

O/0981/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF  
INTERNATIONAL REGISTRATION NO. 1617845  
DESIGNATING THE UNITED KINGDOM  
IN THE NAME OF RENAULT S.A.S.  
IN CLASSES 9 & 28

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600002140  
BY HUMAN HORIZONS HOLDINGS CO., LTD.

AND

IN THE MATTER OF REGISTRATION NO. 917946243  
IN THE NAME OF HUMAN HORIZONS HOLDINGS CO., LTD.  
IN CLASSES 9, 12, 18, 25, 36, 37, 39 & 42

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO. 504730  
BY RENAULT S.A.S.

## **Background and pleadings**

1. On 23 June 2021, Renault S.A.S. (“Renault”) registered the international trade mark displayed below, under number 1617845.



(“Renault’s mark”)

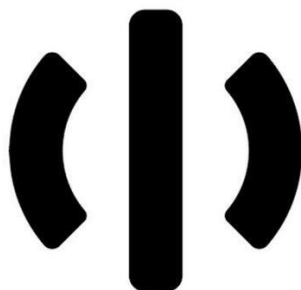
2. With effect from the same date, Renault designated the UK as a territory in which it seeks to protect its mark under the terms of the Protocol to the Madrid Agreement. Protection is sought for the following goods:

Class 9: Scientific apparatus and instruments; nautical apparatus and instruments; surveying apparatus and instruments; photographic apparatus and instruments; cinematographic cameras; optical apparatus and instruments; weighing apparatus and instruments; measuring apparatus and instruments; signalling apparatus and instruments; checking (monitoring) apparatus and instruments; teaching apparatus and instruments; sound recording apparatus; sound transmitting apparatus; sound reproduction apparatus; image recording apparatus; image transmission apparatus; image reproduction apparatus; digital recording media; mechanisms for coin-operated apparatus; cash registers; calculating machines; downloadable e-wallets; data processing equipment; computers; tablet computers; smartphones; electronic book readers; game software; software (recorded programs); computer peripheral devices; detectors; electric wires; electric relays; diving suits; diving gloves; diving masks; clothing for protection against accidents, irradiation and fire; protection devices for personal use against accidents; fire extinguishers; spectacles (optics); 3D spectacles; virtual reality headsets; eyewear; spectacle

cases; integrated circuit cards [smart cards]; bags designed for laptop computers; smart watches; electric batteries; batteries for electronic cigarettes; charging stations for electric vehicles; diagnostic apparatus not for medical use.

Class 28: Games; toys; toys for household pets; play mats; controllers for game consoles; artificial Christmas trees; apparatus for physical education; appliances for gymnastics; fishing tackle; balls for games; billiard tables; billiard cues; billiard balls; card decks; board games; ice skates; roller skates; scooters [toys]; sailboards; surfboards; rackets; snowshoes; skis; protective padding (parts of sportswear); models [toys]; figurines [toys]; robots as toys.

3. Renault's mark was published for opposition purposes on 19 November 2021. On 11 January 2022, Human Horizons Holdings Co., Ltd. ("HHH") opposed the protection of the mark in the UK by way of the fast-track procedure. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). HHH relies upon its UK trade mark number 917946243,<sup>1</sup> which is displayed below.



("HHH's mark")

4. HHH's mark was filed on 22 August 2018 and became registered on 15 December 2018 in respect of the following goods and services, all of which are relied upon for the purposes of the opposition:

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<sup>1</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of the HHH's EUTM number 17946243 being a registered trade mark as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

Class 9: Interactive touch screen terminals; traffic-light apparatus [signalling devices]; facial recognition apparatus; electrified fences; parking meters; holograms; semi-conductors; reflective safety vests; sunglasses; navigational instruments; cabinets for loudspeakers; alarms; calibrating rings; fire extinguishers; electronic key fobs being remote control apparatus; meters; video screens; gauges; accumulators, electric, for vehicles; igniting apparatus, electric, for igniting at a distance; lightning rods.

Class 12: Trolleys; locomotives; cars; automobile tires; air vehicles; bicycles; pumps for bicycle tires; boats; repair outfits for inner tubes; brake discs for vehicles; remote control vehicles, other than toys; carts; seat cushions for the seats of vehicles.

Class 18: Umbrellas; motorized suitcases; canvas bags; walking sticks; travelling bags; fur-skins; leather leads; leather twist; bags for sports.

Class 25: Headgear for wear; gloves [clothing]; shawls; clothing; girdles; hosiery; sports jerseys; raincoats; footwear; motorists' clothing.

Class 36: Real estate management; insurance brokerage; trusteeship; lending against security; charitable fund raising; surety services; finance leasing; financial customs brokerage services; art appraisal; financial management.

Class 37: Clothing repair; heating equipment installation and repair; motor vehicle maintenance and repair; electric appliance installation and repair; repair information; retreading of tires; vehicle washing; burglar alarm installation and repair; rustproofing; airplane maintenance and repair.

Class 39: Parcel delivery; piloting; arranging of transportation for travel tours; car rental; car transport; pleasure boat transport; air transport; transport; rental of storage containers; carting.

Class 42: Cartography services; industrial design; technical research; dress designing; weather forecasting; surveying; computer programming; quality control; vehicle roadworthiness testing; off-site data backup.

5. Given the respective filing dates, HHH's mark is an earlier mark in accordance with section 6 of the Act. As it completed its registration process less than five years before the date on which Renault designated the UK for the protection of its mark, it is not subject to the proof of use requirements specified within section 6A of the Act. Consequently, HHH may rely upon all the goods and services of its mark without having to demonstrate genuine use.

6. By virtue of filing the opposition under this ground, HHH claims that the competing marks are similar, and that the parties' goods and services are identical or similar, giving rise to a likelihood of confusion.

7. Renault filed a counterstatement, denying the ground of opposition. It denies both that the marks are similar, and that the parties' goods and services are identical or similar. On this basis, Renault disputes that there is a likelihood of confusion.

8. On 29 March 2022, Renault made an application to invalidate HHH's mark in full, based upon sections 3(1)(b), 3(1)(c), 3(1)(d), 3(3)(b) and 4 of the Act.

9. Under section 3(1)(b), Renault argues that HHH's mark is not capable of functioning as an indicator of origin as it will be viewed by the relevant public as descriptive of a characteristic of some of the goods, namely, that it will be perceived as a variation of the power, or on/off, symbol. In addition, or in the alternative, Renault claims that HHH's mark is devoid of any distinctive character for all the goods and services because it is excessively simple and banal.

10. Under section 3(1)(c), Renault claims that HHH's mark will be perceived as a variation of the power, or on/off, symbol and is, therefore, descriptive of a characteristic of the goods, namely, that they can be turned on/off with a power switch. This ground is directed at HHH's *interactive touch screen terminals, electrified fences, navigational*

*instruments, alarms, meters and video screens in class 9 and remote control vehicles, other than toys in class 12 only.*

11. Further, Renault claims that, where HHH's mark does not designate the above characteristic, the mark is deceptive, since it will lead the relevant public to believe that the goods and services should possess that characteristic, i.e. that they can be switched on and off. It argues, therefore, that HHH's mark is contrary to section 3(3)(b) in respect of all the goods and services, except for those listed at paragraph 10.

12. As for its claim under section 3(1)(d), Renault reiterates that HHH's mark is likely to be recognised as a variation of the power, or on/off, switch. In this connection, it contends that the mark consists of a sign which is customary in trade.

13. Turning to its claim under section 4, Renault submits that the prohibition of the registration of protected emblems should also apply *mutatis mutandis* to standardised signs. It argues that HHH's mark is a variation of a standardised sign which should remain in the public domain and free for all to use.

14. HHH filed a counterstatement, denying the grounds of opposition. HHH denies that its mark is not capable of designating origin. It also disputes that the mark will be viewed by the relevant public as a variation of the power, or on/off, symbol (rendering it descriptive, deceptive, customary in trade, or otherwise non-distinctive). Moreover, HHH argues that section 4 does not apply to its mark or symbols such as on/off switches.

15. On 24 August 2022, the proceedings were consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008 ("the Rules").

16. Both parties filed evidence in these proceedings. A hearing was requested and held before me, by video conference, on 24 July 2023. Renault was represented by Nora Fowler of Kilburn & Strode LLP. HHH was represented by Julius Stobbs of Stobbs IP.

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

## **Evidence**

18. Renault's evidence is given in two witness statements from Nora Fowler, the second in reply, together with twelve exhibits (NXF1-NXF12), and a witness statement from Béatrice Levy-Moulin, together with six exhibits (XXX1 to XXX6). Ms Fowler is a Trade Mark Attorney at Kilburn & Strobe LLP, Renault's professional representatives. Broadly, she provides evidence on various symbols to support Renault's invalidity action. Ms Levy-Moulin is Intellectual Property Director at Renault, a position she has held since January 2020. Her evidence goes to the company's background, other disputes between the parties, and car roundel logos. She also introduces into the proceedings evidence that, she says, HHH filed in a Chinese dispute.

19. HHH's evidence is given in three witness statements from Shengnan Qu, two of which were in reply, and twenty-seven exhibits (SQ1-SQ25 and SQ1-SQ2).<sup>2</sup> Mr Qu is Legal Counsel at HHH, a position he has held since June 2020. He provides evidence as to the company's background, car roundel logos, and how HHH uses/intends to use its mark.

20. I have read all the evidence and will return to it to the extent I consider necessary in the course of this decision.

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<sup>2</sup> For the sake of clarity, I will refer to the exhibits to Mr Qu's second statement as SQ1(2) and SQ2(2).

## **Preliminary remarks**

### **Effect of EU proceedings**

21. Within her skeleton argument, Ms Fowler correctly highlighted that HHH's mark is a comparable UK trade mark created pursuant to the Withdrawal Agreement between the UK and the EU. She submitted that, on 3 November 2021, an application for invalidation was filed against the EUTM from which it was cloned; in a decision dated 16 May 2023, the EUIPO partially upheld the application. Ms Fowler argued that the outcome of the proceedings against the EUTM ought to be applied to the UK comparable right. This line of argument was also pursued at the hearing.

22. Mr Stobbs argued that the applicability of the EUIPO's decision is not at issue in these proceedings as it had not been foreshadowed in Renault's pleadings. Further, that the outcome of the EU proceedings does not apply because the application for invalidity happened after withdrawal, at a time when the comparable UK trade mark was a legitimately created standalone right.

23. As the point was raised for the first time in Ms Fowler's skeleton argument, I indicated at the hearing that I would write to the parties to obtain their full submissions on it if it became necessary to do so. Upon reflection, I do not consider it necessary; it can be dealt with briefly. Where invalidation proceedings were instituted against an EUTM but not finally determined before 31 December 2020, the outcome of such proceedings can be applied to the relevant UK comparable mark.<sup>3</sup> However, in this case, the application to invalidate the EUTM from which HHH's mark was cloned was not filed until 3 November 2021, i.e. the EU proceedings had not commenced before 31 December 2020. In the absence of any provisions in the Act or Rules stipulating that the outcome of EU invalidation proceedings instituted after 31 December 2020 can be applied to the UK comparable mark, I do not consider it appropriate to do so. As Mr Stobbs submitted, the EUTM and HHH's mark were, at the time of the commencement of the EU proceedings, separate rights, with the fate of the latter no longer tied to that of the former.

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<sup>3</sup> As per Schedule 2A, Part 1 of the Act, paragraph 21A

## Section 4

24. As outlined above, one of Renault's grounds of invalidation is based upon section 4 of the Act. It is pleaded that prohibition of the registration of protected emblems should apply *mutatis mutandis* to standardised signs and close variations thereof. At the hearing, Ms Fowler reiterated this line of argument and maintained that section 4 is a proper basis for invalidation.

25. I agree that the prohibition of registering the specially protected emblems listed in section 4 could constitute a proper basis for invalidation under section 47 in an appropriate case. Section 47(1) stipulates that "the registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration)", and section 3(5), under absolute grounds for refusal of registration, states that "a trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems)".

26. Nevertheless, irrespective of whether the correct ground of invalidation to plead in this regard would strictly be section 3(5) rather than section 4, I do not accept that "standardised signs" such as the on/off or stand-by symbols are covered by section 4. The specially protected emblems referred to in section 4 cover Royal material, flags of the United Kingdom and constituent territories, emblems of Paris Convention countries and certain international organisations, arms granted by the Crown, and the Olympic Symbol.<sup>4</sup> It is an exhaustive list, which does not include any "standardised signs" (as was accepted by Ms Fowler at the hearing). Renault has not produced any authorities which establish that the protection conferred by section 4 should, or can be, applied to symbols or emblems that are not listed.

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<sup>4</sup> See sections 4(1) to 4(5) of the Act. The emblems referred to in section 4(3) are those listed in sections 57 and 58 of the Act.

27. Accordingly, even if I later find that HHH's mark will be seen as a variation of either the on/off or stand-by symbol, Renault's claim under this ground of invalidation cannot succeed. It is dismissed and I shall say no more about it.

### **Relevance of other decisions**

28. I note that both parties have referred to previous decisions to support their positions on several issues. Renault has provided a decision of the EUIPO Boards of Appeal, a judgement of the General Court ("GC") and a letter of refusal of a figurative mark from the EUIPO to support its position regarding the distinctiveness (or a lack thereof) of HHH's mark.<sup>5</sup> In addition, it has filed a decision of the Dusseldorf Higher Regional Court (and an English translation) to support its position on there being no likelihood of confusion between the parties' marks.<sup>6</sup> For its part, HHH has filed a decision of the China National Intellectual Property Administration (and an English translation) to support its position on there being a likelihood of confusion.<sup>7</sup> At the hearing, Mr Stobbs also took me to a previous decision of the Registrar, namely, BL O/245/19, which was filed shortly beforehand.

29. While I note the contents of these decisions, it suffices to say that they are not relevant to the present proceedings. It is well established that previous decisions of this office, the EUIPO or other national offices, are not binding on the Registrar. I accept that, on points of interpretation of EU law, decisions of the GC issued before the end of the transition period are binding. However, that does not apply to findings of fact, or outcomes of multifactorial assessments. Each case must be assessed on its own merits; I do not consider it appropriate to derive my findings or conclusions from the decisions to which the parties refer. Determination of the parties' respective claims will be made in accordance with all the relevant factors and on the basis of all the papers before me.

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<sup>5</sup> Exhibits NXF5 and NXF6

<sup>6</sup> Exhibit XXX2

<sup>7</sup> Exhibit SQ16

## **My approach**

30. As HHH's mark is the sole earlier right relied upon in the opposition against Renault's mark, it is convenient to first deal with Renault's application to invalidate HHH's mark. I will then return to consider HHH's opposition, should it become necessary to do so.

## **Application to invalidate HHH's mark**

31. In invalidation proceedings, section 3 of the Act has application because of the provisions of section 47(1) of the Act, which states:

47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered."

32. Section 3 of the Act, insofar as it is relevant, reads as follows:

"3(1) The following shall not be registered—

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

[...]

(3) A trade mark shall not be registered if it is—

(a) [...]

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

33. The relevant date for determining whether the mark is objectionable under the grounds of invalidation is the filing date of HHH’s mark, i.e. 22 August 2018.

### **Section 3(1)(c)**

34. It is convenient to first consider Renault’s claim under section 3(1)(c). The case law under this ground (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the

purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32;

*Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM (C-80/09 P)*, paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods

or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

35. The position under this ground must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.<sup>8</sup> The relevant public will vary depending on the particular goods and services concerned. However, in this case, average consumers of *interactive touch screen terminals, electrified fences, navigational instruments, alarms, meters and video screens* in class 9 and *remote control vehicles, other than toys* in class 12 will include the general public and professional/business users. At least a medium degree of attention will be paid as the relevant public will consider factors such as, for example, functionality, ease of use, cost and safety.

36. Mr Stobbs confirmed at the hearing that there is no claim on HHH’s part that its mark has acquired distinctiveness through use. Accordingly, I have only the inherent position to consider.

37. HHH’s mark is figurative and consists of three elements. At the centre is a black, rectangular shape with curved corners, presented in a vertical orientation. This element is flanked by two curved black shapes of lesser length. In my view, none of the elements is more dominant than the others; rather, all three elements contribute to the overall impact of the mark in combination.

38. Renault’s case is that HHH’s mark will be viewed as a variation of an on/off symbol and is, therefore, descriptive of goods which have on/off switches. I note from the evidence that the ‘International Standard – Graphic Symbols’ document, produced by the International Electrotechnical Commission (2000 to 2010), has the following entries for the on/off and stand-by symbols:<sup>9</sup>

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<sup>8</sup> *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

<sup>9</sup> Exhibit NXF1



**"ON"/"OFF" (push-push)**

To indicate connection to or disconnection from the mains, at least for mains switches or their positions, and all those cases where safety is involved. Each position, "ON" or "OFF", is a stable position.



**Stand-by**

To identify the switch or switch position by means of which part of the equipment is switched on in order to bring it into the stand-by condition..

39. This evidence supports my own understanding of the symbols. Furthermore, I do not dispute that the goods in question are of the kind which may possess on/off or stand-by functions and may, therefore, feature buttons or switches adorned with the symbols. At least some of them (such as navigation devices and touch screen terminals) have been shown to possess on/off or stand-by buttons in images and printouts from Amazon provided by Ms Fowler,<sup>10</sup> albeit that some of this evidence is undated and of unknown origin. Although Mr Qu disputes that the symbols in the International Standard are relevant to cars,<sup>11</sup> the document says that "each symbol may be used in any field of application provided there is no ambiguity".<sup>12</sup> As such, there is no reason the symbols could not be used in conjunction with vehicles. In fact, printouts from zigwheels.com.au,<sup>13</sup> whilst being an Australian website relating to a 2022 vehicle, clearly show the stand-by symbol on a button within a Toyota Prius car.

40. At the hearing, Ms Fowler submitted that the relevant public is very accustomed to seeing different variations of the symbols. In this connection, I was referred to Google Image search results and printouts from svgrepo.com.<sup>14</sup> This evidence is not without its limitations insofar as establishing that the relevant public was accustomed to different variations of the symbols at the relevant date. For instance, it is undated and there is no indication that it relates to the UK. In any event, the symbols shown in this evidence are very similar (if not identical) to those shown above, i.e. they are only very slight variations of the standardised symbols. They are all far closer in appearance to

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<sup>10</sup> Exhibit NXF4

<sup>11</sup> Second witness statement of Shengnan Qu, §13

<sup>12</sup> Exhibit NXF1

<sup>13</sup> Exhibit NXF4

<sup>14</sup> Exhibits NXF2 and NXF3

them than HHH's mark. They all feature the same essential shape, and none is a significant departure, as can be seen from the following examples:



41. On the basis of this evidence, the aforementioned images and Amazon printouts, and a printout from ebike-mtb.com,<sup>15</sup> I am prepared to accept that the relevant public was accustomed to seeing very slight variations of the standardised symbols, consisting of a line completely enclosed by a circle, or a near-complete circle with the vertical line crossing the uppermost part. However, it is my view that HHH's mark is more than a slight variation of the standardised symbols and I do not consider that HHH's mark will be immediately perceived by the relevant public in the manner asserted. The central shape in HHH's mark is much longer than the central line of the stand-by symbol, and the mark does not feature a circular shape with only an incomplete top. Whilst the central line in the on/off symbol is closer in appearance to the central shape in HHH's mark, it is contained within a complete circle; HHH's mark does not contain a complete circle and, in my view, the outer curved elements are unlikely to be seen as parts of an incomplete circle. Moreover, the gaps between the shapes are too great for the relevant public to perceive the mark as a circle around a line and, therefore, a logical variation of the on/off symbol. Although I acknowledge that HHH's mark is somewhat reminiscent of the symbols, I do not believe that the relevant public would immediately perceive it as a variation thereof without further mental processing or analysis. The overall impression created by HHH's mark is too far removed from the standardised symbols and the limited variations shown in evidence for the mark to be seen as a variation of the symbols.

42. This finding is not disturbed by Renault's argument that it is common to use closed brackets when typing symbols with a circle. The examples shown in evidence from the UK Copyright Service comprise the registered trade mark symbol '®' being produced by typing '(R)', the copyright symbol '©' being produced by typing '(C)', and the sound

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<sup>15</sup> Exhibit NXF4

recording copyright symbol ‘©’ being produced by typing ‘(P)’.<sup>16</sup> I do not doubt that some consumers would have encountered such a typing practice and would, as a consequence, be familiar with it in relation to these particular letters. However, there is no evidence that the on/off and stand-by symbols are created in the same way. Moreover, the evidence suggests that the practice is used in the context of software applications using predictive text to produce those symbols. This is consistent with Ms Fowler’s references at the hearing to Microsoft Word and other such programs. Consumers potentially seeing/using bracketed letters within word-processing software to create a limited number of symbols does not mean, nor prove, that the relevant public is accustomed to seeing the use of brackets as equal to the use of a circle in any context or that the shapes in HHH’s mark would be seen as a circle. In any event, given the overall composition of the mark, the fact that the central shape is not a letter, and that HHH’s mark is not a command/shortcut for creating symbols, it is unlikely that the relevant public would perceive the two curved shapes within the mark as brackets indicating a keyboard shortcut for any symbol. The argument that a consumer would perceive HHH’s mark as a variation on a symbol because that is how they could hypothetically type it is tenuous, at best, and I reject it.

43. I am also not persuaded by the evidence from Ms Fowler and Ms Levy-Moulin that is intended to show that HHH’s mark is, in fact, used as a variation of the on/off symbol. That from Ms Fowler consists of printouts from various websites.<sup>17</sup> This shows use of the standardised symbols on buttons within cars, generally appearing near the steering wheel or located on the central console. There is no obvious reason why such use would be aberrant or why it would be unreasonable to use the symbol on an ignition switch. That from Ms Levy-Moulin consists of documents which are said to be from proceedings between the parties in China.<sup>18</sup> They show HHH’s mark on the central console of a vehicle (along with other locations, such as front-centre of the bonnet), as can be seen in the image below:

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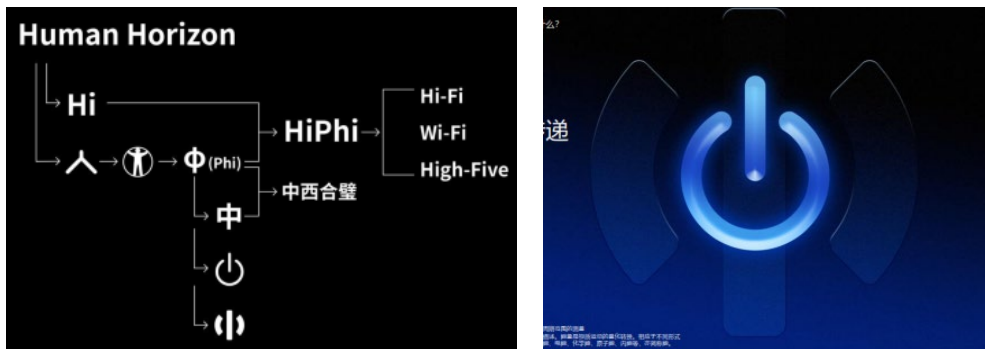
<sup>16</sup> Exhibit NXF8

<sup>17</sup> Exhibits NXF10 to NXF12

<sup>18</sup> Exhibits XXX4 to XXX6



44. However, I do not consider the fact that HHH's mark appears in a particular place in a vehicle to be compelling evidence that the mark is used as a variation of the symbols or will be perceived as such. Neither do I consider the fact that HHH's mark appears to be presented near depictions of the on/off or stand-by symbols in HHH's own materials to be compelling evidence that the mark is used as a variation of the symbols. I accept that it does, as shown in the examples below (from what appears to be a brand profile or marketing document). Nevertheless, that is not conclusive, particularly in the absence of any information which would enable me to contextualise why that is the case.



45. I acknowledge that, as the case law stipulates, it is not necessary that the sign in question is actually used in a way that is descriptive for it to fall foul of section 3(1)(c); it is sufficient, by virtue of the wording of the provision, if the sign could be used for such purposes. However, there is nothing before me which suggests that there is a real risk of this in respect of HHH's mark. The evidence shows that the on/off and stand-by symbols are standardised. I have already outlined the limitations of Renault's evidence which seeks to establish that the relevant public is accustomed to seeing

variations of the on/off and stand-by symbols. Even if slight variations and particular expressions of them are in use, one would expect them to remain more closely aligned to the standardised forms so that the public still recognise them as such and so that they convey the intended meanings. Furthermore, that a mark may become descriptive in the future must be reasonably foreseeable. In this case, I do not consider it to be. Rather, it appears entirely theoretical based on transient similarities between HHH's mark and the on/off and stand-by symbols. In my view, HHH's mark is too far removed from the standardised symbols (or even the limited variations shown in evidence) for it to be logically adopted as a variation thereof in the future.

46. As HHH's mark would not be perceived as a variation of an on/off or stand-by symbol, and there is no reasonably foreseeable risk thereof in the future, there is no basis upon which to conclude that it is exclusively descriptive of the goods at issue under this ground or a characteristic thereof.

47. Renault's claim under section 3(1)(c) of the Act is dismissed.

### **Section 3(3)(b)**

48. In *TWG Tea Company Pte Ltd v Mariage Frères SA*, BL O/358/17, Mr Phillip Johnson, sitting as the Appointed Person, conveniently summarised the case law (at paragraph 84 of his decision) as follows:

“(a) it is necessary to establish that the mark will create actual deceit or a sufficiently serious risk that the consumer will be deceived: *C-87/97 Consorzio per la tutela del formaggio Gorgonzola*, ECLI:EU:C:1999:115, paragraph 41; *C259/04 Emanuel*, ECLI:EU:C:2006:2015, paragraph 47; *C-689/15 W.F. Gözze Frottierweberei*, EU:C:2017:434, paragraph 54;

(b) the deception must arise from the use of the mark itself (i.e. the use per se will deceive the consumer); *Gorgonzola*, paragraph 43; *Emanuel*, paragraph 49; *Gözze Frottierweberei*, paragraph 56;

(c) the assessment of whether a mark is deceptive should be made at the date of filing or priority date and so cannot be remedied by subsequent corrective statements: *Axle Associates v Gloucestershire Old Spots Pig Breeder's Club* [2010] ETMR 12, paragraph 25 and 26;

(d) the decision must have some material effect on consumer behaviour: *CFA Institute's Application* [2007] ETMR, paragraph 40;

(e) where the use of a mark, in particular a collective mark, suggests certain quality requirements apply to goods sold under the mark, the failure to meet such requirements does not make use of the mark deceptive: *Gözze Frottierweberei*, paragraphs 57 and 58;

(f) only where the targeted consumer is made to believe that the goods and services possess certain characteristics which they do not in fact possess will the consumer be deceived by the trade mark: T-248/05, *HUP Usługi Polska v OHIM*, ECLI:EU:T:2008:396, paragraph 65;

(g) where a mark does not convey a sufficient specific and clear message concerning the protected goods and services or their characteristics but, at the very most, hints at them, there can be no deception in relation to those goods and services: *HUP*, paragraph 67 and 68; T-327/16; *Aldi v EUIPO* ECLI:EU:T:2017:439, paragraph 51;

(h) once the existence of actual deceit, or a sufficiently serious risk that the consumer will be deceived, has been established, it becomes irrelevant that the mark applied for might also be perceived in a way that is not misleading: T29/16 *Caffé Nero Group v EUIPO*, ECLI:EU:T:2016:635, paragraph 48;

(i) where a trade mark contains information which is likely to deceive the public it is unable to perform its function of indicating the origin of goods: T-41/05 *SIMS – École de ski internationale v OHIM*, EU:T:991:200, paragraph 50, *Caffé Nero*, paragraph 47.”

49. I can deal with this ground briefly. Renault's case is that, where HHH's mark does not designate a characteristic of the goods and services for which it is registered, it is deceptive since it would lead the relevant public to believe that those goods and services should have that characteristic, i.e. that where the goods and services at issue cannot be switched on and off, consumers will be deceived into believing that they can. This claim is predicated on Renault's argument that HHH's sign would be perceived as an on/off or stand-by symbol.

50. For a claim under section 3(3)(b) to succeed, the mark must create actual deceit or a sufficiently serious risk that the average consumer will be deceived as to the nature, quality and/or geographical origin of the goods, resulting in the economic behaviour of the average consumer being materially affected. I agree that a large proportion of the goods and services at issue under this ground a) cannot typically be turned on/off and b) do not typically feature on/off buttons, such as, for example, *seat cushions, walking sticks, shawls, real estate management, rustproofing, parcel delivery and surveying*. However, I have already found that the relevant public would not perceive HHH's mark as a variation of the on/off or stand-by symbols. Accordingly, it follows that there is no risk that consumers will be deceived in the manner asserted. I should add that a small proportion of the goods at issue under this ground could be turned on/off or feature the standardised symbols, such as, for example *cars and electronic key fobs being remote control apparatus*. Renault has not explained how, even if HHH's mark was perceived as a variation of the symbols, why its presence in relation to those goods would be misleading or deceptive.

51. Renault's claim under section 3(3)(b) of the Act is dismissed.

### **Section 3(1)(d)**

52. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the GC summarised the case law of the Court of Justice of the European Union ("CJEU") under the equivalent of section 3(1)(d) of the Act, as follows:

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the

mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and BSS, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and BSS, paragraph 40)."

53. I can also deal with this ground briefly. Renault's case is that the on/off and stand-by symbols are customary in trade and that HHH's mark is likely to be recognised as

a variation thereof. On this basis, it argues that the mark cannot act as an indication of commercial origin for any of the goods and services for which it is registered.

54. I have already found that the relevant public would not perceive HHH's mark as a variation of the on/off or stand-by symbols. Furthermore, the only evidence of use of HHH's mark adduced by the opponent is HHH's own use, which is in a manner that I have found not to be descriptive of anything. In my view, the evidence before me falls a long way short of demonstrating that the mark has become customary in trade.

55. Renault's claim under section 3(1)(d) of the Act is dismissed.

### **Section 3(1)(b)**

56. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29. [...] the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v*

*OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as *OHIM* points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

57. Again, the position under this ground must be assessed from the perspective of the average consumer. The relevant public will vary depending on the particular goods and services concerned. However, in this case, average consumers will include the general public and professional/business users. At least a medium level of attention will be paid for all the goods and services as the relevant public will consider various factors during the purchasing process. For example, when purchasing goods in class 9, the relevant public will consider functionality, cost and ease of use, whereas, when purchasing goods in classes 18 and 25, the relevant public will consider aesthetics, materials and compatibility with other items. Some goods and services, such as, for example, *cars* and *surveying*, are likely to prompt a more considered thought process

and attract a significant outlay; selection will be of greater importance, and the relevant public will, therefore, exhibit a higher level of attentiveness.

58. Part of Renault's case under this ground is inextricably linked to that considered under section 3(1)(c), i.e. that HHH's mark is descriptive of a characteristic of the goods and is, therefore, devoid of distinctive character. For the same reasons as given under that ground, this part of Renault's claim under section 3(1)(b) is dismissed.

59. However, I bear in mind that the sections 3(1)(b) and 3(1)(c) are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b).<sup>19</sup> In this connection, Renault pursues an alternate pleading under this ground, which applies to all the goods and services for which HHH's mark is registered. It contends that the mark, consisting of a set of simplistic geometric shapes, is devoid of distinctive character because it is excessively simple and, consequently, is not capable of functioning as an immediate indicator of economic origin.

60. In support of this argument, Renault has provided examples of marks which have previously been refused registration by the IPO.<sup>20</sup> Conversely, HHH has provided registration certificates and details relating to its mark (from the UK, EU, China and others), as well as examples of other UK and EU registrations which, it says, support its position on distinctiveness.<sup>21</sup> Whilst the foregoing is noted, it suffices to say that I am not bound by previous decisions taken in the examination process, whether that be of the IPO or other national offices. Moreover, the mere fact that other marks have been regarded as being incapable of identifying the commercial origin of goods or services (and vice versa), is not relevant to establishing, in the present case, whether HHH's mark has the minimum degree of inherent distinctive character necessary for registration in the UK.

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<sup>19</sup> *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, paragraph 25

<sup>20</sup> Renault's statement of grounds, §24

<sup>21</sup> Exhibit SQ4, Exhibit SQ14 and Exhibit SQ1(2); Qu 2, §28

61. I also note that both parties have provided evidence regarding HHH's activities, as well as its alleged conception and use of its mark.<sup>22</sup> Whilst this is noted, it will not have any bearing on my assessment of distinctive character. As previously outlined, there is no claim on HHH's part that its mark has acquired distinctiveness through use; as such, I am concerned with only the inherent position. Furthermore, regardless of whether HHH's mark was designed to be a combination of different descriptive or non-distinctive elements, including Chinese characters, this is a) not obvious from the mark and b) would not be known by the relevant public.

62. Returning to the present case, I bear in mind that the GC has stated that a sign which is excessively simple and is constituted of a basic geometrical figure, such as a circle, a line, a rectangle or a conventional pentagon, is not, in itself, capable of conveying a message which consumers will be able to remember, with the result that they will not regard it as a trade mark unless it has acquired distinctive character through use.<sup>23</sup> However, HHH's mark is not a basic geometric shape or even a combination of basic geometric shapes. As previously outlined, HHH's mark consists of three elements: a black rectangular shape between two black curved shapes. Although the mark is not overly complex and lacks semantic content, it features shapes of different sizes and orientation, in addition to a degree of interaction between those shapes (such as, for example, the opposing curved shapes drawing attention in to the central shape). For this reason, I disagree with Renault that the mark is excessively simple and devoid of any distinctive character. Whilst it is, admittedly, far from being the most distinctive of marks, I am satisfied that HHH's mark possesses the minimum level of inherent distinctive character to enable it to function as an indicator of economic origin in respect of the goods and services for which it is registered.

63. Renault's claim under section 3(1)(b) of the Act is dismissed.

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<sup>22</sup> Exhibit NXF7; First witness statement of Shengnan Qu, §§8, 10, 23, 24 and 25; Exhibits SQ1, SQ2, SQ3, SQ5, SQ6, SQ8, SQ10, SQ11, SQ12 and SQ13; Qu 2, §§15 to 19; Third witness statement of Shengnan Qu, §§2 to 9 and 11 to 13; Exhibits SQ17 to SQ22.

<sup>23</sup> *Vans, Inc. v OHIM*, Case T-53/13, paragraph 70; *Anta (China) Co. Ltd v EUIPO*, Case T-291/16, paragraph 30; *The Smiley Company SPRL v OHIM*, Case T-139/08, paragraph 26; *Cain Cellars, Inc. v OHIM*, Case T-304/05, paragraph 22

## Opposition to Renault's mark

### Section 5(2)(b)

64. Sections 5(2)(a) and 5A of the Act read as follows:

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

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

65. 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 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**

66. In *Canon*, the CJEU stated at paragraph 23 of its judgment that all relevant factors relating to the goods or services themselves should be taken into account when assessing similarity between them. Those factors were said to include their nature, intended purpose, method of use and whether they are in competition or are complementary.

67. Furthermore, the criteria identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity between goods and services also included an assessment as to their users and the channels of trade.

68. 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 that the responsibility for those goods lies with the same undertaking”.

69. In *Gérard Meric v OHIM (“Meric”)*, Case T- 133/05, the GC stated that:

“29. [...] 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.”

70. The goods and services to be compared are outlined at paragraphs 2 and 4, above.

#### Class 9

71. At the hearing, Mr Stobbs contended that *scientific apparatus and instruments* were identical to HHH’s *igniting apparatus, electric, for igniting at a distance*. I agree that, because the former would incorporate the latter, these goods are to be regarded as identical in accordance with *Meric*.

72. *Nautical apparatus and instruments* would include apparatus and instruments to assist in navigating at sea. As such, Renault’s term incorporates HHH’s term *navigational instruments*. These goods are identical in accordance with *Meric*.

73. Clearly, the nature and method of use of *surveying apparatus and instruments* and HHH’s *surveying* differs. However, there is an overlap in intended purpose since the goods and services are both used to examine and record an area and the features of a piece of land. I acknowledge that, in the domestic context, the goods and services are likely to be offered by different undertakings, and one would not expect to be able to purchase them from the same provider. However, in a commercial or industrial context, it is my view that they may reach the market through shared channels of trade. The apparatus is important to the provision of the services in such a way that, in this context, consumers may believe that the responsibility for them lies with the same undertakings. As such, there is a degree of complementarity between them. Although there is an overlapping purpose, I do not consider there to be a directly competitive relationship between them. Surveying is a technical field and, whilst a consumer might purchase particular items of surveying apparatus (such as damp meters and distance measures), a consumer seeking surveying services is likely to require more than a simple measurement. The respective goods and services may also have different users; HHH’s services will be purchased by the general public and businesses without technical knowledge, whereas Renault’s goods are likely to be purchased by professionals in the field (i.e. the surveyors). Taking all of this into account, I find that

there is between a low and medium degree of similarity between the respective goods and services.

74. To my mind, none of Renault's *photographic apparatus and instruments, cinematographic cameras, image recording apparatus, image transmission apparatus or digital recording media* is identical to HHH's *video screens*. Furthermore, they differ in nature, intended purpose and method of use. They are not in competition. However, the respective goods are important to the use of one another, and consumers may believe that responsibility for both lies with the same undertakings. As such, they are complementary. They are also likely to reach the market through shared channels of trade; within retail outlets, the respective goods will be in relatively close proximity, if not on the same shelves. The respective goods may also be produced by the same undertakings. Overall, I find that there is a medium degree of similarity between them.

75. *Optical apparatus and instruments* is a broad term referring to any apparatus or instruments relating to light or the ability to see. It is my view that it would incorporate HHH's *sunglasses* (particularly prescription sunglasses), rendering the respective goods identical in accordance with *Meric*.

76. The nature, method of use and intended purpose of Renault's *weighing apparatus and instruments* and HHH's *gauges* differ. Moreover, they are not in competition. However, the respective goods are important to one another; scales and gauges are both used when measuring weight and work in tandem so that the weight measured can be displayed. In addition, consumers may believe that responsibility for them lies with the same undertakings. As such, they are complementary. The respective goods may also reach the market through overlapping channels of trade. Taking all of this into account, I find that there is between a low and medium degree of similarity between them.

77. *Gauges* in HHH's specification, being instruments that measure and give a visual display of the amount, level, or contents of something, are encompassed by Renault's broader term *measuring apparatus and instruments*. I find that they are identical under the *Meric* principle.

78. *Traffic-light apparatus [signalling devices]* in HHH's specification are a particular type of Renault's *signalling apparatus and instruments*. The respective goods are identical as per *Meric*.

79. *Facial recognition apparatus* in HHH's specification would, in my view, fall within the scope of *checking (monitoring) apparatus and instruments* as the former is a particular example of the latter. Therefore, I find that they are identical under *Meric*.

80. To my mind, *teaching apparatus and instruments* would include audio-visual apparatus with which students interact as part of their learning experience. Therefore, there is a degree of overlap in nature and method of use when compared with HHH's *interactive touch screen terminals*. However, the intended purpose differs in that one is educational and the other is not. Furthermore, it is unlikely that the respective goods will reach the market through shared trade channels; Renault's goods are likely to be sold with other educational equipment, whereas HHH's goods are likely to be sold through technology retailers. The respective goods are not complementary. Neither are they in direct competition. Overall, I find that there is a low degree of similarity between them.

81. It is considered that the nature, intended purpose and method of use of *sound recording apparatus, sound transmitting apparatus and sound reproduction apparatus* is different from that of *video screens* in class 9 of HHH's specification. There is no competition between them. Nevertheless, goods of this nature (such as monitors and microphones/loudspeakers) are likely to reach the market through shared trade channels, such as technology retailers, and may be located in the same sections of those outlets. In certain contexts, the respective goods are important to the use of one another, and consumers may believe they are produced by the same undertakings. There is, therefore, a degree of complementarity between them. Taking all of this into account, I find that there is between a low and medium degree of similarity between them.

82. Renault's *image reproduction apparatus* would incorporate *video screens* in HHH's specification. These goods are identical under the principle in *Meric*.

83. *Cash registers* would include electronic point of sale systems, which may feature touch screens. As such, there is an overlap in nature and method of use with HHH's *interactive touch screen terminals*. In addition, there is a degree of complementarity between them in that HHH's goods are important to cash registers with touch screens and consumers may believe that they are produced by the same undertakings. However, the intended purpose of the respective goods is different; the former is for storing money, as well as calculating and displaying amounts of sales, whereas the latter is not. Moreover, it is unlikely that the goods will reach the market through the same trade channels. They are not in competition. Taking all of this into account, I find that there is between a low and medium degree of similarity between the respective goods. Although they also relate to payments, the same finding cannot be made in respect of *mechanisms for coin-operated apparatus* because there are no clear points of similarity between the respective goods. There is no overlap in nature or method of use, and they are not complementary. I find that they are dissimilar.

84. The nature, intended purpose and method of use of Renault's *calculating machines* (which includes, or is another way of saying, computers), *data processing equipment, computers, tablet computers, smartphones, electronic book readers, virtual reality headsets* and *smart watches* are clearly different from those of *computer programming* in class 42 of HHH's specification. However, Renault's goods all require programming in order for them to function and consumers are likely to believe that the undertaking responsible for goods of this nature is also responsible for their programming. On this basis, I consider the respective goods and services to be complementary. They are also likely to reach the market through shared trade channels. Overall, I find that there is a medium degree of similarity between them.

85. Although the nature, method of use and intended purpose of *game software; software (recorded programs)* and HHH's *computer programming* is different, they may reach the market through shared channels of trade and be provided by the same undertakings. Moreover, programming services are important to the production of software in such a way that consumers may believe that responsibility for them lies with the same undertakings. As such, they are complementary. There is, in some circumstances, a degree of competition between them, since a consumer may seek to have bespoke software created instead of purchasing an off-the-shelf product, or

vice versa. Overall, I find that there is a medium degree of similarity between the respective goods and services. For the same reasons, I also consider HHH's *computer programming* to be similar to a medium degree with Renault's *downloadable e-wallets*, which essentially describes a particular software program.

86. *Computer peripheral devices* include computer monitors. In my view, this is another way of expressing HHH's *video screens*. On this basis, I find that they are identical in accordance with *Meric*. If I am wrong in this finding, it remains the case that the respective goods are highly similar. They overlap in nature, method of use and intended purpose. Moreover, they reach the market through shared trade channels; they are both sold in the same retailers and will be found in the same sections of those outlets. They are not complementary, though they are in competition because a consumer could select one or the other to display the same content.

87. To my mind, although Renault's *detectors* and HHH's *alarms* differ in nature and method of use, there is an overlap in intended purpose insofar as they may both be used for safety. They may also reach the market through shared channels of trade. Renault's goods are, in some circumstances, important to the operation of HHH's goods and consumers are likely to believe that responsibility for them lies with the same undertakings. For instance, there is a close connection between smoke detectors and fire alarms, with the former typically working in tandem with the latter; without the signal sent by the detector, the alarm would not sound. On this basis, I find that the respective goods are complementary. Overall, I find that there is a medium degree of similarity between the goods under consideration.

88. *Electric wires* and *electric relays* have a different nature to HHH's *semi-conductors*. Renault's goods consist of metallic wires; HHH's goods are neither metallic nor wires. The respective goods are not in competition, given one cannot replace the other. However, there is an overlap in purpose since they are all components used in circuitry. They are also likely to reach the market through shared trade channels. The respective goods are complementary, since they are important to one another in such a way that consumers may believe they are produced by the same undertakings. Overall, I find that there is a medium degree of similarity between them.

89. At the hearing, Mr Stobbs contended that *diving suits* and *diving gloves* are similar to HHH's class 25 goods. I note that HHH's specification includes *clothing*, which would cover swimwear, surfwear and the like. Whilst items for diving are more specialist, I consider there to be an overlap in nature since, for example, wetsuits and swimwear share a similar appearance, albeit that they are generally made of different materials. There is also a degree of overlap in purpose; although Renault's goods have other properties which are not shared by HHH's goods, they are both intended to cover the body whilst in the water. As for method of use, there is an overlap in that both are worn on the body. The respective goods may reach the market through shared trade channels, such as, for example, surf shops. However, as diving equipment is specialist in nature, it is unlikely that they will be produced by the same undertakings. In my view, they are neither complementary nor in direct competition. Taking this into account, I find that there is a low degree of similarity between them. I also make the same finding in relation to Renault's *diving masks* for the same reasons.

90. *Clothing for protection against accidents* incorporates HHH's *reflective safety vests*. The respective goods are identical in accordance with *Meric*.

91. *Reflective safety vests* in HHH's specification are also similar to Renault's *clothing for protection against [...] irradiation and fire* and *protection devices for personal use against accidents* to at least a low degree. Notwithstanding the differences in nature, as well as there being no competition or complementarity between them, the respective goods overlap in method of use (in respect of Renault's clothing) and intended purpose (in relation to Renault's protection devices). They are also likely to reach the market through shared trade channels and may be provided by the same undertakings.

92. *Fire extinguishers* appear in both parties' specifications. It is common ground that they are identical goods.

93. I do not consider HHH's *sunglasses* to be identical to Renault's *spectacles (optics)* because, typically, spectacles are characterised by their magnifying properties and are used to aid vision. Conversely, sunglasses provide protection from UV light. However, there is an overlap in nature insofar as both are examples of eyewear.

Moreover, there is also a degree of overlap in purpose since it is possible to purchase 'prescription' sunglasses and spectacles with lenses that darken in sunlight. They may also be provided by the same undertakings and reach the market through shared trade channels. Taking all this into account, I find that there is a medium degree of similarity between the respective goods.

94. *3D spectacles* describe glasses which enable the wearer to view visual content in three-dimensions. They clearly have a different intended purpose when compared with HHH's *sunglasses*. Moreover, they are not typically produced by the same undertakings and are unlikely to reach the market through the same trade channels. There is no competition between them, and they are not complementary. However, I accept that there is an overlap in nature and method of use, both being kinds of eyewear. On this basis, I find that there is a low degree of similarity between the respective goods.

95. Clearly, *sunglasses* in HHH's specification are a type of eyewear. They are, therefore, identical to Renault's *eyewear* as per *Meric*.

96. *Sunglasses* in HHH's specification are also similar to between a low and medium degree to Renault's *spectacle cases*. Although the goods differ in nature, intended purpose and method of use, they are likely to reach the market through the same trade channels and will be in close proximity within retail outlets. Given the relationship between them, as well as consumers likely believing that the responsibility for them lies with the same undertakings, it is my view that there is also a degree of complementarity between them.

97. *Integrated circuit cards [smart cards]* refer to cards which have an embedded circuit chip. They are typically used for making payments, identification and access control. At the hearing, Mr Stobbs argued that these goods are similar to HHH's *semi-conductors* because the latter are a key ingredient in any circuit or processor chip. However, the mere fact that a particular good is used as a part, element or component of another does not suffice, in itself, to show that the finished goods containing those

components are similar.<sup>24</sup> In this case, the respective goods have a different nature, method of use and intended purpose. They are likely to reach the market through different trade channels and be produced by different undertakings. The respective goods are not in competition. Moreover, although semi-conductors may be important to the use of integrated circuit cards, I do not consider that consumers will believe that responsibility for them lies with the same undertakings. As such, they are not complementary. Taking all of this into account, I find that the respective goods are dissimilar.

98. *Bags designed for laptop computers and travelling bags* in class 18 of HHH's specification overlap in nature, intended purpose and method of use. Both are bags, in which items will be placed for storage and transportation. The difference is that one is specifically designed for laptops. I accept that the goods may both reach the market through large retailers, though they are unlikely to be located in close proximity in such outlets. They are not complementary. Neither are they in competition as a consumer is unlikely to purchase a general-purpose travelling bag if they are seeking a laptop bag, or a laptop bag for other items. Overall, I find that there is a low degree of similarity between the respective goods.

99. *Accumulators, electric, for vehicles* in HHH's specification is another way of describing batteries for vehicles. Renault's *electric batteries* would cover those for vehicles. Accordingly, the respective goods are identical under *Meric*.

100. I agree with Mr Stobbs that *batteries for electronic cigarettes* and HHH's *accumulators, electric, for vehicles* overlap in nature and intended purpose, since they are both batteries for powering things, albeit that they are on a different scale and are for different things. The goods are unlikely to reach the market through shared trade channels. Moreover, I do not consider it typical in trade for them to be produced and offered by the same undertakings. They are not complementary. Although both may be used to power something, they are certainly not interchangeable such that they are in competition. In view of all this, I find that the respective goods are similar to a low degree.

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<sup>24</sup> *Les Éditions Albert René v OHIM*, Case T-336/03, paragraph 61

101. In my view, the nature, method of use and intended purpose of *charging stations for electric vehicles* is different from that of *accumulators, electric, for vehicles*. However, there may be an overlap in trade channels and the respective goods may be produced by the same undertakings, i.e. although the manufacturer of the charging stations may differ from the manufacturers of the vehicles themselves, the manufacturers of batteries for electric vehicles may also manufacture charging apparatus for them. There is also a degree of complementarity between them as charging stations for electric vehicles are important to the operation of the batteries within the vehicles and consumers may believe that the responsibility for them lies with the same undertakings. In light of all this, I find that the respective goods are similar to a medium degree.

102. Renault's *diagnostic apparatus not for medical use* and *vehicle roadworthiness testing* in class 42 of HHH's specification clearly have a different nature, method of use and intended purpose. However, aside from medical uses, Renault's goods could apply to any field of application; the term could include diagnostic apparatus for testing the roadworthiness of vehicles. In this connection, the goods are important to the provision of HHH's services and, in my view, consumers are likely to believe that responsibility for both lies with the same undertakings. They are, therefore, complementary. On this basis, I find that there is a low degree of similarity between the respective goods and services.

### Class 28

103. *Clothing* in class 25 of HHH's specification is a broad term which would include a wide range of clothes for various activities, such as, for example, sports, fishing, skating, surfing and skiing. I acknowledge that the nature, intended purpose and method of use of these goods and Renault's *appliances for gymnastics, fishing tackle, balls for games, ice skates, roller skates, sailboards, surfboards, rackets, snowshoes, skis* and *protective padding (parts of sportswear)* is very different. Nevertheless, Renault's goods are likely to reach the market through the same trade channels as the corresponding items of clothing. For example, surfboards are likely to be sold through the same retail outlets that offer surfwear, whilst appliances for gymnastics are likely

to be sold via the same outlets which offer clothing for gymnastics. The respective goods may also be produced by the same undertakings. They are not in competition or complementary. Overall, I find that there is a low degree of similarity between the goods under consideration.

104. At the hearing, Mr Stobbs argued that Renault's *toys, models [toys] and robots as toys* are similar to *remote control vehicles other than toys and cars* in class 12 of HHH's mark. There may be an overlap in that, for example, a toy car is technically a smaller version of a car and would assume the same shape. However, this connection is too tenuous to engage any meaningful similarity. Renault's goods are toys and models, which will be played with for amusement, collected or used for decorative purposes. Cars, on the other hand, are transport vehicles, whilst remote control vehicles are likely to be used in science or industry. Therefore, I consider that the respective goods have a different nature, intended purpose and method of use. The goods are unlikely to reach the market through shared trade channels and there is no evidence that they are produced by the same undertakings. There is no competition between the respective goods, and they are not complementary. Overall, I find that they are dissimilar.

105. The remaining goods in this class are *games, toys for household pets, play mats, controllers for game consoles, artificial Christmas trees, apparatus for physical education, billiard tables, billiard cues, billiard balls, card decks, board games, scooters [toys] and figurines [toys]*. At the hearing, Mr Stobbs contended that these were all similar to HHH's *remote control cars, video screens or interactive touch screen terminals*. However, he did not explain why. To my mind, there are no obvious points of similarity between these goods. There is no clear overlap in nature, intended purpose or method of use. The respective goods reach the market through different trade channels. They are not complementary or in competition. I acknowledge that users may overlap. However, I do not consider that alone to be sufficient to engage any similarity between them. In light of the above, I conclude that these goods are dissimilar.

106. Some degree of similarity between goods or services is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of

confusion to be considered.<sup>25</sup> My findings above mean that HHH's opposition must fail against the goods that I have found to be dissimilar, namely:

Class 9: Mechanisms for coin-operated apparatus; integrated circuit cards [smart cards].

Class 28: Games; toys; toys for household pets; play mats; controllers for game consoles; artificial Christmas trees; apparatus for physical education; billiard tables; billiard cues; billiard balls; card decks; board games; scooters [toys]; models [toys]; figurines [toys]; robots as toys.

### **The average consumer and the nature of the purchasing act**

107. The average consumer is deemed to be reasonably well informed, observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.<sup>26</sup>

108. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

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<sup>25</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

<sup>26</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97

109. Relevant consumers of the goods and services at issue in these proceedings will include members of the general public and business/professional users.

110. Some of the goods, such as, for example, *clothing*, are likely to be relatively frequent and inexpensive purchases, whereas other goods and services such as, for example, *computers*, *charging stations for electric vehicles* and *surveying*, are likely to be much more expensive, occasional purchases. Equally, the importance of the selection and the required thought process is likely to vary significantly. However, to my mind none is merely a causal purchase. The general public will have regard to various factors, such as, for instance, the functionality and ease of use of computer software, compatibility of peripheral devices with other items, the fit and style of eyewear and clothing, and the cost and expertise of the surveyor. For these reasons, whilst the level of attentiveness exhibited during the purchasing process will vary between a medium and high level, the general public is likely to demonstrate at least a medium level of attention in respect of all of the goods and services at issue. The goods are likely to be purchased by the general public from retail outlets and their online equivalents, after viewing information on shelves or on websites. The services are likely to be purchased directly from the provider, after viewing information in brochures or on websites. In light of this, the purchasing process is predominantly visual in nature. However, I do not discount aural considerations entirely as it is possible that the general public may wish to discuss goods and services of this nature prior to making their selection.

111. Many of the same considerations also apply to businesses and professional users. However, the goods and services may be more frequent purchases to support their ongoing use. In addition, businesses and professional users will wish to ensure that they are choosing the right goods or services for their business or profession; they will be mindful of the potentially negative impacts of making an incorrect selection. The level of attention displayed by these consumers will also vary between a medium and high level, depending on the particular good or service being purchased. However, I find that such consumers are also likely to demonstrate at least a medium level of attention in respect of all the goods and services. The goods are likely to be purchased by these consumers from retailers, suppliers and manufacturers, after viewing information in brochures, on the internet, or after a visual inspection of the product.

The services will be sought directly from the provider, after viewing information in brochures or on the internet. Therefore, I find that visual considerations will dominate. Nevertheless, I do not discount an aural component forming part of the process, given that such consumers may engage in verbal consultations or discuss the goods and services prior to making their selection.

### **Distinctive character of the earlier mark**

112. In *Lloyd Schuhfabrik Meyer*, 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 *WindsurfingChiemsee 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 *WindsurfingChiemsee*, paragraph 51).”

113. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor as it directly

relates to whether there is a likelihood of confusion: the more distinctive the earlier mark, the greater the likelihood of confusion.

114. I reiterate that there is no claim on HHH's part that the distinctiveness of its mark has been enhanced through use. As such, I have only the inherent position to consider.

115. I note the parties agree that car logos tend to have simpler designs and that it is usual for car manufacturers to use relatively straightforward designs.<sup>27</sup> However, even if I were to accept that this was the case, it could not have any impact on my assessment of distinctive character because cars are not at issue under this ground.<sup>28</sup>

116. I have already discussed whether HHH's mark can function as an indicator of economic origin in respect of the goods and services for which it is registered. I found that it had the minimum level required for it to do so, though I have not thus far commented on what level of inherent distinctive character it has. HHH's mark is figurative and, as previously stated, consists of three elements: a black rectangular shape between two black, curved shapes. Whilst I have found that the mark is not excessively simple – to the extent that it cannot perform the function of a trade mark – it is not particularly complex or memorable either. There is no semantic content and nothing immediately recognisable within the mark. To my mind, HHH's mark has a low level of inherent distinctive character for all the goods and services at issue.

### **Comparison of marks**

117. It is clear from *Sabel* 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

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<sup>27</sup> Qu 1, §§17, 18 and 28; Exhibits SQ7 and SQ9; Witness statement of Béatrice Levy-Moulin, §9; Exhibit XXX3

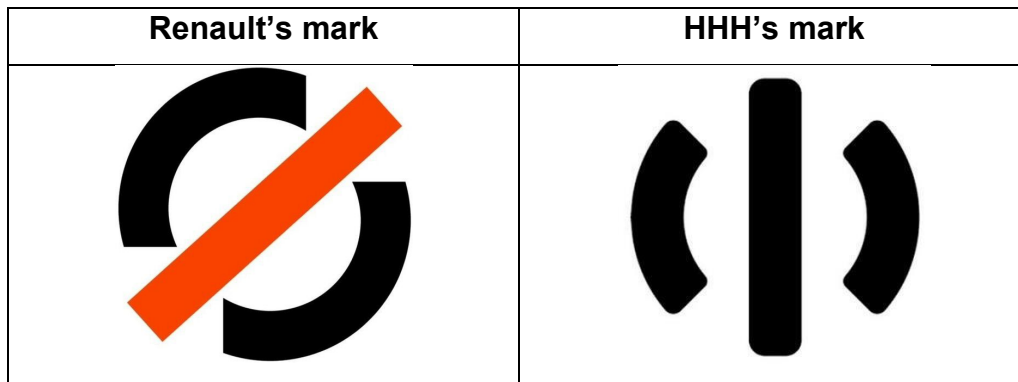
<sup>28</sup> Although *cars* do appear in HHH's class 12 specification, none of my findings of identity/similarity between the parties' goods and services is based upon this term.

mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo* 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.”

118. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

119. The competing marks are as follows:



120. The competing marks are both figurative and consist of three shapes: one straight and two curved. The respective overall impressions of the marks are dominated by all three shapes in combination, as well as how they are oriented. The use of colour in Renault's mark also provides a contribution to its overall impression.

121. It is common ground between the parties that, as neither mark will be articulated by consumers, aural considerations are not relevant to the comparison. Moreover, I agree with HHH that neither of the marks carries a clear meaning; as such, the conceptual position is neutral.

122. I note Mr Qu's submission that if Renault's mark was rotated 45° anticlockwise, it would be identical to HHH's mark, as it would be if an individual approached the front of a car from the south-west.<sup>29</sup> However, my assessment must focus upon a comparison of the marks before me and notional and fair use of those marks. Rotating the designated mark does not constitute notional and fair use of the mark. Neither does approaching the comparison from an entirely hypothetical visual encounter of the mark (on goods which are not at issue).

123. Visually, the competing marks are similar in that they both consist of a straight rectangular shape between two curved shapes. They differ because the marks are oriented differently; Renault's diagonally from bottom-left to top-right and HHH's vertical. The curved shapes in Renault's mark are also much closer to the central shape and the corners of the rectangular and curved shapes are not rounded as they are in HHH's mark. Renault's mark also makes use of the colour orange for the central shape and black for the curved shapes. I do not consider this to be a colour combination of the kind which falls within fair and normal use of a mark registered in black and white and, therefore, it also acts as a point of visual difference. Taking all of this into account, I find that the competing marks are visually similar to between a low and medium degree.

### **Likelihood of confusion**

124. 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. One such factor 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 mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely

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<sup>29</sup> Qu 1, §§30 and 33

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.

125. 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.

126. Earlier in this decision, I concluded that:

- The parties' goods and services are identical or else similar to at least a low degree;
- Relevant consumers of the goods and services will include the general public and business/professional users;
- Both groups of consumers will demonstrate at least a medium level of attention during the purchasing process, though it will be higher in respect of some goods and services;
- The purchasing process will be predominantly visual in nature, though aural considerations have not been discounted;
- HHH's mark possesses a low level of inherent distinctive character;
- The respective overall impressions of the marks are produced by all their constituent elements in combination;
- The competing marks are visually similar to between a low and medium degree.

127. At the hearing, Mr Stobbs took me to what he considered to be notional and fair use of Renault's mark in order to argue against the significance of the use of colour in

the global assessment. I note that the evidence referred to does show Renault's mark being used on cars in all black and white.<sup>30</sup> However, there are only two examples of the mark being used in a solid colour and only when the background is orange, meaning that the mark as designated would not be visible as a whole if so presented. Therefore, I do not consider it to be compelling evidence that a single colour version of Renault's mark should be deemed notional and fair use. This is particularly the case, considering there are many more examples of Renault's mark being used as designated, including on the same vehicle as the two examples of single colour use.

128. Turning to the global assessment, I accept that the competing marks are comprised of similar components, namely, a straight central shape and two curved shapes. Nevertheless, the competing marks comprise only three relatively simple elements and HHH's mark is low in distinctive character. In these circumstances, whilst I recognise that weak distinctiveness does not necessarily preclude a likelihood of confusion,<sup>31</sup> it is my view that the differences between the competing marks take on more significance. In this connection, I consider it unlikely that consumers will misremember the orientation of the marks. Moreover, use of colour plays a significant role in Renault's mark; it is unlikely that consumers will overlook the use of a non-standard colour combination in what is a relatively simple mark. In addition, the curved shapes in Renault's mark are much closer to the central shape, have sharper edges, and form more of a circle. It is also considered that there is no shared concept which could cause consumers to believe the marks are one in the same. Taking all of this into account, it is my view that the differences between the competing marks are likely to be sufficient for consumers – paying at least a medium level of care and attention – to distinguish between and avoid mistaking one for the other. Therefore, notwithstanding the principles of imperfect recollection and interdependency, I do not consider there to be a likelihood of direct confusion, even in relation to goods which are identical.

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<sup>30</sup> Exhibits SQ15

<sup>31</sup> *L'Oréal SA v OHIM*, Case C-235/05P

129. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting 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).”

130. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.<sup>32</sup> I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>33</sup> The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.<sup>34</sup>

131. Having regard to all the above principles, I do not believe that consumers, having noticed the differences between the competing marks, will assume that Renault and HHH are economically linked undertakings on the basis of the competing trade marks. I am unconvinced that consumers would assume a commercial association or licencing arrangement between the parties, or sponsorship on the part of HHH, merely because of similar shape components. HHH’s mark is not so strikingly distinctive that consumers would assume that only HHH would be using the component shapes in a trade mark. To the contrary, I have found it to be low in distinctiveness. Moreover, the differences between the competing marks are not simply adding or removing non-distinctive elements. Nor are the differences consistent with a brand extension or sub-branding exercise. I can see no reason why an undertaking would alter the orientation and style of the component shapes of a mark – the precise expression and configuration of which being where the distinctive character resides – to result in a different mark. Whilst indirect confusion is not limited to the categories outlined in *L.A. Sugar*, to my mind, there is no other basis for concluding that consumers would assume an economic connection between the parties, even when consumers are paying no more than a medium level of attention. It is possible that Renault’s mark will bring HHH’s mark to mind; however, as noted above, that is not sufficient for a finding of indirect confusion. Taking all the above factors into account, I do not consider there

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<sup>32</sup> *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

<sup>33</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

<sup>34</sup> *Liverpool Gin Distillery*

to be a likelihood of indirect confusion between the competing marks, even in relation to goods that are identical.

### **Conclusion**

132. HHH's claim under section 5(2)(b) is dismissed.

### **Overall outcomes**

133. Renault's application to invalidate HHH's mark has failed. Subject to any appeal against my decision, HHH's mark will remain registered in the UK.

134. HHH's opposition against Renault's mark has failed. Subject to any appeal against my decision, Renault's mark will become protected in the UK.

### **Costs**

135. As both parties have achieved what I regard as a roughly equal measure of success (both parties' actions having failed), I direct that both parties should bear their own costs.

**Dated this 20<sup>th</sup> day of October 2023**

**James Hopkins**  
**For the Registrar**