O-1011-23

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK3639719

IN THE NAME OF BBOXX LTD IN RESPECT OF THE TRADE MARK

FLEXX BY BBOXX

IN CLASSES 9 & 11

AND THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO UNDER NO. 504855

BY ZOLA ELECTRIC LTD

BACKGROUND AND PLEADINGS

1. UK Registration No. 3639719 stands in the name of Bboxx Ltd ("the Registered Proprietor"). The trade mark, as shown on the cover page of this decision, was filed by the Registered Proprietor on 11 May 2021. The registration date for the mark was 8 October 2021. The goods as registered are as follows:

> Class 9: Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; solar panels; photovoltaic apparatus and installations for generating solar electricity; portable solar panels; batteries; sealed batteries; solar batteries; rechargeable batteries; chargers for batteries; boxes for batteries; mountings and casings for solar panels and batteries; control units for the distribution of electricity; electricity inverters; inverters for power supplies; televisions, satellite decoders, DVD players, radios and other electronic apparatus for use with solar panels; chargers for mobile phones and other electronic apparatus; battery chargers for laptop computers; remote monitoring apparatus; monitoring instruments; communication hubs; communications equipment; wireless communications equipment; computer networking and data communications equipment; routers; mobile application software; downloadable mobile applications; computer software; computer software for use in remote meter monitoring; credit cards; debit cards; pre-payment cards; meters; meter reading apparatus and instruments; gas meters; water meters; electronic water meters; electricity meters, measuring equipment, fuel dispensing, metering and storage equipment and systems; smoke detectors, gas detectors, carbon monoxide detectors; wireless communications equipment; wireless communications apparatus and instruments; parts, fittings and accessories for all the aforesaid goods.
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> Class 11: Apparatus for lighting, heating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; solar heating installations; solar heating panels, solar panels used in heating and lighting; lamps powered by solar panels; electric lamps; mountings and casings for solar panels;

refrigerators; electric fans; gas stoves; LPG gas stoves; parts, fittings and accessories for all the aforesaid goods.

2. On 9 May 2022, ZOLA ELECTRIC LTD ("the Cancellation Applicant") filed an application for invalidation under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The invalidation is against all of the Registered Proprietor's class 11 goods and the following goods from class 9:

> Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; solar panels; photovoltaic apparatus and installations for generating solar electricity; portable solar panels; batteries; sealed batteries; solar batteries; rechargeable batteries; chargers for batteries; boxes for batteries; mountings and casings for solar panels and batteries; control units for the distribution of electricity; electricity inverters; inverters for power supplies; televisions, satellite decoders, DVD players, radios and other electronic apparatus for use with solar panels; chargers for mobile phones and other electronic apparatus; battery chargers for laptop computers; remote monitoring apparatus; monitoring instruments; communication hubs; communications equipment; wireless communications equipment; computer networking and data communications equipment; computer software for use in remote meter monitoring; meters; meter reading apparatus and instruments; gas meters; water meters; electronic water meters; electricity meters, measuring equipment, fuel dispensing, metering and storage equipment and systems; smoke detectors, gas detectors, carbon monoxide detectors; wireless communications equipment; wireless communications apparatus and instruments; parts, fittings and accessories for all the aforesaid goods.

3. Section 5(2)(b) is relevant in invalidation proceedings under section 47(2) of the Act. The application for invalidation under section 5(2)(b) is on the basis of the following mark and goods.

UK917993977

Mark: FLEX

Filing date: 30 November 2018
Registration date: 19 March 2019

Relying on all goods and services from its specification as follows:

Class 4: Electrical energy from renewable sources; Electrical energy from solar power; Electrical energy.

4. In the statement of grounds the Cancellation Applicant claims that the Registered Proprietor's mark contains their own mark in its entirety and that its position at the beginning of the mark is the most dominant and memorable position. It adds that 'Flexx' and 'Flex' are phonetically and conceptually identical and visually highly similar. The Cancellation Applicant argues that the goods are identical or highly similar.

5. In response, the Registered Proprietor denied all the arguments put forward by the Cancellation Applicant. It put forward the position that the Cancellation Applicant misrepresented their registration which is 'Flexx by BBoxx' not simply 'Flexx' and that the double 'XX' in both 'Flexx' and 'Bboxx' is distinctive. Regarding the goods, it states that they are registered in different classes and denies any similarity.

6. The Cancellation Applicant filed evidence and the Registered Proprietor filed submissions in response. A hearing was held before me on 19 July 2023. The Registered Proprietor was represented by Beth Collett of counsel instructed by Stratagem IP and the Cancellation Applicant was represented by Guy Hollingworth of counsel instructed by Withers LLP. I make this decision having taken full account of all the papers, referring to them below as necessary.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks

Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Evidence

8. The Cancellation Applicant filed evidence in chief in the form of a witness statement dated 18 October 2022 by Richard Penfold of Withers LLP, the representatives, together with five exhibits (RP1-RP5). The exhibits consist of extracts and Wayback machine extracts of the Cancellation Applicant's website in order to show use of their mark and 'Flex products'. The Cancellation Applicant's mark was not subject to proof use and therefore, the evidence provided here is of little assistance to them.

9. The Cancellation Applicant filed a second witness statement from Richard Penfold dated 30 March 2023 together with a further 13 exhibits (RP6- RP19). This evidence is formed of extracts (from the Wayback Machine) of websites of other companies that offer goods and services that are the subject of these proceedings to try and show similarity between them. It also contains state of the register evidence with no supporting evidence showing their use on the market. Again, this evidence is of little assistance to the Cancellation Applicant's arguments. I do not know what these companies have their marks registered for, or whether they have separate marks for different parts of their businesses and I must make my decision on the basis of the registrations that are before me.

Section 47:

10. Section 47 of the Act states as follows:

> "47. –
>
> (1) […]
>
> (2) The registration of a trade mark may be declared invalid on the ground –
>
> (a) that there is an earlier trade mark in relation to which the conditions

set out in section 5(1), (2) or (3) obtain, or

(b) [….]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.
Provided that this shall not affect transactions past and closed."

11. The trade mark upon which the Cancellation Applicant relies qualifies as an earlier trade mark because it was applied for at an earlier date than the contested marks pursuant to section 6 of the Act. The earlier mark is not subject to the proof of use requirements pursuant to section 6A of the Act. This is because it had not completed its registration processes more than 5 years before the filing date of the mark in issue. The Cancellation Applicant can, therefore, rely upon all of the goods for which its mark is registered.

Section 5(2)(b)

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

Case law

13. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("the CJEU") in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel 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

14. Section 60A of the Act provides:

> "(1) For the purpose of this Act goods and services-
>
> (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.
>
> (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
>
> (2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

15. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

16. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)* ('Meric'), Case T-133/05, the General Court ("the GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

18. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

19. The Parties' respective specifications are:

Registered Proprietor's Goods	**Cancellation Applicant's Goods**
	Class 4: Electrical energy from renewable sources; Electrical energy from solar power; Electrical energy.
Class 9: Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; solar panels; photovoltaic apparatus and installations for generating solar electricity; portable solar panels; batteries; sealed batteries; solar batteries; rechargeable batteries; chargers for batteries; boxes for batteries; mountings and casings for solar panels and batteries; control units for the distribution of electricity; electricity inverters; inverters for power supplies; televisions, satellite decoders, DVD players, radios and other electronic apparatus for use with solar panels; chargers for mobile phones and other	

electronic apparatus; battery chargers for laptop computers; remote monitoring apparatus; monitoring instruments; communication hubs; communications equipment; wireless communications equipment; computer networking and data communications equipment; computer software for use in remote meter monitoring; meters; meter reading apparatus and instruments; gas meters; water meters; electronic water meters; electricity meters, measuring equipment, fuel dispensing, metering and storage equipment and systems; smoke detectors, gas detectors, carbon monoxide detectors; wireless communications equipment; wireless communications apparatus and instruments; parts, fittings and accessories for all the aforesaid goods.	
Class 11: Apparatus for lighting, heating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; solar heating installations; solar heating panels, solar panels used in heating and lighting; lamps powered by solar panels; electric lamps; mountings and casings for solar panels; refrigerators; electric fans; gas stoves; LPG gas stoves; parts, fittings and accessories for all the aforesaid goods.	

Class 9:

Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; control units for the distribution of electricity;

20. I consider that the above goods could share an overlap in purpose regarding using electricity in order to power things. There could also be an overlap in trade channels. I find that the goods are essential for the use of each other and it is reasonable for the average consumer to believe they are provided by the same undertaking which would mean the goods are complementary. I do not believe them to share use or users nor to be in competition. I find the goods to be similar to a medium degree.

Solar panels; photovoltaic apparatus and installations for generating solar electricity; portable solar panels;

21. I believe that the users of the above goods from the proprietor's specification will overlap with those of the Cancellation Applicant's 'Electrical energy from solar power'. As solar energy can be used to power a premises, there is also an overlap of use. However, the nature and the purpose differ. Regarding the trade channels, I believe that these also differ. I don't believe they are complementary. The Cancellation Applicant made submissions and referred to the evidence filed alongside the second witness statement regarding these goods being complementary. For there to be complementarity, there is a two part test: firstly, that the goods/services must be indispensable/essential for the use of each other and secondly, that the average consumer may reasonably expect the same undertaking to provide both.[1] I understand that the first part of the test might be satisfied here, solar panels are necessary to the production of solar electricity. However, I find that the second test fails and the average consumer would not necessarily expect their energy companies to be selling solar panels as well. Indeed, some of the evidence provided by the Cancellation Applicant show these goods as being tie-ins.[2] I therefore find these goods to be similar to between a low and medium degree.

[1] *Boston Scientific Ltd v OHIM*, Case T-325/06
[2] Exhibit RP10, page 13 "The French-owned energy giant is looking for 100 homes to trial its Sunplug scheme, which is being offered in conjunction with established solar supplier Lightsource"
Exhibit RP16, Octopus Energy website shows four different brand logos under the heading 'Solar PV' and an offer of £200 off with LUXPOWER for Octopus customers.

Batteries; sealed batteries; solar batteries; rechargeable batteries; chargers for batteries; boxes for batteries;

22. I consider there to be a shared purpose between the above goods from the Registered Proprietor's specification and the Cancellation Applicant's 'Electrical energy' as both are intended to power other items. There could also therefore be an overlap in use and user. The nature differs as do the trade channels. It could be argued that they are in competition however, for the most part consumers do not get to choose whether to power something by electricity or by battery, they would need to choose the item which fits their needs in that respect and that is where the competition lies rather than the goods in question. They are not complementary as they fail the first test of being indispensable for one another. I therefore find these goods to be similar to a low degree.

Mountings and casings for solar panels and batteries;

23. As I mentioned in paragraph 21 above, the use and users of the above goods from the proprietor's specification will overlap with those of the Cancellation Applicant's 'Electrical energy from solar power' however it is further apart in this instance as these mountings and casings will be used in order to affix the solar panels rather than being the source of energy itself. Again, the nature and the purpose differ along with the trade channels. They are not in competition nor are they complementary. I find these goods to be similar to a low degree.

Electricity inverters; inverters for power supplies;

24. Given that I have been given no evidence from the parties regarding these goods, I believe these goods are related to changing voltage/current of electrical energy and therefore, they could be used in the supply of electricity to properties and businesses and therefore, they could overlap in use and user. However, the nature and the purpose differ along with the trade channels. They are not in competition nor are they complementary. I find these goods to be similar to a low degree.

Televisions, satellite decoders, DVD players, radios and other electronic apparatus for use with solar panels; chargers for mobile phones and other electronic apparatus; battery chargers for laptop computers;

25. Although these goods use electricity to work (whether that be from solar energy or not) and that the users, being the general public, might overlap with that of the Cancellation Applicant's 'Electrical energy from solar power', I consider that there is no other overlap of the *Treat* criteria and that a shared user is not sufficient for a finding of similarity. I therefore find these goods to be dissimilar.

Remote monitoring apparatus; monitoring instruments;

26. I find that the above goods from the Registered Proprietor's specification are extremely wide and although there maybe some monitoring apparatus/instruments used in the supply of electricity, there are no further overlaps of the *Treat* criteria and I therefore find them to be dissimilar.

Communication hubs; communications equipment; wireless communications equipment; wireless communications equipment; wireless communications apparatus and instruments; computer networking and data communications equipment; measuring equipment, fuel dispensing,

27. On application of the *Treat* guidance, I cannot see any overlap with the above goods with the Cancellation Applicant's goods and I therefore find them to be dissimilar.

Meters; meter reading apparatus and instruments; computer software for use in remote meter monitoring; metering and storage equipment and systems; electricity meters

28. It is my understanding that meters and their reading apparatus are used in the supply of electricity to assess how much electrical energy is used by each consumer in order to charge for that usage. Therefore, I do feel that these goods are complementary to the Cancellation Applicant's 'electrical energy'. They would also

share users and have an overlap in purpose and trade channels. They differ in nature and are not in competition. I therefore find them to be similar to a medium degree.

Gas meters; water meters; electronic water meters;

29. Although I have found meters more generally to be similar to a medium degree, these goods from the RPs specification are different as they are specifically for gas and water meterage, therefore the users are different- water and gas companies as opposed to electric companies and their customers. They would not be complimentary either nor would they share purpose or trade channels and therefore, I find them to be dissimilar.

Smoke detectors, gas detectors, carbon monoxide detectors;

30. On application of the *Treat* guidance, I cannot see any overlap with the above goods with the Cancellation Applicant's goods and I therefore find them to be dissimilar.

Parts, fittings and accessories for all the aforesaid goods.

31. With regard to the term 'parts and fittings for the aforesaid goods' in this class, to the extent that the parts and fittings relate to goods where I have found similarity then there will be a degree of similarity between the parts and fittings and the Cancellation Applicant's goods

Class 11

Apparatus for lighting, heating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; lamps powered by solar panels; electric lamps; refrigerators; electric fans;

32. As per para 25 above, although these goods use electricity to work (whether that be from solar energy or not) and that the users, being the general public, might overlap with that of the Cancellation Applicant's 'Electrical energy', I consider that there is no

other overlap of the *Treat* criteria and that a shared user is not sufficient for a finding of similarity. I therefore find these goods to be dissimilar.

Gas stoves; LPG gas stoves;

33. On application of the *Treat* guidance, I cannot see any overlap with the above goods with the Cancellation Applicant's goods and I therefore find them to be dissimilar.

Solar heating installations; solar heating panels, solar panels used in heating and lighting;

34. I believe the same assessment applies here as at paragraph 21 above and therefore I find these goods to be similar to between a low and medium degree.

Mountings and casings for solar panels;

35. I believe the same assessment applies here as at paragraph 23 above and therefore I find these goods to be similar to a low degree.

Parts, fittings and accessories for all the aforesaid goods

36. With regard to the term 'parts and fittings for the aforesaid goods' in this class, to the extent that the parts and fittings relate to goods where I have found similarity then there will be a degree of similarity between the parts and fittings and the Cancellation Applicant's goods.

37. In *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, Lady Justice Arden stated that:

> "49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be

considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

38. Therefore, as I have found no similarity between the following goods from the RPs specification, the opposition will fail in relation to them:

> Class 9: Televisions, satellite decoders, DVD players, radios and other electronic apparatus for use with solar panels; chargers for mobile phones and other electronic apparatus; battery chargers for laptop computers; Remote monitoring apparatus; monitoring instruments; Communication hubs; communications equipment; wireless communications equipment; wireless communications equipment; wireless communications apparatus and instruments; computer networking and data communications equipment; measuring equipment, fuel dispensing; Gas meters; water meters; electronic water meters; Smoke detectors, gas detectors, carbon monoxide detectors.
>
> Class 11: Apparatus for lighting, heating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; lamps powered by solar panels; electric lamps; refrigerators; electric fans; gas stoves; LPG gas stoves.

39. The opposition will continue in respect of the following goods:

> Class 9: Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; solar panels; photovoltaic apparatus and installations for generating solar electricity; portable solar panels; batteries; sealed batteries; solar batteries; rechargeable batteries; chargers for batteries; boxes for batteries; mountings and casings for solar panels and batteries; control units for the distribution of electricity; electricity inverters; inverters for power supplies; computer software for use in remote meter monitoring; meters; meter reading apparatus and instruments; metering and storage equipment and systems; electricity meters; parts, fittings and accessories for all the aforesaid goods.

> Class 11: solar heating installations; solar heating panels, solar panels used in heating and lighting; mountings and casings for solar panels; parts, fittings and accessories for all the aforesaid goods.

Average consumer and the purchasing act

40. The average consumer is deemed to be reasonably well informed and reasonably 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

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

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

42. The average consumer of the goods still at issue will predominantly be the general public although there will also be business consumers. In purchasing these goods, the consumer will likely be paying attention to things such as cost, reviews, efficiency and suitability. The costs of such goods will range greatly, between low for items such as batteries to much higher costs for solar panels and ongoing commitments for electrical energy. The parties agreed at the hearing that the level of attention will vary depending on the goods. Therefore, I consider that the average consumer will pay between a medium and high level of attention depending on the goods.

43. All of the goods in question are likely to be purchased following visual inspection either through print or on the internet or on comparison sites or, for goods such as batteries, a physical inspection in a shop. I do not rule out an aural aspect to the selection process from sales persons or word of mouth recommendations.

Comparison of the marks

44. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

45. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

46. The respective trade marks are shown below:

Contested mark	Earlier mark
FLEXX BY BBOXX	FLEX

47. The contested mark is a word mark made up of three words. The Cancellation Applicant claimed that 'FLEXX' played an independent distinctive part in the contested mark however, I find that the overall impression of the mark lies in the combination of the three words.

48. The earlier mark is also a word mark but consists of only one word and therefore, the overall impression lies in that word.

49. Visually, the contested mark comprises of three words which totals 12 letters. The earlier mark is one word of four letters which are identical to the first four letters of the contested mark. I therefore find the marks to be visually similar to no more than a medium degree.

50. Aurally, the earlier mark will be given its ordinary everyday pronunciation. As far as the contested mark goes, I consider that the first word will be pronounced identically to the earlier mark and that the extra 'X' on the end will likely not change the pronunciation. 'By' will also be given its ordinary everyday pronunciation and I consider 'Bboxx' will either be pronounced as bee-box or box. In either case, it has no replication in the earlier mark, nor does 'by' but the first words have identical pronunciation and therefore, I find the marks to be similar to no more than a medium degree.

51. Turning to the conceptual meanings of the marks, the Registered Proprietor put forward the dictionary definitions in their skeleton argument for the Applicant's mark, which I consider to be fair, as follows:

a. a flexible insulated electric cable
b. flexibility or pliability
c. to bend or be bent

52. For the contested mark, the Registered Proprietor said that 'FLEXX' has no meaning at all however, I consider that the average consumer will likely see the word 'FLEXX' as a misspelling of 'Flex' and assign the same meanings as mentioned above. 'By BBoxx' is likely to give them the impression of being the provider of 'Flexx'. I therefore find the marks to be conceptually similar to between a medium and high degree.

Distinctive Character of the Earlier Marks

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber* and *Attenberger* [1999] ECR I-0000, paragraph 49).
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> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

54. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

55. The Cancellation Applicant made no claim of enhanced distinctiveness and their evidence does not support a finding of such. I will therefore consider the position based solely on its inherent distinctiveness.

56. The earlier mark comprises of one ordinary dictionary term which does not appear to be descriptive or allusive of the goods and services offered. I therefore find the mark to be inherently distinctive to a medium degree.

Likelihood of confusion

57. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e., a lesser degree of similarity between the respective goods and services may be offset by a greater degree of similarity between the marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

58. I have found as follows:

a) The remaining goods at issue vary from being similar to between a low and a medium degree.

b) The average consumer is a member of the general public or a professional user, who will pay between a medium and a high degree of attention during the purchasing process.

c) The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.

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d) The overall impression of the contested mark lies in the combination of the three words. The overall impression overall impression of the earlier mark lies in that one word

e) The marks are visually and aurally similar to no more than a medium degree and conceptually similar to between a medium and high degree.

f) The earlier mark is inherently distinctive to a medium degree.

59. I note that the first four letters of both marks are identical however, I find that the additional two words at the end of the contested mark will not go unnoticed by the average consumer, particularly paying between a medium and high degree of attention and when the overall impression of the Registered Proprietor's mark lies in the combination of those words therefore, they will not directly confuse the marks.

60. I will now go on to consider the possibility of indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

> "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)".

61. These examples are not exhaustive but provide helpful focus as was confirmed by Arnold LJ *in Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

> "This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be and exhaustive definition."

62. This type of confusion arises where the average consumer recognises that the marks are different but, because of a common element(s), concludes that the marks emanate from the same or economically linked undertakings. In the present case, I see such confusion arising because the coincidence of 'FLEX' and 'FLEXX' which is phonetically identical but with different spellings would lead an average consumer to believe that they are related undertakings, especially as the average consumer does not compare the marks side by side. Imperfect recollection of the marks could easily lead to a misremembering of the spelling of FLEX/FLEXX.

63. I find that the addition of the words ‘BY BBOXX’ will cause average consumers to consider that the mark is a sub-brand or brand extension and that ‘BBOXX’ is responsible for the ‘FLEX/FLEXX’ brand due to the imperfect recollection of the spelling of these words. I therefore consider that indirect confusion is likely to occur.

Conclusion

64. The declaration of invalidity is successful in relation to the following goods:

> Class 9: Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; solar panels; photovoltaic apparatus and installations for generating solar electricity; portable solar panels; batteries; sealed batteries; solar batteries; rechargeable batteries; chargers for batteries; boxes for batteries; mountings and casings for solar panels and batteries; control units for the distribution of electricity; electricity inverters; inverters for power supplies; computer software for use in remote meter monitoring; meters; meter reading apparatus and instruments; metering and storage equipment and systems; electricity meters; parts, fittings and accessories for all the aforesaid goods.
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> Class 11: solar heating installations; solar heating panels, solar panels used in heating and lighting; mountings and casings for solar panels; parts, fittings and accessories for all the aforesaid goods.

65. The declaration of invalidity fails in relation to the following goods and the registration of them will remain:

> Class 9: Televisions, satellite decoders, DVD players, radios and other electronic apparatus for use with solar panels; chargers for mobile phones and other electronic apparatus; battery chargers for laptop computers; Remote monitoring apparatus; monitoring instruments; Communication hubs; communications equipment; wireless communications equipment; wireless communications equipment; wireless communications apparatus and instruments; computer networking and data communications equipment;

measuring equipment, fuel dispensing; Gas meters; water meters; electronic water meters; Smoke detectors, gas detectors, carbon monoxide detectors.

Class 11: Apparatus for lighting, heating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; lamps powered by solar panels; electric lamps; refrigerators; electric fans; gas stoves; LPG gas stoves.

Costs

66. The guidance for awards of costs are set out in TPN 2/2016.

67. On reviewing the matters at hand, I consider that both parties have had some level of success and some failure. It is my view that on this occasion, the fairest basis to deal with costs is for each party to bear their own in this matter.

68. I therefore make no award of costs in this matter.

Dated this 30th day of October 2023

L Nicholas
For the Registrar