

O/0650/23

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION
NO. WO0000001612759 IN THE NAME
OF LIDL STIFTUNG & CO. KG
FOR THE FOLLOWING TRADE MARK:**



IN CLASSES 9, 35, 36, 37, 38, 40 & 42

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 432841 BY
E DRIVE LTD**

BACKGROUND AND PLEADINGS

1. Lidl Stiftung & Co. KG (“the applicant”) is the holder of the International Registration shown on the cover page of this decision (“the IR”). The IR was registered on 1 February 2021 and, with effect from the same date, the applicant designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR is derived from the applicant’s EU trade mark, being that numbered 018292890, and enjoys a priority date of 18 August 2020. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 28 January 2022 in respect of the goods and services set out in the **Annex** to this decision.
2. On 21 April 2022, E Drive Ltd (“the opponent”) partially opposed the application. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is reliant upon the following UK trade marks:

e Charge

UK registration no: 3078929

Filing date 27 October 2014; registration date 2 February 2018

Relying on all services, namely:

Class 39: Distribution of electricity.

(“the opponent’s first mark”)

e Charge

UK registration no: 3082253

Filing date 19 November 2014; registration date 2 February 2018

Relying on all services, namely:

Class 37: Electrical installation services; installation, maintenance and repair of electric charging points and facilities.

(“the opponent’s second mark”)

3. I will set out that goods and services of the applicant that are subject to this opposition when assessing the goods and services comparison below.
4. The opponent claims that the IR is sufficiently similar to the opponent's marks and is to be registered for very similar goods and services thereby resulting in a significant likelihood of confusion. The applicant filed a detailed counterstatement wherein it denied all of the claims against it.
5. The opponent is represented by Geoffrey Leaver Solicitors LLP and the applicant is represented by CAM Trade Mark & IP Services. Both parties filed evidence in chief with the applicant also opting to file written submissions during the evidence rounds. The opponent filed evidence in reply. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
6. 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

7. The opponent's evidence came in the form of the two witness statements of Mr Toby George Russel dated 9 November 2022 and 14 February 2023, the latter being that which was filed in reply. Mr Russel is the director of the opponent and his first statement is accompanied by one exhibit, being TGR1, and his second statement is not accompanied by any exhibits.
8. The applicant's evidence came in the form of the witness statement of Mr Roman Cholij dated 15 December 2022. Mr Cholij is a Chartered Trade Mark Attorney at

the applicant's representative firm, a position he has held since 10 April 2007. Mr Cholij's statement is accompanied by seven exhibits, being RC1 to RC7.

9. I do not intend to summarise the evidence or submissions of the parties here but will, where necessary, address them below.

PRELIMINARY ISSUES

Preliminary Indication

10. During the course of these proceedings, I note that the Tribunal issued a preliminary indication regarding the outcome of this matter. For the avoidance of doubt, I was not the Hearing Officer that gave this preliminary indication and neither have I given it any consideration in making the following decision. It is not influential upon me, nor is it binding and I will say no more about it.

The opponent's evidence

11. Having considered the opponent's evidence, I note that the majority of the evidence explains, in detail, the background of the opponent and its plans going forward in relation to its 'e Charge' branding. While it is possible for historical evidence regarding an opponent's activities to be used to assist in a claim that said opponent enjoys an enhanced degree of distinctive character in its earlier marks, this is not the case with the evidence before me. I do not intend to go over the evidence in full but note that, for example, there is evidence regarding the registration of the opponent's website, being www.echarge.co.uk, and while I do not doubt the existence of this website, there is no supporting evidence such as UK visitor figures or evidence of the provision of goods or services stemming from visits to said website. Put simply, without anything further, the existence of a website domain being registered is not sufficient evidence of use that can be said to point towards an enhanced degree of distinctiveness. As for the opponent's intentions going forward, these are not relevant to the assessment I must make.

12. Given that the assessments that I must make throughout the course of this decision are notional ones that do not require me to take into account the history or the future plans of the opponent, I fail to see how the opponent's evidence is of any assistance. I will, therefore, say no more about it.

The applicant's evidence

13. The applicant's evidence consists of a range of print-outs that purport to show the common use of 'e Charge' in the marketplace. While noted, it is of no assistance to the present proceedings. Firstly, the print-out evidence all post-dates the relevant date for these proceedings, being 18 August 2020. In any event, the evidence is the mere existence of print-outs showing use of 'e Charge' by other undertakings and not actual evidence of use in the marketplace. On this point and insofar as the evidence has been adduced to prove that the opponent's marks are of weak distinctive character, I refer to the case of *Zero Industry Srl v OHIM*, Case T-400/06, wherein the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). "

14. As above, no evidence has been provided of use of other marks in the marketplace and the mere existence of these marks, be that on the register or via website print-

outs, is of no relevance to the present case. The applicant's evidence is, therefore, of no assistance and I will say no more about it.

DECISION

Section 5(2)(b): legislation and case law

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

“(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 or association with the earlier trade mark.”

16. Section 5A of the Act states as follows:

“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.”

17. The trade marks relied on by the opponent qualify as “earlier trade marks” for the purposes of this decision since they were applied for at an earlier date than the IR.¹ The opponent's marks did not complete their registration process more than five years prior to the priority date of the IR meaning that they are not subject to

¹ See Section 6(1)(a) of the Act

proof of use pursuant to section 6A of the Act. This means that the opponent can rely upon all services for which its marks are registered.

18. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

19. As a preliminary issue to the present comparison I wish to discuss the nature of the partial opposition, being something that the applicant brought up in its counterstatement. In respect of the applicant's class 42 goods, the opponent worded its partial opposition as being targeted against "engineering services relating to energy supply systems; transmission and distribution of electricity." The applicant argues that this is a false representation of the applicant's actual services in that class which are "computer programming for the energy industry, engineering

services relating to energy supply systems; technical monitoring services relating to production, transmission and distribution of electricity.”

20. The applicant has requested that these terms be struck out due to the aforementioned misrepresentation. I note that this issue was raised at the earliest opportunity by the applicant and in filing its evidence or written submissions, the opponent has not sought to clarify its position. In the circumstances, I consider that is open to me to insert the additional words into the opposed specification and proceed as if the opponent had opposed the entirety of the terms for which registration is sought. However, given the lack of response on this point and the fact that the omitted wording (being computer programming and technical monitoring services) is such that the nature of the terms is significantly altered, I am in agreement with the applicant that the opposition against these terms should be struck out entirely.

21. As a result, the competing goods and services are as follows:

The opponent's services	The applicant's goods and services
<p><i>The opponent's first mark</i></p> <p><u>Class 39</u></p> <p>Distribution of electricity.</p> <p><i>The opponent's second mark</i></p> <p><u>Class 37</u></p> <p>Electrical installation services; installation, maintenance and repair of electric charging points and facilities.</p>	<p><u>Class 9</u></p> <p>Apparatus, cables and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus, instruments and cables for electricity; monitoring and control apparatus and instruments for the transportation, distribution and supply of electrical energy; power distribution boxes; power supply units; power supplies; charging stations for electric vehicles; battery charging devices for motor vehicles; charging stations for vehicles; computer</p>

software and hardware for the connection of electrically operated vehicles to the energy system of electric charging stations and electric service stations; computer software and hardware for the commercial and technical operation of electric charging stations and electric service stations; electric batteries for powering electric vehicles; batteries for electric vehicles; electric batteries for vehicles.

Class 35

Management services relating to online registration for the use of electric charging stations and electric service stations; management services relating to the activation of access to electric charging stations and electric service stations; utility meter reading for billing purposes; billing services in the field of energy.

Class 37

Installation, providing, managing, repair and maintenance of chargers, electric charging stations and electric service stations for vehicles; repair, installation and maintenance of electric and electronic equipment, apparatus and instruments; vehicle battery charging; battery changing service for motor vehicles; battery charging

	<p>services for vehicles; charging station services for electric vehicles; battery charging services; leasing of charging equipment.</p> <p><u>Class 38</u> Internet-based telecommunication services to enable users to reserve, activate and pay for charging station sessions to recharge electric vehicles; providing of internet access to electric charging stations and electric service stations.</p> <p><u>Class 40</u> Electricity generating.</p> <p><u>Class 42</u> Automatic checking and inspection of meters and electricity meters.</p>
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22. When making the comparison assessing the similarity of the goods, all relevant factors relating to the goods 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:

“[...] 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”.

23. 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;
- (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.

24. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods (though it equally applies to services) are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

25. The only submissions I have from the opponent in respect of the goods and services comparison is as follows:

“It is clear from the Applicant’s trade mark application that it intends to use its trade mark in connection with the provision of similar, if not identical, services i.e. a network of electric vehicle charging stations.”

26. White noted, the opponent has not provided any specific reasoning in evidence or submissions as to why the goods and services at issue should be considered identical or similar. While the lack of evidence or submissions on this point is not fatal to the opponent's case, I do consider it somewhat of an issue for the opponent. This is on the basis that the goods and services at issue are, in my view, specialist goods and services and, as the comparison I must make is a notional one, I am unable to undertake my own research. As such, I am required to conduct the comparison based on my own understanding of the goods and services at issue. In the present case and in light of the nature of the goods and services at issue, I consider that it would have been helpful to the opponent's case if it had provided specific arguments pointing towards any overlaps in the factors set out in *Treat* (cited above), for example.

Class 9

Apparatus, cables and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus, instruments and cables for electricity; monitoring and control apparatus and instruments for the transportation, distribution and supply of electrical energy; power distribution boxes; power supply units; power supplies.

27. The above goods of the applicant are all goods that can be said to be used in the process of installation, maintenance and repair of electric charging points and facilities. While that alone does not give rise to a level of similarity between the above goods and the "installation, maintenance and repair of electric charging points and facilities" services in the opponent's second mark's specification,² I am of the view that the goods and services will overlap in trade channels and user and share a complementary relationship. This is on the basis that someone looking to obtain the goods to operate their own charging point or facility is also likely to be the user of the services installing, maintaining or repairing the same. The goods and services are also likely to be provided by the same undertaking. Lastly, I am

² See *Les Éditions Albert René v OHIM*, Case T-336/03

of the view that the goods are important and/or indispensable to the services and, as such, the average consumer is likely to believe that they originate from the same undertaking.³ Overall, I am of the view that these goods are similar to a medium degree.

Charging stations for electric vehicles; battery charging devices for motor vehicles; charging stations for vehicles.

28. The above goods of the applicant can be said to be the finished article of the applicant's goods that I assessed at paragraph 27 above. In light of this, I am of the view that the same comparison made above also applies to these goods, namely that the goods and services of the opponent overlap in user and trade channels and are complementary to one another. As such, I consider that these goods are similar to a medium degree.

Computer software and hardware for the connection of electrically operated vehicles to the energy system of electric charging stations and electric service stations;

29. It is my understanding that the above goods will be used in conjunction with charging points and facilities that the user will use to initiate and monitor the charging of their electric vehicle. The goods will also be used to check availability of said charging points. I am of the view that the user of these goods will be members of the general public meaning that, unlike the goods assessed above, the user of these goods will not overlap with the opponent's services. That being said, I consider that the above goods overlap in trade channels and will be complementary to the opponent's services. This is on the basis that, as far as I understand it, the above goods will be provided by the same undertaking that installs and maintains the charging points. As for complementarity, I consider that the user of the above goods will believe that the services provided by the opponent, namely "installation, maintenance and repair of electric charging points and facilities" will be important to the above goods and that the goods and services are

³ See *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

provided by the same undertaking. Overall, I consider that these goods and services are similar to between a low and medium degree.

Computer software and hardware for the commercial and technical operation of electric charging stations and electric service stations.

30. The difference between the comparison of the above goods and those assessed at paragraph 29 above are that, rather than being used by members of the general public looking to charge their vehicles, these goods will be used by service providers who will be operating the charging stations. So while the trade channels and complementarity points discussed in the preceding paragraph apply here, I consider that there is an additional overlap in user. This is due to the fact that the above goods will be used by the same user as those looking to use the opponent's services. Overall, I consider that these goods and services are similar to a medium degree.

Electric batteries for powering electric vehicles; batteries for electric vehicles; electric batteries for vehicles.

31. It is my understanding that the above goods are provided by electric vehicle manufacturers and not the same undertakings as those that install or maintain electrical installations. Further, I appreciate that while the end user of the above goods and the opponent's services will be the same (being people looking to charge their vehicles), the immediate user will differ. The user of the above goods is likely to be car manufacturers building electric vehicles (on this point I note I have nothing to suggest that members of the public would buy individual batteries for their electric vehicles) and the user of the opponent's services will be undertakings looking to install and operate car charging facilities. The nature, methods of use and purpose of the goods and services differ and neither are they competitive or complementary. So while I have found an overlap in end user, I do not consider that this warrants a finding that the goods and services are similar to any sufficient degree. The goods and services are, therefore, dissimilar.

Class 35

Management services relating to online registration for the use of electric charging stations and electric service stations; management services relating to the activation of access to electric charging stations and electric service stations; utility meter reading for billing purposes; billing services in the field of energy.

32. I am of the view that the above services of the applicant are those that are likely to be used by the same user as the opponent's "installation, maintenance and repair of electric charging points and facilities" services. As for trade channels, I have nothing before me to suggest that the undertaking that offers the above services will also offer the opponent's services and, without such, I am not willing to infer that it is common in the trade for them to do so. Aside from the fact that the services can be said to relate to electric charging, the nature, method of use and specific purposes of the services all differ. I see no reason why the services would be complementary and neither are they competitive. Overall, I do not consider that the fact that there is an overlap in user is sufficient to give rise to a level of similarity between these services. They are, therefore, dissimilar.

Class 37

Installation, providing, managing, repair and maintenance of chargers, electric charging stations and electric service stations for vehicles; repair, installation and maintenance of electric and electronic equipment, apparatus and instruments.

33. The above services are, in my view, identical with the opponent's "electrical installation services" and "installation, maintenance and repair of electric charging points and facilities" either self-evidently or under the principle outlined in *Meric*.

Vehicle battery charging; battery changing service for motor vehicles; battery charging services for vehicles; charging station services for electric vehicles; battery charging services.

While the above services involve the distribution of electricity, I am of the view that the closer comparison is in relation to the opponent's "installation, maintenance and repair of electric charging points and facilities." This is on the basis that these services are likely to be provided by the same undertaking meaning that there is an overlap in trade channels between them. I do not consider that the users necessarily overlap because the user of the above services will be those looking to charge their batteries/vehicles whereas the user of the opponent's services will be those looking to install, maintain and repair a charging station. That being said, I consider that the services are complementary to each other on the basis that the opponent's services are ultimately important and/or indispensable to the provision of the various vehicle charging services of the applicant and I consider that the user of the applicant's services will believe the services are provided by the same undertaking. Overall, I consider that these services are similar to between a low and medium degree.

Leasing of charging equipment.

34. The above service is a leasing service and while it relates to charging equipment, I have nothing before me to suggest that a provider of the opponent's services would also provide the above service and, without such, I am not willing to infer that it is common in the trade. Further, I have nothing to suggest that the user looking to lease charging equipment would also seek the services of the opponent, however, that being said I am of the view that they may have a competitive relationship in that a user looking for charging equipment may either lease the equipment or have it installed permanently. While the nature and method of use of the services differ, it can be said that there is some overlap in purpose as both services aim to provide charging equipment, albeit via different methods. Overall, I consider that these services are similar to a low degree.

Class 38

Internet-based telecommunication services to enable users to reserve, activate and pay for charging station sessions to recharge electric vehicles; providing of internet access to electric charging stations and electric service stations.

35. While the above services are not the same as the goods discussed at paragraph 27 above, I consider that the same overlaps apply to these services in that they overlap in user and purpose and are complementary in nature. The reasons discussed at paragraph 27 above regarding the overlap in these factors are applicable here and, as result, I find that these services are similar to a medium degree.

Class 40

Electricity generating.

36. While not the same services as “distribution of electricity” in the opponent’s first mark’s specification, I consider that these services are similar. This is on the basis that an undertaking that distributes electricity is likely to also generate it. Further, while the nature and method of uses differ, the core purpose is that both services aim to provide electricity. I do not consider that the users are the same and I have nothing to suggest otherwise. While not competitive in nature, I do consider that these services are complementary due to the fact that the services are important and/or indispensable to one another and a user who seeks the distribution of electricity is likely to believe that that provider also generates it, or vice versa. Overall, I consider that these services are similar to a medium degree.

Class 42

Automatic checking and inspection of meters and electricity meters.

37. It is my view that the above services cover those services provided by energy suppliers who, instead of asking for customers to send meter readings, install devices on the meters to ensure accurate billing or electricity or gas. Given the broad nature of the opponent’s “electrical installation services” and “distribution of electricity” services (in that they are not limited to electric charging points or facilities), they too can be said to cover other types of services that are commonly

provided by energy suppliers. As such, I consider that there is an overlap in user and trade channels between the services on the basis that, in this context, a member of the general public will seek electrical installation services and request automatic checking and inspection of their meters from the same energy supplier. As for the remaining factors, I do not consider that the services overlap in nature, method of use or purpose and neither are they competitive or complementary (as they are not necessarily important and/or indispensable to one another) in nature. Overall, I consider that these services are similar to a low degree.

38. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, the opposition aimed against dissimilar goods and services will fail.⁴ Those goods and services that I have found dissimilar are set out below and, for the avoidance of doubt, the opposition against them fails at this stage.

Class 9: Electric batteries for powering electric vehicles; batteries for electric vehicles; electric batteries for vehicles.

Class 35: Management services relating to online registration for the use of electric charging stations and electric service stations; management services relating to the activation of access to electric charging stations and electric service stations; utility meter reading for billing purposes; billing services in the field of energy.

The average consumer and the nature of the purchasing act

39. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer*

⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

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.”

40. In my view, the average consumer for the goods at issue will be both members of the general public (in those looking for charge their vehicle, for example) and business users (in those companies looking to install and operate charging stations, for example). For members of the general public, I consider that the goods at issue will, for the most part, be available via online app stores (for downloadable software used to monitor a vehicle charging, for example) where they will be selected after the consumer views an image of them or via general retailers (and their only equivalents) where they will be selected from shelves or from an image on a webpage. In my view, the visual aspect will dominate the selection process, however, I do not discount the aural component playing a role by way of word of mouth recommendations.

41. For business users, the goods and services will be available via specialist retailers or through the producers of the goods/providers of the services directly. As was the case with goods selected by members of the general public, the selection of the goods/services by business users is likely to be primarily visually on the basis that the goods/services are likely to be selected after seeing images of them in catalogues or a list of services in pamphlets (for example). That being said, I consider that the aural component will play a role as the selection of goods/services may also take place after discussions with sales persons, however, even where this occurs, the consumer will still review the products visually.

42. It is my understanding that, regardless of the identity of the user, the goods and services at issue will range in price. Some goods, such as apps or pieces of hardware for example, will be relatively low cost goods or, in some cases, free. However, some will be considerably higher, such as installation of charging stations for example. As for frequency of purchase, I find that the goods and services at issue will be selected infrequently.

43. The level of attention paid by the consumer will vary quite considerably depending on what goods or services are being selected. For example, a user selecting an app to allow them access to a vehicle charging station will pay a low degree of attention on the basis that it is likely to be free and will be required before they are able to initiate a charge with their chosen provider. In addition, users looking to use electric vehicle charging services will consider factors such as reliability, cost of the charge, whether there is any minimum or maximum spend and availability of the chargers. Such a service will, in my view, attract a medium degree of attention. Lastly, I consider that the selection of some of the high cost services (such as installation of charging stations) will result in a relatively high degree of attention (but not the highest). This is on the basis that the user of such services will consider various factors such as expertise offered by the provider, timescale of the project, track record of previous installations undertaken by that provider and testimonials from previous users, for example. To confirm, I consider that the level of attention across the broad range of goods and services at issue will range from low to reasonably high (but not the highest).

Comparison of the marks


44. It is clear from *Sabel 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.

45. 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.”

46. 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.

47. As the opponent’s marks are identical to one another, I will, for the remainder of this marks comparison refer to them in the singular, being *the opponent’s mark*. The respective trade marks are shown below:

The opponent’s mark	The IR
e Charge	 The logo for LIDL eCharge. It features a blue square background. Inside the square, there is a yellow circle with a red border. The letters 'LIDL' are written in blue across the yellow circle, with a red diamond shape between the 'I' and 'D'. Below the circle, the word 'eCharge' is written in white lowercase letters.

48. I have comments and submissions from both parties in respect of the similarity of the marks at issue. While these are noted, I do not intend to reproduce them here

but, for the avoidance of doubt, confirm that I have given the due consideration in making the following assessment.

Overall Impression

The IR

49. The IR is a figurative mark with several elements. The first element (being that it sits at its top) is the word 'LIDL' which is displayed in such a way that the letters 'L-D-L' are presented in a fairly standard blue typeface but the letter 'I' is presented in a more stylistic fashion and in red. The word 'LIDL' sits on a circular yellow background with a red border, which itself sits on a blue background that is bordered by a white square. This element sits atop the word 'eCharge', which is presented in a white standard typeface. Both of these elements are placed on a blue square background. For reasons that I will come to discuss when considering the conceptual comparison below, it is the 'LIDL' device that is the dominant element of the IR with 'eCharge' playing a lesser role. As for the blue background element, I am of the view that this will have a negligible impact due to its role as a banal background.

The opponent's mark

50. The opponent's mark is a word only mark, being 'e Charge'. While presented as two separate words, they will, for reasons I will come to discuss below, be viewed in combination meaning that the overall impression of the opponent's mark lies in both words equally.

Visual Comparison

51. Visually, the marks at issue have a common element in the presence of the letter 'e' followed by the word 'Charge'. While presented differently across the marks ('e Charge' in the opponent's mark and 'eCharge' in the IR), I am of the view that this will be overlooked. This is the only element in the opponent's mark and while it may

have a lesser role in the IR, it will still be a point of visual similarity. On this point, I note that as a word only mark registered in black and white, the opponent's mark is capable of being presented in the same standard typeface used by the same element in the IR and also in the same colour. Aside from the common use of 'eCharge'/'e Charge', all other elements in the IR have no counterpart in the opponent's mark. While I bear in mind that the marks do share one element, the prominence of the 'LIDL' element in the IR and the fact that, by virtue of being the top element, it will be encountered first⁵ are significant points of visual difference. Taking all of this into account, I find that the marks are visually similar to a low degree.

Aural Comparison

52. Aurally, the opponent's mark consists of two syllables that will be pronounced as 'E-CHARJ'. The IR consists of four syllables that will be pronounced as 'LID-LL-E-CHARJ'. While the last two syllables of the IR are identical to the entirety of the opponent's mark, the first two syllables are different and result in a mark that is, aurally, double the length of the opponent's. On this point, I remind myself that the average consumer tends to focus on the beginnings of marks. Further, from an aural perspective, the opponent's mark is a short mark and while there is no special test which applies to the comparison of 'short' marks,⁶ I am of the view that, in the present case, the shortness of the opponent's mark means that the average consumer is more likely to notice the differences. Taking all of this into account, I am of the view that the marks are aurally similar to no more than a medium degree.

Conceptual Comparison

53. The only elements that are capable of having a graspable meaning in the IR are the words 'LIDL' and the word 'eCharge'. 'LIDL' will be understood as a made-up or foreign language word with no obvious meaning in the UK. While I appreciate

⁵ On this point, I remind myself that, as per the case of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, average consumers tend to focus on the beginnings of marks.

⁶ See paragraph 44 of *BOSCO*, BL O/301/20

that 'LIDL' is a popular nationwide supermarket, I remind myself that conceptual comparisons do not take into account the reputation of the marks at issue.⁷ As for the word 'eCharge', I am of the view that in the context of the goods and services at issue, this will be seen as a reference to electronic or electrical charging. It is my view that the letter 'e' before a word is commonly understood as a reference to something that is 'electric' or 'electronic' and will, therefore, combine to form a unit with the succeeding word (such as email for example). While I appreciate that I have no evidence on this point and I am conscious of the importance of not treating my own personal knowledge as being more widespread than it is, I do not consider this to be a point that is likely to cause any serious dispute.⁸ As a result, I find that the 'eCharge' element will be viewed as allusive to the goods and services at issue on the basis that they relate to electric vehicles or electricity in general. In light of this, when the IR is viewed as a whole, I find that it will be understood as a reference to an undertaking known as 'LIDL' (which, as above, has no discernible meaning) that offers electronic charging.

54. As for the opponent's mark, I consider that, again, in the context of the opponent's services, 'e Charge' will be viewed as a reference to electronic or electrical charging. It will, therefore, be seen as allusive to the opponent's services. There are no other elements that contribute to its overall concept. In comparison to the IR, the shared element will be the same and will act as a point of similarity between the marks. That being said, I cannot ignore its allusive nature and the presence of the 'LIDL' element (which has no counterpart in the opponent's mark) and, therefore, find that the marks are conceptually similar to no more than a medium degree.

Distinctive character of the opponent's marks

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

⁷ See the case of *Ravensburger AG v OHIM*, Case T-243/08 which discussed the issue regarding the reputation of an earlier mark having no impact on the conceptual comparison. While this present discussion relates to the later mark, I consider that the same principle applies equally here.

⁸ *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

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

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

56. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its marks have acquired an enhanced degree of distinctiveness and neither has it filed any evidence to that effect. As such, I have only the inherent position to consider.

57. When discussing the applicant’s evidence as a preliminary issue, I set out that it was of no assistance to the present proceedings. While that may be the case, this does not mean that the opponent’s marks must automatically be assigned a strong level of inherent distinctive character. While I have no evidence before me pointing

to a weaker degree of distinctive character, the assessment I must make it based on the inherent position and, in the present case, I have found that 'e Charge', in the context of the goods for which the opponent's marks are registered, is allusive of electronic or electrical charging. There are no other elements in the marks that contribute to the distinctive character and, given the allusive nature of 'e Charge', I find that the opponent's marks are inherently distinctive to a low degree.

Likelihood of confusion

58. 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 trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, 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.

59. I have found the parties' goods range from being identical to similar to a low degree. I have found the average consumer for the goods to be both members of the general public and business users who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part. I have concluded that the level of attention paid by the average consumer will range from a low to a reasonably high degree (but not the highest) when selecting the goods and services at issue. I have found that the opponent's marks are inherently distinctive to a low degree and while this is generally a factor in favour of the

applicant, I remind myself that weak distinctive character of earlier trade marks does not preclude a likelihood of confusion.⁹ In respect of the similarity of the marks at issue, I have found that the marks are visually similar to a low degree and aurally and conceptually similar to no more than a medium degree.

60. I note that in support of its claim for a likelihood of confusion, the opponent has provided the following submissions:

“4. Given the distinctiveness of E Drive Ltd's earlier trade marks, and also the obvious visual and conceptual association between the Applicant's trade mark and E Drive's earlier trade mark arising by the use of the word 'eDrive', it is submitted that the chances of confusion on the part of the public are therefore high. If the Applicant's trade mark is allowed to be registered, a member of the public driving along a road in a few years from now may well come across both an 'eCharge' electric vehicle recharging point as well as a 'Lidl eCharge' electric vehicle recharging point and will be confused as to what, if any, connection exists between the two.

5. To put this a different way, it is submitted that the Applicant has merely adopted E Drive Ltd's earlier trade mark and has tried to claim it as its own simply by placing its name in front of that earlier trade mark. In such circumstances the chances of confusion will clearly be high. Without wishing to sound facetious, it would be the same as E Drive Ltd attempting to register a trade mark for use in connection with a chain of supermarkets that it intended to operate containing the words 'E Drive' in a stylised format followed by the word 'Lidl'. In such circumstances members of the public would understandably be confused as to who operated those supermarkets.”

61. While the above submissions are noted, the reliance upon the visual and conceptual association between the marks is misguided. As I have set out throughout this decision, it is the 'LIDL' element that is the dominant element of the IR and I fail to envisage any scenario where this would be overlooked by the

⁹ *L'Oréal SA v OHIM*, Case C-235/05 P

average consumer to the point that they would be directly confused by the marks at issue. On the contrary, I am of the view that it is the 'LIDL' element that would be used to accurately recall and remember which mark was which. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I find that there is no likelihood of direct confusion between the marks, regardless of the level of attention paid or in circumstances where the marks are viewed on identical goods or services.

62. I turn now to consider a likelihood of indirect confusion and am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

63. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

64. In considering the opponent's submissions (referenced at paragraph 60) in respect of indirect confusion, I wish to point out that the hypothetical situation raised is of no assistance here. Even if such an argument was relevant, it is not on all fours with the present proceedings. Put simply, the common element in the present proceedings is allusive whereas the common element of the hypothetical example provided is not. I fail to see how the same chances of confusion would arise in the two scenarios described.

65. In considering the issue of indirect confusion in line with the categories set out in *L.A. Sugar* (cited above), I do not consider that the common element between the marks is so strikingly distinctive that an average consumer would only consider that only one undertaking would use it. On the contrary, I am of the view that the

average consumer would see the shared use of 'eCharge' (regardless of its presentation) as coincidental in light of the goods and services at issue. In addition, the differences between the marks, most notably the word 'LIDL' is not something that an average consumer would believe that the opponent would use to indicate sub-brand or brand extension. Alternatively, in considering confusion the other way around, I see no reason why the average consumer would believe that an undertaking using the IR would remove its most distinctive element, being 'LIDL' so that its mark would simply read 'eCharge'. Such an alteration is, in my view, an illogical one for an undertaking to take, particularly given the allusive nature of the 'eCharge' element. Taking all of the above into account and bearing in mind the comments of Arnold LJ and James Mellor Q.C. (as he then was) in the preceding paragraph, I do not consider that there is a likelihood of indirect confusion, regardless of the level of attention paid or in circumstances where the marks are viewed on identical goods or services.

CONCLUSION

66. The opposition has failed in its entirety and, subject to any appeal, the IR may proceed to registration in the UK for all of the goods and services that the applicant has designated for protection.

COSTS

67. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. As I have found the applicant's evidence to be of no assistance in these proceedings, I do not consider it appropriate to make a costs award in its favour for the preparation of the same. That being said, the applicant was still required to consider the opponent's evidence and while it was not extensive, I consider that the applicant is entitled to some costs associated with this activity. I also note that, in its counterstatement, the applicant has made a request that the issue regarding the misrepresentation of the applicant's services (being that discussed at paragraphs 19 and 20 above) be taken into account on the point of costs. While this issue was

not addressed again by either party, I do appreciate that it required additional consideration by the applicant in preparing and filing its counterstatement. While I will take this into account when awarding costs for that stage of the proceedings, I do not consider that it resulted in a considerable costs increase so will only make a small allowance for the same.

68. In the circumstances, I award the applicant the sum of **£900** as a contribution towards its costs. The sum is calculated as follows:

Considering the notice of opposition and preparing a counterstatement:	£300
Considering evidence:	£300
Preparation of written submissions:	£300
Total:	£900

69. I hereby order E Drive Ltd to pay Lidl Stiftung & Co. KG the sum of £900. The above 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 10th day of July 2023

A COOPER
For the Registrar

ANNEX

Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus, cables and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus, instruments and cables for electricity; information technology and audio-visual, multimedia and photographic devices; measuring, detecting, monitoring and controlling devices; navigation, guidance, tracking, targeting and map making devices; charging stations for electric vehicles; battery charging devices for motor vehicles; charging stations for vehicles; software; application software; software drivers for electronic devices; mobile apps; downloadable software applications; computer software and hardware for the connection of electrically operated vehicles to the energy system of electric charging stations and electric service stations; computer software and hardware for the commercial and technical operation of electric charging stations and electric service stations; software for the inspection and monitoring of electric apparatus, charging boxes and power points; apparatus and instruments for geolocation; target location apparatus [electric]; software for gps navigation systems; computer software for global positioning systems; data processing apparatus; computers; biometric access control systems; computer programs for the enabling of access or entrance control; access control cards [encoded or magnetic]; apparatus for receiving, recording, transmission, processing, output and reproduction of data, speech, text, signals, sound and images; electric batteries for powering electric vehicles; batteries for electric vehicles; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; electric batteries for vehicles; cables, electric; transformers [electricity]; electricity indicators; connectors (electricity), electrical fittings; junction boxes (electricity); electric control devices for energy management; socket outlets (electric -); computer programs for information, analysing and reporting of energy use, energy efficiency, energy saving, cost analysis, administration, energy analysis and invoice management; mobile apps for information, analysing and reporting of energy use, energy efficiency, energy saving, cost analysis, administration, energy analysis and invoice management;

measuring, monitoring and control apparatus and instruments for the transportation, distribution and supply of electrical energy; power distribution boxes; power supply units; power supplies.

Class 35

Business assistance, management and administrative services; advertising, marketing and promotional services; professional business consultancy; marketing studies; public relations services; organisation of exhibitions and trade fairs for advertising purposes; billing; utility meter reading for billing purposes; billing services in the field of energy; negotiation and conclusion of commercial transactions for third parties; preparation of accounts; management services relating to online registration for the use of electric charging stations and electric service stations; management services relating to the activation of access to electric charging stations and electric service stations; energy price comparison services; tracking and monitoring energy consumption for others for account auditing purposes; assistance and consultancy services in the field of business management in the energy sector; advertising and advertisement services relating to electrical energy and electric vehicles; business consultancy and business information with regard to the sale of electric vehicles.

Class 36

Financial and monetary services, and banking; insurance underwriting; finance services, in particular decentralized financial services; consultancy concerning financing of energy projects, financial consultancy in the energy sector; issuance of prepaid cards and tokens.

Class 37

Installation, providing, managing, repair and maintenance of chargers, electric charging stations and electric service stations for vehicles; repair, installation and maintenance of electric and electronic equipment, apparatus and instruments; vehicle battery charging; battery changing service for motor vehicles; battery charging services for vehicles; charging station services for electric vehicles; battery charging services; leasing of charging equipment.

Class 38

Telecommunication services; internet-based telecommunication services to enable users to reserve, activate and pay for charging station sessions to recharge electric vehicles; electronic transmission of measured data; electronic, electric and digital transmission and distribution of data, signals and messages via data networks; providing connections and rental of connection time for data networks and computer databases; rental of connection access time for databases; providing telecommunication connections and links to databases, computer networks and internet; remote transmission of data by means of telecommunications; providing access to databases; providing access to web sites on the internet; providing of internet access to electric charging stations and electric service stations.

Class 40

Electricity generating.

Class 42

Scientific and technological services and research and design relating thereto; design services; IT programming services; testing, authentication and quality control; design and development of computer hardware and software; development of software, development of software architecture, modules and interfaces; programming of energy management software, advisory services relating to energy consumption and efficiency; computer programming for the energy industry, engineering services relating to energy supply systems; design and development of energy management software; development of energy and power management systems; advisory services relating to the use of energy; technological consultancy in the fields of energy production and use; design and development of software for control, regulation and monitoring of electric energy systems; provision of information concerning research and technical project studies relating to the use of electrical energy; engineering project management services; technical monitoring and evaluation and consultancy in the field of measuring electrical energy; consultancy in the field of energy saving and energy efficiency; research and analysis in the field of energy; certification services for the energy efficiency of buildings; technological analysis relating to energy and power needs of others; technical monitoring services relating to production, transmission and

distribution of electricity; automatic checking and inspection of meters and electricity meters; remote quality control for voltage load; design services for a network environment, computer systems and computer programs relating to payment of charging fees; services relating to helpdesk operation, namely technical information or information exchange support services in emergency and special situations via telephone, email, internet or short message (sms); technological consultancy.