

O/0835/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3685348
BY HAROON SHAIKH**

TO REGISTER:

kerb-e

AS A TRADE MARK IN CLASS 9

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 429590 BY
GRID SMARTER CITIES LIMITED**

BACKGROUND AND PLEADINGS

1. On 24 August 2021, Haroon Shaikh (“the applicant”) applied to register **kerb-e** as a trade mark in the United Kingdom in respect of the following goods:

Class 9

Chargers; Car charger; Battery chargers; Electric battery chargers; Electric-car charger; Charging stations for electric vehicles; Contacts, electric; Electric circuits; Electrical outlets; Connections, electric; Couplings, electric.

2. On 23 December 2021, the application was opposed by Grid Smarter Cities Limited (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concerns the following goods in the application: *Car charger; Electric-car charger; Charging stations for electric vehicles.*

3. The opponent is relying on UK Trade Mark (“UKTM”) No. 3270228, **KERB**, which has a filing date of 13 November 2017 and a registration date of 30 September 2018. It is registered for services in Classes 35 and 39 and the opponent is relying on the following services:

Class 39

Vehicle parking and storage; parking services; parking space rental.

4. This mark qualifies as an earlier mark under the provisions of section 6(1) of the Act by virtue of its earlier filing date. As it completed its registration process less than five years before the application date for the contested mark, it is not subject to the proof of use provisions in section 6A of the Act. The opponent may therefore rely on all the services listed above.

5. The opponent claims that the marks are highly similar, with the first part of the contested mark being identical to the earlier mark and the “e” element likely to be considered by the average consumer as an abbreviation of the word “electronic”. It argues that all modern providers of vehicle parking services provide at least some spaces with charging points for electric vehicles and so the respective goods and

services are highly similar. As a consequence, there is a likelihood of confusion on the part of the public, which includes a likelihood of association with the earlier mark.

6. The applicant filed a defence and counterstatement denying the claims made. In particular, he asserts that there are clear differences between the marks, that the contested mark is *“a play on the popular game Kerby or Kerbie, where the roadside edge or kerb is a critical component of the game, just as the kerb is a critical component of the hardware”* and that the average consumer would make this connection. He also contests the opponent’s claim that providers of car parking services provide at least some spaces with charging stations. He argues that the word “kerb” in relation to vehicle parking services would be seen as non-distinctive and there would be no likelihood of confusion between the marks, given the significant differences between the goods and services.

7. Both parties filed evidence and made written submissions during the evidence rounds. Neither side requested a hearing and both filed final written submissions on 7 June 2023.

8. In these proceedings, the opponent is represented by Murgitroyd & Company and the applicant by Robertson IP.

EVIDENCE

9. The opponent’s evidence comes from Neil Andrew Herron, founder and director of Grid Smarter Cities Limited. His witness statement is dated 6 February 2023 and the evidence goes to the requirements to provide electric vehicle charging provision in parking facilities.

10. The applicant’s evidence comes from the applicant himself and is dated 5 April 2023. His first exhibit provides information on an electric charging system that is not associated with parking spaces, while the second gives data on the number of electric vehicles in the UK.

PRELIMINARY REMARKS

11. I am aware that a preliminary indication was given that there would be a likelihood of confusion between the marks. A preliminary indication, however, is not binding. I shall make my decision on the basis of an assessment of the application against the earlier mark, in the light of the submissions and evidence that have been filed by both parties.

DECISION

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

“A trade mark shall not be registered if because—

...

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

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

13. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation 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-334/05 P) and Bimbo SA v OHIM (Case C-519/12 P):*¹

- 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

¹ 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to refer to the trade mark case-law of EU courts, although the UK has left the EU.

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 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; and

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

Comparison of goods and services

14. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296].

15. The goods services to be compared are shown in the table below:

Contested goods	Earlier services
<u><i>Class 9</i></u> <i>Car charger; Electric car charger; Charging stations for electric vehicles.</i>	

Contested goods	Earlier services
	<u>Class 39</u> <i>Vehicle parking and storage; parking services; parking space rental.</i>

16. I consider there to be a degree of overlap in the end-users of the goods and services: people who use the opponent’s goods to charge their vehicles will also be users of the applicant’s parking services. There will also be some overlap in the purchaser of the goods, as owners of electric vehicles will buy parking services and may also buy charging points to install at their homes or business premises. The purpose, nature and method of use of the goods and services are different. I also consider that the goods and services will be distributed through different trade channels. One would not expect to acquire a car charger or charging station (as opposed to charging services) through the same distribution channels as parking services. The goods and services are also not in competition with each other.

17. This leaves the question of complementarity, and it is on this point that the opponent’s case for similarity between the goods and services rests. The General Court (“GC”) said in *Boston Scientific Ltd v OHIM*, Case T-325/06, that goods and services are complementary when:

“82. ... there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

18. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as complementary and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, as they are here. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking.

19. Mr Daniel Alexander QC, sitting as the Appointed Person, noted in *Sandra Amalia Mary Elliot v LRC Holdings (LUV/LOVE Trade marks)*, BL O-255-13, that:

“18. ... the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in *Boston* as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.

...

20. ... It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

20. The opponent submits that, to the owners and drivers of electric vehicles, electric vehicle chargers are essential for vehicle parking services. When undertaking a long journey, such a driver would need to plan ahead to make sure that they could stop at various points to use charging stations in car parks, for instance at motorway service stations. I accept that the goods and the services would be used together. That, in itself, is not enough for me to find complementarity, as the case law quoted above makes clear. It does not seem to me likely that the average consumer would believe that the goods and services come from the same undertaking, given their difference in nature and the differences in distribution channels.

21. The overlap in user is not, in my view, sufficient for me to find that the goods and services are similar. Where there is no similarity between the goods and services, there can be no likelihood of confusion under section 5(2)(b) of the Act: see *eSure Insurance limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA at paragraph [49]. The opposition therefore fails.

OUTCOME

22. The opposition has failed and Application No. 3685348 will, subject to a successful appeal, proceed to registration.

COSTS

23. The applicant has been successful and is entitled to a contribution towards the cost of these proceedings in line with the scale set out in Tribunal Practice Notice No. 2/2016. In the circumstances, I award the applicant the sum of £1000 which has been calculated as follows:

Preparing a statement and considering the other side's statement: £200

*Preparing evidence and considering and commenting on
the other side's evidence: £500*

Preparation of written submissions in lieu of a hearing: £300

TOTAL: £1000

24. I therefore order Grid Smarter Cities Limited to pay Haroon Shaikh the sum of £1000. 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 4th day of September 2023

Clare Boucher
For the Registrar,
Comptroller-General