice of opposition and considering the applicant's counterstatement	£200
Filing written submissions	£350
Official fee	£100
Total	£650

41. I therefore order Zero Plastic Ltd to pay Cupclub Limited the sum of £650. 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 3rd day of July 2023

S WILSON

For the Registrar

ANNEX 1

Class 5

Sanitising wipes; Antibacterial wipes; Sanitizing wipes; Disposable sanitizing wipes; Disposable sanitising wipes; Sanitary towels; Sanitary tampons; Sanitary pads.

Class 8

Disposable razors.

Class 16

Greetings cards; Cards; Post cards; Blank cards; Printed cards; Note cards; Blank note cards; Birthday cards; Occasion cards; Christmas cards; Thank you cards; Posters; Envelopes; Paper; Paper tapes; Paper carton sealing tape; Sticky tape; Tapes (adhesive -) [stationery]; Adhesive packaging tapes; Gummed tape [stationery]; Paper stock [printing paper]; Gift tags; Gift paper; Adhesive labels; Adhesive stickers; Self-adhesive paper for notes; Toilet paper; Toilet rolls; Paper wipes; Waxed paper; Paper bags; Recycled paper; Giftwrapping paper; Packing cardboard containers; Disposable napkins; Stationery; Packing paper; Packing cardboard; Packing [cushioning, stuffing] materials of paper or cardboard; Packaging materials; Gift packaging; Cardboard packaging; Packaging cartons of cardboard; Gift boxes; Stationery boxes.

Class 21

Tooth brushes; Tooth brush cases.

Class 35

Online ordering services; Providing online marketplaces for sellers of goods and or services; none of the aforementioned services being in connection with or relating to cosmetics, beauty preparations, beauty kits, cosmetic wipes, cosmetic bags, make up, make up utensils, make up applicators, toilet preparations, skin care preparations, nail care preparations, hair care preparations, hair care preparations or related goods; retail services connected with stationary.

Class 39

Warehouse storage; Warehouse storage services; Storage of goods in warehouses; Goods warehousing; Goods (Delivery of -); Delivery of goods; Warehousing of goods; Shipping of goods; Transport of goods; Storage of goods; Warehousing of finished goods; Arranging transportation of goods; Delivery [distribution] of goods; Wrapping and packaging of goods; Packaging and storage of goods; Distribution [transport] of retail goods; Delivery of goods by mail order; Arranging and conducting of mail order delivery services.

ANNEX 2

Class 21

Cups made of environmentally friendly material; cup holders; biodegradable cups; closures for cup lids; reusable containers; food and beverage containers; reusable bottles; reusable cups; reusable food containers; reusable beverage containers; reusable containers for household or kitchen use; reusable containers for cosmetics; reusable containers for household use.

Class 35

Customer services for commercial, promotional and/or advertising purposes; retail services in relation to computer software in matters relating to reusable packaging; assistance in product commercialization, within the framework of a distribution arrangement; business and consultancy services in matters relating to the environment.

Class 39

Collection and transport of recyclable consumer packaging; collection and transportation of reusable consumer packaging; collection and transportation of reusable consumer packaging materials; delivery and distribution of reusable consumer packaging; rental, hire and leasing of transportation vehicles; packaging services; collecting and refilling containers for re-use by consumers.

Class 40

Recycling services; treatment and transformation of packaging containers for consumer use; services to enable the reuse of containers; services to enable the reuse of packaging; sorting of reusable consumer packaging.