O/0884/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003810862

BY HONG KONG C-SMARTLINK INFORMATION TECHNOLOGY CO., LIMITED

TO REGISTER THE TRADE MARK:

Exway

IN CLASSES 9 AND 11

AND

OPPOSITION THERETO UNDER NO. OP000436665

BY

ENEL S.P.A.

Background and pleadings

1. HONG KONG C-SMARTLINK INFORMATION TECHNOLOGY CO., LIMITED ("the applicant") applied to register the trade mark below in the UK on 19 July 2022.

Exway

2. It was accepted and published in the Trade Marks Journal on 5 August 2022 in respect of the following goods:

Class 9 *Accumulators, electric, for vehicles; Chargers for electric batteries; Computer peripheral devices; Solar batteries; Solar panels for the production of electricity;* LCD projectors; Portable media players; Portable vibration speakers; *Electrical plugs; Electrical sockets; Converters, electric; Portable power chargers; Power banks; USB chargers; Battery charging equipment; Cell phone battery chargers; Battery charging devices for motor vehicles; Wireless chargers; Battery chargers; Solar-powered battery chargers; Battery chargers for tablet computers; Chargers for smartphones; Charging stations for electric vehicles*; Light-emitting diodes [LED].

Class 11 Air purifiers; Coffee machines, electric; Desk lamps; Portable stoves; Portable headlamps; Headlights for automobiles; Lights for vehicles; Portable electric fans; Reading lights; String lights for festive decoration; Lamps; Lanterns for lighting; Electric lamps; Anti-glare devices for automobiles [lamp fittings]; Lamps for outdoor use; Solar powered lamps; Lighting apparatus and installations; Ventilation [air-conditioning] installations and apparatus; Ventilation [air-conditioning] installations for vehicles; Electric fans for personal use; Radiators, electric; Pocket warmers.

3. ENEL S.p.A. (“the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon two earlier marks, detailed below.

   No. WO0000001683811, with a date of protection of the international registration in the UK of 24 February 2023, an international registration date of 15 April 2022, and a designation date of 15 April 2022. The mark has a priority date of 18 February 2022. The priority country is Italy and the trade mark number from which priority is claimed is 302022000025382.

   XWAY

   No. WO0000001683813, with a date of protection of the international registration in UK of 8 December 2022, an international registration date of 15 April 2022, and a designation date of 15 April 2022. The priority country is the European Union Intellectual Property Office (EUIPO) and the trade mark number from which priority is claimed is 18675685.

   X WAY

4. The opponent is reliant upon the following goods and services for both the “XWAY” and the “X WAY” marks:

   Class 9 Charging stations for electric vehicles; apparatus and instruments for charging and controlling electric vehicles; software and hardware for operation of charging stations for charging of electric vehicles; computer software applications to locate charging stations; data processing equipment, interfaces, encoded module cards and electronic components for use in conjunction with computers, all with the purpose of enabling automated roaming setup between Charge Point Operators and

e-Mobility Service Providers and with the purpose of enabling charge point information exchange (including transaction events), charge detail record exchange and the exchange of smart-charging commands between parties, all relating to electric charging of vehicles; software, especially open standard software and protocol software for charging electric vehicles; software for automated roaming setup between Charge Point Operators and e-Mobility Service Providers and for charge point information exchange (including transaction events), charge detail record exchange and the exchange of smart-charging commands between parties, all relating to electric charging of vehicles.

Class 37 Electric vehicles charging services, installation, maintenance and repair of charging stations; charging of electric vehicles in the context of an electric vehicle charging infrastructure to enable consumers to recharge electric vehicles, by the purchase of electricity for such vehicles through a network of distribution centres, installations, storage solutions and outlets.

5. The opponent is also reliant upon the following Class 42 services for both marks, with the exception that the words in square brackets do not appear in the "XWAY" mark's specification:

Class 42 Testing, analysis and evaluation of Charge Point Operators and e-Mobility Service Providers in the field of charging electric vehicles to determine conformity with established accreditation standards; computer services, namely, hosting cloud-based management intelligence platform for data collection, data storage, analytics, rate and timing control, and monitoring of electric generation and demand; software as a service (SAAS); hosting a website and computer application software for collection, storage, analysis, control and management of data in the public, residential, commercial and industrial markets for use

in optimization of electric vehicle charging equipment and apparatus and other electric loads and generation; computer services featuring a cloud-based intelligence platform for data optimization of load balancing, energy prices and environmental signals; computer services, namely, configuration of computer systems and [computer] networks that control charging apparatus and other remotely controllable electric loads, for use by electric grid operators, utility companies and energy market participants in the residential, commercial, and industrial markets; computer services, namely, hosting a website for the management of aggregated electric demand, electric vehicle charging stations, energy storage systems and other electric loads and generating systems; [computer services, namely, providing online non-downloadable software for aggregated electric demand, electric vehicle charging stations, energy storage systems and other electronic loads generating systems]; providing software as a service (SaaS) for remote management of electric vehicle charging stations and control of networked electric vehicle charging stations and other electric loads and generating sources; computer programming featuring communication, monitoring and control of electric vehicles.

6. The opponent opposes the applicant's Class 9 goods that are italicised at paragraph 2.

7. In its notice of opposition, the opponent argues that the respective goods and services are identical or similar and that the marks are similar.

8. The applicant filed a Form TM8 and counterstatement denying the claims made.

9. The opponent filed evidence which is summarised below.

10. The opponent filed submissions during the evidence rounds. Neither party filed submissions in lieu of a hearing.

11. The applicant is represented by Marcin Ociepka and the opponent is represented by J A Kemp LLP.

Evidence

12. The opponent filed evidence in the form of a witness statement from Tom Albertini, a Chartered Trade Mark Attorney and Partner at the law firm representing the opponent. The witness statement is signed and dated 10 March 2023. The witness statement is accompanied by Exhibit TPA-1.

13. The evidence seeks to show points of commonality in the trade channels for the charging goods at issue.

DECISION

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

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

(a)…

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

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

15. Given their priority dates, the trade marks upon which the opponent relies qualify as earlier trade marks for the purposes of section 6 of the Act. Further, as protection of the opponent's earlier marks was conferred less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.

Section 5(2)(b) – case law

16. Although the UK has left the EU, section 6(3)(a) of the European (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 make reference to the trade mark case law of EU courts.

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks

bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

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

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

Comparison of goods and services

18. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

> "23. 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 *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

21. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"…the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

22. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, 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 für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

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

24. 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, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

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

While on the other hand:

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

25. The goods and services in question are as follows:

Opponent's goods and services	**Applicant's goods**
Class 9 Charging stations for electric vehicles; apparatus and instruments for charging and controlling electric vehicles; software and hardware for operation of charging stations for charging of electric vehicles; computer software applications to locate charging stations; data processing equipment, interfaces, encoded module cards and electronic components for use in conjunction with computers, all with the purpose of enabling automated roaming setup between Charge Point Operators and e-Mobility Service Providers and with the purpose of enabling charge point information exchange (including transaction events), charge detail record exchange and the exchange of smart-charging commands between parties,	Class 9 Accumulators, electric, for vehicles; Chargers for electric batteries; Computer peripheral devices; Solar batteries; Solar panels for the production of electricity; Electrical plugs; Electrical sockets; Converters, electric; Portable power chargers; Power banks; USB chargers; Battery charging equipment; Cell phone battery chargers; Battery charging devices for motor vehicles; Wireless chargers; Battery chargers; Solar-powered battery chargers; Battery chargers for tablet computers; Chargers for smartphones; Charging stations for electric vehicles.

all relating to electric charging of vehicles; software, especially open standard software and protocol software for charging electric vehicles; software for automated roaming setup between Charge Point Operators and e-Mobility Service Providers and for charge point information exchange (including transaction events), charge detail record exchange and the exchange of smart-charging commands between parties, all relating to electric charging of vehicles.	
Class 37 Electric vehicles charging services, installation, maintenance and repair of charging stations; charging of electric vehicles in the context of an electric vehicle charging infrastructure to enable consumers to recharge electric vehicles, by the purchase of electricity for such vehicles through a network of distribution centres, installations, storage solutions and outlets.	
Class 42 Testing, analysis and evaluation of Charge Point Operators and e-Mobility Service Providers in the field of charging electric vehicles to determine conformity with established accreditation standards; computer services, namely, hosting cloud-based management intelligence platform for	

data collection, data storage, analytics, rate and timing control, and monitoring of electric generation and demand; software as a service (SAAS); hosting a website and computer application software for collection, storage, analysis, control and management of data in the public, residential, commercial and industrial markets for use in optimization of electric vehicle charging equipment and apparatus and other electric loads and generation; computer services featuring a cloud-based intelligence platform for data optimization of load balancing, energy prices and environmental signals; computer services, namely, configuration of computer systems and [computer] networks that control charging apparatus and other remotely controllable electric loads, for use by electric grid operators, utility companies and energy market participants in the residential, commercial, and industrial markets; computer services, namely, hosting a website for the management of aggregated electric demand, electric vehicle charging stations, energy storage systems and other electric loads and generating systems; [computer services, namely, providing online non-downloadable software for aggregated electric demand, electric	

vehicle charging stations, energy storage systems and other electronic loads generating systems]; providing software as a service (SaaS) for remote management of electric vehicle charging stations and control of networked electric vehicle charging stations and other electric loads and generating sources; computer programming featuring communication, monitoring and control of electric vehicles.	

26. “Charging stations for electric vehicles” are identical to the opponent’s “charging stations for electric vehicles”.

27. “Chargers for electric batteries”, “Battery charging equipment”, “Battery charging devices for motor vehicles” and “Battery chargers” are *Meric* identical to the opponent’s “apparatus …. for charging … electric vehicles” in that the goods designated by the earlier mark are included in the more general categories designated by the trade mark application.

28. I compare “Accumulators, electric, for vehicles” with the opponent’s “apparatus … for charging … electric vehicles”. Accumulators (being batteries) and electric vehicle charging apparatus are both prerequisites for the effective operation of an electric vehicle. The charging apparatus connects to the battery via a socket on the vehicle. Both are used by members of the public, albeit electric vehicle charging apparatus might also be purchased by businesses. The respective goods might be purchased through the same trade channels. They are complementary: electric batteries for vehicles and electric vehicle charging apparatus are indispensable to each other in such a way that customers may think the

responsibility for those goods lies with the same undertaking. The goods are not in competition. I find that these goods are of medium similarity.

29. I compare "Electrical plugs", "Electrical sockets" and "Converters, electric" with the opponent's "charging stations for electric vehicles". While the applicant's goods have wider use in respect of the delivery of electric power, they are also component parts of charging stations. In terms of trade channels, charging stations are usually sold through specialist installers or automotive retailers, whereas plugs, sockets and converters will generally be sold through electrical trade suppliers and DIY stores. Nevertheless, the applicant's goods function as parts of the opponent's goods and I consider them to be complementary in that customers may think the responsibility for those goods lies with the same undertaking. I find the respective goods to be of medium similarity.

30. I compare "Computer peripheral devices" with the opponent's "data processing equipment, interfaces, encoded module cards and electronic components for use in conjunction with computers, all with the purpose of enabling automated roaming setup between Charge Point Operators and e-Mobility Service Providers and with the purpose of enabling charge point information exchange (including transaction events), charge detail record exchange and the exchange of smart-charging commands between parties, all relating to electric charging of vehicles". Computer peripheral devices are items that are used in conjunction with computers and as such have that in common with the opponent's goods. However, computer peripherals are typically generic items used in conjunction with personal computers, such as keyboards and mice, whereas the opponent's goods have a highly specialised purpose. As such, the extent of overlap in trade channels could be modest. The respective goods are not complementary and are only in competition where the applicant's generic peripheral devices could perform the function of the opponent's specialised goods. I find the respective goods to be of low similarity.

31. I compare “Portable power chargers”, “Power banks”, “USB chargers”, “Cell phone battery chargers”, “Wireless chargers”, “Solar-powered battery chargers”, “Battery chargers for tablet computers” and “Chargers for smartphones” with the opponent’s “apparatus … for charging … electric vehicles”. While all of the goods at issue have the intended purpose of charging, the applicant’s goods are portable and are used for charging relatively small devices whereas the opponent’s goods are fixed to a wall and are used for charging the large batteries that power electric vehicles. The trade channels will overlap to a modest degree in that automotive retailers sell electric vehicle charging apparatus as well as in-car chargers for devices. The respective goods are not complementary, nor are they in competition. I find the respective goods to be of low similarity.

32. I compare “Solar batteries” with the opponent’s “apparatus … for charging … electric vehicles”. I take solar batteries to be batteries used in conjunction with solar panels. As such, while both sets of goods have to do with the provision of power in a very general sense, solar batteries are not for use in electric vehicles. Furthermore, solar products will often be sold through specialist installers, whereas electric vehicle charging apparatus will be sold through different specialist installers or automotive retailers. They are neither complementary, nor are they in competition. I consider these goods to be dissimilar.

33. I compare “Solar panels for the production of electricity” with the opponent’s “apparatus … for charging … electric vehicles”. While both sets of goods have to do with the provision of power in a very general sense, they differ in the specifics of their nature, purpose, and method of use. Furthermore, solar products will often be sold through specialist installers, whereas electric vehicle charging apparatus will be sold through different specialist installers or automotive retailers. They are neither complementary nor are they in competition. I consider these goods to be dissimilar.

34. In my analysis of the competing goods and services, I do not consider the opponent's goods and services that I have not made reference to put it in any stronger a position than the goods that I have used as points of comparison.

35. I have reviewed Mr Albertini's evidence which seeks to show points of commonality in the trade channels for the charging goods at issue. Exhibit TPA-1 consists of screenshots of the Halfords website with a search for "charging" having been conducted and screenshots of the "Battery chargers" product category page of the B&Q website. The Halfords evidence shows electric vehicle charging apparatus, such as charging cables, and device chargers, such as mobile phone chargers. I find that, in respect of electric vehicle charging apparatus and device chargers, this evidence supports my notional assessment that the trade channels will overlap to a modest degree because automotive retailers sell electric vehicle charging apparatus as well as in-car chargers for devices. However, I do not find the B&Q evidence so comprehensive or compelling that I would broaden my notional assessment to include DIY stores as an area of overlap.

36. As some degree of similarity is required for there to be a likelihood of confusion[1], **the opposition must fail in respect of the following goods**:

Class 9 Solar batteries; Solar panels for the production of electricity.

The average consumer and the nature of the purchasing act

37. 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 was then) described the average consumer in these terms:

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

"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."

38. The goods at issue are electric car chargers, other forms of charger, electric batteries, items used in conjunction with computers and electrical components. While electric car chargers can be expensive, all the goods in question are functional. Some consideration would be given to the technical utility of the goods. Overall, the average consumer, a member of the public, would pay a medium level of attention during the purchasing process.

39. The products in question would be encountered visually online or at a bricks and mortar establishment before any verbal enquiries would need to be made. Visual factors would therefore predominate during the purchasing process, although I do not rule out verbal considerations.

Comparison of the trade marks

40. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by

means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

41. 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.

42. The respective trade marks are shown below.

Opponent's trade marks	Applicant's trade mark
XWAY	Exway
X WAY	

43. The applicant's mark is a plain word mark, "Exway". The opponent's marks are the plain words "XWAY" and "X WAY". There are no other elements that contribute to the overall impressions of the marks. In respect of the opponent's two-word mark, the overall impression is formed by the two words together, with neither word dominating the other.

44. Visually, all three marks are plain word marks. The applicant's mark includes all the letters of the opponent's marks in the same sequence, as a single word – "XWAY" – and two words – "X WAY". The only difference of substance is the presence of the letter "E" at the beginning of the applicant's mark. The different casings in which the marks are presented make no

difference because the marks protect the words, not the casing.[2] Even though the point of difference is at the beginning of the applicant's mark, the respective marks are highly similar visually.

45. Aurally, the respective marks are identical: "EX-WAY".

46. Conceptually, the marks all share the dictionary word "way", meaning the manner in which one does something or the route by which one may travel. The average consumer would not attach a particular meaning to the prefix "x" or "ex". As such, they would derive the same broad concept from the marks – that of something to do with the dictionary word "way". I consider the marks to be conceptually identical.

Distinctive character of the earlier mark

47. 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-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

[2] See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

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)."

48. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

49. The earlier marks are "X WAY" and "XWAY". The words are not wholly invented, in that they include the dictionary word "way", but the preceding "x" does not have a particular meaning. The mark is not suggestive of the opponent's goods or services. Overall, I find the mark to be of medium inherent distinctive character.

Likelihood of confusion

50. 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 or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade 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 they have retained in their mind.

51. I have found the parties' marks to be highly similar visually and to be aurally and conceptually identical. Except where I have found dissimilarity, my analysis of the goods and services has found that they are identical, of medium similarity, or of low similarity. I have identified the average consumer as someone who would pay a medium level of attention during the purchasing process. While visual factors would predominate during this process, I do not rule out verbal considerations. I have found the earlier marks to have a medium degree of inherent distinctive character.

52. I consider that this is a case where direct confusion is highly likely, particularly when the principle of imperfect recollection is borne in mind. The respective marks are very close, and their high similarity visually is such that the applicant's preceding "E" could very easily be mis-recalled as belonging to the opponent's marks. There is therefore a likelihood of direct confusion for all the goods that I have found to be identical or similar, including those that I have found to be of low similarity. In that regard, I bear in mind that there is no minimum threshold level of similarity between goods and services that must be shown as it is sufficient that some similarity exists in order to consider the likelihood of confusion.[3]

CONCLUSION

53. Subject to any appeal, the opposition succeeds in respect of the following contested goods:

Class 9 Accumulators, electric, for vehicles; Chargers for electric batteries; Computer peripheral devices; Electrical plugs;

[3] See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

Electrical sockets; Converters, electric; Portable power chargers; Power banks; USB chargers; Battery charging equipment; Cell phone battery chargers; Battery charging devices for motor vehicles; Wireless chargers; Battery chargers; Solar-powered battery chargers; Battery chargers for tablet computers; Chargers for smartphones; Charging stations for electric vehicles.

54. The opposition fails in respect of the following contested goods:

Class 9	Solar batteries; Solar panels for the production of electricity.

55. The following uncontested goods proceed to registration:

Class 9	LCD projectors; Portable media players; Portable vibration speakers; Light-emitting diodes [LED].
Class 11	Air purifiers; Coffee machines, electric; Desk lamps; Portable stoves; Portable headlamps; Headlights for automobiles; Lights for vehicles; Portable electric fans; Reading lights; String lights for festive decoration; Lamps; Lanterns for lighting; Electric lamps; Anti-glare devices for automobiles [lamp fittings]; Lamps for outdoor use; Solar powered lamps; Lighting apparatus and installations; Ventilation [air-conditioning] installations and apparatus; Ventilation [air-conditioning] installations for vehicles; Electric fans for personal use; Radiators, electric; Pocket warmers.

COSTS

56. As the opponent has been largely successful in respect of those goods that it has contested, I award costs accordingly in line with Annex A of Tribunal Practice Notice 2 of 2016:

Official fees:	£100
Preparing a statement and considering the other side's statement:	£150
Preparing evidence:	£450
Preparing submissions:	£250
Total:	**£950**

57. I order HONG KONG C-SMARTLINK INFORMATION TECHNOLOGY CO., LIMITED to pay ENEL S.p.A. the sum of £950. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of September 2023

JOHN WILLIAMS

For the Registrar